Decision for dispute CAC-UDRP-106594

Case number	CAC-UDRP-106594
Time of filing	2024-06-11 08:57:17
Domain names	foncia-astra-jo.com

Case administrator

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

Complainant

Organization	EMERIA EUROPE

Complainant representative

Organization	ATOUTPI LAPLACE

Respondent

Organization	FONCIA ASTRA

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 provided evidence of ownership of a large number of trademarks, including the following:

- French trademark FONCIA No. 34655504 registered on 27 November 2006
- French trademark FONCIA (logo) No. 3431518 registered on 30 May 2006
- International trademark FONCIA No. 941643 registered on 4 May 2007
- European trademark FONDIA No. 1470210 registered on 6 March 2001

FACTUAL BACKGROUND

The Complainant, EMERIA EUROPE, is French company specializing in real estate services, providing services to individuals and companies. The Complainant has provided evidence of ownership of the registrations for the marks "FONCIA".

The disputed domain name was registered on 9 May 2024 and resolved to an active page reproducing the Complainant's trademark. It currently resolves to an error page.

PARTIES CONTENTIONS

COMPLAINANT

The disputed domain name is confusingly similar to the Complainant's trademarks FONCIA and its domain names. The Complainant contends that the marks are entirely reproduced in the disputed domain name.

Per the Complaint, the Respondent is not authorized by the Complainant in any way and that Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant equally asserts that the use of the domain name in connection to an active website offering real estate services is neither fair, legitimate or non-commercial. On the contrary, the Complainant submits that the disputed domain name is used to disrupt the Complainant's business.

As regards the bad faith of the Respondent, the disputed domain name includes the distinctive and well-known trademark FONCIA. It is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademark.

Furthermore, the Complainant argues that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his website. Therefore, the Complainant deems that the Respondent has registered and is using the domain name at issue in order to intentionally divert traffic away from the Complainant's web site. MX records are also configured, suggesting that the domain name may be actively used for phishing purposes.

RESPONDENT

NO ADMINISTRATIVELY COMPLIANT RESPONSE 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

Notwithstanding the fact that no Response has been filed, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainant.

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following elements:

(i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) that the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant must establish that it has a trademark or service mark and that the disputed domain name is identical or confusingly similar to that trademark or service mark for the Complainant to succeed.

The Complainant is French company specializing in real estate services. The Complainant has provided evidence of ownership of the registrations for the marks "FONCIA". The Panel notes that trademarks provided in support of the complaint alternatively list EMERIA or FONCIA as the owner, and the Complainant provided sufficient evidentiary documentation explaining that "Foncia" is the former company name of the Complainant. Therefore, the Panel accepts that all trademarks be treated as marks of which the Complainant has rights, in line with the Policy.

As regards the question of identity or confusing similarity for the purpose of the Policy, it requires a comparison of the disputed domain name with the trademarks in which the Complainant holds rights. According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), "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".

Also, according to section 1.7 of the WIPO Overview 3.0, "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".

The Panel finds for the Complainant in that the disputed domain name reproduces the marks of the Complainant in their entirety, with the addition of hyphens and the terms "ASTRA" and "JO". Such addition does nothing to diminish the likelihood of confusion.

It is well accepted by UDRP panels that a generic Top-Level Domain ("gTLD") is typically ignored when assessing whether a domain name is identical or confusingly similar to a trademark.

This Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademark and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, any of the following circumstances, if found by the Panel, may demonstrate the respondent's rights or legitimate interests in the disputed domain name:

(i) before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The consensus view of UDRP panels on the burden of proof under paragraph 4(a)(ii) of the Policy is summarized in section 2.1 of the WIPO Overview 3.0, which states: "[…] where 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

The evidence on record does not show that the Respondent was commonly known, as an individual or an organization, by the disputed domain name.

The Panel also accepts, in the absence of a rebuttal from the Respondent, that the Respondent uses the Complainant's trademarks in the disputed domain name without authorization from the Complainant.

Equally, the Panel finds that the Respondent has not made a legitimate noncommercial or fair use of the disputed domain name. The fact that the disputed domain name directed to a website impersonating the Complainant without authorization is, in the opinion of the Panel, a clear indicator that the domain name is not used in a legitimate noncommercial or fair manner.

In the Panel's view such commercial use cannot – from the outset – be considered a legitimate, noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue pursuant to paragraph 4(c)(iii) of the Policy.

The question that remains is whether the Respondent's name (Foncia Astra) is sufficient to grant rights and legitimate interests in the disputed domain name to the Respondent. The Complainant submitted sufficient evidence showing that no FONCIA ASTRA

company is registered in France and the Panel, in its general powers, undertook the same search with the same results.

Therefore, this Panel concludes that the fact that the Respondent name includes the Complainant's name cannot be considered legitimate interest in the present case. The Complainant's name is so well-known in France where the Complainant operates and where the Respondent is located, that it could not be legitimately adopted as a business or company name other than for the purpose of creating an impression of an association with the Complainant.

It is very likely that the Complainant's name would have been chosen as part of its company name by the Respondent only to benefit from Complainant's fame and attract consumers. Of course, such use is not and cannot be considered bona fide under UDRP rules, as ruling otherwise would mean that a Respondent could rely on an initial intentional infringement to demonstrate a legitimate interest, as it has been previously stated by Panels under the Policy.

Therefore, the Panel concludes that the Respondent has no right or legitimate interests in the disputed domain name and therefore finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registration and Use in Bad faith

For the purpose of Paragraph 4(a) (iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of the domain names in bad faith:

(i) circumstances indicating that the holder has registered or has 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 holders documented out-of-pocket costs directly related to the domain name; or

(ii) the holder 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 holder has engaged in a pattern of such conduct; or

(iii) the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on the holder's website or location.

The evidence on the record shows that the Respondent was certainly aware of the existence of the Complainant and of the rights of the Complainant, and that the Respondent, by registering and using the disputed domain name has intentionally attracted internet users by creating a likelihood of confusion with the Complainant's trademark, thereby disrupting the Complainant's business.

Given the long-lasting reputation of the Complainant's company, particularly in France, as well as the structure of the disputed domain name itself, the Respondent cannot have ignored the Complainant's earlier rights, neither can the Respondent have ignored that, when registering the domain name, they would do so in violation of the Complainant's earlier rights.

The Complainant also provided evidence that the Respondent is using the disputed domain name to lead to a website impersonating the Complainant, reproducing its trademarked logo and offering various home goods for sale. This is indicative of bad faith on the part of the Respondent.

The Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith, and therefore finds that the requirement of paragraph 4(a)(iii) of the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **foncia-astra-jo.com** : Transferred

PANELLISTS

Name	**Arthur Fouré**

DATE OF PANEL DECISION 2024-07-23

Publish the Decision