

ADMINISTRATIVE PANEL DECISION

Groupe La Française v. Contact Privacy Inc. Customer 0164789307, Name Redacted¹

Case No. D2022-3257

1. The Parties

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

The Respondent is Contact Privacy Inc. Customer 0164789307, Canada / Name Redacted.

2. The Domain Name and Registrar

The disputed domain names <la-francaise-gestion.com> and <la-francaise-gestion.net> (the “Domain Names”) are registered with (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 1, 2022. On September 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On September 1, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on September 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 September 14, 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”).

¹ “The Respondent appears to have used the name of a third party when registering the Domain Names. In light of the potential identity theft, the Panel has redacted the Respondent’s name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the Domain Names, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).”

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 9, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Parties with Commencement of Panel Appointment Process on October 17, 2022.

The Center appointed Vincent Denoyelle as the sole panelist in this matter on October 26, 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 headquartered company specializing in asset management.

The Complainant is the owner of several trade marks for LA FRANÇAISE including the following:

- European Union Trade Mark LA FRANÇAISE No. 011454402, registered on April 24, 2013 and;
- French Trade Mark LA FRANÇAISE No. 4141946, registered on December 15, 2014.

The Complainant is also the owner of the domain name <la-francaise.com> reflecting its trade mark.

The Domain Names were registered on July 12, 2022.

At the time of the submission of the Complaint, the Domain Name <la-francaise-gestion.com> pointed to a generic registrar holding page and the Domain Name <la-francaise-gestion.net> pointed to a blank page without content. At the time of the Decision, the Domain Name <la-francaise-gestion.com> triggered the following warning message : "Your connection is not private. Attackers might be trying to steal your information from www.la-francaise-gestion.com (for example, passwords, messages or credit cards)" and the Domain Name <la-francaise-gestion.net> triggered an error message.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Names are confusingly similar to the LA FRANÇAISE trade mark in which the Complainant has rights as the Domain Names incorporate the entire LA FRANÇAISE trade mark with the addition of hyphens and the term "gestion" (meaning "management" in French) and that such addition to each of the Domain Names does not prevent the likelihood of confusion between the Domain Names and the Complainant's trade mark.

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the Domain Names. The Complainant states that the Respondent is not sponsored by or affiliated with the Complainant in any way and that the Complainant has not given the Respondent permission to use the Complainant's trade mark in any manner, including in domain names. The Complainant adds that the Respondent is not commonly known by the Domain Names and that although the Registrar's verification response disclosing registrant and contact information for the Domain Names includes the name of the Complainant and of an employee of the Complainant, the Respondent has falsely identified itself as being associated with the Complainant. In addition, the Complainant asserts that the essentially passive use of the Domain Names do not demonstrate any attempt to make a legitimate use of either of the Domain Names and cannot constitute a *bona fide* offer of goods or services. Further, the Complainant contends that while no evidence has been found that the Domain Names were actively used as part of a fraudulent scheme, the fact that MX records

have been activated for the Domain Names implies that they could be used as part of an email phishing scheme in the future.

The Complainant contends that the Respondent has registered the Domain Names in bad faith, with full knowledge of the Complainant's LA FRANÇAISE trade mark and the Respondent could not have ignored the strong reputation of the Complainant's LA FRANÇAISE trade mark. The Complainant adds that the choice of the targeted term "gestion" added to the Complainant's LA FRANÇAISE trade mark demonstrates that the Respondent targeted the Complainant's LA FRANÇAISE trade mark specifically. The Complainant also alleges that the Respondent is using both Domain Names in bad faith. The Complainant asserts that the use of the Domain Names, which are essentially being held passively, constitutes use in bad faith given the overall circumstances of the case including the strong reputation and renown of the Complainant's trade mark LA FRANÇAISE. The Complainant also refers to a previous decision under the Policy which involved the Complainant and the Respondent and was decided in favor of the Complainant. Further, the Complainant points to the fact that the Respondent has set-up MX records on the Domain Names which in light of the other circumstances could suggest an intention to use the Domain Names malevolently in the future.

B. Respondent

The Respondent did not reply to the Complainant's contentions. However, the Center received emails from a third party who declared that he is an employee of the Complainant and that he has been the victim of identity theft and that the email address used to register the Domain Names is not his email address and that he has no relation to the Domain Names.

6. Discussion and Findings

In order to prevail the Complainant must substantiate, for each Domain Name, that the three elements of paragraph 4(a) of the Policy have been met, namely:

- (i) the Domain Names are 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 Domain Names; and
- (iii) the Domain Names have been registered and are being used in bad faith.

In the case of default by a party, as is the case here, paragraph 14(b) of the Rules makes it clear that if a party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

In the absence of a Response from the Respondent whereby the Respondent did not object to any of the contentions from the Complainant, the Panel will have to base its decision on the basis of the Complaint and supporting Annexes.

A. Identical or Confusingly Similar

In light of the evidence provided by the Complainant, the Panel is satisfied that the Complainant has substantiated that it holds valid trade mark rights in LA FRANÇAISE, which is reproduced in its entirety in both Domain Names.

