

Decision for dispute CAC-UDRP-106932

Case number	CAC-UDRP-106932
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Time of filing	2024-10-09 11:12:45
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Domain names	boursoimmo.com
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Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	BOURSORAMA
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Organization	Boursoimmo
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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 name.

IDENTIFICATION OF RIGHTS

The Complainant, conducting business under the company name Boursorama, 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 <bourso.com>, registered since 11 January 2000, and <boursorama.com>, registered since 1 March 1998, and used as its main websites promoting its products and services.

The above-mentioned rights of the Complainant are hereinafter referred to as the BOURSO Trademark.

FACTUAL BACKGROUND

The Complainant is a French corporation founded in 1989, a subsidiary of Société Générale. Pioneer and leader in three core businesses—online brokerage, financial information on the Internet and online banking—the Complainant based its growth on innovation, commitment, and transparency. In France, the Complainant is the online banking reference with over 6 million customers. The Complainant's main website (<www.boursorama.com>) is the first national financial and economic information site and the first French online banking platform with over 41,5 million visits each month.

The disputed domain name was registered on 7 October 2024 by Boursoimmo - Paul Graison, residing in France. It resolves to a page

under construction. Besides, MX servers are configured.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to its trademark, since the BOURSO trademark is reproduced in its entirety and the addition of the generic and descriptive term "IMMO" (abbreviation of the French word "immobilier", which stands for real estate and refers to the Complainant's activities) does not prevent the likelihood of confusion between the disputed domain name and the Complainant's trademark.

The Complainant also contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. 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 name by the Complainant.

According to the Complainant, the Respondent is not commonly known by the disputed domain name, nor has acquired any rights in a trademark or trade name corresponding to the disputed domain name. There is no French organization under the name "BOURSOIMMO".

Furthermore, the disputed domain name is not associated with any active website (page under construction), but MX servers are configured. The Complainant contends that there is no demonstrable evidence that the Respondent used or prepared to use the disputed domain name for any bona fide offering of goods or services.

Finally, the Complainant contends that the Respondent's constructive knowledge of the Complainant's potential rights and the passive holding of the disputed domain name clearly show the Respondent's bad faith in the registration and use of the disputed domain name.

The Complainant requests the transfer of the disputed domain name.

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

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

- (i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used by the Respondent in bad faith.

I. THE COMPLAINANT'S RIGHTS AND THE CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S MARK

The Complainant has established that it has rights in the BOURSO Trademark registered in France since 2000.

The disputed domain name consists of the wording "BOURSO", plus the generic and descriptive term "IMMO", and the top-level domain (TLD) ".COM".

In UDRP disputes, the test for identity or confusing similarity involves a straightforward, reasoned comparison between the complainant's trademark and the disputed domain name. This typically entails a side-by-side evaluation of the domain name and the textual elements of the relevant trademark to determine if the mark is recognizable within the domain name. When a domain name fully incorporates a trademark, or at least a dominant feature of it is evident in the domain name, the domain is generally deemed confusingly similar to the mark for the purposes of UDRP standing. Adding other terms—whether descriptive, geographical, derogatory, or otherwise—does not prevent a finding of confusing similarity under this first element. The TLD is usually disregarded in determining identity or similarity, as it is simply a technical aspect of registration.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark, because it contains the entirety or at least the distinctive part of such mark, namely "BOURSO", combined with the generic and descriptive term "IMMO", which refers to the Complainant's activities. This additional term neither affects the attractive power of the Complainant's mark, nor is sufficient to distinguish the disputed domain name from the BOURSO Trademark. Rather, the addition of such generic and descriptive word increases the risk of confusion. Indeed, Internet users might erroneously believe that the disputed domain name and any related web services (website, e-mail, etc.,) are operated, sponsored or endorsed by the Complainant.

Accordingly, the Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain name is confusingly similar to the Complainant's mark.

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

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 name. If the 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.

The Complainant contends to have no relationship whatsoever with the Respondent. 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 name.

The Respondent is Boursoimmo - Paul Graison, having its address in Paris, France. The Complainant has provided evidence that there is no French organization under the name "BOURSOIMMO". Therefore, there is no evidence available that the Respondent, as an individual, business, or other organization, has been commonly known by the disputed domain name or has acquired any rights in a trademark or trade name corresponding to the disputed domain name.

The disputed domain name incorporates the Complainant's distinctive trademark, combined with a generic and descriptive term, and, thus is confusingly similar to the well-known 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 (descriptive, geographical, pejorative, meaningless, or otherwise) 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.

The Complainant has provided evidence that the disputed domain name is resolving to a page under construction and MX servers were configured. Thus, there is no evidence that, before any notice to Respondent of the dispute, the Respondent used, or demonstrably prepared 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. Also, the non-use of the disputed domain name with active MX servers cannot be considered by the Panel a legitimate noncommercial or fair use of the domain name by the Respondent, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

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 name.

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 name.

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

As mentioned under the first element, the Complainant has sufficiently demonstrated to own rights in the BOURSO Trademark since 2000. The Complainant's trademark was registered France well before the date of registration of the disputed domain name (7 October

2024), is valid and widely-known in the territory where the Respondent resides (France).

The disputed domain name is to be considered confusingly similar to the Complainant's trademark, since it incorporates the entirety or at least the distinctive part of the BOURSO Trademark. The addition of the generic and descriptive term "IMMO" (abbreviation of the French word "immobilier", which stands for real estate and refers to the Complainant's activities) and the TLD ".COM" (technical requirement of the registration) are not sufficient elements to escape the finding of confusing similarity between the disputed domain name and the Complainant's trademark. Internet users might be misled and believe that the disputed domain name and any related web services (website, e-mail, etc.) are operated, sponsored or endorsed by the Complainant.

UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

Given the distinctiveness and reputation of the Complainant's prior mark acquired during the years and confirmed also by several UDRP decisions, it is inconceivable that the Respondent could have registered the disputed domain name for a mere chance without actual knowledge of the Complainant's rights in such 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 name (which is highly unlikely), he omitted to verify that the disputed domain name 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 the domain name registration infringes or violates third party's rights. By registering the disputed domain name confusingly similar with the Complainant's mark, the Respondent has violated, inter alia, the cited provision of the Policy.

As for the use, the disputed domain name is not associated with any active website. However, MX servers are configured, and, therefore, the disputed domain name might be used in phishing attacks and to misrepresent the Complainant.

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 WIPO Case No. D2000-0003 Telstra Corporation Limited v. Nuclear Marshmallows and WIPO Case No. D2000-0400 CBS Broadcasting, Inc. v. Dennis Toeppen).

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 use of false contact details
- the implausibility of any good faith use to which the disputed domain name 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 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 BOURSO Trademark under trademark law.

The Panel is satisfied that the Complainant has met the third requirement of the paragraph 4(a) of the Policy and finds that the disputed domain name has been registered and is being used in bad faith.

Consequently, the disputed domain name is 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. **boursoimmo.com**: Transferred

PANELLISTS

Name Ivett Paulovics

DATE OF PANEL DECISION 2024-11-04

Publish the Decision