

Decision for dispute CAC-UDRP-105362

Case number	CAC-UDRP-105362
Time of filing	2023-04-17 10:05:11
Domain names	acquisitionformbourso.com, accueilboursoprofilpresent.com, constatdegestionboursoposte.com, decouvrirlesparametresbourso.com

Case administrator

Name Olga Dvořáková (Case admin)

Complainant

Organization BOURSORAMA

Complainant representative

Organization NAMESHIELD S.A.S.

Respondents

Name Mondesir Perco

Name Reco Marvyn

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 names.

IDENTIFICATION OF RIGHTS

The Complainant is owner of the French trademark BOURSO no. 3009973, registered since 22 February 2000 in classes 9, 35, 36, 38, 41, 42.

The Complainant is also owner of the domain names <boursos.com>, registered since 11 January 2000, and <boursorama.com>, registered since 1 March 1998 and used as its main website promoting its products and services.

FACTUAL BACKGROUND

The Complainant is a French corporation founded in 1995, a subsidiary of Société Générale. The Complainant is pioneer and leader in three core businesses: online banking, online brokerage and online financial information.

In France, the Complainant is the online banking reference with over 4,7 million customers. The Complainant's main website

(<boursorama.com>) is the first national financial and economic information site and the first French online banking platform.

The disputed domain names are:

<acquisitionformboursocom> registered on 11 April 2023 by Mondesir Perco, an individual residing in Marseille, France;

<accueilboursoprofilpresent.com>, <constatdegestionboursoposte.com> and <decouvrirlesparametresboursocom>, all registered on 13 April 2023 by Reco Marvyn, an individual residing in Paris, France.

The disputed domain names are not associated with any active website.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain names are confusingly similar to its trademark, since the BOURSO trademark is reproduced in its entirety and the addition of the generic and descriptive terms do not prevent the likelihood of confusion between the disputed domain names and the Complainant's trademark.

The Complainant also contends that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark, or apply for registration of the disputed domain names by the Complainant. The Respondent is not commonly known by the domain names, nor has acquired any rights in a trademark or trade name corresponding to the disputed domain names.

Furthermore, the disputed domain names are not actively used. The Complainant contends that the Respondent has made no demonstrable preparations to use the disputed domain names in good faith. To the contrary, two domain names were previously used to resolve to a website with direct reference to the Complainant's activities. Therefore, the Respondent did not use the disputed domain names for any bona fide offering of goods or services.

Finally, the Complainant contends that the registration of disputed domain names confusingly similar to the well-known trademark of the Complainant and, thus, the constructive knowledge on behalf of the Respondent of the Complainant's potential rights, as well as the previous use and the current passive holding of the disputed domain names, clearly shows the Respondent's bad faith in the registration and use of the disputed domain names.

The Complainant requests the transfer of the disputed domain names.

RESPONDENT:

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 have been registered and are 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.

Under paragraph 10(e) of the UDRP Rules, the Panel shall decide, on its own discretion, to consolidate multiple domain name disputes in accordance with the Policy and these Rules. At the same time, paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

In deciding consolidation, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency shall also be taken into consideration by panels (paragraph 10(c) of the UDRP Rules: "The Panel shall ensure that the administrative proceeding takes place with due expedition").

Considered that:

- the disputed domain names were registered nearly on the same date (11 and 13 April 2023);
- all disputed domain names were registered with the same Registrar (GoDaddy, US) and the same privacy/proxy service (Domains By Proxy);
- all disputed domain names use the same hosting provider/IP address in Russia;
- the naming pattern of the disputed domain names consisting in the Complainant's mark plus generic and descriptive terms related to the Complainant's activities (banking services);
- all disputed domain names are inactive,

The Panel finds that, on the balance of the probabilities, the disputed domain names are subject to common control, and the consolidation of the dispute is fair and equitable to the Parties and in line with the principle of procedural efficiency.

PRINCIPAL REASONS FOR THE DECISION

Under paragraph 4(a) of the UDRP Policy, the Complainant is required to prove each of the following three elements to succeed in the administrative proceeding:

- (i) the disputed domain names are 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 disputed domain names; and
- (iii) the disputed domain names have been registered and are being used by the Respondent in bad faith.

I. RIGHTS AND IDENTITY OR CONFUSING SIMILARITY

In UDRP disputes the test for identity or confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing (paragraph 1.7 WIPO Overview 3.0).

Panels have consistently found that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) to the relevant trademark, recognizable within the disputed domain name, would not prevent a finding of confusing similarity under the first element (paragraph 1.8 of WIPO Overview 3.0).

Panels also agree that the TLD is to be ignored for the purpose of determination of confusing similarity between the disputed domain name and the complainant's trademark, as it is a technical requirement of registration (paragraph 1.11.1 WIPO Overview 3.0).

The Complainant has established that it has rights BOURSO trademark since 2000 and valid in the territory where the Respondent resides.

The disputed domain names incorporate the entirety of the Complainant's BOURSO trademark and differ from such mark by merely adding generic and descriptive English and French terms "acquisition form", "accueil profil present" (meaning "welcome present profile"), "constat de gestion poste" (meaning "management report post"), and "decouvrir les paramètres" (meaning "discover the parameters"), as well as the TLD ".com". The addition of such generic and descriptive terms to the Complainant's mark neither affects the attractive power of such trademark, nor is sufficient to distinguish the disputed domain names from the Complainant's mark.

