

ADMINISTRATIVE PANEL DECISION

Carmila v. damien riou, carmila-invest
Case No. D2022-1965

1. The Parties

The Complainant is Carmila, France, represented by IP Twins, France.

The Respondent is damien riou, carmila-invest, Israel.

2. The Domain Name and Registrar

The disputed domain name <carmila-invest.com> 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 31, 2022. On May 31, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 31, 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 June 1, 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 June 2, 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 June 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 28, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 29, 2022.

The Center appointed Torsten Bettinger as the sole panelist in this matter on July 1, 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 real estate company which is part of the Carrefour Group, a French multinational retail and wholesaling corporation headquartered in France.

The Complainant provided evidence of the following trademark registrations:

- EUIPO trademark CARMILA (device) No. 012794467, registered on March 17, 2015, for classes 35 and 36;
- Spanish trademark CARMILA No. M3504331, registered on October 1, 2014, for international class 36;

The Respondent registered the disputed domain name on May 4, 2022.

The disputed domain name resolves to a website that appears to be hosted by the Registrar and does not display any content other than the following:

“Welcome www.carmila-invest.com
Do more with your domain!
Grow your business online with your website.
Building a website is easiest with Zoho Sites.”

5. Parties' Contentions

A. Complainant

The Complainant submits that it owns and operates 214 shopping centers and is the third largest owner of commercial property in Europe. It claims the CARMILA trademark to be well-known.

With regard to the requirement of identity or confusing similarity between the trademark and the disputed domain name pursuant to paragraph 4(a)(i) of the Policy, the Complainant asserts that:

- the disputed domain name is confusingly similar to its well-known trademark CARMILA as the disputed domain name reproduces the Complainant's trademark in its entirety;
- the addition of the term “invest” are not sufficient to distinguish the disputed domain name from Complainant's mark but rather reinforces the risk of confusion; and
- the addition of the generic Top-Level-Domain (“gTLD”) “.com” is not significant in determining whether the disputed domain name is identical or confusingly similar to the Complainant's trademark.

With regards to the Respondent having no rights or legitimate interests in the disputed domain name, the Complainant submitted that:

- based on its research the Respondent has acquired no trademarks in the term CARMILA;
- the Respondent is neither affiliated with, nor has it been licensed or permitted to use Complainant's Carmila Marks or any domain names incorporating the CARMILA Marks;
- there is no evidence that the Respondent is commonly known by the disputed domain name, nor was it known as such prior to the date on which the Respondent registered the disputed domain name;
- the Respondent is not making a legitimate noncommercial fair use of the disputed domain name, as

the disputed domain name resolves to a “default Registrar” website;

- the passive holding of a disputed domain name is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use; and
- Respondent’s failure to use the disputed domain name to provide a *bona fide* offering of goods and services confirms that it does not have a right or legitimate interest in the disputed domain name.

Finally, with regards to the disputed domain name having been registered and being used in bad faith, the Complainant argues that:

- the Respondent had the Complainant’s trademark in mind when he registered the disputed domain name;
- it is highly likely that the Respondent chose the domain name with the expectation that Internet users searching for the Complainant’s services and products would instead come across the Respondent’s domain;
- the non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding; and
- an email address was created at the disputed domain name which appears to mislead Internet users into fake investment plans in shopping centers and real estate property.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy states that the Complainant must prove each of the three following 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

The Complainant has demonstrated that it owns multiple trademark registrations for the mark CARMILA (prior to the registration of the disputed domain name).

It is well-established that the test of identity or confusing similarity under the Policy is confined to a comparison of the disputed domain name and the trademark alone, independent of the products for which the trademark is used or other marketing and use factors usually considered in trademark infringement cases. (See sections 1.1.2 and 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

In this case, the disputed domain name contains the trademark in its entirety and only differs from the Complainant’s trademark CARMILA by the addition of the term “invest”.

The Panel notes that it has long been established under the UDRP case law that wording additional to a trademark in a domain name does not prevent a finding of confusing similarity under the first element of the UDRP (see section 1.8 of [WIPO Overview 3.0](#)) where the mark is recognizable in the domain name.

