Decision for dispute CAC-UDRP-101110

Case number	CAC-UDRP-101110
Time of filing	2015-11-18 16:33:32
Domain names	banc-de-swiss.com, bdeswiss.com, bdsswiss.com , bdswis.com , bd-swiss.com, bdswisss.com , wwwbdswiss.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	BDSwiss Holding Plc

Complainant representative

Organization	n/a

Respondent

Name	daniel hall

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings currently pending.

IDENTIFICATION OF RIGHTS

The Complainant relies on its Community trademark BDSWISS with registration number 012708749 of July 21, 2014.

The registration certificate of this trademark indicates that the current owner is Keplero Holdings Ltd. However, the Complainant has shown that its name changed from Keplero Holdings Ltd to BDSwiss Holding Plc.

In most circumstances, a licensee of a trademark or a related company such as a subsidiary or parent to the registered holder of a trademark is considered to have rights in a trademark under the UDRP.

The Panel is therefore satisfied that the Complainant is the owner of a registered Community trademark for the “BDSWISS” sign.

The Respondent registered the following domain names: <banc-de-swiss.com> registered on November 7, 2012, <bdeswiss.com> registered on May 2, 2013, <bdsswiss.com> registered on January 24, 2014, <bdswis.com> registered on September 17, 2013, <bd-swiss.com> registered on September 17, 2013, <bdswisss.com> registered on January 16, 2014,

and <wwwbdswiss.com> registered on January 22, 2014.

FACTUAL BACKGROUND

The Complainant, an investment firm authorized and regulated by the Cyprus Securities and Exchange Commission, operates a professional broker platform which is used by users located in a large number of countries.

The Complainant owns the following trademark (the “Trademark”) for services in connection with traded options brokerage and exchange services relating to the trading of options: the word trademark BDSWISS, a Community trademark with registration number 012708749 of July 21, 2014.

The Complaint has been filed regarding the following domain names (the “Disputed Domain Names”):

The domain name <banc-de-swiss.com> registered on November 7, 2012.

The domain name <bdeswiss.com> registered on May 2, 2013.

The domain name <bdsswiss.com> registered on January 24, 2014.

The domain name <bdswis.com> registered on September 17, 2013.

The domain name <bd-swiss.com> registered on September 17, 2013.

The domain name <bdswisss.com> registered on January 16, 2014.

The domain name <wwwbdswiss.com> registered on January 22, 2014.

At the time the Complaint was filed, the websites at the Disputed Domain Names redirected to the Complainant’s website (<bdswiss.com>).

PARTIES CONTENTIONS

PARTIES' CONTENTIONS

COMPLAINANT:

The Complainant, an investment firm authorized and regulated by the Cyprus Securities and Exchange Commission, operates a professional broker platform which is used by users located in a large number of countries.

The Complainant asserts that it has registered a Community trademark for the sign “BDSWISS” under the number 012708740 on July 21, 2014.

According to the Complainant, the Disputed Domain Names are confusingly similar to its trademark. Moreover, the addition of a gTLD such as “.com” to the Disputed Domain Names does not sufficiently distinguish the Disputed Domain Names from the Complainant’s trademark.

The Complainant has exclusive and prior rights in the BDSWISS trademark and the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names. Indeed, the Respondent has no connection or affiliation with the Complainant and has not received any license or consent, express or implied, to use the Complainant’s trademark.

The Disputed Domain Names redirect to the Complainant’s website (<bdswiss.com>).

The Complainant contends that the Respondent registered and is using the Disputed Domain Names in bad faith. Indeed, the

Complainant pays affiliate fees from the traffic generated from the Disputed Domain Names to the Respondent. In the Complainant's opinion, if it stops paying the affiliate fees, the Respondent will make sure that the Disputed Domain Names do not redirect to the Complainant's website.

In addition, the Complainant asserts that the fact that the Disputed Domain Names redirect to the Complainant's website indicates that the Respondent does not use the Disputed Domain Names in connection with a bona fide offering of goods and services.

For the foregoing reasons, the Complainant requests that the Disputed Domain Names be transferred from the Respondent to the Complainant.

RESPONDENT:

No administratively compliant Response has been filed.

RIGHTS

According to paragraph 15(a) of the Rules, the Panel shall decide the Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The Respondent did not reply to the Complainant's contentions. However, the consensus view of panelists is that a Respondent's default does not automatically result in a decision in favor of the Complainant. Although, the Panel may draw appropriate inferences from a Respondent's default, paragraph 4 of the UDRP requires the Complainant to support its assertions with actual evidence in order to succeed in a UDRP proceeding.

