

## **ADMINISTRATIVE PANEL DECISION**

Association Française de Normalisation v. Barberis-Negra Olivier  
Case No. D2022-0523

### **1. The Parties**

The Complainant is Association Française de Normalisation (AFNOR), France, represented by Cabinet Greffe, France.

The Respondent is Barberis-Negra Olivier, France.

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

The disputed domain name <nfboisdechauffage.org> is registered with DropCatch.com LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 15, 2022. On February 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 16, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on February 17, 2022, 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 February 18, 2022.

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 February 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 13, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 14, 2022.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on March 17, 2022. 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 the Association Française de Normalisation (AFNOR), which is the holder of the French collective certification mark NF registered on January 16, 1990, under the Number 1588821, in classes 1 to 45, and regularly renewed (the “NF Certification Trademark”).

The disputed domain name <nfboisdechauffage.org> was registered by the Respondent on August 21, 2018 and resolves to a website that presents the wood heating method and includes links to devices for sale on other websites.

#### **5. Parties' Contentions**

##### **A. Complainant**

First, the Complainant stands that the disputed domain name reproduces the NF Certification Trademark to which it only adds terms describing a type of products (“boisdechauffage” meaning “firewood”) for which the NF Certification Trademark is registered.

Second, the Complainant contends that the Respondent has nor rights or legitimate interests in respect of the disputed domain name, since the NF Certification Trademark is a collective certification mark, which purpose is to certify the conformity of a product or a service to specific standard. Each person wishing to use the NF Certification Trademark must have an express authorization from the Complainant and has to comply with extremely restrictive certification procedures. The Complainant points out that the Respondent has never been authorized to use the NF Certification Trademark and has never complied with the certification procedure applicable to heating installations.

At last, the Complainant finds that the Respondent has registered and is using the disputed domain name in bad faith, considering that: (i) the NF Certification Trademark is very ancient and very famous trademark which has been often recognized as renowned by French Courts and European Union Intellectual Property Office (“EUIPO”), (ii) the Respondent’s use of the NF Certification Trademark in the disputed domain name creates a likelihood of confusion and leads consumers to believe that the products which are presented on the Respondent’s website have being approved by the AFNOR in order to attract Internet users to its website for commercial gain, (iii) the Respondent has not responded to the communication of the Complainant asking him to stop using the NF Certification Trademark.

##### **B. Respondent**

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

#### **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that the Complainant shall prove 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.

## A. Identical or Confusingly Similar

According to the Policy, paragraph 4(a)(i), the Complainant shall prove that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

First of all, the Panel finds that the Complainant has provided evidence that it has rights in the NF Certification Trademark.

Then, the Panel wishes to remind that the first element of the UDRP serves essentially 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.

This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of the UDRP (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that the disputed domain name is composed of:

- the NF Certification Trademark in its entirety, and
- the terms "boisdechauffage" meaning "firewood" and
- the generic Top-Level Domain ("gTLD") ".org".

According to prior UDRP panel decisions, it is sufficient that the disputed domain name incorporates the entirety of a trademark, in order to consider the domain name as confusingly similar to that mark for purposes of UDRP standing. The mere addition of additional terms would not prevent a finding of confusing similarity under the first element. (See *Hoffmann-La Roche Inc., Roche Products Limited v. Vladimir Ulyanov*, WIPO Case No. [D2011-1474](#); *Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. [D2000-1525](#); *Bayerische Motoren Werke AG v. bmwcar.com*, WIPO Case No. D2002-0615; *Swarovski Aktiengesellschaft v. mei xudong*, WIPO Case No. [D2013-0150](#); *RapidShare AG, Christian Schmid v. InvisibleRegistration.com, Domain Admin*, WIPO Case No. [D2010-1059](#)).

The Panel considers that, in this case, the addition of the terms "boisdechauffage" to the trademark NF included in the disputed domain name does not prevent a finding of confusing similarity between the latter and the NF Certification Trademark.

Furthermore, while the content of the website associated with the domain name is usually disregarded by panels when assessing confusing similarity under the first element, here, the content of the website associated with the disputed domain name confirms confusing similarity whereby it appears *prima facie* that the Respondent seeks to target the NF Certification Trademark through the disputed domain name (see section 1.15 of the [WIPO Overview 3.0](#)).

Moreover, the gTLD in a domain name is viewed as a standard registration requirement and as such is disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

Therefore, the Panel holds that the disputed domain name <nfboisdechauffage.org> is confusingly similar to the NF Certification Trademark and that the Complainant has established the first element of paragraph 4(a) of the Policy.

## B. Rights or Legitimate Interests

According to the Policy, paragraph 4(a)(ii), the Complainant shall demonstrate that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Policy, paragraph 4(c), outlines circumstances that if found by the Panel to be proved shall demonstrate the Respondent's rights or legitimate interests in the disputed domain name.

These circumstances are:

- before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

According to prior UDRP panel decisions, it is sufficient that the complainant shows *prima facie* that the respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of production to the respondent (see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

Indeed, while the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out *prima facie* 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element (see section 2.1 of the [WIPO Overview 3.0](#)).

According to the Panel, the Complainant has shown *prima facie* that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Indeed, it appears that the Complainant has not given any authorization to the Respondent to use the NF Certification Trademark and that the Respondent has never complied with the certification procedure applicable to heating installations or firewood.

Moreover, the Panel finds that the website to which the disputed domain name resolves, includes links for the purchase of various products related to heating installations and firewood, which do not necessarily appear to have NF certification. Therefore, the use of the disputed domain name does not correspond to a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers (see section 2.9 of the [WIPO Overview 3.0](#)).

In any case, the Respondent did not reply to the Complainant's contentions.

Therefore, according to the Policy, paragraph 4(a)(ii) and 4(c), the Panel considers that the Complainant has established that the Respondent does not have rights to or legitimate interests in the disputed domain name <nfboisdechauffage.org>.

### **C. Registered and Used in Bad Faith**

According to the Policy, paragraph 4(a)(iii), the Complainant shall prove that the disputed domain name has been registered and is being used in bad faith.

Thus, paragraph 4(b) provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

"(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who

is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location."

First of all, the Panel notes that the disputed domain name was registered long after the registration of the NF Certification Trademark, that have furthermore been recognized as renowned by French Courts and EUIPO. Thus, the Panel finds that the Respondent, who is French, knew, or should have known, at the registration stage, that the disputed domain name would be confusingly similar to the NF Certification Trademark.

According to previous UDRP decisions, "the registration of a domain name that is identical or confusingly similar (...) to a famous trademark by an unaffiliated entity can by itself create a presumption of bad faith" (see Section 3.1 of the [WIPO Overview 3.0](#)).

In addition, the Panel notes that the disputed domain name refers to a multitude of products for sale that have not been certified NF, whereas the Respondent could have registered a domain name without reproducing the NF Certification Trademark. Consequently, the Panel considers that the Respondent attempts to attract, for commercial gain, Internet users looking for firewood certified NF to its website. The Respondent's use of the Complainant's certification trademark creates a likelihood of confusion insofar as Internet users may assume that the Respondent's website is affiliated with or otherwise sponsored by NF certified producers of firewood, which cannot be considered a good faith use of the disputed domain name.

Furthermore, the Panel notes that the Respondent has not submitted any reply to the Complaint.

Therefore, in view of all the circumstances of this case, the Panel holds that the disputed domain name has been registered and used in bad faith according to Policy, paragraph 4(a)(iii).

## **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 <nfbaisdechauffage.org> be transferred to the Complainant.

*/Christiane Féral-Schuhl/*

**Christiane Féral-Schuhl**

Sole Panelist

Date: March 31, 2022