

ADMINISTRATIVE PANEL DECISION

Primonial v. Daniel Groell

Case No. D2022-1291

1. The Parties

The Complainant is Primonial, France, represented by Novagraaf France, France.

The Respondent is Daniel Groell, France.

2. The Domain Name and Registrar

The disputed domain name <contact-primonial.com> (the “Disputed Domain Name”) is registered with Wix.com Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 11, 2022. On April 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On April 12, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on April 13, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 13, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 9, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 10, 2022.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on May 12, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and

Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a joint-stock company specialized in wealth management.

The Complainant is the owner of the following trademarks (the "PRIMONIAL Trademarks"):

- the European Union trademark PRIMONIAL, No. 006393649, registered on January 7, 2009, and regularly renewed, for products and services in classes 9, 16, 35, 36, 38, 41, and 42;

- the French trademark PRIMONIAL, No. 3495572, registered on April 18, 2007, and regularly renewed, for products and services in classes 9, 16, 35, 36, 38, 41, and 42.

The Complainant is also the owner of the domain name <primonial.com> and is using the denomination "Primonial" as its incorporation and commercial name.

The Disputed Domain Name <contact-primonial.com> was registered on March 21, 2022 and reverts to the Registrar's parking page and mail exchanger (MX) servers were configured from the Disputed Domain Name to potentially send emails from an email address derived from the Disputed Domain Name.

5. Parties' Contentions

A. Complainant

First, the Complainant stands that the Disputed Domain Name creates a general impression that is almost identical to its PRIMONIAL Trademarks. The Complainant underlines that its PRIMONIAL Trademarks are incorporated in their entirety in the Disputed Domain Name and that the addition of the term "contact" has no consequence in the public's mind since it will be considered as a way to enter into contact with the Complainant.

The Complainant adds that the term "primonial" has no meaning. Moreover, since the term "contact" is descriptive, the dominant element of the Disputed Domain Name is the PRIMONIAL Trademarks, which is wholly encompassed in the Disputed Domain Name.

The Complainant highlights that a worldwide search on the web of the first name and surname of the Respondent showed that the Respondent has no prior rights in "Primonial".

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name given the Respondent has no link with the Complainant and has not been authorized to use the PRIMONIAL Trademarks. Moreover, the Complainant adds that the Disputed Domain Name has never been used by the Respondent since it revolves to a generic webpage of the Registrar. The Complainant adds that the Respondent could not ignore the Complainant's activities and thus its use of its PRIMONIAL Trademarks.

Finally, the Complainant contends that the Disputed Domain Name has been registered and is used in bad faith. The Complainant explains that the Respondent wants to free ride on the Complainant's significant reputation. The Complainant stands that the Disputed Domain Name is inactive and may be used to send fraudulent emails to consumers given that MX servers were configured to generate email addresses from the Disputed Domain Name. The Complainant states that it has sent a cease-and-desist letter to the Registrar.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that the Complainant shall prove the following three elements:

(i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(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 in bad faith.

A. Identical or Confusingly Similar

According to the Policy, paragraph 4(a)(i), the Complainant shall prove that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

First of all, the Panel finds that the Complainant has provided evidence that it has rights in the PRIMONIAL Trademarks.

Then, the Panel wishes to remind that the first element of the UDRP serves essentially as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name.

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 domain name. 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 the UDRP (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that the Disputed Domain Name is composed of:

- the PRIMONIAL Trademark in its entirety, and
- the term "contact", and
- a hyphen, and
- the generic Top-Level Domain ("gTLD") ".com".

According to prior UDRP panel decisions, it is sufficient that the disputed domain name incorporates the entirety of a trademark, in order to consider the domain name as confusingly similar to that mark for purposes of UDRP standing. The mere addition of a word to a mark does not prevent a finding of confusing similarity (see *Hoffmann-La Roche Inc., Roche Products Limited v. Vladimir Ulyanov*, WIPO Case No. [D2011-1474](#); *Magnum Piering, Inc. v. The Mudjacks and Garwood S. Wilson, Sr.*, WIPO Case No. [D2000-1525](#); *Bayerische Motoren Werke AG v. bmwcar.com*, WIPO Case No. [D2002-0615](#); *Swarovski Aktiengesellschaft v. mei xudong*, WIPO Case No. [D2013-0150](#); *RapidShare AG, Christian Schmid v. InvisibleRegistration.com, Domain Admin*, WIPO Case No. [D2010-1059](#)).

