



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE

DOMAIN NAME DISPUTE

ADMINISTRATIVE PANEL

DECISION

CIIDRC case number:	18330-CDRP	Decision date: September 29, 2022
Domain Name:	bollore.ca	
Panel:	Zak Muscovitch	
Complainant:	Bolloré SE	
Complainant's representative:	Laurent Becker of Name Shield	
Registrant:	Diesel Pro, Diesel Pro Inc	

1. Procedural History

The procedural history of this case was set out in a letter from the Canadian International Internet Dispute Resolution Centre ("CIIDRC") to the Panel, as follows:

- a) On August 22, 2022, Laurent Becker of Nameshield, filed a Complaint on behalf of Bolloré SE pursuant to the Canadian Internet Registration Authority ("CIRA") Domain Name Dispute Resolution Policy (the "Policy") and the CIRA Domain Name Dispute Resolution Rules (the "Rules").
- b) On August 23, 2022, CIRA was notified of this proceeding and on the same date, CIRA transmitted by email to CIIDRC, its verification response informing who is the Registrant of the disputed domain name. CIRA also confirmed that the <bollore.ca> domain name (the "Domain Name" or the "Disputed Domain Name") was placed on a Registrar LOCK.

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- c) On August 23, 2022, CIIDRC as Service Provider, confirmed compliance of the Complaint and commencement of the dispute resolution process. As the Complaint with the attachments was filed exclusively online, the Centre delivered the Complaint to the Registrant only by email to the address provided by CIRA.
- d) Pursuant to Resolution Rule 4.4, CIIDRC notified the Registrant of this administrative proceeding and forwarded a Notice of commencement of the administrative proceeding with the Complaint to the Registrant on August 23, 2022.
- e) The Registrant failed to file its response by the due date of September 12, 2022.
- f) The Complainant in this administrative proceeding has elected a Panel consisting of a single-member.
- g) CIIDRC appointed the undersigned to serve as a single-member Panel in the above-referenced matter on September 26, 2022. The undersigned completed and returned to CIIDRC, a statement of acceptance and declaration of impartiality and independence.

This matter is conducted pursuant to the Policy and the Rules of CIRA. Having reviewed the history of the proceeding as set out above, the Panel is satisfied that this proceeding was properly commenced in accordance with the Policy and that despite the required notice having been provided to the Registrant pursuant to Paragraph 2.1(b) of the Rules, the Registrant has not responded to the Complaint.

2. The Parties

The Complaint was commenced against “Diesel Pro” which is the registrant (the “Registrant”) of the Domain Name pursuant to both; a) the Whois record submitted by the Complainant as its Annex “1”; and b) the content of CIRA’s “verification response” received by the CIIDRC on August 23, 2022 (the “Verification Response”) which was subsequently conveyed to the Complainant and Registrant via the CIIDRC’s Notification of Commencement of Proceedings dated, August 23, 2022. The Verification Response additionally identifies the Registrant’s “Organization” as “Diesel Pro Inc”. It therefore appears that although the Registrant is correctly named as “Diesel Pro”, the identified “Organization” is also material since it appears to identify that the Registrant “Diesel Pro” is the Registrant on behalf of “Diesel Pro Inc”, an apparent corporation. Accordingly, the Panel orders in

accordance with Paragraph 9.1(a) of the Rules, that the style of cause in this proceeding be administratively revised to reflect the Registrant as “Diesel Pro, Diesel Pro Inc”.

3. **Canadian Presence Requirements**

In order to satisfy Paragraph 1.4 of the Policy, the Complainant must at the time of submitting a Complaint, satisfy CIRA’s Canadian Presence Requirements (“CPR”) in respect of the Domain Name unless the Complaint relates to a trademark registered in the Canadian Intellectual Property Office (“CIPO”) and the Complainant is the owner of the trademark.

The Complainant has submitted as its Annex “4”, a copy of CIPO Trademark Registration No. TMA635743 in respect of BOLLORÉ & Design, registered March 21, 2005 and expiring March 21, 2030, registered to Bolloré SE.

