Decision for dispute CAC-UDRP-101160

Case number	**CAC-UDRP-101160**
Time of filing	**2016-01-29 10:38:25**
Domain names	**Boursorama.online**

Case administrator

Name	**Lada Válková (Case admin)**

Complainant

Organization	**BOURSORAMA**

Complainant representative

Organization	**Nameshield (Maxime Benoist)**

Respondent

Name	**Mrugesh Thakkar**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings pending or decided between the same parties and relating to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of word mark "BOURSORAMA", CTM no. 001758614 registered on 19 October 2001 for goods and services in classes 9, 16, 35, 36, 38, 41, 42. Moreover, it uses the domains boursorama.com (created on 1 March 1998) and also boursorama.ch, boursorama.info, boursorama.net that redirect to boursorama.com.

The Complainant has also registered a number of further domain names containing the term "BOURSORAMA", i.e. boursorama.biz, boursorama-banque.com, boursorama.eu, boursorama.co.uk and boursorama.fr.

FACTUAL BACKGROUND

The Complainant was founded in 1995 and is active in the field of online brokerage, online financial information and online banking.

The disputed domain name <boursorama.online> was registered on 16 January 2016 by the Respondent.

It results from the Complainant’s documented allegations that no true content is displayed on the website to which the

disputed domain name resolves. This website rather displays the following: “coming soon!”; “Launching soon!”; “We are working on a great website… Stay Tuned”.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

1. The Complainant contends that the disputed domain name <boursorama.online> is identical to its trademark and branded services BOURSORAMA. The Complainant states that it is the owner of several trademarks BOURSORAMA, in particular CTM no. 001758614 registered on 19 October 2001 and that in France, BOURSORAMA is the online banking reference with over 505,000 customers in late 2013. The portal www.boursorama.com is the first national financial and economic information website.

2. According to the Complainant's allegations the Respondent has no rights or legitimate interests in respect of the disputed domain name, nor is the Respondent commonly known by the disputed domain name. The Complainant further states that the Respondent is not related in any way with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent. The Complainant asserts that it neither licensed nor authorized the Respondent to make any use of the Complainant’s trademark or apply for registration of the disputed domain name. Moreover, according to the Complainant, any website used with the domain name <boursorama.online> will create a risk of confusion with its trademark, since its core business is developed online.

3. The Complainant further contends that the disputed domain name has been registered in bad faith. The Complainant states that the disputed domain name is identical to its well-known trademark BOURSORAMA that is also registered in the Trade Mark Clearing House (TMCH) since 16 April 2014. Thus, the Respondent was necessarily aware of the trademark when he registered the disputed domain name. The Complainant refers to previous decisions in which other panels confirmed the notoriety of the Complainant and its trademark. Furthermore the Complainant contends that the Respondent has redirected the contested domain name to a "coming soon" page and has failed to demonstrate any preparation to use it in connection with a legitimate purpose. Moreover, the Complainant does not envisage any use of the disputed domain name that would not be illegitimate, as internet users could likely believe that the disputed domain name and corresponding website are operated by, or affiliated with, the Complainant.

The Complainant therefore requests the transfer of the disputed domain name.

RESPONDENT:

1. According to the Respondent’s allegations the Complainant has no trademark rights, especially from where the domain is registered. In fact, according to the Respondent, this domain will host site for target audience in India. In this regard, the Respondent notes that BOURSORAMA is not a registered trademark in India. In addition it is neither well-known or famous in any aspect for the target audience, nor has it any presence at all in India. Finally, the Respondent notes that BOURSORAMA is not a trade mark or any sort of business identifier in any aspect for target audience.

The Respondent contends that the term BourSoRama translates to ‘Stories of RAMA’, being RAMA a well-known god in context of Hindu religion, the most followed religion in India. BourSoRama.online represents therefore the idea of having stories of lord RAMA online.

2. According to the Respondent’s allegations the disputed domain name is neither identical nor confusingly similar to the protected mark, because it is formed with a so called "portmanteau effect" in English language, which suggests that there are three words ‘Bour’ ‘So’ ‘Rama’ that are put together. In the Respondent's view, these terms are to be translated into ‘Story of Rama’ which has no relation whatsoever with the business online services offered by the Complainant. The Respondent confirms that it is not related to any activity of the Complainant and that the website to be presented under the disputed domain name will not have any relation to Complainant's activity. However, in the Respondent’s view having no relation to

the Complainant is no grounds to assume that the Respondent does not have legitimate right to make use of disputed domain name.

