

ADMINISTRATIVE PANEL DECISION

MIROVA v. HENRY CAHILL

Case No. D2023-0710

1. The Parties

Complainant is MIROVA, France, represented by Inlex IP Expertise, France.

Respondent is HENRY CAHILL, France.

2. The Domain Name and Registrar

The Disputed Domain Name <mirova-invest.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 16, 2023. On February 16, 2023, the Center emailed the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 16, 2023, the Registrar emailed the Center its verification response, disclosing registrant and contact information for the Disputed Domain Name, differing from the named Respondent (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent email communication to Complainant on February 17, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on February 20, 2023.

The Center verified that the Complaint, along 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 Respondent of the Complaint, and the proceedings commenced on February 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 15, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on March 21, 2023.

The Center has appointed Nathalie Dreyfus as the sole panelist in this matter on March 23, 2023. The Panel finds that it was properly established. The Panel has submitted the Statement of Acceptance and

Declaration of Impartiality and Independence, as required by the Center in order to guarantee compliance with the Rules, paragraph 7.

4. Factual Background

Complainant is Mirova, a French financial company specializing in sustainable investment. The Complainant provides a wide range of services under its trade name and trademarks MIROVA through an offer of on-site services.

The Complainant is linked to NATIXIS, a well-known company specialized in the banking and financial sector.

Complainant demonstrates its ownership over many trademarks consisting of or including the word MIROVA in France and abroad, among which:

- European Union word trademark No. 10787307, MIROVA dated of September 10, 2012, for goods and services in classes 16, 35 and 36;
- European Union combined trademark No. 11123726, MIROVA RESPONSIBLE INVESTING dated of January 14, 2013, for goods and services in classes 16, 35 and 36;
- International word trademark No. 1146522, MIROVA dated of August 14, 2012, for services in classes 35 and 36

In addition, Complainant has registered several domain names incorporating the brand MIROVA, such as <mirova.com> registered on October 14, 2009 and <mirova.fr> registered on March 7, 2012.

The Disputed Domain Name, <mirova-invest.com>, has been registered on December 21, 2022, with the registrar NameCheap, Inc and resolves to an inactive page.

5. Parties' Contentions

A. Complainant

Firstly, Complainant argues that the Disputed Domain Name is confusingly similar to its trademarks MIROVA as it includes Complainant's trademarks in its entirety. Moreover, Complainant insists on the fact that the term "MIROVA" has no meaning and is highly distinctive.

To support this claim, Complainant primarily refers to its sound reputation, especially in France, where Respondent is located.

Moreover, Complainant argues that the addition of the term "INVEST" does not add distinctive character and does not prevent a discovery of confusing similarity between the Disputed Domain Name and Complainant's trademarks, by referring to previous UDRP decisions, amongst which:

- *Syngenta Participations AG v. Privacy Service Provided by Withheld for Privacy ehf / Nikolay Kovalev*, WIPO Case No. [D2022-1337](#);
- *Carmila v. damien riou, carmila-invest*, WIPO Case No. [D2022-1965](#);
- *Mirova v. DAVID BOUR, MIROVA*, WIPO Case No. [D2022-3262](#).

Secondly, Complainant claims that Respondent has no rights or legitimate interests in this Disputed Domain Name.

Undeniably, Complainant states that it has not granted any license nor authorization to Respondent to register the Disputed Domain Name and that there has been no relationship of any kind between Complainant and Respondent.

Complainant also claims that Respondent does not own any trademark rights including MIROVA or MIROVA-INVEST.

Complainant also states that Respondent is not commonly known by the Disputed Domain Name and that the Disputed Domain Name redirects to an error page which, according to Complainant, does not constitute a *bona fide* offering of goods or services or legitimate, non-commercial or fair use (See *alfinger AG v. 华元科 (huayuanke)*, WIPO Case No. [D2021-0677](#)).

