

Decision for dispute CAC-UDRP-105524

Case number CAC-UDRP-105524

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Domain names boursoramacertif.com

Case administrator

Organization Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization BOURSORAMA

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Name Mike Riki

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 is the registered owner of EUTM registration number 001758614 EUTM BOURSORAMA, registered on October 9, 2001 for goods and services in classes 9, 16, 35, 36, 38, 41, 42 and uses the mark extensively on its banking portal website at <www.boursorama.com>.

FACTUAL BACKGROUND

The Complainant is the owner of the BOURSORAMA mark for which it holds the EUTM registration described above.

As a provider of financial services online, with a primary focus in France, it has an established Internet presence hosting a portal website at <www.boursorama.com>.

In addition, the Complainant owns a number of domain names comprising the distinctive wording BOURSORAMA such as the abovementioned <boursorama.com>, used as the address of its primary website, which has been registered since March 1, 1998, and the domain name <boursoramabanque.com> which has been registered since May 26, 2005.

The disputed domain name was registered on June 8, 2023, and resolves to an inactive web page.

There is no information available about the Respondent except for that provided in the Complaint, as amended, the Registrar's published Whois and the information provided by the Registrar in response to the request by the Center for details of the registration of the disputed domain name.

The Registrar has disclosed that the Respondent, who availed of a privacy service to conceal his identity on the published Whois, is the registrant of the disputed domain name.

PARTIES CONTENTIONS

Complainant

The Complainant claims rights in the BOURSORAMA mark established through its ownership of the EUTM registration described above and extensive use of the mark in its core businesses providing an online brokerage and banking services through its portal website at <www.boursorama.com>.

Since its establishment the Complainant has grown to have currently over 4,9 million customers.

Firstly, the Complainant alleges that the disputed domain name <boursoramacertif.com> is confusingly similar to its trademark BOURSORAMA, because it includes the trademark in its entirety.

Furthermore, the Complainant contends that the addition of generic term "certif" is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark BOURSORAMA, arguing that it is well-established that "a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP". See Dr. Ing. h.c. F. Porsche AG v. Vasily Terkin, WIPO Case No. D2003-0888.

Additionally, the Complainant contends that the addition of the generic Top Level Domain ("gTLD") suffix <.com> does not change the overall impression that the disputed domain name is associated with the Complainant's BOURSORAMA mark, and it does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and its domain names associated. See F. Hoffmann-La Roche AG v. Macalve e-dominios S.A. WIPO Case No. D2006-0451, ("It is also well established that the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.").

In support of its claims the Complainant submits that numerous panels established under the Policy have also confirmed the Complainant's rights such as:

- CAC Case No. 104433, BOURSORAMA SA v. 1337 Services LLC <fr-boursorama.com>.
- CAC Case No. 102278, BOURSORAMA v. yvette cristofoli, <boursorama-ecopret.com>;
- CAC Case No. 101844, BOURSORAMA SA likid french, <client-boursorama.net>.

Thus, the disputed domain name is confusingly similar to the Complainant's trademark.

The Complainant next alleges that the Respondent has no rights or legitimate interests in the disputed domain name, arguing that in accordance with the decision in Croatia Airlines d.d. v. Modern Empire Internet Ltd. WIPO Case No. D2003-0455,, the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests, and once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name at issue. If the Respondent fails to do so, the Complainant is deemed to have satisfied pursuant to Policy paragraph 4(a) (ii).

The Complainant argues that the Respondent is not known by the disputed domain name; the Respondent is not identified in the Whois database as the disputed domain name; and past panels have held that a respondent is not commonly known by a disputed domain name at issue where the relevant Whois information shows that the registrant of the disputed domain name does not have a name similar to the disputed domain name. See Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group Forum Case No. FA 1781783, <bobsfromsketchers.com> ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy 4(c) (ii) that Respondent is not commonly known by the disputed domain name under Policy 4(c) (ii).").

The Complainant asserts that the Respondent is not known to the Complainant, and is neither affiliated with, nor authorized by the Complainant in any way. The Complainant adds that it does not carry out any activity for, nor has it any business with the Respondent.

Furthermore, the Complainant asserts that it has not granted any license or authorization to the Respondent to make any use of the Complainant's BOURSORAMA mark, to or apply for registration of the disputed domain name.

It is further argued that the disputed domain name resolves to a blank web page with the wording "Success! Your new web server is ready to use", as shown in a screen capture exhibited in an annex to the Complaint. The Complainant contends that the screen capture confirms that the Respondent does not use the disputed domain name, and has no demonstrable plan to use the disputed domain name. See Ashley Furniture Industries, Inc. v. Joannet Macket / JM Consultants Forum Case No. FA 1773444 ("The Panel finds that Respondent's lack of content at the disputed domain shows the lack of a bona fide offering of goods or services or a legitimate noncommercial or fair use per Policy 4(c)(i) and (iii).").

Next the Complainant submits that the disputed domain name was registered and is being used in bad faith.

The Complainant argues that the BOURSORAMA mark which is incorporated in the disputed domain name is well known and distinctive. In France, the Complainant uses the BOURSORAMA mark in its online banking enterprise with over 4,9 million customers; and the portal site at <www.boursorama.com>.

