Decision for dispute CAC-UDRP-103425

Case number	CAC-UDRP-103425
Time of filing	2020-11-25 09:41:53
Domain names	deka-eu.com

Case administrator

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

Complainant

Organization	DekaBank Deutsche Girozentrale

Complainant representative

Organization	Grünecker Rechts- und Patentanwälte PartmbB

Respondent

Name	JACOB TAIWO AWOLUSI

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant has provided evidence of ownership of the following trademarks:

- European Union Trademark DEKA registered under No. 001555705 with an application date of March 14, 2000;

- European Union Trademark DEKA registered under No. 016449332 with an application date of March 19, 2017;

- German Trademark DEKA Investmentfonds registered under No. 399704566 with an application date of November 10, 1999.

FACTUAL BACKGROUND

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

The Complainant is a German credit institution and has been providing financial services since 1918 to investors. The Complainant has been providing access to a wide range of investment products and services using the company name Deka

since 1956. The Complainant is globally active in the banking sector and operates branch offices or representative offices in Luxemburg, France, United Kingdom and the United States among other countries.

The Complainant is the proprietor of the trademarks European Union Trademark Registration No. 001555705 DEKA with an application date of March 14, 2000 and European Union Trademark Registration No. 016449332 DEKA (figurative) with an application date of March 19, 2017 and German Trademark Registration No. 399704566 DEKA Investmentfonds (figurative) with an application date of November 10, 1999. The trademarks are all registered for "Financial affairs, monetary affairs" in class 36. The trademarks are used by the Complainant for services in the banking sector.

The Complainant is active under the company name DEKA and has registered the domain names <deka.de>, <deka.com> among others all in the field of banking and financial services.

The disputed domain name <deka-eu.com> was registered on September 23, 2020 and hosted a website active in the banking sector and financial affair. The term "deka" in a red square was used as URL icon (favicon) in an identical design as the Complainants EUTM 016449332 DEKA (figurative). The website reachable under the domain name was designed very similar to the website of the Complainant and has even shown a picture of one of the Complainants employees. This picture was allegedly taken from the Complainants own website under https://www.deka.de/.

The Respondent is unknown. Under November 5, 2020 a cease and desist letter was sent to the Respondents e-mail address under ak9oiwr700opgks8rpl0@h.o-w-o.info. No response was received. At the same date, a request to receive details of the Registrant of the domain was send to the Registrar on November 2, 2020 and November 5, 2020. No response was received.

The disputed domain name <deka-eu.com> is confusingly similar to the earlier trademark rights of the Complainant DEKA, DEKA Investment (figurative) and DEKA (figurative). The term DEKA is identically used in the domain name. The additional use of the terms "-" and "eu" to the elements "deka" does not exclude the finding of confusing similarity. The term "eu" will be perceived as a reference to the territory of the European Union, in which the Complainant is originally located. The additional term is therefore descriptive.

The Respondent has no rights or legitimate interests in registering the disputed domain name. The disputed domain name is not used in connection with a bona fide offering of goods or services as the disputed domain name is allegedly used to attract internet users for commercial gain by creating a likelihood of confusion with the Complainant’s Trademark.

The disputed domain name is used in bad faith because the purpose of the registration was to attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant’s trademarks.

The Complainant requests that the Panel adopts English in this proceeding. The disputed domain name is composed of the mark “deka” and the term "eu" which refers to the territory of the European Union. English is one of the official languages of the European Union. In addition, the content of the website hosted under the domain was in English language which shows that the Respondent understands English and its intention is to target internet users who understand English.

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

Notwithstanding the fact that no Response has been filed, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainant.

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following elements:

(i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) that the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant must establish that it has a trademark or service mark and that the disputed domain name is identical or confusingly similar to that trademark or service mark for the Complainant to succeed.

The Complainant, DekaBank Deutsche Girozentrale, is German credit institution founded in 1918 and offering a wide range of investment and financial services. The Complainant has provided evidence of ownership of the marks "DEKA" and "DEKA INVESTMENTFONDS":

As regards the question of identity or confusing similarity for the purpose of the Policy, it requires a comparison of the disputed domain name with the trademarks in which the Complainant holds rights. According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), “this test 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”.

Also, according to section 1.7 of the 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”.

The disputed domain name wholly incorporates the Complainant’s trademarks "DEKA" in addition to the generic term “eu”, as well as a hyphen. This addition does not prevent a finding of confusing similarity with the Complainant’s trademarks. The fact that a domain name wholly incorporates a complainant’s trademark is sufficient to establish identity or confusing similarity for the purpose of the Policy, despite the addition of other words to such marks. The Panel accepts the Complainant's statement that the term "eu" is very likely to be perceived as a reference to the European Union, where the Complainant is established.

It is well accepted by UDRP panels that a generic Top-Level Domain (“gTLD”), such as “.com”, is typically ignored when assessing whether a domain name is identical or confusing similar to a trademark.

This Panel concludes that the disputed domain name is confusingly similar to the Complainant’s trademark and therefore

finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, any of the following circumstances, if found by the Panel, may demonstrate the respondent's rights or legitimate interests in the disputed domain name:

(i) before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The consensus view of UDRP panels on the burden of proof under paragraph 4(a)(ii) of the Policy is summarized in section 2.1 of the WIPO Overview 3.0, which states: "[…] 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 evidence on record does not show that the Respondent was commonly known, as an individual or an organization, by the disputed domain name.

The Panel also finds, in the absence of a rebuttal from the Respondent, that the Respondent uses the Complainant's trademarks in the disputed domain name without authorization from the Complainant.

Equally, the Panel accepts that the Respondent has not made a legitimate noncommercial or fair use of the disputed domain name.

Therefore, the Panel concludes that the Respondent has no right or legitimate interests in the disputed domain name and therefore finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registration and Use in Bad faith

For the purpose of Paragraph 4(a) (iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of the domain name in bad faith:

(i) circumstances indicating that the holder has registered or 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 holders documented out-of-pocket costs directly related to the domain name; or

(ii) the holder 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 holder has engaged in a pattern of such conduct; or

(iii) the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the

holder'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 your website or location or of a product or service on the holder's website or location.

The Panel finds the third and fourth element of Paragraph 4(b) of the Policy applicable in the present case. The evidence on the record shows that the Respondent was certainly aware of the existence of the Complainant and of the rights of the Complainant, and that the Respondent, by registering and using the disputed domain name has intentionally attracted internet users by creating a likelihood of confusion with the Complainant's trademark.

The use of an active website displaying the Complainant's trademark in connection with the disputed domain name is further evidence of bad faith use on the part of the Respondent.

Additionally, the record shows that the Complainant's representative sent a cease-and-desist letter to the Respondent before the submission of the Complaint which apparently remained unanswered. The Panel finds that, from the receipt of the letter by the Respondent, the latter cannot be in a position to ignore the Complainant's rights.

The Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith, and therefore finds that the requirements of paragraph 4(a)(iii) of the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **DEKA-EU.COM**: Transferred

PANELLISTS

Name	**Arthur Fouré**

DATE OF PANEL DECISION 2020-12-22

Publish the Decision