Furthermore, it is well accepted under the UDRP case law that the specific gTLD designation such as “.com”, “.net”, “.org” is not to be taken into account when assessing the issue of identity and confusing similarity, except in certain cases where the applicable top-level suffix may itself form part of the relevant trademark (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)) section 1.11).

For the foregoing reasons the Panel concludes that the disputed domain name is confusingly similar to the Complainant’s CARMILA trademarks; thus, the first element is fulfilled.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy a respondent may establish its rights or legitimate interests in the domain name, among other circumstances, by showing any of the following elements:

“(i) before any notice to you [the Respondent] of the dispute, your 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
(ii) you [the Respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
(iii) you [the Respondent] are 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.”

The Complainant submitted that it is the owner of 214 shopping centers in Europe and stated that the Respondent is not a licensee, authorized agent of the Complainant, or in any other way authorized by the Complainant to register the disputed domain name.

These assertions and evidence are sufficient to establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

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 disputed 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](#).

The Respondent chose not to contest the Complainant’s allegations and has failed to come forward with any evidence to refute the Complainant’s *prima facie* showing that the Respondent lacks rights or legitimate interests. The Panel therefore accepts these allegations as undisputed facts.

From the record in this case, the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. The Panel notes that the Respondent has provided the organization name “carmila-invest” to the Registrar, but has not participated in this proceeding to explain this; the Panel therefore accords this no weight – and considers it either an attempt by the Respondent to make the corresponding name appear legitimate or was merely done out of convenience to match the disputed domain name itself – as any registrant can enter any name with the registrar without verification.

On this basis, and given that the disputed domain name incorporates the Complainant’s domain name in its entirety and differs from the Complainant’s trademark only by the addition of the word “invest” the Panel concludes that the Respondent lacks rights and legitimate interests in the disputed domain name and that, accordingly, the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- i. circumstances indicating that the Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name; or
- ii. the Respondent has registered the disputed 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 disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. by using the disputed 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.

The Complainant holds multiple trademark registrations for the CARMILA trademark in various countries that predate the registration of the disputed domain name.

Given that the disputed domain name incorporates the Complainant's CARMILA mark in its entirety it is widely known in many countries it is unlikely that the Respondent coincidentally registered the disputed domain name without any knowledge of the Complainant's rights in the CARMILA mark.

The fact that the disputed domain name resolves to a webpage that appears to merely display advertising of the Registrar of the disputed domain name but has not yet been actively used does not prevent a finding of bad faith use.

Although the circumstances listed in paragraph 4(b) are all phrased in terms of affirmative actions by the Respondent, it is by now well accepted that the passive holding of a website, in certain circumstances, can constitute bad faith use under the Policy. (See, e.g., *Teachers Insurance and Annuity Association of America v. Wreaks Communications Group*, WIPO Case No. [D2006-0483](#); *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); see also [WIPO Overview 3.0](#), section 3.3.)

While panels 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 *Telstra Corporation Limited v. Nuclear Marshmallows*, *supra*; see also [WIPO Overview 3.0](#), section 3.3.)

The circumstances of the present case are sufficiently similar to those present in *Telstra* to establish bad faith passive holding of the disputed domain name.

Based on the record in this proceeding, the Panel is satisfied that the Complainant's CARMILA mark is distinctive and widely-known.

Given that the disputed domain name consists of Complainant's CARMILA mark in combination with the descriptive wording, the disputed domain name is also not susceptible to be used in a good faith generic or descriptive sense.

Furthermore, the Respondent has not replied to the Complaint nor provided any evidence of actual or contemplated good faith use of the disputed domain name.

The Panel therefore finds that the circumstances, as described above, show that the Respondent's registration and passive holding of the disputed domain name equals a bad faith registration and use of the disputed domain name and therefore the Complainant also established the third element of the Policy.

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, <carmila-invest.com> be transferred to the Complainant.

/Torsten Bettinger/

Torsten Bettinger

Sole Panelist

Date: July 13, 2022