

Decision for dispute CAC-UDRP-105142

Case number	CAC-UDRP-105142
Time of filing	2023-01-19 09:50:44
Domain names	foncia-patrimoine.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	EMERIA EUROPE
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Complainant representative

Organization	ATOUT PI LAPLACE
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Respondent

Organization	foncia-patrimoine
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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, formerly known as “FONCIA GROUPE”, is the owner of several trademarks consisting of the term “FONCIA®”, such as: the European trademark registration FONCIA® n° 001470210 registered since March 06, 2001 as well as the international trademarks “FONCIA®” n° 941643 registered since May 04, 2007 and “FONCIA°” n° 554821 registered since June 6th, 1990.

The Complainant is also the owner of the domain names www.emeria.eu registered on July 27, 2021 & www.foncia.com registered on December 11th, 1998.

FACTUAL BACKGROUND

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

The Complainant is a French company, and the world's leading provider in real estate services, providing services to both individuals and businesses.

The Complaint operates in France under the FONCIA brand through a unique network of over 500 branches. The Complainant also holds leading positions in Switzerland, Germany and the UK and has strong presence in Belgium, Luxembourg, the Netherlands and Portugal where the company operates under various brands through a network of over 200 branches. It represents 17,000 employees in

8 countries, over 700 branches that correspond to €1.5bn revenue.

The Complainant is the owner of several trademarks consisting of the term “FONCIA®”, including but not limited to: European trademark registration FONCIA® n° 001470210 registered since March 06, 2001 as well as the international trademarks “FONCIA®” n° 941643 registered since May 04, 2007 and “FONCIA °” n° 554821 registered since June 6th, 1990, among many others.

The Complainant is also the owner of the domain names www.emeria.eu registered on July 27, 2021 & www.foncia.com registered on December 11th, 1998.

The disputed domain name <foncia-patrimoine.com> was registered on December 22, 2022.(hereinafter, the “Disputed Domain Name”).

The Complainant indicates that the Disputed Domain Name resolves to an inactive website and it has been used for phishing purposes.

According to Complainant’s non-contested allegations, the Respondent has no rights or legitimate interest in respect of the Disputed Domain Name and the Complainant is not related in any way to the Complainant’s business.

For the purpose of this case, the Registrar confirmed that the Respondent is the current registrant of the Disputed Domain Name and that the language of the registration agreement is English.

The facts asserted by the Complainant are not contested by the Respondent.

PARTIES CONTENTIONS

COMPLAINANT:

First element: Similarity

The Complainant states that the Disputed Domain Name is confusingly similar to its trademark “FONCIA®”.

The Complainant asserts that the use of the trademark FONCIA combined with the generic term “patrimoine”, meaning “patrimony” in French, does not prevent the Disputed Domain Name from being identical or confusingly similar to the Complainant’s trademark.

Second element: Rights or legitimate interest

The Complainant contends that no authorization has been given to anyone to make any use or apply for registration of the Disputed Domain Name and have no affiliation at all with the Respondent.

Additionally, the Complainant argues that Respondent cannot claim prior rights or legitimate interest in the Disputed Domain Name that was well created after the Complainant proceeded with the filing of the trademarks, sign and domain name FONCIA.

Furthermore, the Disputed Domain Name resolves to an inactive website, and it has been used to send fraudulent emails. As a consequence, the Complainant states that there is no right nor legitimate interests for the Respondent to adopt the Disputed Domain Name.

Third element: Bad faith

The Complainant states that the Disputed Domain Name is confusingly similar to its trademark FONCIA®.

In addition, the Complainant’s brand FONCIA is a well-known and repute trademark for real estate services offered in France. Thus, the Respondent should have known about the Complainant at the time of the registration of the Disputed Domain Name.

Furthermore, the Disputed Domain Name has been used to send fraudulent emails to third parties in view of investing in financial products and in real estate investments in order to raise money illegally in a phishing scheme.

Finally, the Complainant argues that the Respondent is probably the same individual who has been involved in three different UDRP proceedings involving similar phishing scheme. Therefore, the Complainant contends that the use of the Disputed Domain Name demonstrates Respondents’ intention to abusively benefit from Complainant’s reputation and to obtain money.

RESPONDENT

Respondent did not reply to the Complaint

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

According to Paragraph 4(a) of the Policy, the complainant is required to prove each of the following three elements to obtain an order that a domain name should be transferred or cancelled:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and are being used in bad faith.

The Panel has reviewed in detail the evidence available to it and has come to the following conclusions concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in the proceeding:

(A) THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S RIGHTS.

