ARBITRATION
AND
MEDIATION CENTER

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

ADMINISTRATIVE PANEL DECISION
BTP Prevoyance and PRO BTP Finance SA v. antoine forille
Case No. D2024-2971

1. The Parties

The Complainants are BTP Prevoyance and Pro BTP Finance, both located in France, represented by Derriennic Associés, France.

The Respondent is antoine forille, France.

2. The Domain Name and Registrar

The disputed domain name <probtp-finance.com> is registered with Hostinger Operations, UAB (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 22, 2024. On July 23, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 24, 2024, 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 ("Privacy Protect, LLC (PrivacyProtect.org)") and contact information in the Complaint. The Center sent an email communication to the Complainants on July 26, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on July 31, 2024.

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 August 2, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 22, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 23, 2024.

The Center appointed Fabrice Bircker as the sole panelist in this matter on August 28, 2024. 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

According to undisputed elements, the Complainants belong to a French social protection group serving companies and people active in the building and civil engineering sector.

With nearly 6,000 employees, they provide various types of insurance and financial services to their more than 3 million clients.

The Complainants' activities are notably protected through the following trademark registration which is held by BTP Prevoyance:



, French trademark registration No. 3894981 filed on February 2, 2012, registered on June 1, 2012, duly renewed since then, and designating products and services of classes 16, 35, 36, 38, 39, 41, 44 and 45.

The Complainants have also on online presence, in particular through the <probtpfinance.com> domain name, which was registered on March 4, 2008.

This domain name is held by Pro BTP Finance and redirects to its official website, where the PRO BTP FINANCE trademark is used.

The disputed domain name, <probtp-finance.com>, was registered on June 7, 2024.

It does not resolve to an active website.

Very little is known about the Respondent, except that, based on the information disclosed by the Registrar, he is apparently located in France.

On July 2, 2024, the Complaints sent a cease and desist letter to the Respondent and the latter has been remaining silent.

5. Parties' Contentions

A. Complainants

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainants contend that the disputed domain name is confusingly similar to their PRO BTP FINANCE trademark, because it reproduces the later.

Besides, the Complainants argue that the Respondent has no rights or legitimate interests in respect with the disputed domain name, in substance because:

- the Respondent does not use the disputed domain name,

- the Complainants have never authorized the Respondent to register and/or use any domain name incorporating their trademark,

- the Respondent does not hold any trademark or tradename corresponding to the disputed domain name.

Then, the Complainants contend that the disputed domain name has been registered and is being used in bad faith, notably because:

- the disputed domain name has been registered to prevent the Complainants from reflecting their trademark in a corresponding domain name,

- the disputed domain name conveys a risk of confusion with the PRO BTP brand, which is well-known,

- the disputed domain name typo squats the Complainants' <probtpfinance.com> domain name,

- the disputed domain name resolves to an inactive website, which amounts to bad faith use by virtue of the passive holding doctrine.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules provides that "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Paragraphs 10(b) and 10(d) of the Rules also provide that "[i]n all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case" and that "[t]he Panel shall determine the admissibility, relevance, materiality and weight of the evidence".

Besides, the Respondent's failure to reply to the Complainant's contentions does not automatically result in a decision in favor of the Complainant, although the Panel is entitled to draw appropriate inferences therefrom, in accordance with paragraph 14(b) of the Rules (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 4.3).

Taking the foregoing provisions into consideration the Panel finds as follows.

6.1 On the procedure – consolidation of multiple complainants

Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. At the same time, paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder. In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation. WIPO Overview 3.0, section 4.11.1.

In the present situation, the Panel finds that:

- according to uncontested elements, the Complainants belong to the same group of companies,

- one of the Complainants is the owner of the invoked trademark, whereas the other Complainant is using said trademark (in particular as company name and on its website).

As a result, the Panel considers not only that the Complainants may have a common grievance against the Respondent, but also that accepting a consolidation of the Complainants would not be prejudicial to the Respondent and is even equitable and procedurally efficient.

Therefore, the Panel permit the consolidation of the Complainants.

6.2 On the substance

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily 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. WIPO Overview 3.0, section 1.7.

Based on the available record (Annex 1 of the Complaint), the Panel finds the Complainants have shown rights in respect of a trademark or service mark for the purposes of the Policy. WIPO Overview 3.0, section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. WIPO Overview 3.0, section 1.7.