Finally, Complainant emphasizes that Respondent registered and used the Disputed Domain Name in bad faith.

Complainant highlights the distinctiveness and well-known status of its trademarks, citing previous UDRP decisions in which the Panel took into account the notoriety of Complainant's trademarks:

- *MIROVA v. redacted for privacy / Tod Francis, Francis Trucking Inc.*, WIPO Case No. [D2020-2148](#);
- *MIROVA v. Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf. / Gaulard Didier*, MIROVA, WIPO Case No. [D2021-1481](#)
- *MIROVA v. Contact Privacy Inc. Customer 0162716733 / Tabora Dee, mirova*, WIPO Case No. [D2021-3713](#)

Moreover, a quick MIROVA search on Internet would have revealed to Respondent the existence of Complainant and its trademark.

Complainant asserts that Respondent employed a privacy service in order to hide its identity and to avoid being notified of a UDRP proceeding which is an implication of bad faith (See for instance *GVC Holdings plc / ElectraWorks Limited v. Registration Private, Domains By Proxy, LLC / Adnan Atakan Alta*, WIPO Case No. [D2016-2563](#)).

The Disputed Domain Name directs to an error page. There is no evidence of advertising, promotion or public display of the Disputed Domain Name, and no positive action being taken by Respondent in relation to the Disputed Domain Name. Complainant considers that the passive holding of the Disputed Domain Name should be deemed as bad faith use.

Furthermore, Complainant has observed that the Disputed Domain Name has been set up with MX records, meaning that e-mails could therefore be sent from a "@mirova-invest.com" e-mail address. Therefore, Complainant is concerned that Respondent may use the Disputed Domain Name for phishing or other fraudulent activities.

Complainant also states that Respondent mentioned an incorrect address when registering the Disputed Domain Name, which is a clear implication of bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules directs this Panel to "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".

In accordance with paragraph 4(a) of the Policy, Complainant must prove each of the following three elements in order to obtain an instruction that the disputed domain name should be cancelled or transferred:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
 - (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.
- The *onus* of proving these elements is on Complainant.

A. Identical or Confusingly Similar

According to paragraph 4(a)(i) of the Policy, Complainant must prove that the Disputed Domain Name is confusingly similar to a registered trademark in which Complainant has rights.

With regards to this, Complainant has submitted evidence proving its rights in the MIROVA trademarks. The trademark is markedly protected in France where Respondent is located. Therefore, the Panel considers the trademarks rights of Complainant in the sign MIROVA to be established.

The Disputed Domain Name includes Complainant's trademarks in their entirety. Long-standing UDRP case law highlights that confusing similarity is established where the trademark is recognizable within the Disputed Domain Name (See section 1.7 and 1.8 of the [WIPO Overview 3.0](#)).

The addition of the term "INVEST" would not prevent a finding of confusing similarity under Policy, paragraph 4(a)(i). The Panel agrees that the Disputed Domain Name reproduces the trademark MIROVA with the only apparent difference being the addition of the term "INVEST" which does not prevent confusing this similarity.

Furthermore, the generic Top-Level Domain ("gTLD") ".com" only responds to a material requirement to register a domain name and is usually disregarded in order to assess the confusing similarity between a domain name and a trademark (See *Société Air France v. Registration Private, Domains By Proxy, LLC, DomainsByProxy.com / Carolina Rodrigues*, WIPO Case No. [D2019-0578](#)).

In accordance with the aforementioned reasons, the Panel finds that the Disputed Domain Name is confusingly similar to Complainant's trademark and therefore the condition of paragraph 4(a)(i) is fulfilled.

B. Rights or Legitimate Interests

Under Policy paragraph 4(a)(ii), Complainant must first make out a *prima facie* case showing that Respondent lacks rights and legitimate interests in respect to the Disputed Domain Name and then the responsibility of providing proof shifts to Respondent to come forward with, evidencing rights or legitimate interests. If Respondent fails to do so, Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. In the current case, Respondent did not submit arguments in response to the complaint.