Paragraph 4(a)(i) of the Policy establishes the obligation of the Complainant to demonstrate that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant submitted copies of the following trademark registrations:

- French trademark FONCIA n° 941643 filed on December 08, 1989 to cover inter alia class 36 services.
- French trademark FONCIA n° 1564240 filed on May 04, 2007 to cover inter alia class 36 services.
- French trademark FONCIA n° 554821 filed on June 06, 1990 to cover inter alia class 36 services.
- European trademark FONCIA GROUPE n° 017987683 filed on November 19, 2018 and registered to cover inter alia class 36 services.
- European trademark FONCIA n° 001470210 filed on January 11, 2000 and registered to cover inter alia class 36 services.
- International trademark for FONCIA n° 941643 filed on May 4, 2007 and registered to cover inter alia class 36 services in European countries, Switzerland, China, Monaco and Liechtenstein.
- International trademark for FONCIA n° 554821 filed on June 6, 1990 and registered to cover inter alia class 36 services in Benelux, Switzerland and Germany.

The Complainant's trademarks were registered prior to 2022, the year of the creation date of the Disputed Domain Name.

In the current case, the Disputed Domain Name is composed of the trademark FONCIA® together with the French generic term "patrimoine", which translation into English means "patrimony". In assessing confusing similarity, the Panel finds the Disputed Domain Name is indeed confusingly similar to the Complainant's trademark, as it incorporates the entirety of the FONCIA® trademark plus the French generic term patrimony. In this vein, UDRP panels agree that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See paragraph 1.8. of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition 3.0 ("WIPO Jurisprudential Overview 3.0.).

UDRP panels agree that the TLD may usually be ignored for the purpose of determination of identity or confusing similarity between a domain name and the Complainant's trademark as it is technical requirement of registration. See paragraph 1.11.1 of WIPO Jurisprudential Overview 3.0.

Therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the Disputed Domain Name is confusingly similar to Complainant's "FONCIA®" trademark.

(B) RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME.

The second element of the Policy requires that the Complainant establishes that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The generally adopted approach, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it with relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name; see, for example, CAC Case No. 102333, Amedei S.r.l. v sun xin. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

In this regard, Paragraph 4 (c) provides with circumstances which could prove rights or legitimate interest in the Disputed Domain Name on behalf of the Respondent such as:

- (i) before any notice to Respondent of the dispute, Respondent is using or provides with 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 (as an individual, business, or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) The Respondent is making a legitimate noncommercial 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.

The Respondent did not reply to the Complaint despite the efforts made by this Center to notify the Complaint. In this regard, the Complainant has confirmed in the Complaint that the Disputed Domain Name is not connected with or authorized by the Complainant in any way.

From the information provided by the Complainant, there is no evidence or reason to believe that the Respondent (as individual, business or other organization) has been commonly known by the Disputed Domain Name.

The Respondent's name "Antoine Grenier" is all what it links the Disputed Domain Name with the Respondent. Absent of any other evidence such as a personal name, nickname or corporate identifier, the Panel is of the opinion that the Respondent is not commonly known by the Disputed Domain Name.

The Complainant indicates that they have not granted authorization to the Respondent to use their "FONCIA®" trademarks. Furthermore, the Complainant asserts that the Respondent is not affiliated with him nor authorized in any way to use the trademark "FONCIA®".

In terms of the evidence provided by the Complainant, the website linked to the Disputed Domain Name resolves to an inactive website.

Different Panels have confirmed that the lack of content at the Disputed Domain Name can be considered as a finding that Respondent does not have bona fide offering of goods and services (see, for example, Forum Case No. FA 1773444, Ashley Furniture Industries, Inc v. Joannet Macket/JM Consultants).

Moreover, the Complainant has provided with evidence about phishing emails sent from the Respondent to Complainant's customers using the Disputed Domain Name with the purpose of gaining money illegally in a phishing scheme.

Past Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.

In light of the reasons above mentioned, the Panel concludes that the Complainant has satisfied the second element of the Policy.

(C) BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME.

Paragraph 4(a)(iii) of the Policy indicates that the Complainant must assert that the Respondent registered and is using the Disputed Domain Name in bad faith. In this sense, Paragraph 4(b) of the Policy sets out four circumstances which if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- circumstances indicating that the Respondent has registered or acquired the Disputed Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Disputed 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
- the Respondent has registered the Disputed Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding Disputed Domain Name, provided that Respondent has engaged in a pattern of such conduct; or
- the Respondent has registered the Disputed Domain Name primarily for the purpose of disrupting the business of a competitor; or

- by using the Disputed Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other on-line 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.

