

Decision for dispute CAC-UDRP-103708

Case number	CAC-UDRP-103708
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Time of filing	2021-03-31 08:39:57
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Domain names	bollorelogistics.info
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Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)
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Complainant

Organization	BOLLORE SE
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Complainant representative

Organization	Nameshield (Enora Millocheau)
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Respondent

Organization	BOLLORE LOGISTICS AUSTRALIA PTY LTD
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registrant, among others, of the following trademarks:

- international trademark registration No. 1025892 "Bolloré LOGISTICS", registered on July 31, 2009, for goods and services in classes 35, 36 and 39; and

- international trademark registration No. 1302823 "BOLLORÉ LOGISTICS", registered on January 27, 2016, for goods and services in classes 4, 9, 35, 36, 39, 40 and 42.

The disputed domain name was registered by the Respondent on March 14, 2021.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant states that it is one of the 500 largest companies in the world, and it was founded in 1822. The Complainant

points out that it is listed on the Paris Stock Exchange and that it holds strong positions in Transportation and Logistics, Communication and Media, Electricity Storage and solutions. The Complainant underlines that the majority interest of the group's stock is controlled by the Bolloré family. The Complainant adds that the group also manages a number of financial assets including plantations and financial investments. The Complainant points out that its subsidiary BOLLORE LOGISTICS is one of the 10 leading worldwide transport and logistics companies. It adds that, with a presence on the five continents, BOLLORE LOGISTICS offers a large range of modular services extending across seven core categories: Multimodal Transport, Trade Compliance, Contract Logistics, Global Supply Chain, Industrial Projects, E-commerce, and Customer Value. The Complainant points out that it is the owner of several international trademarks containing the word "BOLLORE LOGISTICS".

The Complainant adds that it is also the owner of number of domain names, like for example the domain name <bollore-logistics.com> registered on January 19, 2009. The Complainant observes that the disputed domain name was registered on March 14, 2021 and resolves to the BOLLORE LOGISTICS' official website. The Complainant contends that the disputed domain name is identical to the trademark BOLLORE LOGISTICS, because the disputed domain name includes its trademark in its entirety. The Complainant contends that addition of the top-level domain ".INFO" is not sufficient to escape the finding that the disputed domain name is identical to the Complainant's trademark and does not change the overall impression of the designation as being connected to its trademark. The Complainant contends that the Respondent is not affiliated with nor authorized by BOLLORE in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant states that it does not carry out any activity for, nor has any business with the Respondent. The Complainant adds that neither licence nor authorization has been granted to the Respondent to make any use of the Complainant's trademark BOLLORE LOGISTICS, or apply for registration of the disputed domain name by the Complainant. The Complainant notes that the disputed domain name redirects to the BOLLORE LOGISTICS' official website. The Complainant's contends that the Respondent is not making a bona fide offering of goods or services by means of the disputed domain name, or a legitimate non-commercial or fair use of it. The Complainant considers that the Respondent has no rights or legitimate interests to the disputed domain name. The Complainant states that the disputed domain name is identical to its well-known and distinctive trademark and the associated domain name. The Complainant submits that all the Google results for the expression "BOLLORE LOGISTICS" refers to the Complainant's subsidiary. The Complainant argues that in the WHOIS database the Respondent attempts to pass off as the Complainant's subsidiary in Australia BOLLORE LOGISTICS AUSTRALIA. The Complainant considers that, given the distinctiveness of the Complainant's international trademark and its reputation, the Respondent has registered the disputed domain name in knowledge of the Complainant, which evidences bad faith. The Complainant adds that the disputed domain name redirects to the Complainant's own official website and, due to this fact, it contends that the Respondent has knowledge of the Complainant's rights prior to the registration of the disputed domain name, which is a hallmark of bad faith. The Complainant argues that the disputed domain name has been registered by the Respondent in an effort to take advantage of the good reputation Complainant had built up in its BOLLORE LOGISTICS trademarks, with the sole aim to create a likelihood of confusion with the Complainant's trademarks and domain names. The Complainant contends that the disputed domain name was registered and is being used in bad faith.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has not shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

As Complainant has failed to demonstrate that the second requirement is fulfilled, the Panel shall not examine the Complainant's contentions with regard to registration and use in bad faith.

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the disputed domain name, the Complainant has to demonstrate that:

- (i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) The disputed domain name has been registered and is being used in bad faith.

