

## **ADMINISTRATIVE PANEL DECISION**

Agence Centrale Des Organismes De Securite Sociale v. Yamamoto Isoroku  
Case No. D2022-4542

### **1. The Parties**

The Complainant is Agence Centrale Des Organismes De Securite Sociale, France, represented by Alain Bensoussan SELAS, France.

The Respondent is Yamamoto Isoroku, United States of America.

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

The disputed domain name <urssaf-portaii.com> and <urssaf-pro.com> are registered with OwnRegistrar, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed in French with the WIPO Arbitration and Mediation Center (the "Center") on November 29, 2022. On November 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 30, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (WhoisSecure) and contact information in the Complaint. The Registrar also indicated that the language of the Registration Agreement was English. The Center sent an email communication to the Complainant on December 1, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Center also sent an email communication to the Complainant on December 1, 2022, inviting the Complainant to provide sufficient evidence of an agreement between the Parties for French to be the language of proceeding, a Complaint translated into English, or a request for French to be the language of proceedings. The Complainant filed an amended Complaint in English on December 2, 2022.

The language of the proceedings is English according to the paragraph 11(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules").

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 December 12, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 1, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 3, 2023.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on January 13, 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 the French national fund of the collection branch of the general social security system, which has the power to direct, control, and coordinate the collection of social security and family allowance contributions in France.

The Complainant obtained registrations for the trademark URSSAF in France, including Trademark Registration Number 4721802, registered on May 7, 2021.

The Complainant is also the owner of other domain names incorporating the trademark URSSAF, such as <urssaf.fr> and <urssaf.org>.

The Respondent registered both disputed domain names, <urssaf-portaii.com> and <urssaf-pro.com>, on July 25, 2022.

As evidenced in the Complaint, the disputed domain name <urssaf-portaii.com> does resolve to any active website and the disputed domain name <urssaf-pro.com> resolves to a website reproducing the Complainant's trademark URSSAF and requesting visitor's personal data to "obtain money saving offers".

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

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

The Complainant makes the following contentions:

(i) The disputed domain names are identical or confusingly similar to the Complainant's trademark. The Complainant is the owner of French trademark registrations for URSSAF. The disputed domain names reproduce identically the single word element of the earlier mark URSSAF, and add the descriptive and generic terms "portaii" and "pro", separated from the URSSAF sign by a dash. Previous UDRP decisions has held that the the terms "portal" (English translation of the French word "portail") and "pro" (referring to the term "professional") are generic in nature in association with a complainant's mark. Thus, neither the addition of the dash, nor the addition of the generic terms "portaii" and "pro" in the second position, reduces the likelihood of confusion with the identical reproduction of the Complainant's trademark URSSAF.

(ii) The Respondent has no legitimate interests in the disputed domain names. It is accepted that a complainant must make out a *prima facie* case that a respondent lacks rights or legitimate interests. The burden of production on this element shifts to the respondent. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have met the requirements of paragraph 4(a)(ii) of the Policy. The Complainant is the owner of the earlier French well-known trademark URSSAF. The name "UrssaF" enjoys a reputation among a large segment of the public in France because of its massive use since 1960. The Respondent is not the owner of any registered trademark consisting of the sign URSSAF and the only rights in the sign URSSAF identified on the databases consulted are those owned by the Complainant. In addition, the Respondent has not received any authorization from the Complainant to register or exploit

the sign URSSAF in any capacity whatsoever, and in particular as a domain name.

(iii) The Respondent registered and is using the disputed domain names in bad faith. It is up to the respondent, before proceeding with the registration of a domain name to verify that such registration does not infringe the rights of third parties. In addition, the registration of a domain name that is identical or confusingly similar to a widely-known trademark can by itself create a presumption of bad faith, particularly domain names incorporating the mark plus a descriptive term. The use of a domain name associated with the collection of data raises the possibility of phishing attempts, when Internet users think that they are directed to an official domain name of the complainant. Also, the absence of use of a domain name and the provision of false contact details are further indications of bad faith. Beyond its registration, the disputed domain name <urssaf-pro.com> gives access to an Internet website reproducing the sign URSSAF, whose main objective is to collect personal data and on which it is impossible to identify the publisher and may include phishing activities. The disputed domain name <urssaf-portaii.com> has not been used to date. Even though, any use of these disputed domain names would be likely to create a likelihood of confusion with the Complainant's trademark, suggesting the existence of an authorization given by the Complainant or of any link with the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain names, the Complainant shall prove the following three elements:

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

### **A. Identical or Confusingly Similar**

The Complainant has provided evidence of its trademark registrations for URSSAF in France.