In order to obtain the transfer of the Disputed Domain Names and according to paragraph 4(a) of the Policy, the Complainant must prove each of the following:

"(i) The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(ii) The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;

(iii) The Disputed Domain Name has been registered and is being used in bad faith".

At the same time, in accordance with paragraph 14(b) of the Rules:

"(a) In the event that a Party, in the absence of exceptional circumstances, does not comply with any of the time periods established by these Rules or the Panel, the Panel shall proceed to a decision on the complaint.

(b) If a Party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, these Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate".

The Panel finds that in this case there are no such exceptional circumstances. Consequently, failure on the part of the Respondent to file a response to the Complaint permits an inference that the Complainant's reasonable allegations are true. It may also permit the Panel to infer that the Respondent does not deny the facts that the Complainant asserts.

There are two parts to the inquiry under the first element of the Policy. The Complainant must first demonstrate that it has rights in a trademark and secondly that the Disputed Domain Names are identical or confusingly similar to such trademark.

The Panel is satisfied that the Complainant is the owner of a registered Community trademark for the "BDSWISS" sign.

The Complainant registered its Trademark on July 21, 2014, while the Disputed Domain Names had been registered between

November 7, 2012, and January 24, 2014.

Registration of the Disputed Domain Names before the Complainant acquires its trademark rights in the name BDSWISS does not prevent a finding of identity or confusing similarity under the UDRP.

Indeed, the question of priority of the Complainant's trademark rights is not an issue to be dealt with under paragraph 4(a)(i) of the Policy, as registration of the Disputed Domain Names before the Complainant acquires corresponding trademark rights, does not prevent a finding of identity or confusing similarity.

However in such circumstances, it may be difficult to prove that the Disputed Domain Names were registered in bad faith under the third element of the UDRP (see in this regard the following developments).

The Panel therefore turns to the second part of the inquiry.

Regarding the addition of the gTLD ".com" to the Disputed Domain Names, it is well-established that gTLDs may typically be disregarded in the assessment under paragraph 4(a)(i) of the Policy.

Indeed, "a principle which applies to all the domain names is that the addition of generic top level domains (gTLDs) or country code top level domains (ccTLDs) does not affect the confusing similarity or identity between the domain name and the trade mark(s) in issue. This has been clearly established from the beginning of the UDRP process, and now is no longer an issue. Thus, the addition of various types of gTLDs to the domain names (".com", ".net") does not change the assessment of confusing similarity" (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

1/ Regarding the domain name <bdeswiss.com>

This Disputed Domain Name incorporates the Complainant's trademark with the mere addition of the letter "e" between "bd" and "swiss".

The Panel finds it clear that altering the Complainant's trademark by one letter is strongly evocative of typosquatting, which "consists of registering misspelled trademarks as domain names, and then deriving profits from Internet users seeking the rightful owners of those trademarks as revenues can be generated by web links and pop-up advertisements on the websites to which those domain names point or on the websites on which those domain name are parked" (see Thomson Broadcast and Media Solution, Inc., Thomson v. Alvaro Collazo, WIPO Case No. D2004-0746).

The Disputed Domain Name which contains a common or obvious misspelling of the Trademark normally will be found to be confusingly similar to such Trademark, where the misspelled Trademark remains the dominant or principal component of the Disputed Domain Name.

In the present case, the Panel considers that the addition of the letter "e" in the Disputed Domain Name is a purposeful type of misspelling. "This appears to be a case of 'typosquatting' conduct which creates a virtually identical and/or confusingly similar mark to the Complainant's trademark for the purpose of paragraph 4(a)(i) of the Policy" (see Corcom, Inc. v. Jazette Enterprises Limited, WIPO Case No. D2007-1218).

In these circumstances, the Panel finds that the Disputed Domain Name <bdeswiss.com> is confusingly similar to the trademark in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy have been satisfied.

2/ Regarding the domain name <bdsswiss.com>

This Disputed Domain Name incorporates the Complainant's trademark with the mere addition of the letter "s" between "bd" and "swiss".

The Panel finds it clear that altering the Complainant's trademark by one letter is strongly evocative of typosquatting.

In these circumstances, the Panel finds that the Disputed Domain Name <bdsswiss.com> is confusingly similar to the trademark in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy have been satisfied.

3/ Regarding the domain name <bdswis.com>

This Disputed Domain Name reproduces the Complainant's trademark with the mere suppression of the letter "s" at the end of the Disputed Domain Name.

The Panel finds it clear that altering the Complainant's trademark by one letter is strongly evocative of typosquatting.

In these circumstances, the Panel finds that the Disputed Domain Name <bdswis.com> is confusingly similar to the trademark in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy have been satisfied.

