Decision for dispute CAC-UDRP-100995

Case number	CAC-UDRP-100995
Time of filing	2015-06-04 15:33:20
Domain names	boursoramasecuritycheck.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	BOURSORAMA S.A.

Complainant representative

Organization	Nameshield (Anne Morin)

Respondent

Organization	Stephane Arninda

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings to the Panel's knowledge.

IDENTIFICATION OF RIGHTS

The Complainant relies on its various registered marks including and commencing with its Community Trade Mark no. 001758614 for the word mark BOURSORAMA applied for on 13/07/2000 and registered on 19/10/2001 and various subsequent registered national marks in France. It also relies on its use online of its various 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. One of the earliest of the emerging e-commerce providers, it enjoyed substantial growth due to its continuous expansion of its products and grew into a pioneer and market leader in its three core businesses: online brokerage, financial information on the Internet and online banking. Today in France, BOURSORAMA is the leading online banking provider at its portal www.boursorama.com with over 505,000 customers by late 2013. The Disputed Domain Name <boursoramasecuritycheck.com> was registered on 18 May 2015 by "Stephane Arninda."

The Complainant says the Disputed Domain Name is confusingly similar to its registered trademarks and rights as the Disputed Domain Name contains the Complainant's trademark in its entirety. The addition of the terms "SECURITY" and "CHECK", at the end of the Disputed Domain Name, does not alter 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. Citing: WIPO - D2007-1140 - MasterCard International Incorporated v. Michael J Yanda, Indy Web Productions; WIPO - D2001 0026 - Arthur Guinness Son & Co. (Dublin) Limited. v. Tim Healy/BOSTH and WIPO - D2000 1487 - Heineken Brouwerijen B.V. v. Mark Lott. On the contrary, the terms "SECURITY" and "CHECK" are two expressions closely linked to the banking world, and therefore are more likely to increase the risk of confusion than remove it. Further, they do not change the overall impression that the registrant is connected to the Complainant or prevent the likelihood of confusion or association between the Disputed Domain Name and the Complainant, and its trademarks and domain names. Moreover, the mark BOURSORAMA® is a fanciful term, distinctive only of 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 being related to the Complainant. Thus, the Disputed Domain Name is confusingly similar to the Complainant's trademark.

The Respondent lacks rights or legitimate interest in the Disputed Domain Name. According to the 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 UDRP. 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. The Complainant further says the Respondent has no rights or legitimate interests in the Disputed Domain Name and is not related in any way to its business.

The information regarding the Respondent, provided by Whois for the Disputed Domain Name is "Stephane Arninda." 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". Citing: NAF - FA699652 - Braun Corp. v. Loney and NAF - FA139720 - Tercent Inc. v. Lee Yi. Furthermore, the Disputed Domain Name has resolved to an inactive page (“passive holding”) since its registration. Indeed, the Respondent could not have used the Disputed Domain Name without infringing the Complainant's intellectual property rights. Therefore, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Disputed Domain Name has been registered and is being used in bad faith. According to the Whois information, the Respondent "Stephane Arninda" resides in France, 4 rue de la riviere 75019 Paris. Furthermore, the Complainant's trademarks are well known particularly in France, where it was established since 1995. Indeed, a Google search on the expression BOURSORAMA® displays several results, all of them related to the Complainant. The Disputed Domain Name is confusingly similar with the Complainant's well known trademarks BOURSORAMA®. Thus, given the distinctiveness of the Complainant's trademark and reputation, and given the fact that the Respondent is identified as French, the Respondent registered the Disputed Domain Name with full knowledge of the Complainant's trademarks. Moreover, the Disputed Domain Name has been passively held since its registration. As prior UDRP panels have held, the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use. Citing: WIPO - D2000-0003 - Telstra Corporation Limited v. Nuclear Marshmallows and
WIPO - D2000-0400 - CBS Broadcasting, Inc. v. Dennis Toeppen. On this basis, the Complainant concludes that the Respondent has registered and is using the Disputed Domain Name in bad faith. The Complainant therefore requests the transfer of the Disputed Domain Name.

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. In particular, the service of the Complaint by email to s.arninda@europe.com was confirmed to have been duly sent and relayed and under the Policy, the Complainant was duly served as required.

PRINCIPAL REASONS FOR THE DECISION

In this case, the Complainant's mark is well known in France and publicly available on-line materials prove this reputation. Further, the Complainant's mark is highly inherently fanciful due to the element "orama". The Disputed Domain Name is confusing similar and the addition of the non-distinctive words "Security" and "Check" serve only to focus the consumer on the Complaint's service sector--compounding the likelihood of confusion and confusing similarity.

The Respondent did not come forward to defend its mark and no defence of legitimate rights or use arises on the face of the case. While issues of legitimate use or rights might arise from use of the descriptive and common word Bourse (stock market) alone, the registered mark is unique to, and distinctive of, the Complainant due to the fanciful element "orama."

As to bad faith, the fact of passive holding can be a neutral factor particularly, when as here, it is not clear that revenue is generated. While the evidence on actual use is lacking, we strongly suspect the Disputed Domain Name was registered for email use although there is no evidence it was put to such use. While postmaster@BOURSORAMASECURITYCHECK.COM bounced, it is entirely possible that a different user name might have at some stage worked or been used. While we cannot make a finding without such evidence, it must be noted that the Disputed Domain Name has inherent potential as an instrument for misuse in a serious manner particularly in light of the Complainant's services sector-- online banking and finance.

We note the UDRP imposes a duty to avoid registering the marks of others. We find bad faith in all of the circumstances and particularly in light of the fact that the marks are true reputation marks and are well known in France.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOURSORAMASECURITYCHECK.COM**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2015-07-14

Publish the Decision