Regarding the generic Top-Level Domain ("gTLD") ".com" in the disputed domain name, it is well established that a gTLD does not generally affect the assessment of a domain name for the purpose of determining identity or confusingly similarity. WIPO Overview 3.0, section 1.11.1.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainants, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where complainants make 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 domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainants are deemed to have satisfied the second element. WIPO Overview 3.0, section 2.1.

Having reviewed the available record, the Panel finds the Complainants have established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainants' prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Indeed, the Complainants contend that they have not given their consent to the Respondent to use their PRO BTP FINANCE trademark in a domain name registration or in any other manner.

Besides, there is nothing in the record of the case likely to indicate that the Respondent may be commonly known by the disputed domain name.

Furthermore, the disputed domain name is not used (it resolves to an inactive website) and nothing in the case file suggests that the Respondent has made preparations to use it for legitimate purposes.

At last, the Respondent has not replied to the Complainant's contentions.

As a consequence, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Complainants notably contend that the disputed domain name has been registered to prevent them from reflecting the PRO BTP FINANCE trademark in a corresponding domain name.

However, for the transfer be pronounced on the ground of article 4(b)(ii) of the Policy, the Complainants have to demonstrate that the Respondent is engaged in a pattern of conduct of registering domain names to prevent complainants from reflecting their trademarks in corresponding domain names.

On this point the Complainants are silent.

Nevertheless, the Panel used his general powers[1] to conduct a limited search for the Respondent's name in the public and freely available database of WIPO UDRP Panel Decisions[2]. It appeared that a decision issued after the introduction of the present procedure has ordered the transfer of a domain name held by the Respondent (*Banque Palatine v. antoine forille*, WIPO Case No. D2024-2404).

As UDRP panels have held that establishing a pattern of bad faith conduct requires more than one, but as few as two instances of abusive domain name registration (WIPO Overview 3.0, section 3.1.2), and given that the disputed domain name consists in the mere reproduction of the PRO BTP FINANCE trademark, the Panel consider that the conditions set out by article 4(b)(ii) of the Policy are met.

In addition, the Panel is of the opinion that the Respondent registered the disputed domain name being aware of the Complainants' trademark, that is to say in bad faith, because:

- the disputed domain name reproduces the Complainant's PRO BTP FINANCE trademark, which predates it by more than 10 years,

- the disputed domain name is almost identical to the domain name used by one of the Complainants to resolve to the official website for their PRO BTP FINANCE,

[1] It is well established that the general powers of a panel as articulated inter alia in paragraphs 10 and 12 of the Rules include, among others, the possibility to undertake limited factual research into matters of public record if the panel considers such information useful to assessing the case merits and reaching a decision. These limited factual researches notably include visiting the website linked to the disputed domain name in order to obtain more information about the respondent or its use of the domain name, consulting historical resources such as the Internet Archive (www.archive.org) in order to obtain an indication of how a domain name may have been used in the relevant past, reviewing dictionaries or encyclopedias (e.g., Wikipedia), or accessing trademark registration databases (see for instance, WIPO Overview 3.0, section 4.8).

[2] This database is available at the following address: https://www.wipo.int/amc/en/domains/search/

- according to the information provided by the Registrar, the Respondent is located in France, where the Complainants are particularly active on the market,

- the Respondent has not put forward any argument intended to establish his good faith.

At last, Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. WIPO Overview 3.0, section 3.3. Having reviewed the available record, the Panel notes i) the reputation of the Complainant's trademark which is well known, ii) the composition of the disputed domain name in as far as it identically reproduces the PRO BTP FINANCE trademark and is almost identical to the domain name resolving to the institutional website for said trademark, and iii) the implausibility of any good faith use of the disputed domain by the Respondent in particular because of the above-described pattern of conduct of registering domain names reflecting third parties' trademarks, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds the third element of the Policy has been established.

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 <probtp-finance.com> be transferred to the Complainants[3].

/Fabrice Bircker/
Fabrice Bircker
Sole Panelist
Date: September 2, 2024

[3] The Complainants did not specify in the Remedies Requested in favor of which of them a transfer of the disputed domain name has to be ordered. Therefore, the Panel left up to the Complainants to determine which of them has to be the registrant of the disputed domain name, the transfer of which may be requested by any of them to the Registrar.