Decision for dispute CAC-UDRP-106241

Case number	CAC-UDRP-106241
Time of filing	2024-02-08 15:16:29
Domain names	bourso-online.com

Case administrator

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

Complainant

Organization	BOURSORAMA

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	jaqh ehri

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 owner of the French trademark "BOURSO" No. 3009973 filed on February 20, 2000.

FACTUAL BACKGROUND

The Complainant is a French company active in the field of online brokerage, financial information on the Internet and online banking. The Complainant operates the online portal www.boursorama.com which is a financial and economic information site and French online banking platform.

The Complainant also owns the domain name <bourso.com>, registered on January 11 , 2000, and <boursobank.com> registered since November 23, 2005.

The disputed domain name <bourso-online.com> was registered on February 6, 2024.

PARTIES CONTENTIONS

1. **Complainant**

The Complainant argues that the disputed domain name is confusingly similar to its French trademark BOURSO and its associated domain names, pointing out that the domain name includes its trademark BOURSO in its entirety.

The Complainant contends that the addition of the word "ONLINE" is not sufficient to escape the finding that the disputed domain name is confusingly similar to the BOURSO trademark.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name.

Specifically, the Complainant notes that (i) the Respondent is not known as the disputed domain name and is not affiliated with or authorized by the Complainant in any way, (ii) the Respondent has not been granted any license or authorization by the Complainant to use its trademark BOURSO or to register the disputed domain name, and (iii) the Complainant does not perform any activity for or conduct any business with the Respondent.

Complainant alleges that Respondent has registered and is using the disputed domain name in bad faith. The Complainant contends that the BOURSO trademark has a significant reputation in France and abroad in connection with online financial services due to its long-term use since 1995 and notes that the addition of the term "ONLINE" to the BOURSO trademark cannot be accidental as it directly refers to the Complainant's online activities. Therefore, it is reasonable to conclude that the Respondent registered the disputed domain name with full knowledge of the Complainant's trademark.

The Complainant further contends that the Respondent has not demonstrated any activity with respect to 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 unlawful, such as passing off, a violation of consumer protection laws, or an infringement of the Complainant's trademark rights. Finally, Respondent alleges that MX servers are configured that suggests that they may be actively used for email purposes.

2. **Respondent**

No administratively compliant response has been submitted by the Respondent.

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).

The Complainant has successfully demonstrated that it is the rightful owner of the French "BOURSO" trademark. The Panel acknowledges that the Complainant's BOURSO trademark is unmistakably recognizable in the disputed domain name and it notes that the additional word ONLINE is, due to its generic character, insufficient to prevent likelihood of confusion with the Complainant's trademark.

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).

A complainant is required to establish a prima facie case that the respondent lacks rights or legitimate interests. Once such a case is made, the burden of proof shifts to the respondent to demonstrate their rights or legitimate interests in the disputed domain name. Failure to do so results in the complainant satisfying paragraph 4(a)(ii) of the Policy (as per Article 2.1 of WIPO Jurisprudential Overview 3.0 and WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

Based on the contentions of the Complainant, the Panel finds that the Complainant has successfully established a prima facie case that the Respondent lacks rights or legitimate interests. As the Respondent has failed to provide relevant evidence demonstrating any such rights or legitimate interests, the Complainant is deemed to have satisfied the second element.

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).

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark (see Article 3.1. of WIPO Jurisprudential Overview 3.0).

Registration in bad faith

In determining whether the disputed domain name was registered in bad faith, the Panel specifically considered the following factors

(a) The reputation and acquired distinctiveness of the BOURSO mark. The Complainant contends that the Complainant's trademark has a significant reputation in France and abroad in connection with online financial services. In support of this claim, the Complainant refers to the previous decision confirming that the BOURSO trademark is well known in France, namely WIPO Case No. D2021-0671, Boursorama S.A. v. Contact Privacy Inc. Client 1249617786 / Marcou. In considering whether this Panel may rely on previous UDRP decisions in which the reputation of the BOURSO mark has been recognized by different UDRP panels, the Panel has considered Article 4.1 of the WIPO Jurisprudence Overview 3.0 and finds it to be consistent with the conclusion that, in the case of the same or similar circumstances, recognition of a mark's reputation in a previous UDRP decision should be considered in determining whether the complainant's mark enjoys such reputation. On this basis, the Panel concludes that the Complainant has sufficiently demonstrated the existence of a reputation for the mark BOURSO in France.

