

ADMINISTRATIVE PANEL DECISION

PRIMONIAL v. Name Redacted

Case No. D2023-0024

1. The Parties

The Complainant is PRIMONIAL, France, represented by Novagraaf France, France.

The Respondent is Name Redacted¹.

2. The Domain Name and Registrar

The disputed domain name <primonial-gestion.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 January 4, 2023. On January 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 5, 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 (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 17, 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 January 19, 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 January 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 12, 2023. No formal Response was received, but the Center received emails communications from the Respondent on February 6, 2023 and on March 2, 2023.

¹ Please see section 6.1

The Center appointed Fabrice Bircker as the sole panelist in this matter on March 3, 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 a French company active in the field of wealth and asset management.

It counts more than 1,000 employees and around 120,000 clients in France and in the European Union. Besides, it has collected more than EUR 10 billion to invest in 2019, and currently manages more than EUR 50 billion.

The Complainant runs its business under the name PRIMONIAL, which is notably protected through the following trademark:

PRIMONIAL, European Union Trade Mark No. 6393649, filed on October 16, 2007, registered on January 7, 2009, duly renewed since then, and designating products and services of classes 9, 16, 35, 36, 38, 41, and 42.

The Complainant has also an online presence through the <primonial.com> domain name which is registered since March 12, 2007, and which resolves to its official website.

The disputed domain name was registered on December 23, 2022.

At the time of filing of the Complaint and of drafting the decision, it does not direct to an active website.

However, MX and SPF records are set up on it.

5. Parties' Contentions

A. Complainant

The Complainant requests the transfer of the disputed domain name, and its arguments can be summarized as follows:

Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to its PRIMONIAL trademark because it incorporates said trademark in its entirety and the latter remains recognizable within it.

Rights or Legitimate Interests

The Complainant argues that there is no business or legal relationship between it and the Respondent, which is not authorized to use its PRIMONIAL trademark in any way.

Besides, the Complainant also puts forward that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name because it is not using it in connection with an active website.

The Complainant also claims that the Respondent has no rights nor legitimate interests in the disputed domain name as it has no trademark rights in "primonial", nor in "primonial gestion".

Finally, the Complainant contends that the Respondent could not ignore its rights because it is a global leader in the field of wealth management.

Registered and Used in Bad Faith

The Complainant contends that the disputed domain name has been registered in bad faith because it fully reproduces the PRIMONIAL trademark, which has no meaning and is distinctive.

Besides, the Complainant claims that it enjoys a significant reputation, and that the Respondent has registered the disputed domain name to take advantage of the Complainant's reputation.

The Complainant also puts forward that as the disputed domain name does not resolve to an active website, the Respondent has no intention of using it, with the possible exception to send fraudulent emails.

Finally, the Complainant argues that as the Respondent has configured MX servers on the domain name, this demonstrates that the latter intends to use it to send emails liable to mislead their recipients with the Complainant's rights.

B. Respondent

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

However, on February 6, 2023, further to the delivery of the hard copy of the Complaint, he sent a communication to the Center indicating (in French) in substance that:

- he is not related with this matter,
- he is a French citizen and does not speak English,
- the email address and phone number mentioned in his regard in the procedure, are not his,
- his presence in the procedure is a mistake.

Then, on March 2, 2003, the named Respondent sent another communication to the Center indicating in substance that he has just discovered being victim of a financial scam and also probably of an identity theft.

6. Discussion and Findings

6.1. Preliminary Procedural Issue – Respondent and Redaction of Respondent's Identity

The named Respondent's communications asserting that he has nothing to do with the disputed domain name and then that he is probably victim of an identity theft are not accompanied with relevant supporting document, such as the proof of filing of a criminal complaint.

This necessarily raises the question to know whether such communications are purely opportunistic or if the named Respondent is actually victim of an identity theft.

In this case, the Panel finds that:

- on the balance of probabilities and in particular because the communications of the named Respondent support the Complainant's interests, his assertions may be true,
- the alleged identity theft of the named Respondent is not contested by the Complainant,
- in case where the named Respondent was actually victim of an identity theft, the publication of his name in the decision may be detrimental to his repute.

In these circumstances, and pursuant to paragraph 4(j) of the Policy and paragraph 16(b) of the Rules, this Panel is of the opinion that no useful purpose is to be served by referring to the name of the named Respondent. Therefore, the Panel has decided to redact the named Respondent's identity from this decision.

As a consequence, the expression “Respondent” in this decision will identify not the named Respondent, but the person who has actually proceeded with the registration of the disputed domain name and who holds it.

6.2 Substantive Issues

Paragraph 4(a) of the Policy provides that for obtaining the transfer or the cancellation of the disputed domain name, the Complainant must establish each of the following three elements:

- (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.

Besides, 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”.

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

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must first establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to its trademark.

