# Decision for dispute CAC-UDRP-101932

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| Case number | **CAC-UDRP-101932** |
| Time of filing | **2018-07-19 12:21:43** |
| Domain names | **sber.com** |

## Case administrator

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| Name | **Sandra Lanczová (Case admin)** |

## Complainant

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| Organization | **Sberbank of Russia** |

## Respondent

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| Organization | **Struever Brothers, Eccles,and Rouse** |

OTHER LEGAL PROCEEDINGS

The Panel is unaware of other legal proceedings, pending or otherwise, which relate to the Disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the proprietor of numerous earlier rights consisting of or including the letters SBER. These are, amongst others:

Russian trademark SBER (Word mark) registered under No. 623735 on 13.07.2017 (date of priority: 06.09.2016) for services of class 36 and International Registration SBER (Word mark) registered under No. 1355502 on 09.02.2017 in AT, BA, BY, CH, CN, CY, CZ, DE, HR, KZ, RS, SI, SK, UA, GB, IN, TR, US for services of class 36.

The Complainant is also known under the name SBERBANK.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

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; (Policy, Paragraph 4(a)(i); Rules, Paragraphs 3(b)(viii), (b)(ix)(1))

The Complainant is the owner of intellectual property rights on the family of trademarks «Sber» and «Sberbank», including the following:

SBER - Word trademark according to certificate of registration № 1355502, date of the registration 09.02.2017. International registration (countries: AT, BA, BY, CH, CN, CY, CZ, DE, HR, KZ, RS, SI, SK, UA, GB, IN, TR, US) concerning the 36 class of the Nice Classification.

SBER - Word trademark according to certificate of registration № 623735, date of the registration 13.07.2017 (date of priority: 06.09.2016), Registered in the Russian Federation concerning the 36 class of the Nice Classification.

СБЕР - Word trademark according to certificate of registration № 433395 date of the registration 24.03.2011 (date of priority: 26.07.2010). Registered in the Russian Federation concerning 1-45 class of the Nice Classification.

SBERBANK - Word trademark according to certificate of registration № 463470, date of the registration 04.06.2012 (date of priority: 03.08.2011). Registered in the Russian Federation concerning the 36 class of the Nice Classification.

SBERBANK - Word trademark according to certificate of registration № 1097227, date of the registration 05.09.2011. International registration (countries: AT, BA, BX, BY, CN, CY, CZ, DE, FI, HR, HU, IE, IT, JP, PL, RS, SG, SI, SK) concerning the 36 class of the Nice Classification.

SBERBANK – Combined trademark according to certificate of registration № 1025684, date of the registration 22.12.2009. International registration (countries: AT, BA, BY, CH, CN, CZ, DE, HR, HU, KZ, RS, SI, SK, GB, TR, US) concerning the 36 class of the Nice Classification.

SBERBANK - Combined trademark according to certificate of registration № 417926, date of the registration 08.09.2010 (date of priority: 07.10.2009). Registered in Russian Federation concerning the 36 class of the Nice Classification.

According to the Complainant, the disputed domain name includes the identical trademark "Sber" and is also confusingly similar to the trademark «СБЕР» («SBER» in Cyrillic), to the group of trademarks «SBERBANK» and the combined trademark "Sberbank".

The Complainant argues that confusing similarity between the disputed domain name and Sberbank's trademarks is confirmed by sound (phonetic) similarity in connection with the inclusion of the element «Sber» in the disputed domain name. Word "Sber" has an identical pronunciation in Russian and English languages that enforce the phonetic similarity of a domain name with trademarks of the Complainant.

It is also argued that there is a graphic (visual) confusing similarity between the disputed domain name «sber.com» and Sberbank's trademarks «SBER» Certificate № 1355502 and № 623735 (on the assumption of the general visual perception; regarding use of the same alphabet in the name of Sberbank trademark and a domain name - "sber.com").

Moreover, the Compainant contends that there is a semantic similarity between the disputed domain name and Sberbank's family of trademarks «SBER» and «SBERBANK» in connection with the inclusion of element «SBER». According to the Complainant, it should be also noted that designation «SBER» is a short name of «SBERBANK» and is perceived and recognized by many consumers not only in the Russian Federation, but also abroad, as a firm name of the Bank.