In support of its claim to having an extensive reputation in the mark, the Complainant refers to the decisions of the panels in BOURSORAMA v. PD Host Inc - Ken Thomas CAC Case No. 101131, ("In the case at hand, the Respondent acted in bad faith especially because the Respondent, who has no connection with the well-known "BOURSORAMA" trademark, registered a domain name, which incorporates the well-known "BOURSORAMA" trademark and it is totally unrealistic to believe that the Respondent did not know the Complainant's trademark when registered the domain name <wwwboursorama.com>."); and Boursorama SA v. Estrade Nicolas WIPO Case No. D2017-1463, ("Given the circumstances of the case including the evidence on record of the longstanding of use of the Complainant's trademark, and the distinctive nature of the mark BOURSORAMA, it is inconceivable to the Panel in the current circumstances that the Respondent registered the disputed domain name without prior knowledge of the Complainant and the Complainant's mark.").

Consequently, the Complainant argues that the Respondent must have known about the Complainant and its rights at the time of the registration of the disputed domain name.

Further referring to the exhibited screen capture of the web page to which the disputed domain name resolves, the Complainant adds that the Respondent has not demonstrated any activity in respect of the disputed domain name, and argues that it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name 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 rights under trademark law.

Based on this information, previous panels have held that the mere registration of a domain name that is identical or confusingly similar to a well-known or widely-known trademark by an unaffiliated entity may be sufficient to create a presumption of bad faith (WIPO Summary, version 3.0, sections 3.1.4). In addition, the domain name is not used or does not indicate any information about a development project.

Such a practice, defined in many previous decisions as "passive holding", is considered as a bad faith use.

Respondent

No administratively compliant 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

The Complainant's Rights

The Complainant has provided convincing, uncontested evidence that it has rights in the BOURSORAMA mark, established by the ownership of its EUTM registration described above.

Furthermore, the Complainant's uncontested evidence is that it has an extensive goodwill and reputation in the BOURSORAMA mark in its financial services business including online on its portal website at <www.boursorama.com> with over 4,9 million customers which is sufficient to establish rights in the mark under the Policy.

Confusing Similarity

The disputed domain name <boursoramacertif.com> consists of Complainant's BOURSORAMA mark in its entirety in combination with the element "certify" and the gTLD extension <.com>.

The Complainant's BOURSORAMA mark is the initial, dominant and only distinctive element in the disputed domain name. Neither the element "certify" nor the gTLD extension <.com>. add any distinguishing character and their presence within the disputed domain name do not prevent a finding of confusing similarity with the BOURSORAMA mark.

This Panel finds therefore that the disputed domain name is confusingly similar to the BOURSORAMA mark, and the Complainant has therefore succeeded in the first element of the test in Policy paragraph 4(a)(i).

Rights and Legitimate Interest

The Complainant has made out a prima facie case that the Respondent has no rights legitimate interests in the disputed domain name arguing that:

- the Respondent is not known as the disputed domain name;
- the Respondent is not identified in the Whois database as the disputed domain name;
- past panels established under the Policy have held that a respondent is not commonly known by a disputed domain name at issue if as in the present case the Whois information was not similar to the disputed domain name;
- the Respondent is not known by the Complainant;
- the Respondent is not is not affiliated with, nor authorized by the Complainant in any way;
- the Complainant does not carry out any activity for, nor has it any business with the Respondent;
- the Complainant has not granted any license or authorization to the Respondent to make any use of the Complainant's BOURSORAMA mark, to or apply for registration of the disputed domain name;
- the exhibited screen capture of the webpage to which the disputed domain name resolves is shown to be merely a blank web page with the wording "Success! Your new web server is ready to use";
- the exhibited screen capture confirms that the Respondent does not use the disputed domain name and has no demonstrable plan to use the disputed domain name which shows that disputed domain shows that the Respondent is not using the disputed domain name to make a bona fide offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name.

It is well established that once a complainant makes out a prima facie case that a respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts to the respondent to prove its rights or legitimate interests.

The Respondent has failed to discharge that burden and therefore this Panel must find that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore succeeded in the second element of the test in Policy Paragraph 4(a)(ii).

Bad Faith

The Complainant has adduced clear and convincing, uncontested evidence that it has established trademark rights and an extensive goodwill and reputation in the BOURSORAMA mark which long predate the registration and first use of the disputed domain name on June 8, 2023.

It is most improbable that the disputed domain name <boursoramacertif.com> which is composed of only BOURSORAMA trademark in its entirety, generic term "certif", and the gTLD extension <.com> was chosen and registered without knowledge of the Complainant, its BOURSORAMA mark, name and online financial services business.

This Panel finds therefore that on the balance of probabilities the disputed domain name was registered in bad faith with the Complainant in mind with the intention of taking predatory advantage of the Complainant's goodwill and reputation in the BOURSORAMA mark.

The uncontested evidence is that the Respondent has failed to use the disputed domain name for any purpose except to resolve to an inactive webpage with the words "Success! Your new web server is ready to use". These words have no meaning in the context of the registration and use of the disputed domain name.

The Respondent is passively holding the confusingly similar domain name, in circumstances where the Respondent has no rights or

legitimate interest in the disputed domain name, the Respondent is not using the disputed domain name to offer or provide any bona fide goods or services, nor is the Respondent making a fair or non-commercial use of the disputed domain name.

This Panel accepts the Complainant's uncontested submissions that there is no plausible, actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate, such as by passing off, infringing consumer protection legislation, or infringing the Complainant's rights under trademark law.

This Panel finds therefore that such passive holding of the disputed domain name by the Respondent constitutes use in bad faith for the purposes of the Policy.

As this Panel has found that the disputed domain name was registered and is being used in bad faith, Complainant has succeeded in the third element of the test in Policy paragraph 4(a)(iii) and is entitled to succeed in its application.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **boursoramacertif.com**: Transferred

PANELLISTS

Name	James Bridgeman
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DATE OF PANEL DECISION **2023-07-11**

Publish the Decision
