

Decision for dispute CAC-UDRP-105559

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| Case number | CAC-UDRP-105559 |
| Time of filing | 2023-06-22 09:23:08 |
| Domain names | nouvellemajs-boursorama.com, newauthapps-boursorama.com |

Case administrator

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| Name | Olga Dvořáková (Case admin) |
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Complainant

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| Organization | BOURSORAMA |
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Complainant representative

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| Organization | NAMESHIELD S.A.S. |
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Respondent

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| Organization | Cloud DNS Ltd |
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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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of EUIPO trademark registration number 001758614 for the mark BOURSORAMA registered on October 19, 2001.

FACTUAL BACKGROUND

The Complainant is pioneer and leader in its three core businesses: online brokerage, financial information on the Internet, and online banking. In France, BOURSORAMA is the online banking reference with over 4.9 million customers. The Complainant's portal is the first national financial and economic information site and the first French online banking platform. The Complainant also owns a few domain names, including the mark BOURSORAMA, e.g., the domain name <boursorama.com> registered on March 1, 1998.

The disputed domain names were registered on June 16, 2023. The domain name <nouvellemajs-boursorama.com> resolves to the official homepage of the Complainant's website, and the domain name <newauthapps-boursorama.com> remains inactive.

PARTIES CONTENTIONS

Complainant:

(i) The Complainant is the owner of EUIPO trademark registration number 001758614 for the mark BOURSORAMA registered on October 19, 2001. The disputed domain names <nouvellemajs-boursorama.com> and <newauthapps-boursorama.com> are confusingly similar to the Complainant's mark because the disputed domain names incorporate the Complainant's mark in their entirety with the addition of generic terms and the ".com." gTLD.

(ii) The Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent is not related in any way to the Complainant's business. The Respondent is not commonly known by the disputed domain names. The Respondent is not affiliated with the Complainant nor authorized by the Complainant in any way to use the trademark BOURSORAMA. The Complainant does not carry out any activity for, nor has any business with the Respondent. The Respondent does not use the disputed domain names in connection with a bona fide offering of goods or services, or legitimate noncommercial or fair use because the disputed domain name <nouvellemajs-boursorama.com> resolves to the official homepage of the Complainant's website; and the disputed domain name <newauthapps-boursorama.com> remains inactive.

(iii) The Respondent registered and uses the disputed domain names in bad faith. The Respondent had knowledge of the Complainant's rights in the BOURSORAMA mark before registering the disputed domain names. The incorporation of the Complainant's well-known mark BOURSORAMA into the disputed domain names, coupled with the redirection of the disputed domain <nouvellemajs-boursorama.com> to the Complainant's website and the passive holding of the disputed domain name <newauthapps-boursorama.com> constitutes the Respondent's bad faith registration and use 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 names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

Preliminary Issue: Language of the Proceedings

The Panel notes that the Registration Agreement is written in Japanese, thereby making the language of the proceedings in Japanese. The Complainant has requested that the proceeding should be conducted in English. The Panel has the discretion under UDRP Rule 11(a) to determine the appropriate language of the proceedings taking the particular circumstances of the administrative proceeding into consideration. See Section 4.5, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition; see also Lovehoney Group Limited v yan zhang, CAC 103917 (CAC August 17, 2021) (finding it appropriate to conduct the proceeding in English under Rule 11, despite Japanese being designated as the required language in the registration agreement). The Complainant contends that (i) the choice of language is related to the combined fact that the English language is the language most widely used in international relations and is one of the working languages of the Center; (ii) the disputed domain names are formed by words in Roman characters (ASCII) and not in Japanese script; and (iii) in order to proceed in Japanese, the Complainant would have had to retain specialized translation services at a cost very likely to be higher than the overall cost of these proceedings. The use of Japanese in this case would therefore impose a burden on the Complainant which must be deemed significant in view of the low cost of these proceedings.

In addition to the reasons as listed above, the Panel notes that the disputed domain name <nouvellemajs-boursorama.com> resolves to the official homepage of the Complainant's website, which provides services in English as well indicating the

Respondent's ability of understanding the English language. Pursuant to UDRP Rule 11(a), the Panel finds that persuasive argument has been adduced by the Complainant. After considering the circumstance of the present case, in the absence of the Response and no objection to the Complainant's request for the language of proceeding, the Panel decides that the proceeding should be in English.

