

SYRELI



DÉCISION DE L'AFNIC

clickcease.fr

Demande n° FR-2021-02504



I. Informations générales

i. Sur les parties au litige

Le Requérant : La société CHEQ AI TECHNOLOGIES (2018) LTD

Le Titulaire du nom de domaine : La société Domain Privacy Trustee SA

ii. Sur le nom de domaine

Nom de domaine objet du litige : clickcease.fr

Date d'enregistrement du nom de domaine : 17 juin 2020 soit postérieurement au 1^{er} juillet 2011

Date d'expiration du nom de domaine : 17 juin 2022

Bureau d'enregistrement : Infomaniak Network SA

II. Procédure

Une demande déposée par le Requérant auprès de l'Afnic a été reçue le 16 août 2021 par le biais du service en ligne SYRELI.

Conformément au règlement SYRELI (ci-après le Règlement) l'Afnic a validé la complétude de cette demande en procédant aux vérifications suivantes :

- o Le formulaire de demande est dûment rempli.
- o Les frais de Procédure ont été réglés par le Requérant.
- o Le nom de domaine est actif.
- o Le nom de domaine a été créé ou renouvelé postérieurement au 1^{er} juillet 2011.
- o Le nom de domaine visé par la procédure ne fait l'objet d'aucune procédure judiciaire ou extrajudiciaire en cours.

L'Afnic a procédé au gel des opérations sur ce nom de domaine et a notifié l'ouverture de la procédure au Titulaire le 31 août 2021.

Le Titulaire a adressé une réponse à l'Afnic le 16 septembre 2021.

Le Collège SYRELI de l'Afnic (ci-après dénommé le Collège) composé de Marine CHANTREAU (membre suppléant), Loïc DAMILAVILLE (membre titulaire) et Marianne GEORGELIN (membre titulaire) s'est réuni pour rendre sa décision le 30 septembre 2021.

III. Argumentation des parties

i. Le Requérant

Selon le Requérant, l'enregistrement ou le renouvellement du nom de domaine <clickcease.fr> par le Titulaire est « susceptible de porter atteinte à des droits de propriété intellectuelle ou de la personnalité », et le Titulaire ne justifie pas « d'un intérêt légitime et agit de mauvaise foi ».

(Art. L. 45-2 du code des postes et des communications électroniques)

Dans sa demande, le Requérant a fourni les pièces suivantes :

- Echange de courriels entre les Parties du 09 au 25 novembre 2020 rédigés en langue anglaise ;
- Extrait de la base Whois du nom de domaine <clickcease.fr> enregistré le 17 juin 2020 ;
- Courrier en langue anglaise du 12 août 2021 adressé à l'Afnic ;
- Courrier en langue anglaise du 04 janvier 2021 adressé à la société FirstPointSarl ;
- Notice d'information en langue anglaise extraite du registre « United States Patent and Trademark office » concernant la marque « ClickCease » ;
- Certificat d'enregistrement rédigé en langue étrangère concernant la marque « ClickCease » numéro 308326 extrait du site web trademarks@justice.gov.il.

Dans sa demande, le Requérant indique que :

[Citation partielle de l'argumentation]

« COMPLAINT

I. Introduction

1. This Complaint is hereby submitted for decision in accordance with the Rules for Alternative Dispute Resolution Procedures (the "Rules") approved by the Minister responsible for electronic communications on March 14, 2016 .

II. The Parties

A. The Complainant

2. The Complainant in this administrative proceeding is Cheq AI Technologies (2018) Ltd., a company registered in Israel with company number 514142140 whose registered office is at [adresse], Israel.

3. The Complainant's contact details are:

[coordonnées]

4. The Complainant's authorized representative in this administrative proceeding is:

[coordonnées]

B. The Respondent

5. The Respondent's details are Blackbelt Sarl – Francois B 1003 Lausanne.

III. The Domain Name

6. This dispute concerns the domain name identified below:

Domain name Created on Expiration Date

ClickCease.fr June 17, 2020 June 17, 2022

IV. Factual and Legal Grounds

7. The Complainant and the Clickcease Brand:

7.1. The Complainant is a leading online provider for marketing organizations looking to secure their business from invalid traffic ("IVT"), which for years, through a proprietary developed platform, allows businesses to protect their websites from malicious access by bots, paid clicks and competitors.