3. In addition, the Respondent alleges that it has legitimate and non commercial interest in the domain name.
It acknowledges that the Complainant could be the owner of trademark and business firms in Europe, but that this does not automatically translate to the worldwide rights for similar sounding domain or business names for all gTLDs. In this regard, the Respondent does not intent to infringe the rights over the domains owned by the Complainant. The Respondent rather wishes to protect his own right as the owner of a different domain, i.e. "BourSoRama.Online". Furthermore, the Respondent asserts that he will use the disputed domain name for a good cause, i.e. to promote eLearning & bring awareness to power of internet in rural parts of India where online stories of the most popular mythical character RAMA can act as a catalyst for kids to embrace the power of internet. This will be a legitimate non-commercial platform for kids to benefit from picture stories available online. The Respondent further contends that such a website will be supported by ad-revenue.

4. In addition, the Respondent claims that the disputed domain name has not been registered in bad faith and certainly had not been used in bad faith. In the Respondent's view the Complaint did not provide any supporting elements in support of its allegations. In particular, with regard to the Complainant’s allegation following which the Respondent has failed to demonstrate any preparation to use the domain name, the Respondent contends that as a matter of fact this allegation itself shall not be sustainable as like any other website, the design, creation, content preparation and launch of site takes considerable time and cannot be achieved merely in one month. Moreover, the Respondent contends that he did not act in bad faith or with the desire to sell the disputed domain name for profit gain. Additionally, in order to confirm his good faith, the Respondent contends that he is ready to sign a memorandum of understanding confirming amongst others, not to sell the disputed domain name for the next three years and validate eventual selling transactions over next 10 years with the Complainant or its representative, giving absolute priority to Complainant in case it wishes to acquire this domain name.

The Respondent requests to deny the remedies requested by the Complainant.

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).

It results from the evidence provided that the Complainant is the registered owner of Community word mark BOURSORAMA no. 001758614 registered on 19 October 2001. This trademark predates the creation date of the disputed domain name, which is 16 January 2016.

The Panel shares the view that the application of the confusing similarity test under the UDRP typically involves a straightforward visual or aural comparison of the trademark with the alphanumeric string in the domain name (see WIPO overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (hereinafter "WIPO Overview 2.0" at para. 1.2). In this basis, the Panel shares the consensus view according to which it generally satisfies the threshold requirement of having trademark rights if the Complainant owns a corresponding trademark (see WIPO Overview 2.0 at para. 1.1.). The disputed domain name is identical to the Complainant’s trademark since it incorporates the Complainant’s trademark in its entirety. In the light of the above principles this Panel has consequently no doubts that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

In accordance with the well-established precedent (see WIPO Overview 2.0 para. 1.2) the TLD suffix in a domain name will be generally disregarded under the confusing similarity test as it is a technical requirement of registration. Additionally, this Panel holds that the afore-mentioned rule might be complemented in cases where new gTLDs such as ".online" are involved (cf. Volkswagen AG v. Jan-Iver Levsen, WIPO Case No. D2015-0069 for another new gTLD, i.e. ".limo") and LEGO Juris A/S v. Jack Hollingsworth, WIPO Case No. D2015-0081 for ".london"). In fact, Internet users will not only adjudge the gTLD ".online" its undisputed technical function, but additionally understand it as being an indication to "online services" and therefore as a generic term, which is totally applicable to the field in which the Complainant plays a role, i.e. online financial and economic information-services. In the Panel's view, the suffix gTLD ".online" combined with the trademark BOURSORAMA is therefore likely to be understood by Internet users as referring to online services originating from or connected to the trademark

BOURSORAMA. As a result, the gTLD ".online" is not qualified to exclude confusing similarity between the Complainant's trademark and the disputed domain name but does even support the findings of confusing similarity in the case at hand.

Some Panels have additionally required that, for a domain name to be regarded as confusingly similar to a complainant's trademark, there must be a risk that Internet users may actually believe there to be a real connection between the domain name and the complainant and/or its goods and services. Such Panels would typically assess this risk having regard to such factors as the overall impression created by the domain name, the distinguishing value (if any) of any terms, letters or numbers in the domain name additional to the relied-upon mark, and whether an Internet user unfamiliar with any meaning of the disputed domain name seeking the complainant's goods or services on the world wide web would necessarily comprehend such distinguishing value vis-à-vis the relevant mark (see WIPO Overview 2.0 at para. 1.2). It is the Panel's view that, even if the disputed domain name was formed with a so called "portmanteau effect" in English language - as asserted by the Respondent - there is no distinguishing value of any terms, letters or numbers in the domain name <boursorama.online> additional to the relied-upon mark "BOURSORAMA" (that is fully incorporated in the disputed domain name) and that could lead to affirm that there is no risk that Internet users may actually believe there to be a real connection between the disputed domain name and the Complainant and/or its goods and service.