The Panel is satisfied that all other 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 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
- (2) respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See *Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (FORUM July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also *Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Rights

The Complainant claims rights in the mark BOURSORAMA as identified in the section 'Identification of Rights' above. The Panel notes that the EUIPO trademark registration is sufficient to establish rights in that mark. Since the Complainant provides evidence of trademark registration with the EUIPO, the Panel finds that the Complainant has established its rights in the mark BOURSORAMA. The Complainant contends that the disputed domain names <nouvellemajs-boursorama.com> and <newauthapps-boursorama.com> are confusingly similar to the Complainant's mark because the disputed domain names incorporate the Complainant's mark in their entirety with the addition of generic terms and the ".com." gTLD. The Panel notes that the use of a mark in its entirety with the mere addition of a descriptive or generic term and a gTLD fails to sufficiently distinguish a disputed domain name for the purposes of paragraph 4(a)(i) of the Policy. See *MTD Products Inc v J Randall Shank*, FA 1783050 (Forum June 27, 2018) ("The disputed domain name is confusingly similar to Complainant's mark as it wholly incorporates the CUB CADET mark before appending the generic terms 'genuine' and 'parts' as well as the '.com' gTLD."); see also *Wiluna Holdings, LLC v. Edna Sherman*, FA 1652781 (Forum Jan. 22, 2016) (Finding the addition of a generic term and gTLD is insufficient in distinguishing a disputed domain name from a mark under Policy paragraph 4(a)(i)). The Panel finds that the disputed domain names incorporate the BOURSORAMA mark in their entirety, merely adding the generic terms nouvelle (meaning "new"), majs (meaning "update"), new, auth, and apps and the ".com." gTLD. Therefore, the Panel finds that the disputed domain names are confusingly similar to the BOURSORAMA mark under Policy paragraph 4(a)(i).

No rights or legitimate interests

The Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain names under Policy paragraph 4(a)(ii), then the burden shifts to the Respondent to show it does have rights or legitimate interests. See *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. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain names. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP). See also *Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii)).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent is not known by 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 BOURSORAMA, or apply for

registration of the disputed domain names. When a response is lacking, WHOIS information may be used to determine whether a respondent is commonly known by the disputed domain names under Policy paragraph 4(c)(ii). See H-D U.S.A., LLC, v. Ilyas Aslan / uok / Domain Admin ContactID 5645550 / FBS INC / Whoisprotection biz, FA 1785313 (Forum June 25, 2018) (“The publicly available WHOIS information identifies Respondent as ‘Ilyas Aslan’ and so there is no prima facie evidence that Respondent might be commonly known by either of the [<harleybot.bid> and <harleybot.com>] domain names.”). Additionally, lack of authorization to use a complainant’s mark may indicate that the respondent is not commonly known by the disputed domain names. See Google LLC v. Bhawana Chandel / Admission Virus, FA 1799694 (Forum Sep. 4, 2018) (concluding that Respondent was not commonly known by the disputed domain name where “the WHOIS of record identifies the Respondent as ‘Bhawana Chandel,’ and no information in the record shows that Respondent was authorized to use Complainant’s mark in any way.”). The WHOIS information for the disputed domain names lists the registrants as “Cloud DNS Ltd (Domain Administrator d b a privacy cloudns net).” Nothing in the record suggests that the Respondent was authorized to use the BOURSORAMA mark. Therefore, the Panel finds that the Respondent is not commonly known by the disputed domain names per Policy paragraph 4(c)(ii).

The Complainant also contends that the Respondent does not use the disputed domain names in connection with a bona fide offering of goods or services, or legitimate noncommercial or fair use. The Panel notes that the disputed domain name <nouvellemajs-boursorama.com> resolves to the official homepage of the Complainant’s website; and the disputed domain name <newauthapps-boursorama.com> remains inactive.

The Panel finds that the Respondent’s use of the disputed domain name <nouvellemajs-boursorama.com> to redirect to the Complainant’s website is likely to confuse consumers as to the relationship between the Complainant and the Respondent. A simple redirect or forwarding of a domain name to the Complainant’s controlled website does not grant the Respondent rights or a legitimate interest in the disputed domain names and it cannot constitute a bona fide offering of goods or services or a legitimate noncommercial or fair use under the UDRP. See Altavista Co. v. Brunosousa, D2002-0109 (WIPO April 3, 2002) (where the panel found that respondent “has no right or legitimate interest to use an otherwise deceptive trademark . . . even if it is directed to the legitimate owner of the trademark); see also MySpace, Inc. v. Gomez, D2007-1231 (WIPO Oct. 17, 2007) (finding that “the linking of the disputed domain name to the Complainant’s commercial website is not a legitimate non-commercial or fair use of the domain name” and that the respondent’s use “cannot give rise to a right or legitimate interest in the disputed domain name”).

