

Decision for dispute CAC-UDRP-103915

Case number	CAC-UDRP-103915
Time of filing	2021-07-07 09:16:31
Domain names	boursorama-s2s.com, boursorama-ss2.com

Case administrator

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

Organization	BOURSORAMA SA
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Complainant representative

Organization	Nameshield (Enora Millocheau)
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Respondent

Name	zack levy
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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 names.

IDENTIFICATION OF RIGHTS

The Complainant relies on its various registered marks including its EU Trade Mark no. 001758614 for the word mark BOURSORAMA registered on 19/10/2001 in classes 9, 16, 35, 36, 38, 41 and 42. It also has various subsequent national registered marks in France. It also relies on its use online of its related domain names, including <boursorama.com> registered in 1998. Further it relies on the protection offered by French national laws on unfair competition.

FACTUAL BACKGROUND

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

Founded in 1995, BOURSORAMA S.A., the Complainant, was one of the very first online financial platforms in Europe. It grew into a market leader in its three core businesses: online brokerage, financial information on the Internet and online banking. Today in France, BOURSORAMA is a leading online banking provider and its portal at www.boursorama.com has millions of customers.

The disputed domain name <boursorama-ss2.com> was registered on 27 June 2021 and is inactive. The disputed domain

name <boursorama-s2s.com> was registered on 30 June 30 2021 and resolves to an error page.

These same parties were involved in a dispute in this forum earlier this year, CAC case no. 103813. That case concerned the two domain names: <boursorama-dps2d.com> and <boursoramadsp2.com>. The Complainant succeeded in that case in May 2021 and those domains were found to have been registered and used in bad faith.

In that case the added material was "DPS2" there representing "Directive on Services for Payment with 2 factors" a commonly used abbreviation and name, for the Directive (EU) 2015/2366 of 25 November 2015 on payment services in the internal market, amending Directives 2002/65/EC, 2009/110/EC and 2013/36/EU and Regulation (EU) No 1093/2010, and repealing Directive 2007/64/EC. The Panel found the added abbreviation related to the Complainant's banking activities and, as combined with the Complainant's well known trademark BOURSORAMA, did not avoid confusing similarity between the disputed domain names and the Complainant's trademark.

Here the Complainant says the additional material in the disputed domain names is also an abbreviation and a misspelt version of the term "PSD2" (meaning "Payments Service Directive 2", referring to a Directive of the European Parliament on payment services within the internal market.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant alleged that the disputed domain names are confusingly similar to its trademark BOURSORAMA as the disputed domain names include the Complainant's BOURSORAMA trademark in its entirety, while the additional material does not change the overall impression of the designation. It says it is well-established that "a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP". Please see WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasily Terkin.

References:

- WIPO Case No. D2000-1164, Boeing Co. v. Bressi;
- The Forum Case No. FA 1773444, Ashley Furniture Industries, Inc. v. Joannet Macket / JM Consultants;
- CAC Case No. 101131, BOURSORAMA v. PD Host Inc - Ken Thomas;
- WIPO Case No. D2017-1463, Boursorama SA v. Estrade Nicolas.

The Complainant further asserts that the Respondent is not commonly known by the disputed domain names, and was neither licensed nor otherwise authorized by the Complainant to use its trademark BOURSORAMA as part of the disputed domain names. Further, the disputed domain names are not used in relation with a website and the Respondent did not make any use of disputed domain names since its registration, and the Respondent has no demonstrable plan to use the disputed domain names since its registration. Therefore the Respondent does not have any rights or legitimate interest in the disputed domain names. See for instance the Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com>.

As to Bad Faith, the Complainant's trademark BOURSORAMA is well known and the Complainant contends that it is therefore reasonable to infer that the Respondent has registered the disputed domain names with full knowledge of the Complainant's trademark BOURSORAMA.

References

- WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows;
- WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen.

RESPONDENT:

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, to the satisfaction of the Panel, 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

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

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

The Complainant says the disputed domain names are confusingly similar to its registered trademarks as they contain the Complainant's trademark in its entirety with the addition of some new characters which do not alter the impression or that fact. Indeed, when a distinctive trademark is paired with less distinctive terms, the combination will typically be found to be confusingly similar to the distinctive trademark. See WIPO - D2007-1140 - MasterCard International Incorporated v. Michael J Yanda, Indy Web Productions and WIPO - D2001 0026 - Arthur Guinness Son & Co. (Dublin) Limited. v. Tim Healy/BOSTH and WIPO - D2000 1487 - Heineken Brouwerijen B.V. v. Mark Lott.

As the Panel found in the previous case between these parties, the new characters/terms are conceptually closely linked to the banking and financial services world, and therefore likely to increase the risk of confusion. Further, they do not change the overall impression that the registrant is connected to the Complainant or prevent the likelihood of confusion or association.

Moreover, the mark BOURSORAMA is a fanciful term, distinctive only for the Complainant. It has no ordinary meaning whatsoever in English, French or in any other language. A Google search of the expression BOURSORAMA displays several results, all of them related to the Complainant.

Thus the Panel finds the disputed domain names are confusingly similar to the Complainant's trademark.

As to whether the respondent lacks rights or legitimate interest in the disputed domain name, according to WIPO case no. D2003-0455, "Croatia Airlines d.d. v. Modern Empire Internet Ltd.", the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden shifts to the Respondent to demonstrate rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy.

In this case, the Complainant says the Respondent is not affiliated with it nor authorized by it in any way and the Complainant

does not carry out any activity for, nor has any business with, the Respondent. On the fact of it the Respondent has no rights or legitimate interests in the disputed domain names and is not related in any way to its business. Past panels have held a Respondent not commonly known by a domain name if the Whois information was not similar to the domain name and here the Respondent is not known as "BOURSORAMA". See the Forum Case - FA699652 - Braun Corp. v. Loney and Forum Case - FA139720 - Tercent Inc. v. Lee Yi. Furthermore, the disputed domain names resolve to an inactive page ("passive holding") since registration, so there is no use. The Respondent has not come forward and has advanced no basis on which we could conclude that he has a right or legitimate interest in the domain names and none is obvious on the face of the matter. See WIPO Case No. D2000-1164, Boeing Co. v. Bressi and the Forum Case No. FA 1773444, Ashley Furniture Industries, Inc. v. Joannet Macket / JM Consultants. Therefore, the Panel finds the Respondent has no rights or legitimate interests in respect of the disputed domain names.

As to whether the disputed domain names have been registered and are being used in bad faith, a Google search on the expression BOURSORAMA displays several results, all of them related to the Complainant. See CAC Case No. 101131, BOURSORAMA v. PD Host Inc - Ken Thomas and WIPO Case No. D2017-1463, Boursorama SA v. Estrade Nicolas. The disputed domain names are confusingly similar with the Complainant's well known trademarks BOURSORAMA. Thus, given the distinctiveness of the Complainant's trademark and its reputation, and given the fact of the previous case, between these same parties over similar marks, the Panel finds this Respondent registered the disputed domain names with full knowledge of the Complainant's trademarks and the intention to free-ride on them. Here there was clearly actual knowledge due to the previous case.

The Complainant has discharged its burden of proof on all three limbs of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOURSORAMA-S2S.COM**: Transferred
2. **BOURSORAMA-SS2.COM**: Transferred

PANELLISTS

Name	Victoria McEvedy
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DATE OF PANEL DECISION	2021-08-10
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Publish the Decision