

Decision for dispute CAC-UDRP-105259

Case number	CAC-UDRP-105259
Time of filing	2023-03-07 11:16:56
Domain names	mabanque-boursorama.com

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	BOURSORAMA
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Name	Karim Lahcen
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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 has established that it has rights in the European trademark for BOURSORAMA registered on October 19, 2001 and by virtue of being registered as the owner of that trademark.

FACTUAL BACKGROUND

The Complainant is a French company engaged in the business of online brokerage, financial information on the internet and online banking. Through its website at www.boursorama.com it is the first national financial and economic information website and the first French online banking platform. It has owned the registered European trademark for BOURSORAMA registered number 001758614 since October 19, 2001. It also owns several domain names such as <boursorama.com> registered on March 1, 1998 and <boursorabanque.com> registered on May 26, 2005.

The Respondent registered the disputed domain name <mabanque-boursorama.com> on March 1, 2023. The Complainant is concerned that the disputed domain name has been registered and that the Respondent has embodied in it the entirety of the BOURSORAMA mark even although it is not in use and resolves to an error page. This has obvious potential for improper use.

Therefore, the Complainant has filed this Complaint to have the domain name transferred to the Complainant.

PARTIES CONTENTIONS

A. COMPLAINANT

The disputed domain name <mabanque-boursorama.com> is confusingly similar to the BOURSORAMA Trademark in which the Complainant has rights.

The Respondent has added to the BOURSORAMA trademark by way of a prefix, the generic word “mabanque”, a French term meaning “my bank” in English, which gives the impression that the domain name is an official domain name of the Complainant that will lead to an official website of the Complainant, which is false. Indeed, the presence of that generic word strengthens the notion that the domain name is an official domain name of the Complainant.

The gTLD “.com” is not taken into account in this exercise.

The Complainant only has to establish a prima facie case on this issue and, if made out, the Respondent then has to rebut that case.

The Respondent has no rights and legitimate interests in respect of the disputed domain name as the Respondent is not commonly known by the domain name, not affiliated with or authorised by the Complainant in any way and has no licence nor authorisation to use the Complainant’s trademark or register the disputed domain name. The Respondent has not used the domain name and has no demonstrable plan to use it.

The disputed domain name was registered by and is being used by the Respondent in bad faith. That is because it includes the well-known and distinctive BOURSORAMA trademark, the Respondent must have known of the Complainant and its trademark, the domain resolves to an error page and there is no plausible legitimate use that could be made of the domain name.

B. RESPONDENT

Respondent did not file a Response in this proceeding.

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

DISCUSSION AND FINDINGS

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the

“Policy” or “UDRP”) of the Internet Corporation for Assigned Names and Numbers (“ICANN”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the CAC Supplemental Rules.

A. Administrative compliance

By notification dated March 7, 2023 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that the Complaint did not provide the name of the Respondent (domain-name holder) and all information (including any postal and e-mail addresses and telephone and fax numbers) known to Complainant regarding how to contact Respondent or any representative of Respondent, including contact information based on pre-complaint dealings, in sufficient detail to allow the CAC to send the Complaint as described in Paragraph 2(a) [Rules, Paragraph 3(b)(v)]. The notification invited the Complainant to have regard to the Registrar’s verification available in the online case file in the form of a non-standard communication regarding the appropriate identification of the domain name holder. On March 7, 2023, the Complainant filed an Amended Complaint and the CAC determined also on March 7, 2023 that the Complaint should be admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiency has been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In that regard, the Panel also notes that the onus is on the complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (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 is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

A. Identical or Confusingly Similar

The Complainant has adduced evidence that the Panel accepts, namely Annex 2 to the Complaint, that the Complainant is the registered owner of the European trademark for BOURSORAMA No. 0017586 registered on October 19, 2001 (“the BOURSORAMA trademark”).

It will be seen therefore that the trademark was registered well before the disputed domain name was registered, which was on March 1, 2023, as is demonstrated by Annex 4 to the Complaint. The Complainant has verified that the Respondent is the registrant of the disputed domain name.

The Panel next finds that the disputed domain name is confusingly similar to the BOURSORAMA trademark for the following reasons.

First, the domain name includes the entirety of the BOURSORAMA trademark. Accordingly, it is clear that the domain name has been inspired by and is an attempt to copy the trademark. It is also clear and has been held many times in prior UDRP decisions that when internet users see an entire trademark used in a domain name in this way, they naturally conclude that the domain name is an official domain name of the trademark owner.

Secondly, the domain name also includes , as a prefix to the trademark, the generic term “mabanque” and a hyphen. That generic expression means “mybank” in the French language. Internet users who see the entire domain name would then naturally conclude that the entire domain name was an assertion that it related to the Complainant itself or that it was authorised by the Complainant, neither of which is true. In this particular case, internet users would also conclude that the domain name was owned by a person or entity that was entitled to assert that it related to its bank, namely the Boursorama bank which is also not true. Internet users would also conclude that the entire domain name would lead to an official website of the Complainant, which is also not true.