Accordingly, the Panel finds that Paragraph 1.4 of the Policy is satisfied as the Complainant, Bolloré SE, is the owner of a CIPO registered trademark that was registered at the time that this proceeding was commenced and that this trademark registration relates to the Domain Name which is the subject of this proceeding, namely <BOLLORE.CA>.

The Panel also finds that the Complainant satisfies Paragraph 1.9(b) of the Policy in that by initiating this proceeding, the Complainant has represented and warranted to CIRA and the Registrar inter alia, that if CIRA transfers the Registration of the Domain Name to the Complainant, the Complainant will satisfy the CPR at the time of such transfer. The Complainant’s aforementioned registered trademark would serve to satisfy Paragraph 2(q) of the CPR.

4. **The Complaint**

The Complainant alleges that the Disputed Domain Name should be transferred in accordance with Paragraph 4.3 of the Policy as this is an “Applicable Dispute” pursuant to Paragraph 3.1 of the Policy which is set out in part, below:

3.1 Applicable Disputes. A Registrant must submit to a Proceeding if a Complainant asserts in a Complaint submitted in compliance with the Policy and the Resolution Rules that:

(a) the Registrant's dot-ca domain name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights;

(b) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4; and

(c) the Registrant has registered the domain name in bad faith as described in paragraph 3.5.

Pursuant to Paragraph 4.1 of the Policy, to succeed in this proceeding, the Complainant must prove on a balance of probabilities that:

(a) the Registrant's dot-ca domain name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights; and

(b) and the Registrant has registered the domain name in bad faith as described in paragraph 3.5;

and the Complainant must provide some evidence that:

(c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4. Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name as described in paragraph 3.4.

5. **Factual Grounds**

The Complainant has provided the following factual background:

"The Complainant, BOLLORÉ SE was founded in 1822. Thanks to a diversification strategy based on innovation and international development, it now holds strong positions in all its activities around three business lines, Transportation and Logistics, Communication and Media, Electricity Storage and solutions (please see their website at: www.bolloré.com). The Complainant is one of the 500 largest companies in the world. Listed on the Paris Stock Exchange, the majority interest of the Group's stock is always controlled by the Bolloré family. The BOLLORÉ Group has 79,000 employees world-wide with the turnover that equals to 24,109 million euros, operating income in the amount of 1,650 million euros and the shareholders' equity in the amount of 25,984 million euros based on the results in 2020.

The Complainant is the owner of several trademarks including the term “BOLLORE”, such as the Canadian trademark registration BOLLORE® n° TMA635743 registered on 2005-03-21.

The Complainant also owns and communicates on the Internet through various domain names, the main one being <bollore.com>, registered on July 24th, 1997.

The disputed domain name <bollore.ca> was registered on August 17th, 2022 and resolves to a registrar parking page.

6. Confusingly Similar to a Mark

The Complainant has alleged in accordance with Paragraph 4.1 of the Policy, and the Panel so finds, that the Registrant’s Domain Name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the Domain Name and continues to have such rights. Pursuant to Paragraph 3.1(a) of the Policy, a Complainant must have a “Mark”. A “Mark” is defined at Paragraph 3.2 of the Policy as inter alia, a trademark that is registered with CIPO. As set out above, the Complainant is the owner of a CIPO registered trademark for BOLLORÉ & Design, registered March 21, 2005 and this therefore qualifies as a Mark as understood by the Policy (the “Complainant’s Canadian Trademark”).

The Complainant has alleged that the Disputed Domain Name was registered on August 17, 2022. The Whois report that the Complainant filed shows a “Creation Date” of August 17, 2022. Although a “Creation Date” may not always correspond to a “Registration Date”, this date is corroborated by the CIRA’s Verification Response which indicates that the Registrant agreed to the CIRA Registration Agreement on August 17, 2022. Accordingly, the Panel finds that the Disputed Domain Name was registered on August 17, 2022. This is subsequent to the registration of the Complainant’s Registered Trademark and the Complainant continues to have rights in this trademark which does not expire until March 21, 2030.

