

ADMINISTRATIVE PANEL DECISION

Groupe La Française v. Pierre Edouard, lafrancaise-gestion
Case No. D2022-1859

1. The Parties

The Complainant is Groupe La Française, France, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Pierre Edouard, lafrancaise-gestion, Israel.

2. The Domain Name and Registrar

The disputed domain name <lafrancaise-gestion.net> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 23, 2022. On May 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 24, 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 May 24, 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 May 30, 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 May 31, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 21, 2022. On July 7, 2022, the Respondent sent an informal message to the Center.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on July 6, 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 French-based global asset management founded in 1975, having as of March 31, 2022 EUR 51 billion in assets under its management. In addition to that, the Complainant operates its official website under the domain name <la-francaise.com>, registered on December 7, 2010, and is the owner of the following trademark registrations:

- European Union Trade Mark registration No. 011454402 for LA FRANÇAISE and device, registered on April 22, 2013, in classes 35 and 36;
- European Union Trade Mark registration No. 013780093 for LA FRANÇAISE, registered on June 23, 2015, in classes 16, 35, 36 and 38;
- French trademark registration No. 4141946 for LA FRANÇAISE and device, registered on December 15, 2014, in classes 16, 35, 36 and 38; and
- International trademark registration No. 1264656 for LA FRANÇAISE, registered on April 7, 2015, in classes 35 and 36.

The disputed domain name <lafrancaise-gestion.net> was registered on February 16, 2022 and resolves to a parked webpage.

5. Parties' Contentions

A. Complainant

The Complainant asserts to be a well-recognized global asset management company with reported EUR 51 billion in assets as of March 31, 2022, counting with more than 540 employees, representing 20+ nationalities and operations in Paris, Frankfurt, Hamburg, London, Luxembourg, Madrid, Milan, Hong Kong, China and Seoul.

Also according to the Complainant, it has been recognized within the industry and abroad through numerous awards and accolades, having recently been ranked 237th on the Thinking Ahead Institute (TAI) / Pensions and Investments (P&I) 500 – Top 500 Asset Managers Worldwide.

Under the Complainant's view, the disputed domain name is confusingly similar to its trademark given its reproduction in conjunction with a hyphen and the descriptive term "gestion" ("management" in French) which is closely linked and associated with the Complainant's trademark and field of activity.

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name given that:

- (a) the Respondent is not sponsored by or affiliated with the Complainant in any way;
- (b) the Complainant has not licensed, authorized, or permitted the Respondent to register domain names incorporating the Complainant's trademark; or given the Respondent permission to use the Complainant's trademarks in any manner, including in domain names;

- (c) the Respondent is not commonly known by the disputed domain name;
- (d) the Respondent is using the disputed domain name to redirect Internet users to a generic holding page that lacks content; not having demonstrated any attempt to make a legitimate use of the disputed domain name; and
- (e) the presence of MX records implies that the disputed domain name could be used as part of an email phishing scheme in the future.

As to the registration of the disputed domain name in bad faith, the Complainant asserts that the Respondent knew, or at least should have known, of the existence of the Complainant's trademark given that its LA FRANÇAISE trademark is known internationally, with trademark registrations across numerous countries, having the Complainant marketed and rendered and services using this trademark since 1975, which is well before the Respondent's registration of the disputed domain name.

In addition to that, the Respondent provides false contact information in the respective Whois record.

The Complainant argues that the present use of the disputed domain name in connection with a parked webpage amounts to bad faith use of the disputed domain name given the implausibility of any good faith use to which the disputed domain name may be put.

Lastly, given the MX-records that are set up for the disputed domain name the Complainant contends that there is a risk that the Respondent is using or could use the disputed domain name in e-mail communication in an attempt to pass off as the Complainant for fraudulent activities.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions. On July 7, 2022, the Respondent sent an informal message to the Center simply stating: "Hello What can I do to keep my domain name? I am not using any brand or anything that is a trademark!".

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (i) the disputed domain name is identical or confusingly similar to a trademark 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 in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain name.

A. Identical or Confusingly Similar

The Complainant has established rights in the LA FRANÇAISE trademark duly registered in several jurisdictions.

The Panel finds that the disputed domain name reproduces the entirety of the Complainant's mark. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the

complainant's trademark and the disputed domain name". See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7. The addition of a hyphen and the term "gestion" does not prevent a finding of confusing similarity (see [WIPO Overview 3.0](#), section 1.8).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark. The first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that may indicate the Respondent's rights to or legitimate interests in the disputed domain name. These circumstances are:

- (i) before any notice 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 (as an individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired 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 Respondent has failed to invoke any of the circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights to and/or legitimate interests in the disputed domain name. Nevertheless, the burden is still on the Complainant to first make a *prima facie* case against the Respondent (being the overall burden of proof always with the Complainant, but once 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).

In that sense, the Complainant indeed states that the Respondent is not sponsored by or affiliated with the Complainant in any way nor has the Complainant licensed, authorized, or permitted the Respondent to register domain names incorporating the Complainant's trademark; or given the Respondent permission to use the Complainant's trademarks in any manner, including in domain names.

Also, the absence of any indication that the Respondent holds rights in a term corresponding to the disputed domain name, or any possible link between the Respondent and the disputed domain name that could be inferred from the details known of the Respondent or a webpage relating to the disputed domain name available at the disputed domain name, corroborate with the Panel's finding of the absence of rights or legitimate interests.

Therefore, the Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name. The second element of the Policy has also been met.

C. Registered and Used in Bad Faith

This case presents the following circumstances which indicate under the balance of probabilities bad faith registration and use of the disputed domain name:

- a) the Complainant is a well-known company that holds registered trademarks in LA FRANÇAISE, which is reproduced in its entirety in the disputed domain name along with the term "gestion" (which is the French word for "management"), being the term "gestion" one connected with the Complainant's business;
- b) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name;

- c) the indication of what appears to be false contact details not having the Center been able to deliver the written communication to it; and
- d) the potential use of the disputed domain name in connection with e-mail addresses.

Further, previous UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

For the reasons above, the Respondent's conduct has to be considered, in this Panel's view, as bad faith registration and use of the disputed domain name.

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 <lafrancaise-gestion.net> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: July 20, 2022