

ADMINISTRATIVE PANEL DECISION

CITYA Immobilier v. Domain Administrator, Fundacion Privacy Services LTD
Case No. D2023-1723

1. The Parties

The Complainant is CITYA Immobilier, France, represented by Cabinet Bouchara, France.

The Respondent is Domain Administrator, Fundacion Privacy Services LTD, Panama.

2. The Domain Name and Registrar

The disputed domain name <wwwcitya.com> is registered with Media Elite Holdings Limited (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 19, 2023. On April 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 22, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 April 26, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 16, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 17, 2023.

The Center appointed Anna Carabelli as the sole panelist in this matter on June 9, 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 real estate agency network founded by Mr. Philippe Briand in 1990.

The founder of the Complainant is the proprietor of a number of registered trademarks comprising CITYA, including France trademark number 3186328 CITYA and device, filed on October 1, 2002 and duly registered in classes, 35, 36, 38 and 41. The Complainant has the exclusive rights to exploit the CITYA trademarks registered in the name of its founder, and for over 30 years has provided real estate services in France, under the CITYA mark.

The Complainant has a network of 236 real estate agencies with more than 3,500 employees throughout France, and operates a website at the domain name <citya.com> registered on June 28, 2001, offering and marketing the Complainant's services which include real estate searches, sale, purchase, rental management, and co-ownership management services.

The disputed domain name was registered on March 2, 2012. The evidence in the Complaint is that the disputed domain name resolves to a parking page that contains a number of sponsored links, including links to competitors of the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant's submits and contends that:

- The disputed domain name is confusingly similar to the CITYA trademark in which the Complainant has rights. In this regard, the Complainant notes that the disputed domain name entirely incorporates the Complainant's trademark, which is distinctive and well known. The addition of the letters "www" does not prevent a finding that the disputed domain name is confusingly similar to the Complainant's CITYA registered trademark.

The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has not received any permission or consent from the Complainant to use its CITYA mark, and is not commonly known by the disputed domain name.

- The disputed domain name displays pay-per-click advertising resolving to third party companies that operate in the real estate field and offer the same services as the Complainant's. In this regard, the Complainant points out that previous UDRP panels have recognized that the use of a domain name to host pay-per-click links does not represent a *bona fide* offering of goods and services where such use competes with or capitalizes on the reputation and the goodwill of the complainant's mark or otherwise mislead Internet users. By using the disputed domain name as a parking page, in French language, referring to the Complainant's competitors, the Respondent could not have ignored the Complainant and its trademark.
- The disputed domain name was registered in bad faith, long after registration of the Complainant's trademark CITYA. It is inconceivable that the Respondent did not have in mind the Complainant's mark when registering the disputed domain name.
- The disputed domain name is being used in bad faith. By setting up a parking page on the disputed domain name and therefore generating pay-per-click revenue through links with titles in French language related to the Complainant's activity, the Respondent intentionally attempted to attract, for commercial gain, French Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's trademark. The Complainant notes that according to previous UDRP decisions the registrant is responsible for the content of the website associated with its domain

name, therefore there is no need to determine if the revenues from its parking page are actually collected by the Respondent or by the Registrar.

Based on the above, the Complainant requests that the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel to decide the Complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the Complainant must prove each of the following:

- (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.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii), shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the Respondent, shall be evidence of the Respondent's rights to or legitimate interests in the disputed domain name for the purpose of paragraph 4(a)(ii) above.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademark CITYA based on the evidence submitted in the Complaint.

The disputed domain name consists of the Complainant's trademark CITYA with the addition of the letters "www", followed by the generic code Top-Level Domain ("gTLD") .com.

The ".com" gTLD is a mere technical requirement for registration. As such, it is typically disregarded for the purposes of consideration of confusing similarity between a trademark and a domain name. See section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition - "[WIPO Overview 3.0](#)".

As highlighted in section 1.7 of the [WIPO Overview 3.0](#), the threshold test for confusing similarity 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 disputed domain name, *i.e.*, "wwwcitya".

The disputed domain name entirely incorporates the Complainant's mark CITYA and this is a sufficient element to establish confusing similarity, as held by previous UDRP panels (*e.g.*, *Banca Mediolanum S.p.A. v. Domains By Proxy, LLC / Marzia Chiarello*, WIPO Case No. [D2020-1955](#); *Virgin Enterprises Limited v. Domains By Proxy LLC, Domainsbyproxy.com / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO

Case No. [D2020-1923](#); *Patagonia, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1409](#)).

As recorded in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element.

Accordingly, the Panel finds that disputed domain name is confusingly similar to the mark in which Complainant has rights. Therefore, the Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) before any notice to it of the dispute, its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name, even if it has acquired no trademark or service mark rights;
- (iii) it 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.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, based on the following: (a) the Complainant hold prior rights in the registered CITYA mark which is distinctive and well known, (b) the Respondent has not been authorized to use the Complainant's trademarks in any way, and is not commonly known by the disputed domain name (c) the disputed domain name resolves to a pay-per-click webpage displaying a number of sponsored links, including links to competitors of the Complainant, and such use does not represent a *bona fide* offering of goods and services.

According to section 2.1 of the [WIPO Overview 3.0](#), while the overall burden of proof in UDRP proceedings is on the complainant, 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 a *prima facie* case 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.

Here the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. By not submitting a response, the Respondent has failed to invoke any circumstance, which could have demonstrated any rights or legitimate interests in the disputed domain name under paragraph 4(c) of the Policy. The Panel notes that the use of a domain name to host a parked page comprising pay-per-click links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant's marks or otherwise mislead Internet users. See section 2.9 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Complainant has established element 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name

has been registered and used in bad faith. Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, which includes: “(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

In the present proceedings, the Respondent’s bad faith registration is established by the fact that the disputed domain name (i) purposefully incorporates the Complainant’s CITYA trademark and (ii) was registered long after this trade mark became well known to consumers. Indeed, the Complainant has been using the CITYA trade mark to conduct its business for at least over 20 years. Given the distinctiveness and the well-established reputation of the Complainant’s trademark it is not conceivable that the Respondent did not have in mind the Complainant’s trademark when registering the disputed domain name.

According to the uncontested evidence submitted by the Complainant, the disputed domain name directs Internet users to a parked webpage showing pay-per-click links in French language to third party websites, and include real estate sales and links to the Complainant’s competitors.

In the Panel’s view, the circumstances of the case indicate that the Respondent has registered the disputed domain name with knowledge of the Complainant’s trademark, and that the Respondent’s primary intent with respect to the disputed domain name is to trade off the value of the Complainant’s trademark. In line with previous UDRP decisions, the Panel finds that the purpose of the Respondent’s registration and use of the disputed domain name is to capitalize on the reputation and the goodwill of the Complainant’s trademarks and to intentionally attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s trademark.

Based on the above, the Panel finds that the Complainant has established also 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 <wwwcitya.com> be transferred to the Complainant.

/Anna Carabelli

Anna Carabelli

Sole Panelist

Date: June 9, 2023