

## **ADMINISTRATIVE PANEL DECISION**

### **PRIMONIAL v. Name Redacted**

#### **Case No. D2023-0151**

#### **1. The Parties**

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

The Respondent is Name Redacted.<sup>1</sup>

#### **2. The Domain Name and Registrar**

The disputed domain name <primonialgestion.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 12, 2023. On January 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 13, 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 18, 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”).

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<sup>1</sup> Further to section 6.1 below, the Respondent appears to have used the name of a third party when registering the disputed domain name. 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 disputed domain name, 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Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case.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 January 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 13, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 14, 2023.

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 Trademark 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 was registered on March 12, 2007, and which resolves to its official website.

The disputed domain name was registered on January 5, 2023.

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

However, MX (Mail Exchange) and SPF (Sender Policy Framework) 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 the 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, is distinctive and enjoys a significant reputation.

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.

Moreover, the Complainant argues that as the Respondent has configured MX servers on the disputed domain name, this could at least demonstrate that the Respondent intends to send emails and mislead their recipients with the Complainant’s rights.

Furthermore, the Complainant highlights that the disputed domain name has been registered the day following its filing of an UDRP complaint regarding the <primonial-gestion.com> domain name, which was registered with the same Registrar.

At last, the Complainant mentions that on January 11, 2023, the domain name <primonial-gestion.com> has been used in relation with 650,000 text messages containing a fake link related to said domain name.

The Complainant concludes that the Respondent has registered and is currently using the disputed domain name in bad faith, only to take advantage of the reputation of the Complainant or to send fraudulent e-mails.

### **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1. Preliminary Procedural Issue – Respondent and Redaction of Respondent’s Identity**

At the time of deciding on the present procedure, this Panel has also been appointed to decide on another procedure involving the very same Parties.

In this other procedure, the named Respondent has sent to the Center communications asserting in substance that the Registrant of the disputed domain name has usurped his identity, and the Panel has consequently decided to redact the name of the named Respondent.

For the sake of consistency, and pursuant to paragraph 4(j) of the Policy and paragraph 16(b) of the Rules, the Panel is of the opinion that, in this case too, 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

Pursuant to paragraph 4(a) of the Policy, for obtaining the transfer 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”.

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 section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”)).

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 the [WIPO Overview 3.0](#), section 1.7: “[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 identically reproduces the PRIMONIAL trademark, and because the added element, namely “gestion”, does not prevent the Complainant’s trademark from being 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 the disputed 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 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) 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,
- the disputed domain name has been registered the day following the filing of an UDRP Complaint by the Complainant against the <primonial-gestion.com> domain name which is also hold by the Respondent.

These circumstances establish that the Respondent's bad faith registration as he was necessarily aware of the Complainant's rights when he registered the disputed domain name.

#### **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 because the present situation clearly falls within the doctrine of passive holding.

Indeed, i) the Complainant's trademark is intrinsically distinctive and enjoys a repute 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), iv) the Respondent has registered the disputed domain name just after the filing of an UDRP Complaint against another domain name very close to the Complainant's rights, and v) 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 the disputed domain name by the Respondent seems implausible (see [WIPO Overview 3.0](#), section 3.3).

The Panel is also concerned that the disputed domain name is connected to active 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 potential intent to use the disputed domain name to exchange emails.

Given i) the composition of the disputed domain name, in as far it can impersonate the Complainant, ii) the clear absence of rights of the Respondent, iii) the fact that the disputed domain name has been registered just after the filing of an UDRP Complaint against a very close domain name also hold by the Respondent, and iv) 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 Complainant's mark.

As a consequence of all the above, the third element under the Policy set for 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 <primonialgestion.com> be transferred to the Complainant.

*/Fabrice Bircker/*

**Fabrice Bircker**

Sole Panelist

Date: March 14, 2023