Complainant emphasizes that Respondent was not authorized to register and use the Disputed Domain Name and that there is no relationship between Complainant and Respondent.

Long-standing UDRP case law has considered these circumstances to be sufficient to make a *prima facie* case that Respondent lacks rights or interests in the Disputed Domain Name (see for instance *Linklaters LLP v. WhoisGuard Protected / Cindy Smith*, WIPO Case No. [D2019-0941](#)).

Furthermore, Respondent is not commonly known by the Disputed Domain Name (see for instance *LEGO Juris A/S v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-0248](#))

Respondent cannot claim prior rights or legitimate interest in the Disputed Domain Name as Complainant's trademarks has preceded the registration of the Disputed Domain Name for years.

What is more, there is no evidence that Respondent, before any previous notice of this dispute, was using or had made palpable provisions to use the Disputed Domain Name or a corresponding name in connection with a *bona fide* offering of goods or services, in accordance with paragraph 4(c)(i) of the Policy. The Disputed Domain Name, which incorporates Complainant's trademark, redirects to an inactive webpage. Therefore, no *bona fide* offering of goods or services has been established with the Disputed Domain Name.

In view of the previously mentioned circumstances, the Panel finds that Respondent has no rights or legitimate interests concerning the Disputed Domain Name, and the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

To fulfill the third requirement of the Policy, Complainant must prove that the Disputed Domain Name was registered and used in bad faith.

1) Registration in bad faith

Bad faith can be found where Respondent "knew or should have known" of Complainant's trademark rights and regardless, registered a domain name in which they had no rights or legitimate interests (see for instance *Research In Motion Limited v. Privacy Locked LLC/Nat Collicot*, WIPO Case No. [D2009-0320](#) and *The Gap, Inc. v. Deng Youqian*, WIPO Case No. [D2009-0113](#)).

Complainant has shown trademarks rights on "MIROVA" since at least since 2012. Complainant's registered trademarks significantly precede the registration date of the Disputed Domain Name.

Besides, Complainant claims that the MIROVA trademarks are renowned in France and abroad, which Respondent does not contest.

It is accurate that a simple trademark or Internet search would have revealed the MIROVA trademarks to Respondent.

Therefore, the Panel finds that Respondent had registered the Disputed Domain Name in bad faith.

2) Used in bad faith

The Disputed Domain Name redirects to an inactive page. There is no clear indication of any positive action being assumed by Respondent in relation to the Disputed Domain Name. This state of inactivity does not necessarily mean that the Disputed Domain Name has been used in good faith as passive holding does not impede a finding of bad faith (See section 3.3 of the [WIPO Overview 3.0](#)).

In accordance with the passive holding doctrine, use of bad faith is more likely when Respondent passively holds the Disputed Domain Name, especially when the Disputed Domain Name incorporates a famous trademark (see *e.g.*, *Hugo Boss Trade Mark Management GmbH & Co. KG, et al. v. Private Registration/George Kara*, WIPO Case No. [D2015-0666](#)), noting that Complainant argues that MIROVA is a well-known trademark, which Respondent does not contest.

Besides, the Panel notes that the Disputed Domain Name is connected with MX Records which enable Respondent to send e-mails using an e-mail address that includes the Disputed Domain Name. It seems inconceivable that Respondent will be able to make any good faith use of the Disputed Domain Name as part of an e-mail (See *Marklinck SA v. Obabko Nikolay Vladimirovich*, WIPO Case No. [D2019-2371](#); *Belron International Limited v. Milen Radumilo*, CAC-UDRP-103470).

In light of the above, the Panel finds that Respondent registered and used the Disputed Domain Name in bad faith under paragraph 4(a)(iii) of the Policy.

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, <mirova-invest.com> be transferred to Complainant.

/Nathalie Dreyfus/

Nathalie Dreyfus

Sole Panelist

Date: April 6, 2023