The trademark URSSAF is wholly encompassed within the disputed domain names.

The disputed domain names differ from the Complainant's trademark by the addition of the terms "-portaii", in <urssaf-portaii.com>, and "-pro", in <urssaf-pro.com>, as well as of the generic Top-Level Domain ("gTLD") ".com".

Previous UDRP decisions have found that symbols (such as the hyphen) and additional terms (such as "portaii" and "pro") to a trademark do not prevent a finding confusing similarity. This has been held in many UDRP cases (see, e.g., *Inter-IKEA Systems B.V. v. Evezon Co. Ltd.*, WIPO Case No. [D2000-0437](#); *The British Broadcasting Corporation v. Jaime Renteria*, WIPO Case No. [D2000-0050](#); *Volvo Trademark Holding AB v. SC-RAD Inc.*, WIPO Case No. [D2003-0601](#); *Wal-Mart Stores, Inc. v. Lars Stork*, WIPO Case No. [D2000-0628](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#); *AltaVista Company v. S. M. A., Inc.*, WIPO Case No. [D2000-0927](#)).

It is also already well established that the addition of a gTLD extension such as ".com" is typically irrelevant when determining whether a domain name is confusingly similar to a complainant's trademark. As a result, the Panel finds the disputed domain names to be confusingly similar to the Complainant's trademark.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate a right or legitimate interest in a domain name:

(i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services; or

(ii) the respondent has been commonly known by the domain name; or

(iii) 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 at issue.

Based on the Respondent's default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain names.

The Complainant has not licensed nor authorized the use of its trademark to the Respondent, and the Panel finds no indication that the Respondent is commonly known by the disputed domain names.

Actually, the Respondent has not indicated any reason to justify why the specific terms "urssaf-portail" and "urssaf-pro" were chosen to compose the disputed domain names. Also, one of the disputed domain names is not even being used, and the other does not provide a context that could explain the Respondent's choice.

"Urssaf" has no dictionary meaning and Google searches for this term point to the Complainant.

Therefore, the use of the Complainant's trademark in the context of the disputed domain names cannot qualify as a *bona fide* offering of services.

Consequently, the Panel is satisfied that the Complainant has proven the second element of the Policy.

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

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in 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 registration 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 documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent 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 its website or location or of a product or service on its website or location.

When the disputed domain names were registered by the Respondent in 2022, the term "Urssaf" was already well known for decades in France and directly connected to the Complainant.

The disputed domain names encompass the previously registered trademark URSSAF.

The Panel considers that the addition of the terms “-portaii” and “-pro” may even enhance the risk of confusion in the present case, respectively suggesting that the disputed domain names refer to the Complainant’s official Internet portal and professional services.

According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, section 3.1.4, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

Therefore, the Panel concludes that it is unlikely that the Respondent was not aware of the Complainant’s trademarks and that the adoption of the disputed domain name was a mere coincidence.

As already mentioned, the disputed domain name <urssaf-pro.com> is linked to a website reproducing the Complainant’s trademark URSSAF and requesting user’s personal data. Currently, no active website is linked to the disputed domain name <urssaf-portaii.com>, but this is not enough to avoid the Panel’s findings that both disputed domain names are being used in bad faith.

In the Panel’s view, the circumstances of this case, including:

- (a) the Respondent not presently using the disputed domain name <urssaf-portaii.com>;
- (b) the Respondent not indicating any intention to use the disputed domain name <urssaf-portaii.com>;
- (c) the Respondent not providing justifications for the registration of both domain names, containing a third-party famous trademark;
- (d) the distinctive nature of the Complainant’s trademark URSSAF, which has no dictionary meaning;
- (e) the adoption of privacy services when registering both disputed domain names;
- (f) the lack of any plausible good faith reason for the adoption of the terms “urssaf-portaii” and “urssaf-pro” by the Respondent; and
- (g) the phishing use being made of the disputed domain name <urssaf-pro.com>, seeking sensitive personal data from Internet users.

are enough in this Panel’s view to characterize bad faith registration and use in the present case.

Accordingly, the Panel finds that the disputed domain names were registered and are being used in bad faith, and the Complainant has also satisfied the third element 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 names, <urssaf-portaii.com> and <urssaf-pro.com>, be transferred to the Complainant.

*/Rodrigo Azevedo/*

**Rodrigo Azevedo**

Sole Panelist

Date: January 25, 2023