Hence, this Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain names are confusingly similar to the Complainant's mark.

II. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAMES

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 names. If a complainant makes out a prima facie case that the respondent

lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (see 2.1 WIPO Overview 3.0).

The Complainant contends to have no relationship whatsoever with the Respondent(s), Mondesir Perco and Reco Marvyn, individuals based in France. The Respondent has never received any approval of the Complainant, expressed or implied, to use the Complainant's trademark or to register and use the disputed domain names.

No evidence is available that the Respondent has been commonly known by the disputed domain names or has acquired any rights in a trademark or trade name corresponding to the disputed domain names.

The Respondent registered four domain names, all of them incorporating the Complainant's trademark plus additional generic and descriptive terms in English and French, and, thus confusingly similar to the BOURSO trademark.

UDRP panels have found that domain names identical or confusingly similar to a complainant's trademark carry a high risk of implied affiliation. A domain name consisting of a trademark plus an additional term at the second- or top-level is seen as tending to suggest sponsorship or endorsement by the trademark owner. Thus, UDRP panels have largely held that such composition cannot constitute fair use.

Moreover, there is no evidence that, before any notice to Respondent of the dispute, he used, or demonstrably prepared to use, the domain names or names corresponding to the domain names in connection with a bona fide offering of goods or services.

Currently, the disputed domain names do not resolve to any active website. In the past, the first domain name resolved to an error page and the other three domain names resolved to a parking page without any substantial content.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain names.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain names.

III. REGISTRATION AND USE OF THE DISPUTED DOMAIN NAMES IN BAD FAITH

The disputed domain names have been registered and are being used in bad faith for the following cumulative reasons.

The Respondent has used a privacy or proxy service when registering the disputed domain names. Although the use of such service is not in and of itself an indication of bad faith, the circumstances and the manner in which such service is used may however impact the Panel's assessment of bad faith (see 3.6 WIPO Overview 3.0).

The disputed domain names are to be considered confusingly similar to the BOURSO trademark, since they incorporate such mark in its entirety and differ from it merely by adding non-distinctive and descriptive terms in English and French referring to the Complainant's business activities, and the TLD ".com" (which is disregarded for the purpose of determination of confusing similarity between the disputed domain names and the trademarks of the Complainant as it is a technical requirement of registration).

UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see 3.1.4 WIPO Overview 3.0).

Given the distinctiveness and the reputation of the Complainant's prior mark acquired over the years (in particular in France where the Respondent resides), also confirmed in other UDRP disputes (see Boursorama S.A. v. Ibraci Links, Ibraci Links SAS WIPO Case No. D2022-4646), it is inconceivable that the Respondent could have registered the disputed domain names confusingly similar to the Complainant's trademark for a mere chance without actual knowledge of the Complainant and its mark and the intention to exploit such reputation by diverting traffic away from the Complainant's website.

Even assuming that the Respondent had no knowledge of the Complainant's prior mark at the time of registration of the disputed domain names (which is quite unlikely), he omitted to verify that the disputed domain names would have infringed the Complainant's earlier rights or, even worse, he verified it and deliberately proceeded with the infringing registration.

Under paragraph 2 of the Policy, it is the Respondent's responsibility to determine whether a domain name registration infringes or violates third party's rights. By registering the disputed domain names confusingly similar with the Complainant's well-known mark, the Respondent has violated, inter alia, the cited provision of the Policy.

Furthermore, since the Respondent registered four domain names, all of them consisting of the Complainant's distinctive trademark in its entirety with the addition of generic and descriptive terms, the Panel finds that the Respondent is engaged in a pattern of abusive conduct (paragraph 4(b)(ii) of the Policy).

Currently, the disputed domain names do not resolve to any active website.

UDRP panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding (see 3.3 WIPO Overview 3.0 and in particular Telstra Corporation Limited v. Nuclear Marshmallows WIPO Case No. D2000-0003).

The following factors were considered by the Panel when applying the passive holding doctrine in the present case:

- the degree of distinctiveness and/or reputation of the Complainant's trademark;
- the failure of the Respondent(s) to submit a response or to provide any evidence of actual or contemplated good faith use;
- the Respondent's concealing its identity (privacy or proxy service) or use of false contact details;
- the implausibility of any good faith use to which the disputed domain names may be put.

Taken into account all circumstances of this case, the Panel finds that it is not possible to conceive of any plausible actual or contemplated active use of the domain names 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 BOURSO mark under trademark law.

The Panel, thus, finds that the Complainant has discharged the burden of proof to show that the disputed domain names have been registered and are being used in bad faith (paragraph 4(a)(iii) of the Policy).

Therefore, the disputed domain names are to be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **acquisitionformbourso.com**: Transferred
2. **accueilboursoprofilpresent.com**: Transferred
3. **constatdegestionboursoposte.com**: Transferred
4. **decouvrirlesparametresbourso.com**: Transferred

PANELLISTS

Name	Ivett Paulovics
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DATE OF PANEL DECISION 2023-05-17

Publish the Decision
