Decision for dispute CAC-UDRP-102833

Case number	CAC-UDRP-102833
Time of filing	2019-12-30 14:11:25
Domain names	clients-boursorama.work

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	BOURSORAMA SA

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Julio Jaime

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other proceedings, pending or decided, which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of a large portfolio of trademarks. In particular, BOURSORAMA SA owns the EU Registration No. 1758614 "BOURSORAMA" registered on October 19, 2001 (and duly renewed) for classes 9, 16, 35, 36, 38, 41 and 42.

FACTUAL BACKGROUND

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

Founded in 1995, Boursorama, the Complainant, is 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 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.

The Complainant notes that the disputed domain name was registered on December 16, 2019.

The Complainant assumes that the disputed domain name is confusingly similar to its registered trademark "BOURSORAMA" as the disputed domain name contains the Complainant's trademark in its entirety. The addition of a

hyphen and of the generic term "clients" does not alter the finding of similarity between the signs.

Furthermore, according with the Complainant's statement, the Respondent lacks rights or legitimate interest in the domain name in dispute since 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. In addition, according to the Whois information connected to <clients-boursorama.work>, the Respondent is not commonly known with the terms Boursorama or clients-boursorama.

The Complainant also contends that the website in relation with the domain name in dispute only displays an inactive page since its registration and that the incorporation of a famous mark into a domain name coupled with an inactive website may be evidence of bad faith registration and use.

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.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 4(a) of the Policy provides that to obtain the transfer of the domain name, the Complainant must prove that each of the following elements is present:

(i) the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and

(iii) the Domain Name has been registered and is being used in bad faith.

A) The Panel finds that the disputed domain name <clients-boursorama.work> is confusingly similar to the Complainant's trademark because it wholly incorporates "BOURSORAMA". The Panel notes that the addition of the generic term "clients" and of the hyphen to the only distinctive part of the domain name consisting of the Complainant's registered and well-known mark neither affects the attractive power of such trademark, nor is sufficient to negate the confusing similarity between the disputed domain name and the Complainant's mark (see Boursorama SA v. spawen ablecat, CAC Case No. 101620). The Panel's view is that the element "client-", used as a prefix in the disputed domain name, was clearly chosen by the Respondent to mislead "clients" into believing they are accessing a client portal. In such circumstances the inclusion of this

element only increases, not decreases, the likelihood of confusion (see Boursorama SA v. Technology Vavalle, CAC Case No. 102331). Finally, the Panel notes that the consensus view in previous UDRP panel decisions is that in determining confusing similarity under paragraph 4(a) of the Policy, the generic Top-Level Domain (“gTLD”) suffix (“.work” in this particular instance) should be disregarded. Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B) The Complainant has long standing rights in the mark "BOURSORAMA". The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and as the Respondent was never authorized or licensed or otherwise permitted by the Complainant to use the disputed domain name. The Respondent, in the absence of any response, has not shown any facts or elements to justify legitimate rights or interests in the disputed domain name. Therefore, on the basis of the evidences submitted and in the absence of a response the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C) The Complainant’s trademark “BOURSORAMA” is distinctive and well-known. It is uncontroverted that Complainant’s use and registration of the "BOURSORAMA" mark largely precede the registration date of the disputed domain name. The fact that the Respondent has registered a domain name that includes "BOURSORAMA", with the addition of a hyphen and of a generic term, clearly indicates that the Respondent had knowledge of the Complainant’s trademark at the time of registration of the disputed domain name. This is a clear evidence of registration of the domain name in bad faith. The disputed domain name is linked to a page without any substantial content (passive holding). Countless UDRP decisions confirmed that the passive holding of a domain name with knowledge that the domain name infringes another party’s trademark rights is evidence of bad faith registration and use (see, in this regard, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). The consensus view of UDRP panelists is that passive holding of a domain name may, in appropriate circumstances, be consistent with a finding of bad faith. In particular, previous panels have tended to make such findings in circumstances in which, for example, a Complainant’s mark is well-known, and there is no conceivable use that could be made of the domain name that would not amount to an infringement of the Complainant’s trade mark rights. As regards to the first aspect, the Complainant has already extensively proved the renowned of its trademark. For what concern the second circumstance, it must be underlined that it is objectively not possible to understand what kind of use the Respondent could make with a domain name which includes the Complainant’s trademark (with the mere addition of a hyphen and of a generic term) currently extensively used by the latter. In the light of the above, the present case completely matches to the above requirements and the passive holding of the disputed domain name has to be considered a use in bad faith. In this respect it is important also to consider the decision in case Comerica Inc. v. Horoshiy, Inc. WIPO Case No. D2004-0615 according to which "The very act of having acquired [the domain name] raises the probability of Respondent using [it] in a manner that is contrary to Complainant’s legal rights and legitimate interests. [...] To argue that Complainant should have to wait for some future use of the disputed domain names to occur in order to demonstrate Respondent’s bad faith use is to render intellectual property law into an instrument of abuse by the Respondent. The result would be the likelihood of the accumulation and use of disputed domain names for the implicit, if not explicit, purpose of misappropriating or otherwise unlawfully undermining Complainant’s goodwill and business. The fact that this misappropriation may occur in any as yet undetermined manner at an uncertain future date does not negate Respondent’s bad faith. On the contrary, it raises the spectrum of continuing bad faith abuse by Respondent of Complainant’s mark, name and related rights and legitimate business interests". The Panel is therefore convinced that, even though the disputed domain name has not yet been actively used, the Respondent’s non-use of the disputed domain name equals to use in bad faith (see also Amundi Asset Management v. Amundi, CAC Case No. 102288 and Accor v. VNT Corporation, CAC Case No. 100004). In the light of the above, the Panel considers that also the third and final element necessary for finding that the Respondent has engaged in abusive domain name registration and use has been established. Accordingly, the Panel finds that the Complainant has satisfied 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. **CLIENTS-BOURSORAMA.WORK**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2020-02-20

Publish the Decision