

ADMINISTRATIVE PANEL DECISION

Fidal et Associés v. Bernard Valo

Case No. D2023-0676

1. The Parties

The Complainant is Fidal et Associés, France, represented by Fidal, France.

The Respondent is Bernard Valo, France.

2. The Domain Name and Registrar

The disputed domain name <fidal-law.com> is registered with Hostinger, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 14, 2023. On February 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 17, 2023, 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 (Domain Admin, Privacy Protect, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 22, 2023 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 February 24, 2023.

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 March 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 27, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 30, 2023.

The Center appointed Elise Dufour as the sole panelist in this matter on April 5, 2023. 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 Fidal et Associes, a French Law firm created in 1922, with more than 1350 lawyers, and a turnover of EUR 317 million in 2013.

The Complainant owns various trademark registrations and notably the following ones:

- FIDAL, French trademark n°1434480 registered on November 9, 1987 for services in classes 35 and 36 and duly renewed;
- FIDAL, French trademark n°3277713 registered on March 4, 2004 for products and services in classes 9, 16, 35, 36, 38, 41 and 42 and duly renewed;
- FIDAL, European Union Trade Mark n°000959700 registered on January 17, 2000 for products and services in classes 35, 36 and 42;

The Complainant also owns a portfolio of domain names that incorporate the FIDAL trademark, such as:

- <fidal.com> registered on August 7, 2001;
- <fidal.fr> registered on December 30, 1996;
- <fidal.eu> registered on June 10, 2006;
- <fidal.org> registered on April 24, 2001.

The disputed domain name was registered on January 23, 2023 and used to resolve to a parking page of the hosting provider. It now resolves to an inactive website.

5. Parties' Contentions

A. Complainant

The Complainant claims that the disputed domain name is (i) identical or at least confusingly similar to its earlier trademark FIDAL, (ii) that the Respondent has no rights or legitimate interests in the disputed domain name, and (iii) that the disputed domain name has been registered and is being used in bad faith.

(i) The Complainant claims that the disputed domain name is confusingly similar to its earlier trademark FIDAL, which is reproduced letter by letter with the addition of the term "law", which is the main activity of the Complainant. For the Complainant, the likelihood of confusion between the Complainant's trademarks and the disputed domain name is enhanced by the well-known character of the trademark and company name FIDAL in the field of legal services. In addition, the addition of the generic Top-Level Domain ("gTLD") ".com" does not change the overall impression of the designation as being connected to the Complainant's trademark.

(ii) The Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name: the Respondent is not currently and has never been known under the name FIDAL, the Complainant has not licensed or otherwise permitted the Respondent to use its trademark FIDAL. Furthermore, the Complainant contends that the disputed domain name is not used in connection with a *bona fide* offering of goods or services, as the disputed domain name directs to the registrar's webpage.

(iii) the Complainant considers that the Respondent must have had the FIDAL trademarks in mind when registering the disputed domain name as the disputed domain name is identical to its previous trademark in association with the term "law". The Complainant also claims that the Respondent's use of the disputed domain name is made in bad faith, as it resolves to an inactive website, which could mislead users to an unrelated website. In addition, the Respondent did not reply to the Complaint and did not provide any evidence of actual or contemplated good-faith use of the litigious domain name.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant owns trademark registrations for the trademark FIDAL. The Panel is satisfied that the Complainant has established its ownership of the trademark FIDAL.

The disputed domain name wholly incorporates the Complainant's trademark FIDAL, which, as it has been long established by previous UDRP panels, may be sufficient to determine that a disputed domain name is identical or confusingly similar to the Complainant's trademarks.

In addition, the disputed domain name comprises the Complainant's trademark FIDAL in its entirety with the addition of a hyphen and the term "law", which describes the Complainant's activity. Neither the hyphen nor the term "law" would eliminate confusing similarity.

Finally, it is well established that the addition of the gTLD ".com" may be disregarded when assessing similarity as it is a standard registration requirement (see section 1.11.1, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), and *SAP SE v. Mohammed Aziz Sheikh, Sapteq Global Consulting Services*, WIPO Case No. [D2015-0565](#)).

Thus, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark.

The Panel finds that the requirement of paragraph 4(a)(i) of the Policy is met.

B. Rights or Legitimate Interests

On the basis of the evidence and arguments submitted, the Panel considers that the Complainant has successfully established the Respondent is not commonly known under the disputed domain name, nor does the Respondent own registered trademark rights in the disputed domain name or has been authorized by the Complainant to use its prior trademarks in any way.

In addition, the disputed domain name reproduces the Complainant's previous trademark with the term "law", related to the Complainant's activity, which carries a risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see section 2.5.1, [WIPO Overview 3.0](#)).

The Panel hence finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name.

It is well established that once a complainant makes out a *prima facie* case that a respondent has no rights or legitimate interests in the disputed domain name, the burden of production shifts to the Respondent to prove its rights or legitimate interests.

However, the Respondent did not formally provide a response or any evidence in this administrative proceeding.

On the basis of the foregoing, the Panel considers that none of the circumstances of rights or legitimate interests envisaged by paragraph 4(c) of the Policy apply, and that the Complainant has satisfied the requirements of the second element under the Policy.

C. Registered and Used in Bad Faith

With regards to the registration of the disputed domain name, the Panel finds that at the time of the registration of the disputed domain name, the Respondent must have been aware of the existence of the Complainant's trademark and activities.

Indeed, given the fact that the disputed domain name incorporates the Complainant's trademark in association with the term "law", describing the Complainant's activity, the Respondent cannot credibly claim to have been unaware of the existence of the previous trademark of the Complainant.

In addition, the disputed domain name resolved to a parked page of the hosting provider and currently resolves to an inactive website. The passive holding does not prevent a finding of bad faith in the circumstances of this case, as it has been considered by past UDRP panels in similar cases. See section 3.3, [WIPO Overview 3.0](#).

In any case, the Panel considers finally that it is not possible to conceive of any plausible contemplated use of the disputed domain name by the Respondent that would not in all likelihood amount to be bad faith use within the meaning of the Policy because it would involve the intentional deception of Internet user.

Therefore, the Panel finds that the requirement of registration and use in bad faith is satisfied, according to the Policy, paragraph 4(a)(iii).

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 <fidal-law.com> be transferred to the Complainant.

/Elise Dufour/

Elise Dufour

Sole Panelist

Date: April 19, 2023