Finally, the “.com” suffix and a hyphen, both of which are present in the domain name, are disregarded for the purposes of assessing confusing similarity, as they could not negate the clear impression that the domain name is confusingly similar to the trademark, which it clearly is.

The Panel therefore finds that the disputed domain name is confusingly similar to the BOURSORAMA trademark and that this conclusion is supported by the prior UDRP decisions cited by the Complainant.

The Complainant has thus made out the first of the three elements that it must establish.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [respondent] of the dispute, your 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) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you [respondent] are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to divert consumers misleadingly or to tarnish the trademark or service mark at issue.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the Complainant will have failed to discharge its onus and the Complaint will fail.

It is also well-established that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain and that when such a *prima facie* case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP. The Panel, after considering all of the evidence in the Complaint, finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name.

That *prima facie* case is made out from the following considerations.

- The Complainant has clearly established its rights in the BOURSORAMA mark.
- The evidence of the Complainant is that the Respondent is not related in any way to the Complainant's business, is not affiliated with the Complainant or authorized by it in any way to use the BOURSORAMA trademark and does not carry out any activity for, nor has any business with, the Complainant.
- The evidence shows that the Respondent is not commonly known by the domain name under paragraph 4(c)(ii) of the Policy.
- The evidence is that no licence nor authorisation has been granted by the Complainant to the Respondent to make any use of the trademark or to register the disputed domain name.
- The disputed domain name resolves to an error page and there is no evidence that the Respondent has or has had a plan of any sort to use the disputed domain name. Thus, it can be assumed that the Respondent registered it for a bad motive such as to try to sell it.
- None of this conduct is *bona fide* or legitimate and none of it comes within any of the criteria for a right or legitimate interest in a domain name that are set out in paragraph 4(c) (i) – (iii) of the Policy. Nor is there any evidence to show that the Respondent could in any other way show a right or legitimate interest in the domain name.

These facts give rise to the *prima facie* case made out by the Complainant. The Respondent has not filed a Response or made any other answer to the claims of the Complainant and is in default. Accordingly, the *prima facie* case has not been rebutted and the Complainant has made out the second of the three elements that it must establish.

C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

- (i) circumstances indicating that the respondent has registered or 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 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 or service on the site or location.

The conduct of the Respondent in registering the domain name clearly amounts to bad faith registration and its conduct since the registration by retaining it and putting the Complainant at the risk of it being used to its detriment and in breach of its trademark, clearly amounts to bad faith use. That is so for the following reasons.

First, the Respondent must have been aware of the existence of the Complainant and its prominent reputation when it registered the disputed domain name, because the Respondent chose the name of the domain name itself and then made an addition to it by adding the prefix "mabanque" to suggest that it was its, the Respondent's, bank or that it was entitled to say that it was. Thus, the Respondent had actual knowledge of the Complainant and its trademark which has long been a ground for finding bad faith registration and, by retaining the domain name, its use. The Panel therefore finds that it is highly likely that the Respondent chose the trademark, made the addition and registered the domain name to invoke the existence and activities of the Complainant for an improper purpose and therefore in bad faith.

Secondly, the conduct of the Respondent brings the case within the provisions of paragraph 4(b) (i) of the Policy, that being the most likely explanation for registering the domain name and for retaining it.

Thirdly, the same considerations bring the case within the provisions of paragraph 4(b) (iii) of the Policy.

Fourthly, the same conduct of the Respondent leads to the conclusion that the Respondent, in registering the domain name deceptively and without any authority to do so, must have intended to create a likelihood of confusion, with the intention of attracting current and potential customers of the Complainant looking for its services and doing so in this misleading manner. Thus, the matter comes within the provisions of paragraph 4(b) (iv) of the Policy.

Fifthly, there is no conceivable ground for concluding that the Respondent was acting in good faith, as the Respondent was clearly targeting the Complainant.

Finally, in addition and having regard to the totality of the evidence, the Panel finds that, in view of Respondent's registration of the disputed domain name using the BOURSORAMA mark and retaining it, the Respondent registered and used it in bad faith within the generally accepted meaning of that expression.

As the Complainant rightly submits, such conduct of the Respondent has been held by previous UDRP panels to constitute bad faith registration and use.

Accordingly, the Complainant has shown the third of the three elements that it must establish.

As the Complainant has made out all of the constituent elements under the Policy, it is entitled to the relief it seeks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **mabanque-boursorama.com**: Transferred

PANELLISTS

Name	Neil Brown
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DATE OF PANEL DECISION	2023-04-12
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Publish the Decision