B. The Respondent has no rights or legitimate interests in respect of the domain name;
(Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2))

The Complainant argues that the Respondent does not have any legal rights and real interests concerning the disputed domain name, which is passively held by the Respondent and is not in use. There is no content on the web-site under disputed domain name.

The status of the Respondent and its business activity is under question. According to the Complainant, information taken from WHOIS database shows that the disputed domain name is/was registered in the name of Struever Brothers, Eccles and Rouse, address: 1040 HULL ST STE 200, Baltimore, MD, 21230-5349, US. According to the public information from the

register of the companies posted on the web-site of the State Maryland the status of the company is forfeited and the business in not in good standing.

In the e-mail correspondence during the period of September-October 2017 (attached to the Complaint) the Complainant requested the Registrar – Network Solutions LLC to provide the information about the administrator/registrant of the disputed domain name: full name, postal and e-mail addresses, the telephone and telefax numbers. However, the Complainant was only advised to check the information in the WHOIS database. No concrete data about the administrator/registrant of the disputed domain name was provided. Therefore, the Complainant sent a cease and desist letter to the Respondent that was indicated as a holder of the domain name in WHOIS.

The Respondent has no relation to the business activities of the Complainant and did not receive any written consent from Sberbank to use in the Internet, including the domain name, the designations confusing similarly to Sberbank's family of trademarks. Sberbank of Russia is one of the largest bank in Russia and one of the largest banks of Europe, having representative offices and subsidiaries in many foreign countries. In particular, besides the CIS countries, Sberbank is represented in nine countries of the Central and Eastern Europe, and also in China, India and Turkey. Moreover, Sberbank operates in many other countries. In Russia, Sberbank has more than 110 million customers. Under the company name and trade designation in which the word "Sberbank" is used, the Complainant carries out his activity since 1991. At that moment according to the constituent documents Sberbank works under the following firm name: Public joint-stock company "Sberbank of Russia" (abbreviated company: PJSC Sberbank). In English: Sberbank of Russia (Sberbank). In the domain name of the Sberbank' web site (www.sberbank.ru) the name "sberbank" is also used.

In the absence of Respondent's right or real legitimate interest, such administration of the disputed domain name contradicts the provisions of the article 16 of the TRIPS Agreement. In accordance with article 16 of the Agreement on trade-related aspects of intellectual property rights (Marrakech, 15 April 1994, further referred as the "TRIPS Agreement"), the owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion.

According to the Complainant, such unfair use of the trademarks in the absence of permission of the right holder is recognized as the infringement of exclusive rights of the Complainant.

C. The domain name was registered and is being used in bad faith.
(Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3))

The disputed domain name is passively held by Respondent and is not in use.

According to the Complainant, on November 01, 2017 and January 23, 2018 a Cease and Desist letter was sent to the email address of the Respondent indicated in the WHOIS database with request to stop the infringement of exclusive rights of the Bank for "SBER" trademark, as well as to stop the unfair competition and transfer to the Complaint of the right of administration of the disputed domain name and to refrain from subsequent use of intellectual property, the exclusive rights over which belong to the Complaint, without consent of the right holder. However, the Complaint has never received a response.

According to the Complainant, the actions of the Respondent regarding the disputed domain name not only infringe the exclusive rights of the Bank's trademarks «SBER» and the group of trademarks «SBERBANK», but also constitute the act of unfair competition, since this creates an obstacle for the Bank in the placement of information about Sberbank and its products and services in the Internet in the domain zone .com with the use of "SBER" trademarks.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

1. The Panel finds that the disputed domain name is identical to the Complainant's trademarks "SBER" as the difference between the disputed domain name and the Complainant's trademarks in the gTLD ending ".COM" are not relevant for the comparison of the signs.

2. The Panel finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, neither of the disputed domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain name. The Respondent is not commonly known under the disputed domain name. This prima facie evidence was not challenged by the Respondent.

3. In the absence of a Response to the cease and desist letter and the Complaint, the Panel infers that the Respondent had the Complainant's trademarks "SBER" and "SBERBANK" in mind when registering the disputed domain name, which was therefore registered and is being (passively) used in bad faith, in order to take advantage of the reputation and the renown of the Complainant's trademarks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **SBER.COM**: Transferred

## PANELLISTS

| Name | **Udo Pfleghar** |
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DATE OF PANEL DECISION 2018-08-27

Publish the Decision