7.2. The Complainant's offering is available internationally with a significant presence in the European Economic Area ("EEA") and North America. The Complainant has two products, separately branded – CHEQ.ai targets larger customers with more significant and global traffic, and Clickcease targets small and medium business with more local business.

7.3. The Complainant has invested a great deal of time and money in developing the Complainant brand "Clickcease" (the "Brand"), including registration of trademarks in several jurisdictions, as detailed below.

7.4. The Complainant, has invested, and continues to invest, significant resources in promoting its offerings under the Brand and trademarks around the world. In the course of 2020, the Complainant began more concerted efforts to market its small and medium business solution in the EEA, under the Brand, as described below.

8. The Respondent's Registration of the Disputed Domain:

8.1. On May 7, 2020, Mr. [Prénom NOM] CEO of Firstpoint Sarl ("Firstpoint"), contacted the Complainant on LinkedIn and introduced himself as a potential partner interested in becoming an exclusive reseller of the Brand's products in France. The Complainant and Firstpoint entered into discussions regarding this business opportunity and agreed that in connection with the contemplated commercial arrangement between the parties, Firstpoint would acquire the disputed domain name (the "Domain") on behalf of and for the Claimant, as the Domain was intended to be used for marketing of the Brand's products, and otherwise in connection with Claimant's operations, in French-speaking countries. Such acquisition of the Domain by Firstpoint was under the express understanding that Firstpoint would promptly transfer the ownership of the Domain to Claimant, following execution of a reseller agreement.

8.2. The Domain was acquired by Mr. [Prénom NOM] on behalf of Firstpoint, but registered in the name of the Respondent, on June 17, 2020, shortly following the commencement of the parties' commercial discussions. During the commercial discussions, a number of drafts of a reseller agreement were exchanged between

Claimant and Firstpoint, in which the parties' intent that the Domain would be transferred to Claimant's ownership as part of the business relationship was explicitly stated. In connection with this understanding, Mr. Florian even initiated the transfer but for a reason unbeknownst to the Claimant, did not complete the transfer process.

8.3. Following the exchange of a few draft agreements, the Claimant determined to terminate the negotiations for several reasons unrelated to the use of the Domain.

Following the decision to terminate the commercial discussions, Claimant requested that Mr. [Titulaire] finalize the transfer of the Domain from Respondent to Claimant, which as noted above was acquired by Respondent on behalf of Firstpoint solely for the purpose of the relationship with Claimant, all as discussed and agreed by the parties.

8.4. However, Mr. [Titulaire] refused to cause Respondent to transfer the Domain, without specifying any reason for his refusal. Furthermore, on November 24, 2020 Mr. [Titulaire] wrote in an email to Claimant's representative with whom he had been in contact, Mr. [Titulaire], that it is not Firstpoint's intention to use the Domain. In fact as of the date of this claim, there is no content on the Domain, and Respondent has not made any use of the Domain. Mr. [Titulaire] then advised Claimant to "proceed with lawyers" since Firstpoint does not intend on taking any actions to transfer the Domain to our Claimant's ownership or to even discuss the matter further with Claimant.

8.5. It has recently come to Claimant's attention that Firstpoint, on behalf of whom Respondent purchased the Domain, has entered into a distribution relationship in France with one of Claimant's competitors. Therefore, it can be concluded that the Respondent's refusal to transfer the Domain to Complainant is intended to impede Claimant's marketing efforts in France, thereby gaining an unfair competitive advantage over Claimant.

9. The Legal Grounds

9.1. This Complaint is based on the following grounds:

A. The domain name is identical or confusingly similar to a trademark or service mark in

which the Complainant has rights;

9.2. The Complainant's subsidiary, which was merged into the Claimant, is the proprietor of registrations for word marks on the term "ClickCease", in the USA (R.N 88062122), and Israel (R.N 308326) (the "Marks").

9.3. The Complainant submits that the Domain is identical and confusingly similar to the Marks, as it consists of the term ClickCease, followed with the suffix <.fr>, which does not create an overall different impression.

9.4. With respect to the suffix <.fr>, the Complainant refers to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), which states in Clauses 1.11.1-2 that:

"The applicable Top Level Domain ("TLD") in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. The practice of disregarding the TLD in determining identity or confusing similarity is applied irrespective of the particular TLD (including with regard to "new gTLDs")."