(b) The long-term registration of the Complainant's French trademark BOURSO, which dates back to 2000, while the disputed domain name was registered in February 2024.

(c) That both parties are domiciled in France and that the BOURSO trademark is also registered and protected in France.

(d) That the Respondent has used the words "ONLINE" while the Complainant is particularly known for providing its financial services "online".

Based on the foregoing, the Panel concludes that the Respondent must have been aware of the Complainant and its trademark when it registered the disputed domain name.

Therefore, the Panel finds that the Respondent registered the disputed domain name in bad faith.

Use in bad faith

The disputed domain name includes the Complainant's trademark in its entirety, giving the impression of a connection to the goods/services marketed by the Complainant and creating a likelihood of confusion with the BURSO trademark.

There is no active website associated with the disputed domain name. In this regard, the Panel considered whether, in the circumstances of this particular case, the Respondent's passive holding of the disputed domain name could be considered a use of the disputed domain name in bad faith. According to the WIPO Jurisprudence Overview 3.0, non-use of a domain name would not preclude a finding of bad faith under the passive holding doctrine. Factors considered relevant in applying the passive holding doctrine include (i) the degree of distinctiveness or reputation of the complainant's mark; (ii) the respondent's failure to file a response or to provide evidence of actual or intended good faith use; (iii) the respondent's concealment of its identity or use of false contact information (in violation of its registration agreement); and (iv) the implausibility of any good faith use to which the domain name might be put (see also Telstra Corporation Limited vs. Nuclear Marshmallows, WIPO Case No. D2000-0003, <telstra.org>).

In the circumstances of this case, the Panel finds that the Complainant has successfully demonstrated the acquired distinctiveness and reputation of the Complainant's BOURSO mark. In addition, the Panel notes that the Respondent has not provided any response or evidence of actual or intended use in good faith. The Panel also notes that the telephone number provided by the Respondent to the registrar, namely "111111111111", is clearly incorrect.

Finally, the Panel verified that MX records were set up for the disputed domain name. An MX record is a resource record in the Domain Name System that specifies which email server is responsible for accepting email on behalf of a domain name (see WIPO Case No. D2022-0479 CKM Holdings Inc. v. Grant Chonko, Genesis Biosciences). The Panel notes that it is not necessary to assign MX records to a domain name if the registrant does not intend to use the domain name to send and receive e-mail. The activation of MX records to designate an email server and enable email is an action that goes beyond the mere registration of the disputed domain name and indicates that the Respondent has associated the disputed domain name with email servers, which creates a risk that the Respondent may use the disputed domain name for misrepresentation and/or phishing and spamming activities.

Therefore, the Panel is satisfied that the totality of the circumstances of this case supports a finding that the Respondent's failure to use the domain name for a functional website, coupled with the setting of MX records, supports the Panel's finding that the disputed domain name is being used in bad faith.

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 Panel has determined that the disputed domain name is confusingly similar to the Complainant's trademark.

Based on the contentions presented by the Complainant, the Panel has found that the Complainant has satisfactorily made a prima facie case that the Respondent lacks rights or legitimate interests. As the Respondent has failed to provide relevant evidence demonstrating any such rights or legitimate interests, the Complainant is deemed to have satisfied the second element.

The Panel finds that, based on the Complainant's contentions and evidence, it can be concluded that the Respondent must have been aware of the Complainant's trademarks when it registered the disputed domain name, and as such, the Respondent has registered the disputed domain name in bad faith.

Lastly, the Panel has concluded that the Complainant has successfully proven that the disputed domain name is being used in bad faith.

Therefore, for the aforementioned reasons, the Panel orders that the disputed domain name <bourso-online.com> 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. **bourso-online.com**: Transferred

PANELLISTS

Name	**Karel Šindelka**

DATE OF PANEL DECISION 2024-03-20

Publish the Decision