Consequently, the condition of paragraph 4(a)(i) of the Policy is fulfilled.

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 of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights to or legitimate interests in the disputed domain names by demonstrating any of the following:

(i) before any notice to it of the dispute, the Respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the Respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent’s rights or legitimate interests in the disputed domain name. In the Panel’s view, the Complainant has made a prima facie case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

First of all, the Respondent is not commonly known by the disputed domain name nor has it acquired trademark rights pursuant to paragraph 4(c)(ii) of the Policy.

Furthermore, no content is displayed on the website to which the disputed domain name resolves. Such use can neither be considered a bona fide offering of goods or services nor a legitimate noncommercial 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 in the sense of paragraph 4(c)(i) and (iii) of the Policy.

The Panel finds that the BOURSORAMA mark is distinctive. As already affirmed by other Panels (see e.g. BOURSORAMA S.A. v. Stephane Arninda, CAC case no. 100995; BOURSORAMA S.A. v. Williams Halus, CAC case no. 100854; Boursorama S.A. v. Daven Mejon, WIPO Case No. DCO2014-0023) the Complainant's mark is well known in France and publicly available on-line materials prove this reputation. In addition, this Panel finds it most likely that the Respondent selected the disputed domain name with the intention to take advantage of the Complainant’s reputation by registering a domain name fully containing the

Complainant’s trade name with the intent to attract Internet users for commercial gain.

It is acknowledged that once the Panel finds 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 disputed domain name. The mere indication of an alleged intention to use the disputed domain name in future for a website in connection with a specific activity is not a sufficient and valid proof of any legitimate interest. The Panel therefore finds that the Respondent failed to come forward with any relevant allegations or evidence in this regard and therefore concludes that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant is therefore deemed to have satisfied 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).

The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, “in particular but without limitation”, be evidence of the disputed domain name’s registration and use in bad faith.

In the case at hand, the Respondent indicated some points he would be ready to accept in a memorandum of understanding and that concern the eventual future selling of the disputed domain name. In this regard the Panel notes that evidence to offer the disputed domain name for sale is generally admissible under the UDRP, and is often used to show bad faith. This applies both in relation to offers by a respondent to sell made prior to a complainant's filing of a UDRP complaint, or after such filing. The latter takes into account the fact that cybersquatters often wait until a trademark holder launches a complaint before proceeding to such a proposal. The legal criteria for showing bad faith directly specify that an offer for sale can be evidence of bad faith, and panels are competent to decide whether settlement discussions represent a good faith effort to compromise or a bad faith effort to extort. Admissibility may turn to some extent on which party - complainant or respondent - initiated the settlement discussions, and on whether the complainant itself may have solicited any offer to sell (see WIPO Overview 2.0 at para. 3.6 with further references).

Furthermore, the disputed domain name does not resolve to an active website. The Panel first notes that passive holding does not preclude a finding of bad faith (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). Consequently, the Panel must examine all the circumstances of the case to determine whether the Respondent is acting in bad faith (see WIPO Overview 2.0 at para. 3.2 with further references). In particular, it is the view of this Panel that the Respondent’s indications and conditions as to a possible future sale of the domain name and the distinctive character of the term "BOURSORAMA" suggest that the Respondent was aware that it has no rights or legitimate interests in the disputed domain name, and that the disputed domain name has been registered and is being used in bad faith. Taking finally into account that the Complainant has been established many years ago and it trademark has existed for years, this Panel concludes that the Respondent knew or should have known the Complainant’s BOURSORAMA trademark when it registered the disputed domain name, and that there is no plausible legitimate active use of the disputed domain name.

Finally, with regard to the alleged conceptual meaning of "BOURSORAMA" the Panel stresses that Respondent did not specify in which language the term BOUSORAMA corresponds to "Stories of RAMA" in English and that the Respondent further failed to provide any evidence as to the alleged translation. It rather limited itself to provide internet printouts merely limited to "RAMA". To the Panel's knowledge the term "RAMA" may indeed refer to one of the popular deities in Hinduism. However, no evidence as to the alleged meaning of the further verbal element "BOURSO" being provided, this Panel cannot establish any translation in the sense brought forward by the Respondent.

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.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOURSORAMA.ONLINE**: Transferred

PANELLISTS

Name	**Dr. Tobias Malte Müller**

DATE OF PANEL DECISION 2016-03-14

Publish the Decision