9.5. Similarly, in the case of F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., WIPO Case No. D2006-0451 (<https://www.wipo.int/amc/en/domains/decisions/html/2006/d2006-0451.html>), the panel held that:

"It is also well established that the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar"

9.6. In light of the foregoing, the Complainant submits that the Disputed Domain Name is completely identical, and confusingly similar to the Plus500 Marks.

B. The Respondent has no rights or legitimate interests in respect of the domain name;

9.7. The Respondent is not affiliated in any way with the Complainant and has never been licensed or otherwise authorized to use the Marks by the Complainant.

9.8. The Respondent has not used, or made demonstrable preparations to use, the Domain or any name corresponding to the Domain in connection with a bona fide offering of goods or services.

9.9. As described above, the Respondent purchased the Domain in the context of commercial discussions with the Complainant which discussions did not mature into an agreement. Furthermore, Respondent is affiliated with the CEO of Firstpoint, a company currently engaged in marketing activities in France for Complainant's competitors.

9.10. Hence, the Respondent clearly used the Domain to assist Firstpoint in gaining a competitive advantage over Complainant in France, by blocking the Complainant from setting up a local website in the French language using the French TLD with the domain name associated with the Complainant.

9.11. Based on such infringing and bad faith activity the Complainant submits that the Respondent did not use the Domain for any legitimate interests or a bona fide offering of goods or services.

9.12. Furthermore, currently the Domain leads users to an inactive website. In this respect, the Complainant refers to the case of Line Corporation v. LINE Cooperation, WIPO Case No. DME2020-0002

(<https://www.wipo.int/amc/en/domains/search/text.jsp?case=DME2020-0002>), in which the panel held that:

"Prior to the notice of the dispute, Respondent did not demonstrate any use of the Domain Name or a trademark corresponding to the Domain Name in connection with a bona fide offering of goods or services.

On the contrary, as Complainant has demonstrated, the Domain Name leads to an inactive website. Passive holding of a domain name does not constitute a bona fide offering of goods or services (Philip Morris USA v. [Prénom Nom], WIPO Case No. D2015-1779; L'Oréal v. Haya Manami, WIPO Case No. D2015-0924)."

9.13. Having regard to the foregoing, the Complainant submits that the Domain was not

used and is not used in connection with a bona fide offering of goods or services.

9.14. To the best of the Complainant's knowledge neither the Respondent, nor any business operated by it, is or has ever been commonly known by the Domain.

9.15. The Complainant submits that the Respondent made an illegitimate commercial use of the Domain in order to gain an unfair competitive advantage over the Complainant in marketing competitive products in French speaking countries, as detailed above.

Furthermore, the Complainant submits that the fact that the Respondent is currently holding the Domain with no activity thereunder, by itself constitutes an illegitimate commercial use of the Domain.

9.16. With respect to the fact that currently there is no active website on the Domain, the Complainant refers to the case of Philip Morris USA Inc. v. [Prénom Nom], WIPO case No. D2016-1302 (<https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2016-1302>), where the panel held that:

"several UDRP panels have found that when respondents fail to make any use of the disputed domain name as in the case at hand, and merely point that domain name to an inactive website, such respondents have no rights or legitimate interests in the domain name. See, e.g., Société nationale des télécommunications: Tunisie Telecom v. [Prénom Nom], WIPO Case No. D2009-1529 (noting that passive holding of a disputed domain name "does not constitute a legitimate use of such a domain name" that would give rise to a legitimate right or interest in the name)."

9.17. In light of the foregoing, the Complainant submits that the Respondent did not use and does not use the Domain for legitimate non-commercial or fair use.

C. The domain name was registered and is being used in bad faith.

9.18. The Complainant owned and used the Marks long before the Respondent had registered the Domain. Respondent came to own the Domain following discussions to engage in a commercial relationship with Complainant, initiated by Respondent's representative. Therefore, it is clear that the Respondent knew about the Complainant's Marks and operation.

