Panel Decision for dispute CAC-ADREU-007847

Case number	CAC-ADREU-007847
Time of filing	2020-02-25 14:28:08
Domain names	cic-immobilier.eu

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	CREDIT INDUSTRIEL ET COMMERCIAL

Respondent

Name	Alain MILLET

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

There are no other legal proceedings related to the disputed domain name.

FACTUAL BACKGROUND

The Complainant, Credit Industriel et Commercial (“CIC”) is a subsidiary of the banking group Credit Mutuel based in France. It provides banking and financial services. The Complainant is the registered owner of the following trade marks:
1. French trademark "CIC" No. 1358524 registered 6 October 1986;
2. European Union trademark "CIC" No. 005891411 registered 10 May 2007;
3. French trademark "Agence Immobilière CIC" No. 4322390 registered 14 December 2016; and
4. International trademark "CIC BANQUES" No. 585098 registered 10 April 1992.

The Complainant owns a number of websites that incorporate the term CIC. It owns www.cic.fr and has owned this website since the 28 May 1999.

The Respondent is Alain Millet also based in France. He is the registered owner of the disputed domain name <cic-immobilier.eu>. The disputed domain name was registered on 30 April 2018.

A. COMPLAINANT

The Complainant asserts it has registered rights in the French word trademarks, the EU word trademark and the International word trademark for CIC described above. It submits that the disputed domain name is identical or confusingly similar to its trademarks.

The Complainant notes that it has a substantial reputation as a bank in France and this has been found in a number of Panel decisions including WIPO Case No. D2013-1263 Credit Industriel et Commercial S.A v. Jeongyong Cho and WIPO Case No. D2013-2143 Credit Industriel et Commercial S.A., (“CIC”) v. Mao Adnri.

The Complainant submits that the addition of a generic top-level domain (gTLD) name “.eu” is legally irrelevant and should not be taken into account in establishing whether the disputed domain name is identical or confusingly similar to the Complainant’s trademark.

According to the Complainant, the inclusion of the word “immobilier” (which translates to real estate in English) in the disputed domain name is not sufficient to avoid confusion in the public’s mind. It notes that panels have found that that the addition of a prefix that relates to one or more generic or descriptive terms from the Complainant’s field of activity may strengthen the likelihood of confusion between the trademark and the disputed domain name. See WIPO No. D2019-0022 Crédit Industriel et Commercial S.A. contre Alain Millet, an earlier case involving the Complainant and the Respondent.

It follows, the Complainant contends, that the disputed domain name is confusingly similar to the Complainant's trademarks.

The Complainant asserts that the Respondent has no rights or legitimate interests in the disputed domain name, that it is not related to the Complainant in any way, is not an agent of the Complainant and that the parties do not carry on any business together. The Complainant confirms that the Respondent had not applied for, or been granted a licence to use the disputed domain name.
The Complainant notes that the Respondent does not own any trademark registrations for CIC or CIC IMMOBILIER.

The Complainant asserts that the Respondent did not register the disputed domain name until late in 2018 despite claiming he has used the term in business since 2007. In WIPO No. D2019-0022 Crédit Industriel et Commercial S.A. contre Alain Millet the Panel found that this late registration did not support the Respondent's contention that he has carried out business under the name since 2007.
As a result, the Complainant asserts that the Respondent lacks any rights or legitimate interest in the disputed domain name.

The Complainant submits that the Respondent has registered and used the disputed domain name in bad faith.

In light of fact that CIC bank is widely known, in particular in France, the Complainant claims that it seems impossible that the Respondent was not aware of the existence of the banking group and of its trademarks CIC and AGENCE IMMOBILIERE CIC when he registered the disputed domain name. In support of this argument the Complainant referred to the finding of the Panel in WIPO No. D2019-0022 Crédit Industriel et Commercial S.A. contre Alain Millet.

The Complainant submits that the Respondent has not provided any evidence of historical use of the acronym CIC. When the Complainant carried out research in relation to the French terms "Consultants Immobilier Commerces» or "Consultants Immobilier et Commercial ", the Complainant did not find any results that related to the Respondent.

The Complainant also argues that a number of its registered trademarks and domain names existed before the Respondent allegedly commenced trading in 2007.

In relation to bad faith use, the Complainant notes that the disputed domain name has remained inactive since its registration. Moreover, the disputed domain name has been renewed despite the fact that the Panel ordered the transfer of similar domain names including "CIC" from the Respondent to the Complainant in the UDRP decision D2019-0022 ibid. Moreover, the Respondent undertook not to register the disputed domain name prior to the UDPR decision.

The Complainant notes that the fact that the disputed domain name has remained inactive could constitute passive holding. Previous panels have found that the passive holding of a disputed domain name may infer a finding of bad faith.

Therefore, the Complainant submits that the Respondent has registered and is using the disputed domain name in bad faith.