The Panel also finds that the Disputed Domain Name is Confusingly Similar to the Complainant’s Canadian Trademark. Pursuant to Paragraph 3.3 of the Policy, in determining whether a domain name is “Confusingly Similar” to a Mark, the Panel shall only consider whether the domain name so nearly resembles the Mark in appearance, sound, or the ideas suggested by the Mark as to likely to be mistaken for the Mark.

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Paragraph 1.2 of the Policy states that a “domain name” means the domain name excluding the “dot-ca” suffix. Accordingly, for the purpose of comparing the Disputed Domain Name to the Mark, the .ca suffix is ignored. Paragraph 3.2 of the Policy states that the word elements of a design trademark qualify as a Mark. The Complainant is the owner of the BOLLORÉ & Design trademark and the word element consists of the word, BOLLORÉ. Although the Domain Name does not contain the “é” with l’accent aigu, that is a minor difference which does not change the fact that the Domain Name is Confusingly Similar to the word elements of the Complainant’s Trademark as understood by the Policy. It should be noted that when a .CA domain name is registered, all variations of the domain name with various accented characters are reserved for the registrant and cannot be registered by anyone else.¹

7. **No Legitimate Interest**

The Complainant alleges that the Registrant has no legitimate interest in the Domain Name as understood by Paragraph 3.1 of the Policy.

The Complainant alleges that the Registrant is not identified in the Whois database by the Disputed Domain Name, thereby providing no indication that the Registrant is commonly known by the Domain Name. The Complainant also alleges that the Registrant is not affiliated nor authorized by the Complainant in any way and the Registrant is not related in any way to the Complainant’s business. The Complainant alleges that the Registrant has not been licensed or authorized to make any use of the Complainant’s Trademark. The Complainant alleges and shows via submitted evidence, that the Domain Name resolves to a “registrar parking page” thereby indicating according to the Complainant, that the Registrant has not made any use of the Domain Name and that there is no indication of any demonstrable preparations to use the Domain Name.

The Registrant has not responded to the Complaint and therefore has not answered any of these allegations. In particular, the Registrant has not provided any evidence that it meets any of the criteria that may establish a legitimate interest in the Domain Name as set out in Paragraph 3.4 of the Policy. No evidence has been provided that the Domain Name

¹ See: <https://www.cira.ca/ca-domains/register-your-ca-domain/domains-french-accented-characters>

corresponds to a descriptive word. No evidence has been provided that the Registrant registered the Domain Name because of any descriptive meaning or that it was used for any non-commercial activity. The Domain Name does not appear to correspond to the legal name of the Registrant nor does it appear to correspond to a geographical place. Accordingly, in the indication that the Registrant meets any of the criteria established by Paragraph 3.4 of the Policy, the Panel finds that on a balance of probabilities, the Registrant has no legitimate interest in the Domain Name. Based upon the evidence provided by the Complainant that has not been rebutted by the Registrant, the Domain Name appears to solely, or at least primarily, correspond to a distinctive and longstanding trademark used by the Complainant inter alia in the transportation and logistics field and the Registrant has no apparent legitimate interest in the Domain Name.

8. Registration in Bad Faith

The Complainant alleges that the Registrant registered the Domain Name in bad faith in accordance with Paragraph 3.5 of the Policy.

The Complainant alleges that the Complainant's Trademark is "well-known and distinctive" and that the Complainant is one of the 500 largest companies in the world. The Complainant also references two UDRP decisions from the Czech Arbitration Court (namely CAC Case Nos. 102015 and 101696) wherein the Panels respectively noted that the Complainant had a "well-known brand name" and "a strong reputation". The Complainant contends that given the distinctiveness of the Complainant's trademark and reputation, it "inconceivable" that the Registrant could have registered the Disputed Domain Name without actual knowledge of the Complainant's trademark rights. The Complainant states that the fact that the Domain Name resolves to a parking page with various ads demonstrates that the Respondent is not making any genuine use of the Domain Name and supports a finding of bad faith registration.

