Decision for dispute CAC-UDRP-101933

Case number	CAC-UDRP-101933
Time of filing	2019-08-26 16:16:45
Domain names	sberbank.org

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Sberbank of Russia

Respondent

Organization	Whois Privacy Corp.

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant states, and provides evidence to support, that it is the owner of certain trademark registrations that consist of or contain the mark SBERBANK (the "SBERBANK Trademark"), including Russian Reg. No 209662 for a design mark that contains the text СБЕРБАНК РОССИИ (Russian for "SBERBANK OF RUSSIA") (registered March 18, 2002) for use in connection with, inter alia, savings banks (as shown in an English translation provided by Complainant); Russian Reg. No. 463470 for SBERBANK (registered June 4, 2012) for use in connection with, inter alia, savings banks (as shown in an English translation provided by Complainant); and Int'l Reg. No. 1097227 for SBERBANK (registered September 5, 2011) for use in connection with, inter alia, savings banks.

FACTUAL BACKGROUND

Complainant states that it is "one of the largest banks in Russia and Europe, has its representative offices and subsidiaries in many foreign countries, in particular, besides the CIS countries, Complainant is represented in several countries of the Central and Eastern Europe, and also in China, India and Turkey. Moreover, Complainant operates in many other countries. In Russia Complainant has more than 110 million customers. Under the company name and firm designation in which the word 'Sberbank' is used, the Complainant carries out his activity since 1991."

The disputed domain name was created on October 29, 2005, and is being used in connection with a monetized parking page with sponsored links.

Paragraph 4(a)(i) of the Policy: Complainant states, inter alia, that the disputed domain name is confusingly similar to the SBERBANK Trademark because it contains the SBERBANK Trademark in its entirety.

Paragraph 4(a)(ii) of the Policy: Complainant states, inter alia, "Respondent has no relation to the business activities of the

Complainant and didn't receive any written consent from Sberbank to use on the Internet, including the domain name, the designations identical and/or confusingly similar to Sberbank's family of trademarks"; and Respondent's website using the disputed domain name "contains financial advert and information with reference to [Complainant's] products."

Paragraph 4(a)(iii) of the Policy: Complainant states that the disputed domain name was registered and is being used in bad faith because, inter alia, the SBERBANK Trademark "is used on the Web-site with intention of the owner of the disputed domain name to provide advertising space to the 3rd parties, to attract as much as possible users by parasitizing on [Complainant's]reputation and its well-knownness among the consumers and in the result to gain a profit. In particular, the advertising banners about services and products of the 3rd parties, including financial organizations, are placed on the Web-site, however they include words «Sberbank Онлайн», «Sberbank» and when the user clicks on such advertising banners, he is redirected to the hyperlinks to the web sites that have nothing in common with the Complainant and aren't connected with the Complainant by any commercial relations"; and "[t]he use of the trademarks of Sberbank based on intention of the Web site's owner to increase rating (position) of Web site in Search Engines due to reputation and popularity of Sberbank among the population / customers."

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 or confusingly similar 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

Identical or Confusingly Similar

Based upon the trademark registrations cited by Complainant, it is apparent that Complainant has rights in and to the SBERBANK Trademark.

As to whether the disputed domain name is identical or confusingly similar to the SBERBANK Trademark, the relevant comparison to be made is with the second-level portion of the disputed domain name only (i.e., "sberbank") because "[t]he 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." WIPO Overview of WIPO Overview 3.0, section 1.11.1.

Here, the disputed domain name contains the SBERBANK Trademark in its entirety. As set forth in section 1.7 of WIPO Overview 3.0, "in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing." Further, section 1.8 of WIPO Overview 3.0 states: "Where the relevant

trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element."

Accordingly, the Panel finds that Complainant has proven the first element of the Policy.

Rights or Legitimate Interests

Complainant states, inter alia, that "Respondent has no relation to the business activities of the Complainant and didn't receive any written consent from Sberbank to use on the Internet, including the domain name, the designations identical and/or confusingly similar to Sberbank's family of trademarks"; and Respondent's website using the disputed domain name "contains financial advert and information with reference to [Complainant's] products."

WIPO Overview 3.0, section 2.1, states: "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."

The Panel finds that Complainant has established its prima facie case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the Policy.

Registered and Used in Bad Faith

Whether a domain name is registered and used in bad faith for purposes of the UDRP may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the Policy: (i) circumstances indicating that the registrant has registered or the registrant has 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 the registrant's documented out-of-pocket costs directly related to the domain name; or (ii) the registrant has 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 registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's 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 the registrant's website or location or of a product or service on the registrant's website or location.

Numerous panels under the UDRP have found the registration and use of a domain name that is confusingly similar to a complainant's trademark to constitute bad faith pursuant to paragraph 4(b)(iv) of the Policy where, as here, the domain name is associated with monetized parking pages that could be construed as associated with the complainant. See, e.g., Wal-Mart Stores, Inc. v. Whois Privacy, Inc., WIPO Case No. D2005 0850; Columbia Pictures Industries, Inc. v. North West Enterprise, Inc., WIPO Case No. D2006-0951; and Dr. Martens International Trading GmbH, Dr. Maertens Marketing GmbH v. Private Whois Service, WIPO Case No. D2011-1753.

Accordingly, the Panel finds that Complainant has proven the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SBERBANK.ORG**: Transferred

PANELLISTS

Name	**Douglas M. Isenberg**

DATE OF PANEL DECISION 2019-10-17

Publish the Decision