The Panel considers that, in this case, the addition of the term "contact" to the distinctive PRIMONIAL Trademark included in the Disputed Domain Name does not prevent a finding of confusing similarity between the latter and the PRIMONIAL Trademarks (see section 1.8 of the [WIPO Overview 3.0](#)).

Moreover, the gTLD in a domain name is viewed as a standard registration requirement and as such is disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

Therefore, the Panel holds that the Disputed Domain Name is confusingly similar to the PRIMONIAL Trademarks and that the Complainant has established the first element of paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

According to the Policy, paragraph 4(a)(ii), the Complainant shall demonstrate that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Policy, paragraph 4(c), outlines circumstances that if found by the Panel to be proved shall demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Name.

These circumstances are:

- before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

According to prior UDRP panel decisions, it is sufficient that the complainant shows *prima facie* that the respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of production to the respondent (see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

Indeed, while the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out *prima facie* 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 (see section 2.1 of the [WIPO Overview 3.0](#)).

According to the Panel, the Complainant has shown *prima facie* that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

Indeed, it appears that the Complainant has not given any license or authorization of any other kind to the Respondent to use the PRIMONIAL Trademarks. Moreover, the Panel finds that there is no evidence that the Respondent is commonly known by the Disputed Domain Name or that the Respondent has the intent to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services. On the contrary, the Disputed Domain Name is linked to the Registrar's parking page. Moreover, MX servers were configured which could allow email addresses to be generated from the Disputed Domain Name.

In any case, the Respondent did not reply to the Complainant's contentions.

Moreover, considering the nature of the Disputed Domain Name, Internet users may think that the Disputed Domain Name and/or any email address derived from the Disputed Domain Name would constitute a valid way to contact the Complainant. Thus, the Disputed Domain Name carries a risk of implied affiliation (see section 2.5.1 of the [WIPO Overview 3.0](#)).

Therefore, according to the Policy, paragraphs 4(a)(ii) and 4(c), the Panel considers that the Respondent does not have rights to or legitimate interests in the Disputed Domain Name.

C. Registered and Used in Bad Faith

According to the Policy, paragraph 4(a)(iii), the Complainant shall prove that the disputed domain name has been registered and is being used in bad faith.

Thus, paragraph 4(b) of the Policy provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 respondent's documented out-of-pocket costs directly related to the domain name; or

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

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

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the respondent's website or location or of a product or service on the respondent's website or location.

First, the Panel considers that it is established that the Complainant's PRIMONIAL Trademarks were registered before the registration of the Disputed Domain Name and the Complainant also owns a domain name and a company name containing the term "primonial". Therefore, there is a presumption of bad faith registration of the Disputed Domain Name, given the fact that the Disputed Domain Name wholly reproduces the PRIMONIAL Trademarks.

Moreover, the Panel points out that the Disputed Domain Name is linked to the Registrar's parking page without being actively used, which constitutes a passive holding of the Disputed Domain Name. UDRP panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding.

"While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put." (See section 3.3 of the [WIPO Overview 3.0](#)).

Therefore, the Panel finds that the following circumstances reinforce the fact that the Respondent has registered and is using the Disputed Domain Name in bad faith:

- the Complainant has provided that the term "Primonial" is distinctive and that it is well known by its PRIMONIAL Trademarks;
- the Respondent has not provided any answer to the Complainant's contentions.

Considering all of the above, it is not possible to conceive any plausible actual or contemplated good faith registration and use of the Disputed Domain Name by the Respondent.

Therefore, in view of all the circumstances of this case, the Panel holds that the Respondent has registered and is using the Disputed Domain Name in bad faith according to the Policy, paragraphs 4(a)(iii) and 4(b).

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Name <contact-primonial.com> be transferred to the Complainant.

/Christiane Féral-Schuhl/

Christiane Féral-Schuhl

Sole Panelist

Date: May 26, 2022