It results from the documents supporting the Complaint, and in particular from Annex 5, that the Complainant is the owner of trademark registrations for PRIMONIAL, such as the one detailed in section 4 above.

Turning to whether the disputed domain name is identical or confusingly similar to the Complainant’s trademark, as indicated in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”): “[w]hile each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trade mark (...), the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.”

This test is satisfied here, as the disputed domain name, <primonial-gestion.com>, identically reproduces the PRIMONIAL trademark, and because the added element, namely “gestion”, consists of a mere dictionary term, which does not prevent the Complainant’s trademark to remain recognizable.

Indeed, there is a consensus view among UDRP panels that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element of the Policy (see [WIPO Overview 3.0](#), section 1.8).

Besides, the generic Top-Level-Domain (gTLD) “.com” may be ignored for the purpose of assessing the confusing similarity, because it only plays a technical function.

Consequently, the first element under the Policy set for by paragraph 4(a)(i) is fulfilled.

B. Rights or Legitimate Interests

Under the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name.

Once such a *prima facie* case is made out, the respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see [WIPO Overview 3.0](#), section 2.1).

In the present case, the Complainant contends that it has not given its consent for the Respondent to use its PRIMONIAL trademark in 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 in relation with an active website and nothing in the case file suggests that the Respondent has made preparations to use it for legitimate purposes.

In view of all the above, the Panel finds that the Complainant has discharged its burden of proof that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The burden of production now shifts to the Respondent to show that it does have rights or legitimate interests in the disputed domain name.

The Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the disputed domain name.

Furthermore, the Panel finds that the disputed domain name carries a high risk of implied affiliation with the Complainant ([WIPO Overview 3.0](#), section 2.5.1).

Taking all the above into consideration, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain names, and therefore that the Complainant has satisfied the second element in paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and is using the disputed domain name in bad faith.

Registration in Bad Faith:

In the present case, the Panel notes that:

- the PRIMONIAL trademark predates the registration of the disputed domain name by 15 years,
- the PRIMONIAL trademark is intrinsically distinctive and, given the uncontested elements provided in the Complainant, it enjoys a repute on the market,
- the term “gestion” (which means “management” in French, and in English) in the disputed domain name directly refers to the activities of the Complainant,
- when registering the disputed domain name, the Respondent has not only used a privacy service, but has also very likely usurped the identity of a third party.

In this Panel’s view, these circumstances establish the Respondent’s bad faith registration of the disputed domain name, and in particular that he was more than likely aware of the Complainant’s rights.

Use in Bad Faith:

The fact that the disputed domain name does not resolve to an active website does not prevent a finding of bad faith use because the present situation clearly falls within the doctrine of passive holding.

Indeed, i) the Complainant's trademark is intrinsically distinctive and enjoys a reputation on the market, ii) the Respondent has failed to submit a response or to provide any evidence of actual or contemplated good-faith use, iii) the disputed domain name exactly reproduces the Complainant's prior trademark along with the term "gestion" (which refers to the Complainant's activities), and iv) the Respondent has registered the disputed domain through a privacy service and, on the balance of probabilities, in usurping the identity of a third party.

In such a context, any good faith use of said disputed domain name by the Respondent seems implausible (See [WIPO Overview 3.0](#), section 3.3).

The Panel is all the more convinced of this noting the Complainant's business sector, the nature of the disputed domain name, and that the Respondent has set up MX (Mail Exchange) and SPF (Sender Policy Framework) Records for the disputed domain name.

MX Records enable to use a domain name to send emails. SPF Record allows the receiving email server to check, during email delivery, that an email (incoming from a specific domain name) is submitted by an IP address and/or email server authorized by that domain name's administrators.

Even if the case file does not contain any evidence of use of the disputed domain name for sending and receiving emails, it nevertheless remains that the mere fact to proceed with such an advanced technical configuration reveals at least a likely intent to use the disputed domain name to exchange emails.

Given i) the composition of the disputed domain name, in as far as it can impersonate the Complainant, ii) the clear absence of rights of the Respondent, iii) the fact that the Respondent has concealed his identity through a privacy service and has, on the balance of probabilities, usurped the identity of a third party, it is extremely likely that the disputed domain name may be used for fraudulent activities, such as phishing schemes impersonating the Complainant.

In any case, in the above-described context, the detention of the disputed domain name in the hands of the Respondent at least represents an unbearable threat hanging on the head of the Complainant.

In the absence of any explanation from the Respondent, the Panel concludes that the Respondent's primary motive in relation to the use of the disputed domain name is to unduly capitalize on, or otherwise take fraudulent advantage of, the Complainant's trademark rights, by creating a likelihood of confusion with the latter.

As a consequence of all the above, the third element under the Policy set forth by paragraph 4(a)(iii) is fulfilled.

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 <primonial-gestion.com> be transferred to the Complainant.

/Fabrice Bircker/

Fabrice Bircker

Sole Panelist

Date: March 17, 2023