Decision for dispute CAC-UDRP-101139

Case number	CAC-UDRP-101139
Time of filing	2015-12-28 08:46:07
Domain names	impaye-lapostemobile.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	LA POSTE

Complainant representative

Organization	Nameshield (Maxime Benoist)

Respondent

Name	RIVERA BERNARD

OTHER LEGAL PROCEEDINGS

The Panel is aware of no other legal proceedings that are pending or decided and that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant states, and provides evidence to support, that it is the owner of a number of trademark and domain name registrations that include LA POSTE and LA POSTE MOBILE, including French Reg. Nos. 3,835,713 (registered May 31, 2011) for LA POSTE MOBILE; and 1,572,869 for LA POSTE (registered December 7, 1989). Complainant cites the following UDRP decisions that have found Complainant owns rights in the LA POSTE and LA POSTE MOBILE trademarks: La Poste contre la Société L et Cie, WIPO Case No D2001-1253 (<la-poste-versailles.com>); La Poste v. William Damien, WIPO Case No. 2001-1378 (<wwwlaposte.com>); and La Poste v. Beugre Leger, WIPO Case No. D2012-2146 (<mandats-laposte.com>).

The disputed domain name was registered on November 20, 2015.

FACTUAL BACKGROUND

Complainant states that it is a subsidiary of the group LA POSTE, a French public limited company and the national postal service. Complainant states that LA POSTE MOBILE is the commercial name of the company La Poste Telecom, a French company created on October 6, 2010, whose activity is a Mobile Virtual Network Operator.

The domain name is not used in connection with an active website.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the 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 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 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

Complainant contends that "the addition of the French word 'IMPAYE' at the beginning of the domain name, which means in English 'unpaid', may suggest that the domain name <impaye-lapostemobile.com> is an official website of La Poste Mobile dedicated to late payments for the mobile subscriptions."

Based upon the trademark registrations cited by Complainant, it is apparent that Complainant has rights in and to the LA POSTE and LA POSTE MOBILE trademarks.

Notably, the disputed domain name contains the LA POSTE MOBILE trademark in its entirety. Previous panels have found that “the fact that a domain name wholly incorporates a complainant’s registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy.” Oki Data Americas, Inc. v. Asdinc.com, WIPO Case No. D2001-0903. See also Hoffmann-La Roche Inc., Roche Products Limited v. Vladimir Ulyanov, WIPO Case No. D2011-1474 (“when a domain name wholly incorporates a complainant’s registered mark, that may be sufficient to establish confusing similarity for purposes of the Policy”).

The addition of certain words, as here, can “exacerbate[ ] the confusing similarity between the [Complainant’s] trademark and the Domain Name and increase[ ] the risk of confusion between the Domain Name and the…trademarks.” Costco Wholesale Corporation and Costco Wholesale Membership, Inc. v. Kenneth Terrill, WIPO Case No. D2010-2124 (citing Playboy Enterprises International, Inc. v. John Taxiarchos, WIPO Case No. D2006-0561 (citing Yellow Corporation v. MIC, WIPO Case No. D2003-0748 (“when a domain name is registered which is a well-known trademark in combination with another word, the nature of the other word will largely determine the confusing similarity”))).

Here, because the word “impaye" may be associated with Complainant’s trademark, this word increases the confusing similarity between the disputed domain name and Complainant’s trademarks. See, e.g., Gateway Inc. v. Domaincar, WIPO Case No. D2006-0604 (finding the domain name <gatewaycomputers.com> confusingly similar to the trademark GATEWAY because the domain name contained “the central element of the Complainant’s GATEWAY Marks, plus the descriptive word for the line of goods and services in which the Complainant conducts its business”).

Accordingly, the Panel finds that Complainant has proven the first element of the Policy.

Complainant contends that, inter alia, "Respondent is not affiliated with nor authorized by LA POSTE in any way"; that "[t]he

information regarding the Respondent, provided by the Whois of the disputed domain name <impaye-lapostemobile.com>, is 'RIVERA BERNARD'" -- not LA POSTE; and that "[n]either licence nor authorization has been granted to the Respondent to make any use of the Complainant's trademarks LA POSTE MOBILE®, or apply for registration of the disputed domain name by the Complainant."

Under the Policy (see WIPO Overview 2.0, paragraph 2.1) "[…] a 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 of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP."

Based on the facts and contentions set out above, the Panel finds that Complainant has established its prima facie case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the Policy.

Complainant contends that, inter alia, "[g]iven the distinctiveness of the Complainant's trademark and reputation it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademarks"; "the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use"; and "the source code page of the website linked to the domain name <impaye-lapostemobile.com> refers to an URL from the official website of the Complainant allowing to connect to the customer's La Poste Mobile account" which "can demonstrate that the Respondent wants to use this domain name in bad faith."

Whether a domain name is registered and used in bad faith for purposes of the Policy may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the Policy: (i) circumstances indicating that the respondent has registered or the respondent has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

The above list is not exhaustive and, instead of citation to anything therein, Complainant largely relies on the "passive holding" doctrine set forth in Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. That case said that an inactive website, as here, can indicate bad faith after evaluating the following factors: (i) whether the complainant's trademark "has a strong reputation and is widely known"; whether (ii) "the Respondent has provided... evidence... of any actual or contemplated good faith use by it of the domain name"; (iii) whether "the Respondent has taken active steps to conceal its true identity, by operating under a name that is not a registered business name"; whether (iv) "the Respondent has actively provided, and failed to correct, false contact details, in breach of its registration agreement"; and whether (v) "taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law."

As numerous panels citing the Telstra decision have made clear, it is not necessary that all of the foregoing factors be in favor of the complainant to find bad faith. In any event, in this case, it is clear that the LA POSTE and LA POSTE MOBILE trademarks are strong and widely known, in light of the extensive international trademark portfolio cited by Complainant and previous UDRP decisions relating to those trademarks; the absence in the case file of any evidence from Respondent of any actual or contemplated good faith use by it of the domain names; and the Respondent's apparent use (as shown in the case file) of a privacy service that previously (prior to the filing of the Complaint) identified Respondent as using a contact email

address with the domain name <myprivateregistration.com> and that was updated by the Registrar only following a verification request from the Czech Arbitration Center. Upon evaluation of the above-listed factors, the Panel concludes that bad faith exists pursuant to the doctrine of passive holding.

Accordingly, the Panel finds that Complainant has proven the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **IMPAYE-LAPOSTEMOBILE.COM**: Transferred

PANELLISTS

Name	**Douglas M. Isenberg**

DATE OF PANEL DECISION 2016-02-10

Publish the Decision