9.19. Furthermore, the fact that currently the Domain leads to an inactive website, also constitutes use of the Domain in bad faith. In this regard, please find the case of Philip Morris Products S.A. v. [Prénom Nom], WIPO Case No. D2021-0142 (<https://www.wipo.int/amc/en/domains/decisions/text/2021/d2021-0142.html>), in which the panel held that:

"The Domain Name currently leads to an inactive website. The non-use of a domain name would not prevent a finding of bad faith (See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; WIPO Overview 3.0, section 3.3)."

9.20. Accordingly, the Respondent has clearly acted and continues to act in bad faith in the registration and use of the Disputed Domain Name.

D. Conclusion

9.21. The Domain is identical or confusingly similar to the Marks, in in which the Complainant has rights.

9.22. The Respondent has no rights or legitimate interests in respect of the Domain.

9.23. The Respondent has registered, used and is using the Domain in bad faith.

V. Remedies Requested

10. For the reasons described in Section VI above, the Complainant requests the Center appointed in this administrative proceeding that the Domain be transferred to the Complainant.

VI. Other Legal Proceedings

11. Other than as described in this Complaint, no other legal proceedings have been commenced or terminated in connection with or relating to the Domain.

Respectfully submitted,

[Prénom Nom]

For and on behalf of
Cheq AI Technologies (2018) Ltd.
Aug 11st, 2021
List of Annexes [Liste des annexes] ».

Le Requérant a demandé la transmission du nom de domaine.

ii. Le Titulaire

Le Titulaire a adressé une réponse à l'Afnic le 16 septembre 2021.

Dans sa réponse, le Titulaire a fourni la pièce suivante :

- Extrait du registre sans radiations du canton de Vaud de la société Blackbelt Sarl inscrite le 13 mai 2015 sous le numéro IDE\UID CHE-287.680.863.

Dans sa réponse, le Titulaire indique que :

[Citation complète de l'argumentation]

« Bonjour,

Nous faisons suite à la demande SYRELI FR-2021-02504 vis-à-vis du nom de domaine clickcease.fr.

Pour nous, l'enregistrement du domaine respecte les dispositions de l'article L45-2 du CPCE, dans la mesure où il s'agit d'une législation française. Or, le défendeur détient bien la marque Clickcease aux Etats-Unis et en Israël, mais pas sur le territoire français, ni même européen.

Nous ne comprenons donc pas sur quelle base légale le nom de domaine devrait être transféré ou supprimé de force.

Nous sommes toutefois ouverts à un arrangement à l'amiable avec Clickcease. A aucun moment l'objectif de la société Blackbelt Sarl a été de garder le nom de domaine dans le but de nuire à la marque Clickcease, d'ailleurs le nom de domaine n'a pas été utilisé, en attendant des clarifications vis-à-vis de son usage final. »

IV. Discussion

Au vu des écritures et pièces déposées par les deux parties,

Au vu des dispositions du Règlement,

Au vu des dispositions prévues à l'article L. 45-6 du Code des Postes et des Communications Electroniques,

Le Collège a évalué :

La Recevabilité de la demande et des pièces

L'article I.iv du Règlement SYRELI dispose que « [...] La procédure se déroule en langue française [...] Le Collège se réserve le droit de ne pas prendre en compte les documents soumis dans d'autres langues [...] ».

Le Collège a constaté que l'intégralité de la demande du Requérant ainsi que les pièces justificatives étaient fournies en langue anglaise.

Le Collège a donc décidé de les écarter de la discussion.

Par suite, le Collège a donc considéré qu'il ne pouvait pas se prononcer sur l'atteinte aux droits invoqués par le Requérant.

V. Décision

Le Collège a décidé de rejeter la demande de transmission du nom de domaine <clickcease.fr>.

VI. Exécution de la décision

Conformément à l'article (II) (viii) du Règlement, la décision de l'Afnic ne sera exécutée qu'une fois écoulé un délai de quinze (15) jours civils à compter de la notification de la décision aux parties.

Conformément à l'article (II) (vii) du Règlement, l'Afnic notifie par courrier électronique et postal la décision à chacune des parties.

Elle procédera au dégel des opérations sur le nom de domaine selon les dispositions du Règlement.

Le Bureau d'enregistrement est informé de la décision par courrier électronique.

À Montigny-le-Bretonneux, le 4 octobre 2021

Pierre BONIS - Directeur général de l'Afnic