The Complainant specifically relies upon Paragraph 3.5(b) of the Policy which provides as follows:

“3.5 Registration in Bad Faith. For the purposes of paragraphs 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:

(b) the Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant’s licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone or in concert with one or more additional persons has engaged in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names;

The difficulty with the Complainant’s reliance on Paragraph 3.5(b) is that Paragraph 5(b) particularly requires that the Registrant “has engaged in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as Domain Names”. The Complainant has not furnished any evidence of such a pattern. Nevertheless, the indicia of bad faith registration which are enumerated in the subparagraphs to Paragraph 3.5 of the Policy, are only examples of bad faith registration and are not exhaustive. Accordingly, even without relying upon Paragraph 3.5(b) in particular, the Complainant’s allegation that it is “inconceivable” that the Registrant did not have actual knowledge of the Complainant’s trademark rights and that the Registrant’s specific purpose in registering the Domain Name was to target the Complainant’s well-known mark, is a firm basis for finding possible bad faith registration.

There are nevertheless certain inadequacies in the evidence presented by the Complainant. The Complainant does not provide any actual evidence to support that the Registrant had likely been aware of the Complainant other than the fact that the Registrant registered the Disputed Domain Name corresponding to the Complainant’s Trademark. The Complainant could have for example, demonstrated that the Registrant is apparently in the trucking and transportation business and as such would have likely been aware of the Complainant. The Complainant claims that its brand is well-known, but aside from general reliance on UDRP cases that made such a finding and some limited data about the size of its operation from its own website, the Complainant has not provided any evidence of reputation or use in Canada or in the United States where the Registrant is apparently located pursuant to the Registry Verification and the Notice of Commencement. The Complainant’s Trademark does not appear to be a household name and may very well be unknown to persons outside of the specific industries where it

operates. As such, it would have been helpful in making its case, had the Complainant provided evidence of its operations in Canada and the United States, together with third party media coverage, advertising and marketing expenditures, and other evidence that would support that the Complainant was so well known that it was likely the target of the registration, particularly where such evidence would appear to be readily available.

Despite these inadequacies in the evidence, the Panel can however, still conclude that on a balance of probabilities, the Complainant was the target of the Registrant's registration of the Domain Name. The Registrant has not responded to the allegations despite apparently receiving the notice of proceedings as required pursuant to the Rules. Had the Registrant had an affirmative defense to make to these allegations, it can be assumed that it would have made it. For example, if the Registrant had registered the Domain Name because it corresponds to a surname used by a principal of the Registrant, it would have been expected that the Registrant had come forth with such evidence.

Moreover, the evidence that has been submitted demonstrates sufficiently if not ideally, that the Complainant is a massive corporation with well-established rights in a distinctive brand, such that in the absence of any explanation forthcoming from the Registrant, it appears likely that the Registrant must have specifically been aware of the Complainant's trademark rights and that was the reason that the Registrant registered the Domain Name in an effort to unfairly capitalize on the Complainant's trademark rights and to prevent the Complainant from registering the Domain Name which corresponds to its trademark. This conclusion is further corroborated by the fact that the Registrant appears to be in a business related to the Complainant's business of transportation and logistics, based upon the identification of the Registrant as "Diesel Pro" of Diesel Pro Inc". It is unlikely to be a mere coincidence that the Registrant's business appears to relate to diesel fuel which is commonly used in transportation.

9. **DECISION and ORDER**

For the above reasons, in accordance with Paragraph 4 of the CDRP, Paragraph 12 of the Resolution Rules, the Panel orders that the Domain Name, BOLLLORE.CA, be transferred to the Complainant.

Made as of September 29, 2022

SIGNATURE OF PANEL

A handwritten signature in black ink, consisting of the initials 'Z.M.' in a cursive style.

Zak Muscovitch, Panelist

