

Decision for dispute CAC-UDRP-104004

Case number CAC-UDRP-104004

Time of filing 2021-09-02 09:53:54

Domain names mutuelle-macif.com

Case administrator

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

Complainant

Organization MACIF

Complainant representative

Organization IP TWINS

Respondent

Name Wang Xian Sheng

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 a mutual benefit insurance company of France. It existed and has been active under the acronym MACIF since its establishment back in 1960.

The Complainant MACIF is the registered owner of a number of trademarks comprising the denomination MACIF alone or in combination with a logo or descriptive terms. It has submitted documents demonstrating numerous trademark rights, incl. specifically the following trademark registrations:

i) International trademark MACIF N° 529935 registered on 24 November 1988, duly renewed and designating services in international class 36;

ii) International trademark MACIF N° 529934 registered on 24 November 1988, duly renewed and designating services in international class 36.

The Complainant is also the owner of <macif.com> registered on 5 March 1997. Its main domain name is <macif.fr> registered on 23 April 1997. These domains are actively used in connection with the Complainant's official website.

FACTUAL BACKGROUND

The Complainant is Mutuelle Assurance des Commerçants et Industriels de France et des cadres et salariés de l'industrie et du commerce (MACIF). The Complainant is a French mutual insurance company founded in Niort, France, in 1960.

The term "MACIF" is an acronym which has not in itself a specific meaning in French or in English, except that this acronym refers to the name of the Complainant "Mutuelle Assurance des Commerçants et Industriels de France et des cadres et salariés de l'industrie et du commerce".

The Complainant submits that its earlier trademarks MACIF enjoy a wide-spread continuous reputation, particularly on the French market. This is evidenced by the large number of client members and subscribers of the Complainant, and provides evidence of the receipt of the "Argus" award for the best external communication campaign in the insurance category.

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, 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. The Panel notes there were no language requests and/or statements made in the present matter. Paragraph 11(a) allows the Panel to determine the language of the proceedings having regard to all the circumstances, which in this occasion the Panel finds it to be English.

PRINCIPAL REASONS FOR THE DECISION

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- (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.

Reasons for Decision

I. Identical or Confusingly Similar

The Complainant provided evidence of its rights in the MACIF trademarks (as stated above), as well as submitted evidence, backing that the MACIF trademarks are well-known.

The Panel finds that the disputed domain name reproduces entirely the MACIF trademark from the Complainant, with the addition of the generic and descriptive term "mutuelle".

The Panel notes that the Complainant is a mutual insurance company (in French, "société d'assurance mutuelle"). The addition of the term "mutuelle" in the disputed domain name together with the acronym MACIF is confusingly similar to the Complainant's trademarks, but also reinforces the likelihood of confusion in the mind of the general public.

As per the top-level domains (.com), these are not significant in determining whether the domain name is identical or confusingly similar to the rights of the Complainant.

Therefore, 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).

B. The Respondent has no rights or legitimate interests in respect of the disputed domain name

The registered owner and the Respondent is ("Wang Xian Sheng"), of Hebei, China.

The Panel agrees with the Complainant and has not found evidence that the Respondent is known by the disputed domain name, nor that the Respondent has been commonly known by the disputed domain name (nor as an individual or business).

In this respect, the Panel found that WIPO has recently issued a decision against the same Respondent, (See WIPO Case No. D2021-2583, *Compagnie Générale des Etablissements Michelin v. (Wang Xian Sheng)*), in which similar circumstances occurred.

The Panel notes, as per the Complainant's statements, that the Respondent reproduces the Complainant's registered trademarks MACIF in the disputed domain name without any license or authorisation from the Complainant, and is not using the disputed domain name in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use.

To the contrary, the disputed domain name redirects users to a website which are unrelated to the term "mutuelle" or "macif" (also not to be found in Chinese characters on the website). The disputed domain name rather redirects to a different website (in Chinese), that promotes and encourages Internet users to make money on said website (e.g. providing as example an individual that made a lot of money using the system promoted on said site).

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a prima facie showing that a respondent possesses no rights or legitimate interests in a domain name, and the burden of production shifts to the respondent. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. D2008-1393.

Based on all the facts stated above, 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).

C. The disputed domain name has been registered and is being used in bad faith

The Panel finds that the Respondent's actions indicate that the Respondent registered and is using the disputed domain name in bad faith.

Taken the notoriety and well-known MACIF trademarks, it is unlikely that the use of the MACIF acronym by the Respondent is due to coincidence. The Panel agrees with the Complainant that the Respondent had the Complainant's name and trademark in mind (especially by adding the descriptive term "mutuelle") when registering the disputed domain name. This was most likely done in the hope and expectation that Internet users searching for the Complainant's services and products would instead come across the Respondent's site. Such use of the domain names cannot be seen as being performed in good faith.

The Respondent's choice of the disputed domain name cannot have been accidental and must have been influenced by the fame of the Complainant and its earlier trademarks.

The Panel also noted the previous Decisions stated by the Complainant that have established the notoriety of the MACIF trademark in the past (See for example WIPO Case No. D2003-0083, Mutuelle Assurance des Commerçants et Industriels de France et des Cadres et Salaries de L'industrie et du Commerce (MACIF) v. Mr. Pierre Gricourt, as well as ADR Case 103551).

As per the use, previous panels have found that continuous use of the disputed domain name to redirect Internet traffic to an unrelated site does, constitute use in bad faith (See as an example, WIPO Case No. D2015-1400 Western Woods Distributing, Inc. v. Domains By Proxy, LLC, DomainsByProxy.com / Mike Mallon).

Additionally, the Panel found that WIPO has recently issued a decision against the same Respondent, (See WIPO Case No. D2021-2583, Compagnie Générale des Etablissements Michelin v. (Wang Xian Sheng)), in which very similar circumstances occurred in comparison to the present dispute.

Based on all the circumstances and evidence presented in this case, the Panel finds that the Respondent acquired and is using the disputed domain name to attract Internet users by creating a likelihood of confusion with the Complainant's earlier marks, and to intentionally deceive Internet users.

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).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MUTUELLE-MACIF.COM**: Transferred

PANELLISTS

| | |
|------|-----------------------------|
| Name | Laura Martin-Gamero Schmidt |
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DATE OF PANEL DECISION 2021-11-15

Publish the Decision