The Panel further notes that failure to make an active use of the disputed domain name <newauthapps-boursorama.com> does not represent a bona fide offering of goods and services or a legitimate or fair use per Policy paragraph 4(c)(i) and (iii). See CrossFirst Bankshares, Inc. v. Yu-Hsien Huang, FA 1785415 (Forum June 6, 2018) (“Complainant demonstrates that Respondent fails to actively use the disputed domain name as it resolves to an inactive website. Therefore, the Panel finds that Respondent fails to actively use the disputed domain name for a bona fide offering of goods or services or legitimate noncommercial or fair use under Policy ¶ 4(c)(i) or (iii).”).

The Panel therefore finds the Respondent fails to use the disputed domain names in connection with a bona fide offering of goods and services or a legitimate or fair use per Policy ¶ 4(c)(i) and (iii).

The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names.

Bad faith

The Complainant contends that the Respondent registered and uses the disputed domain names in bad faith. The Respondent redirects the disputed domain <nouvellemajs-boursorama.com> to the Complainant’s website. The Panel finds that the Respondent’s redirection of customers from the disputed domain name <nouvellemajs-boursorama.com> to the Complainant’s legitimate website is likely to create confusion as to the association of the parties, instill mistaken confidence in Internet users that the disputed domain name is a reliable website for consumers interested in the Complainant’s offerings, and ultimately to take economic advantage of future consumers through the Respondent’s efforts to legitimize the disputed domain name. See McKinsey Holdings, Inc. v. Mgr. Jakub Bystron, FA 1330650 (FORUM July 23, 2010) (finding that the Respondent’s use of the <mckinsey.us> domain name to resolve to the Complainant’s official website was further evidence of bad faith registration and use under Policy paragraph 4(a)(iii)); see MySpace, Inc. v. Gomez, D2007-1231 (WIPO Oct. 17, 2007) (finding bad faith when “Respondent has been using the disputed domain name to link to the Complainant’s own website. Inherent in that conduct is the risk that the Respondent may at any time cause Internet traffic to re-direct to a website that is not that of, or associated with, the Complainant.”). The Panel therefore finds that the Respondent used the disputed domain name <nouvellemajs-boursorama.com> to commercially benefit off the Complainant’s mark in bad faith for the purposes of Policy paragraph 4(b)(iv).

The Complainant also contends that the disputed domain name <newauthapps-boursorama.com> remains inactive, and the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the 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. The Panel agrees that the passive holding of a domain name does not necessarily circumvent a finding that the domain name is being used in bad faith within the requirements of paragraph 4(a)(iii) of the Policy. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003 (finding that in considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii), the panel must give close attention to all the circumstances of the respondent’s behaviour, and a remedy can be obtained under the Policy only if those circumstances show that

the respondent's passive holding amounts to acting in bad faith.)

The particular circumstances of this case that the Panel has considered are:

(i) The Complainant is pioneer and leader in its three core businesses: online brokerage, financial information on the Internet, and online banking. In France, BOURSORAMA is the online banking reference with over 4.9 million customers. The Complainant's portal is the first national financial and economic information site and the first French online banking platform. As such, the Complainant's mark BOURSORAMA is considered as being a well-known and reputable trademark; and

(ii) The Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name <newauthapps-boursorama.com>.

Taking into account all of the above, the Panel concludes that the Respondent's passive holding of the disputed domain name <newauthapps-boursorama.com> constitutes bad faith under Policy, paragraph 4(a)(iii) and that the Respondent is using the disputed domain name in bad faith.

The Complainant further contends that the Respondent had knowledge of the Complainant's rights in the BOURSORAMA mark before registering the disputed domain names. The Complainant points out that the disputed domain names are confusingly similar to its trademark BOURSORAMA; the Respondent redirects the disputed domain <nouvellemajs-boursorama.com> to the Complainant's website; and its mark BOURSORAMA is well-known. The Panel infers, due to the notoriety of the Complainant's mark and the manner of use of the disputed domain names that the Respondent had knowledge of the Complainant's rights in the BOURSORAMA mark at the time of registering the disputed domain names, and finds that the Respondent registered the disputed domain names in bad faith under Policy paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **nouvellemajs-boursorama.com**: Transferred
2. **newauthapps-boursorama.com**: Transferred

PANELLISTS

| | |
|------|------------------------------|
| Name | Mr. Ho-Hyun Nahm Esq. |
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DATE OF PANEL DECISION **2023-07-21**

Publish the Decision