In accordance with the evidence provided by the Complainant, the Disputed Domain Name is currently not in use. It is well established at different UDRP panel resolutions that the lack of use of a domain name does not prevent from finding bad faith (e.g. Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. 2000-0003).

In this vein, WIPO Jurisprudential Overview, version 3.0. at paragraph 3.3. provides some factors that have been considered relevant in applying the passive holding doctrine such as: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

For the current case, the evidence at hand confirms that Complainant's "FONCIA®" trademarks are distinctive and the Complainant has a strong reputation in the real estate services, at least in Europe. Furthermore, the Complainant has provided evidence that the Respondent should have found information over the internet about Complainant's trademarks rights over its trademark rights before registering the Disputed Domain Name.

In addition to the above described and from the Panel perspective, the following circumstances also confirm Respondent's bad faith in the registration of the Disputed Domain Name:

- (a) By conducting a search over the Internet, the Respondent should have been made aware of Complainant's trademarks "FONCIA®" trademarks as well as their reputation in the real estate in Europe;
- (b) The Disputed Domain Name is composed with the brand "FONCIA®" combined with the generic term "patrimoine", meaning "patrimony" in French. Absent of Respondent's reply, this combination is only a confirmation of Respondent's knowledge of Complainant's trademark "FONCIA®" prior to the registration of the Disputed Domain Name;
- (c) The Complainant's trademark rights over "FONCIA®" predate the date of registration of the Disputed Domain Name;
- (d) The website associated with the Disputed Domain Name is inactive;

These factors make the Panel believe that the Disputed Domain Name was registered with the intention to attract, for commercial gain, Internet users to the Respondent's website or other on-line 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.

The Complainant has provided with evidence showing that the Disputed Domain Name has been used for phishing purposes by sending emails to third parties using the name and surname of a Complaint's employee. Past Panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. (In some such cases, the respondent may host a copycat version of the complainant's website.)

See paragraph 3.4 of WIPO Jurisprudential Overview 3.0.

One additional argument presented by the Complaint relates to the possibility that the Respondent is also the owner of three similar domain names used for phishing purposes. In this regard, the Complainant was able to provide with evidence showing that the domain name <emeria-foncia.com> was created by the Respondent under the name Antoine Grenier and the Complainant successfully filed and won the UDRP Case No. 104997 before this Center regarding said domain name. Moreover, the Complainant also provided with information about the domain names <foncia-gestion.com> - created on October 27, 2022 and the domain name <groupe-emeria.eu> - created on September 28th, 2022. Both domain names were registered on the name of Edmon Pupil under the email address a.grenier@e.mail.fr and in both cases the Complaint also filed successfully Domain Name disputes; i.e. CAC UDRP 104995 & ADR 08430.

After reviewing the evidence provided by the Complainant, this Panel was not able to review enough and clear evidence to connect the four domain names with the same Respondent, however and for the purposes of this third element, past Panels have held that establishing a pattern of bad faith conduct requires more than one, but as few as two instances of abusive domain name registration. In this sense, the Complainant has been able to demonstrate that the Respondent also registered the domain name emeria-foncia.com and this is enough to confirm that the Respondent has been involved a pattern of bad faith conduct. Here is important to note that this Panel also believe that the four domain names might be connected – by checking at the composition of the email address a.grenier@e.mail.fr provided for the registration of the domain names <foncia-gestion.com> & <groupe-emeria.eu> – however, this Panel cannot make any confirmation absent of a clear evidence provided by the Complainant.

See paragraph 3.1.1 of WIPO Jurisprudential Overview 3.0.

In light of the evidence presented to the Panel, including: a) the likelihood of confusion between the Disputed Domain Name and the Complainant's "FONCIA®" trademarks, b) the lack of reply to this Complaint by Respondent, c) the fact that the Disputed Domain Name is being passively held, iv) the fact that the Disputed Domain Name has been used for sending phishing attacks, and, v) the fact that the Respondent has been involved in a pattern of abusive registrations, the Panel draws the inference that the Disputed Domain Name was registered is being used in bad faith.

Therefore, the Panel concludes that Respondent registered and is using the disputed domain name in bad faith and thus has satisfied

the requirement under 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. **foncia-patrimoine.com**: Transferred

PANELLISTS

Name	Victor Garcia Padilla
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DATE OF PANEL DECISION	2023-02-20
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Publish the Decision