B. RESPONDENT

The Respondent did not submit a response.

DISCUSSION AND FINDINGS

Rights

The Complainant has established that it owns the French, European and International trademarks for CIC. The French CIC trademark was registered under number 1358524 on 6 October 1986 and the European Union trademark "CIC" No. 005891411 was registered 10 May 2007.

The disputed domain name incorporates in entirety the Complainant's CIC trademark and is identical to EU TM 00589141 with the exception of a hyphen and the word "immobilier". The inclusion of the common word "immobilier" which is a generic descriptive term for real estate does not distinguish the mark and the ".eu" element is not relevant here.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's registered trademark and the Complaint succeeds under this element of the Policy.

No rights or legitimate interests

The Complainant says that it has neither licensed nor authorised the Respondent to use its CIC trade mark and that it does not carry out

business with the Respondent. It also submits that the Respondent is not commonly known by the terms CIC or CIC IMMOBILIER. Moreover, the Complainant submits that the Respondent does not appear to have any registered rights in CIC or CIC IMMOBILIER.

The Panel notes that the CIC mark is very well reputed in France and the Respondent is both based in France and has been in a previous dispute with the Complainant, which suggests that the Respondent was more likely than not well aware of the Complainant's business and trademark when it registered the disputed domain name, but did so in any event for its own purposes.

The Panel 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. The Respondent has failed to respond or to rebut this case, therefore and for the reasons set out below under "Bad Faith" the Panel finds that the Complainant succeeds under Article 21 (1) (a) of EC Regulation No 874/2004.

Bad faith

The Complainant's French word mark number 1358524 for CIC was registered in 1986 and the disputed domain name was only registered in 2018. In circumstances that the Complainant's brand is renowned in France and internationally, it is more likely than not that the Respondent was aware of the Complainant's business and CIC mark when it registered the disputed domain name.

The disputed domain name does not resolve to an active website and it appears that it has been held passively since its registration. Previous panels have found that holding a disputed domain name passively will not prevent a finding of bad faith in appropriate circumstances. Section 3.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition provides that the relevant factors include a consideration of (i) the degree of distinctiveness or reputation of the Complainant's mark; (ii) the failure of the Respondent to submit a response or to provide evidence of actual or contemplated good faith use; (iii) the Respondent's concealment of its identity or provision of false contact details and (iv) the implausibility of any good faith use to which the disputed domain name may be put.

In this case the Complainant's CIC trademark has, in the Panel's view, a high degree of distinctiveness and through use over many years has developed a very considerable degree of reputation and goodwill in France. The Respondent has no rights or legitimate interests and appears to have no credible explanation for the choice of the disputed domain name.

It is also appropriate to refer to the Respondent's previous track record in respect of the Complainant's trademarks. In the UDRP decision D2019-0022 ibid the WIPO Administrative Panel ordered that the Respondent transfer the disputed domain names: <cicimmobilier.org>, <cic-immobilier.online>, <agencesimmobilierescic.com>, <agencescic.com>, <agenceimmobilierecic.com>, <agencecic.com> to the Complainant. Moreover, before the UDRP decision issued the Respondent provided an undertaking to not renew the disputed domain name <cic-immobilier.eu> at its expiration date. In this regard the Panel also finds that the Respondent has engaged in a pattern of conduct as set out in Article 21 (3)(b)(i) of the EC Regulation No 874/2004.

Although under the Regulation the Complainant is only required to make out a case for registration or use in bad faith, in the circumstances the Panel finds that the Respondent has both registered and has also used the disputed domain name in bad faith and the Complaint also succeeds under this element of the Policy.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the disputed domain name <CIC-IMMOBILIER.EU> be transferred to the Complainant

PANELISTS

Name	Alistair Payne

DATE OF PANEL DECISION 2020-02-24

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant owns registered trademark rights for the CIC trademark. The disputed domain name wholly incorporates the CIC mark and as a result the disputed domain name is confusingly similar to the Complainant's trademarks.

There is no evidence that the Respondent was permitted to use the Complainant's CIC trademark and no evidence that it was making a bona fide or non-commercial use of the disputed domain name.

The CIC trademarks enjoy an established reputation and are distinctive. As a result, it is likely that the Respondent knew of the existence of the Complainant's CIC mark and the disputed domain name was registered with prior knowledge of the Complainant's trademark.

It appears that the disputed domain name has been held passively since its registration. Moreover, It appears that a pattern has emerged whereby the Respondent targets the Complainant's trademarks. Following UDRP decision D2019-0022 on 2 April 2019 the Respondent was ordered to transfer similar disputed domain names to the Complainant. The Respondent also proceeded to renew the disputed domain name despite providing an undertaking before the 2019 UDRP decision issued that he would not renew the disputed domain name <cic-immobilier.eu> at its expiration date.

As a result the Panel finds that the disputed domain name was both registered and has been used in bad faith.