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark or service mark rights. There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark. The Complainant has proven ownership, among others, of the registered trademark "BOLLORÉ LOGISTICS", identified in section "Identification of rights" above. On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain name itself to the Complainant's trademark. The disputed domain name differs from the Complainant's trademark only by the addition of the top-level domain ".INFO". It is well established that merely adding a top-level domain to a trademark is not sufficient to distinguish a domain name from a trademark (see, for example, CAC Case No. 100831). Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or
- (iii) [the Respondent] [is] making a legitimate non-commercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name. The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative".

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in a domain name. As clarified by other panels, the Respondent's failure to submit a response does not imply that the Complaint should automatically be successful (see, for example, CAC Case No. 101183).

The Complainant states:

- that the Respondent is not affiliated with nor authorized by BOLLORE in any way;
- that it does not carry out any activity for, nor has any business with the Respondent;
- that neither licence nor authorization has been granted to the Respondent to make any use of the Complainant's trademark BOLLORE LOGISTICS, or apply for registration of the disputed domain name by the Complainant;
- that the disputed domain name redirects to the BOLLORE LOGISTICS' official website.

In the Panel's opinion, taking into account the fact that the Respondent's company name is BOLLORE LOGISTICS AUSTRALIA PTY LTD, the Complainant has not made a prima facie case which demonstrates that the Respondent has no rights or legitimate interest in the disputed domain name. The Panel observes that, in the light of the fact that the words BOLLORE LOGISTICS are followed by the geographic name related to the place where the company is based ("Australia"), and by the abbreviation for its type of company ("PTY LTD", which is the abbreviation for "proprietary limited company"), it is possible to identify the distinctive part of the Respondent's business name as BOLLORE LOGISTICS. Consequently, the Panel is convinced that, on the balance of probabilities, the Respondent may be commonly known as the disputed domain name. Other panels have considered that being commonly known by a name substantially corresponding to the disputed domain name may prevent the establishment of the proof that the Respondent does not have any right or legitimate interest in the disputed domain name (see, for example, WIPO Case No. D2015-0467). The Panel shares this view. As regards the alleged passing off, no evidence of such conduct has been provided, and in any case the Panel finds that this matter falls outside the scope of the UDRP. It is well established that if a Panel makes a finding that the matter is outside the scope of the UDRP because it involves a business dispute between two parties, the Panel may dismiss the Complaint (see, for example, FORUM Case No. FA1902001829345). Indeed, this issue is not suited for resolution under the UDRP, which is designed to address clear cases of abusive cybersquatting (see, for example, WIPO Case No. D2016-0181). In this case, where the Respondent appears to be BOLLORE LOGISTICS AUSTRALIA PTY LTD, the Complainant's allegation that "the Respondent attempts to pass off as the Complainant's subsidiary in Australia BOLLORE LOGISTICS AUSTRALIA", is, in the view of the Panel, a question which falls outside the scope of the UDRP and for this reason the Complaint should be rejected.

As regards the argument based on the fact that the disputed domain name redirects to the BOLLORE LOGISTICS' official website, it should be observed that other panels have considered the direct link to a complainant's website as passive use (see, for example, WIPO Case No. D2007-1231). Even if this argument concerns mainly the assessment of bad faith, as it has been mentioned both in support of the second element and of the third element, the Panel will examine it here under both points of view. The Panel considers that, even if in abstracto the above-mentioned use could be, in specific circumstances, as evidence of bad faith, in the circumstances of this particular Complaint, where the Respondent appears to be BOLLORE LOGISTICS AUSTRALIA PTY LTD, no finding that the disputed domain name has been registered and used in bad faith can be made. Furthermore, linked to the above consideration on the third element, and because of the issue of the alleged passing off which falls outside the scope of the UDRP, the Panel considers that the fact that the disputed domain name resolves to the Complainant's website is not, per se, evidence of the Respondent's lack of rights or legitimate interests in the disputed domain name.

In view of all the above, and without prejudice to the right of the Complainant to submit the dispute to the courts of competent jurisdiction, the Panel finds that the Complainant has failed to demonstrate that the Respondent has no rights or legitimate interests in the disputed domain name and resultantly the Complaint fails under paragraph 4(a)(ii) of the Policy.

BAD FAITH

As the Complaint is rejected for the reasons above, the Panel shall not examine the Complainant's contentions with regard to registration and use in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **BOLLORELOGISTICS.INFO**: Remaining with the Respondent

PANELLISTS

Name	Michele Antonini
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DATE OF PANEL DECISION	2021-05-02
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Publish the Decision