The second point that has to be considered is whether the Domain Names are identical or confusingly similar to the trade mark LA FRANÇAISE in which the Complainant has rights.

At the second level, the Domain Names incorporate the Complainant's LA FRANÇAISE trade mark in its entirety with the addition of hyphens "-" and the term "gestion" which means "management" in French. The

terms added to the Domain Names do not prevent a finding of confusing similarity between the Complainant's trade mark and the Domain Names.

Then there is the addition of the generic Top-Level-Domain ("gTLD") ".com" and ".net". As is generally accepted, the addition of a gTLD such as ".com" or ".net" is merely a technical registration requirement and as such is typically disregarded under the first element of confusing similarity test.

Thus, the Panel finds that the Domain Names are identical or confusingly similar to a trade mark or service mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out relevant circumstances that could demonstrate that a respondent has rights or legitimate interests in a domain name, namely:

Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate [the respondent's] rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to [the respondent] 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
- (ii) [the respondent] (as an individual, business, or other organization) ha[s] been commonly known by the domain name, even if [the respondent] ha[s] acquired no trade mark or service mark rights; or
- (iii) [the respondent] is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

Numerous previous panels have found under the UDRP that once the Complainant makes a *prima facie* showing that the Respondent does not have rights or legitimate interests in the domain name, the burden of production shifts to the Respondent to rebut the showing by providing evidence of its rights or interests in the domain name.

Having reviewed the Complainant's assertions and evidence, the Panel is satisfied that the Complainant has made a *prima facie* showing that the Respondent lacks rights or legitimate interests in the Domain Names.

The Complainant has stated that it does not know the Respondent and that it has not licensed or otherwise authorized the Respondent to make any use of its LA FRANÇAISE trade mark. There is no evidence that the Respondent is commonly known by either of the Domain Names and although the Registrar's verification response disclosing registrant and contact information for the Domain Names includes the name of the Complainant and of an employee of the Complainant, both the Complainant and the employee of the Complainant have declared that this is a case of fraudulent impersonation and identity theft.

The past and present use of the Domain Names, which are essentially held passively, with the Domain Name <la-francaise-gestion.com> currently triggering the following warning message: "Your connection is not private. Attackers might be trying to steal your information from www.la-francaise-gestion.com (for example, passwords, messages or credit cards)" cannot be considered *bona fide*, legitimate or fair.

Furthermore, the nature of the Domain Names, comprising the Complainant's trade mark in its entirety in combination with an additional term targeting the Complainant's business, carries a risk of implied affiliation. See section 2.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Thus, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Names.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a number of relevant non-exhaustive circumstances, which can be deemed to constitute evidence of registration and use of a domain name in bad faith, namely:

(i) circumstances indicating that [the respondent has] registered or acquired [a disputed] 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 trade mark 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 trade mark 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 [the respondent's] website or other on-line 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.

Given the circumstances described in the Complaint and the documentary evidence provided by the Complainant, the Panel finds that the Domain Names were registered in bad faith.

The Domain Names reproduce the exact LA FRANÇAISE trade mark of the Complainant and this cannot be a coincidence given the overall circumstances of the present case including: (i) the goodwill and reputation of the Complainant's LA FRANÇAISE trade mark, as substantiated by the Complainant, (ii) the fact that the Domain Names were registered relatively recently and many years after the registration of the trade mark LA FRANÇAISE, (iii) the targeted choice of dictionary term added to the trade mark LA FRANÇAISE in the Domain Names and (iv) the claim that the Respondent has registered the Domain Names by fraudulently impersonating the Complainant and an employee of the Complainant.

Thus, the Panel finds that the Domain Names were registered in bad faith.

As for use of the Domain Names in bad faith, given the circumstances described in the Complaint, the evidence provided by the Complainant and the brief verification carried out by the Panel of the websites associated with the Domain Names, the Panel considers that the Domain Names are used in bad faith.

In essence, the Domain Names appear to be passively held. Passive use itself would not cure the Respondent's bad faith given the overall circumstances here, specifically the goodwill and reputation of the Complainant's LA FRANÇAISE trade mark and the Respondent's default to file a Response.

Furthermore, the Respondent, using the identity of the same third party as in the present proceeding, was a party to a previous adverse decision under the Policy against the Complainant.

The fact that the Respondent chose not to object to the Complainant's assertions and that the Respondent appears to have used the name of a third party when registering the Domain Names can only reinforce the Panel's view that the Domain Names are used in bad faith.

Finally, this is further supported by the fact that the Respondent deliberately chose to conceal its identity by means of a privacy protection service, which, in the circumstances, is an additional indication of the Respondent's bad faith and their intent to use the Domain Names in a way which may be abusive or otherwise detrimental to the Complainant and its rights.

Thus, the Panel finds that the Domain Names have been registered and are also being used in bad faith.

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 Domain Names <la-francaise-gestion.com> and <la-francaise-gestion.net> be transferred to the Complainant.

/Vincent Denoyelle/

Vincent Denoyelle

Sole Panelist

Date: November 7, 2022