4/ Regarding the domain name <bd-swiss.com>

This Disputed Domain Name reproduces the Complainant's trademark with the mere addition of a hyphen between "bd" and "swiss".

The addition of a hyphen does not sufficiently distinguish the Disputed Domain Name from the Complainant's trademark.

In these circumstances, the Panel finds that the Disputed Domain Name <bd-swiss.com> is confusingly similar to the trademark in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy have been satisfied.

5/ Regarding the domain name <bdswisss.com>

This Disputed Domain Name incorporates the Complainant's trademark with the mere addition of the letter "s" at the end of the Disputed Domain Name.

The Panel finds it clear that altering the Complainant's trademark by one letter is strongly evocative of typosquatting.

In these circumstances, the Panel finds that the Disputed Domain Name <bdswisss.com> is confusingly similar to the trademark in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy have been satisfied.

6/ Regarding the domain name <wwwbdswiss.com>

This Disputed Domain Name incorporates the Complainant's trademark with the mere addition of the letters "www" at the beginning of the Disputed Domain Name.

The Panel considers that the addition of the "www" prefix was very likely intended to draw in Internet users who mistyped the Complainant's website address by omitting the period (or full stop) between "www" and "bdswiss.com".

In these circumstances, the Panel finds that the Disputed Domain Name <wwwbdswiss.com> is confusingly similar to the trademark in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy have been satisfied.

7/ Regarding the domain name <banc-de-swiss.com>

This Disputed Domain Name only reproduces the geographic term “swiss” from the Complainant’s trademark while the distinctive part of this Disputed Domain Name is not identical or substantially similar to the Complainant’s trademark.

In these circumstances, the Panel finds that the Disputed Domain Name <banc-de-swiss.com> is not confusingly similar to the trademark in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy have not been satisfied.

Because the Panel has determined that the Disputed Domain Name <banc-de-swiss.com>at issue is not identical or substantially similar to the Complainant’s trademark, there is no need to determine whether the Respondent has rights or legitimate interests in respect of this particular Disputed Domain Name. The following developments will therefore focus on the six other Disputed Domain Names.

NO RIGHTS OR LEGITIMATE INTERESTS

Paragraph 4(c) of the Policy lists several ways in which the Respondent may demonstrate rights or legitimate interests in the Disputed Domain Names:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

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

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

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

The consensus of previous decisions under the Policy is that the Complainant may establish this element by making out a prima facie case, not rebutted by the Respondent, that the Respondent has no rights or legitimate interests in the Disputed Domain Names. In the present case, the Panel finds that the Complainant has made out such a prima facie case.

The Respondent is not an authorized dealer, distributor or licensee of the Complainant and has been given no other permission from the Complainant to use the Complainant’s Trademarks.

The Respondent’s name does not bear any resemblance to the Disputed Domain Names nor is there any basis to conclude that the Respondent is commonly known by the Trademark or the Disputed Domain Names. Furthermore, there is no evidence that the Respondent has made demonstrable preparations to use or is using such terms in connection with a bona fide offering of goods and services.

The Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Names.

The Respondent has not rebutted this by way of a formal Response.

In all of these circumstances, the Panel finds that the Complainant has proved that the Respondent has no rights or legitimate interests in the Disputed Domain Name and that the requirements of paragraph 4(a)(ii) of the Policy have been satisfied.

BAD FAITH

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

“(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

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

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location”.

The Complainant registered its Trademark on July 21, 2014, while the Disputed Domain Names had been registered between November 7, 2012, and January 24, 2014. Thus, the Respondent could not have had constructive knowledge of the Complainant’s trademark when registering the Disputed Domain Names.

Indeed, “a trademark that did not exist at the time the disputed domain name was registered cannot serve as the basis for a claim under the ICANN Policy, since it is impossible for the domain name to have been registered in bad faith” (see John Ode d/ba ODE and ODE - Optimum Digital Enterprises v. Intership Limited, WIPO Case No. D2001-0074).

Additionally, the Complainant pays affiliate fees from the traffic generated from the Disputed Domain Names to the Respondent. In the Complainant’s point of view, since the Respondent obtains a financial benefit from the Complainant, it can be logically presumed that the Respondent has registered the Disputed Domain Names in order to prevent the Complainant from using these.

However, in light of the specific circumstances, the financial relationship between the Complainant and the Respondent does not permit to assert that the Respondent is using the Disputed Domain Names in bad faith.

In the same way, the same financial relationship between the Complainant and the Respondent does not permit to assert that the Respondent intentionally attempted to attract, for commercial gain, Internet users to the website at the Disputed Domain Names.

Considering all the facts and evidence submitted by the Complainant, the Panel finds that the requirements of paragraph 4(a)(iii) of the Policy are not fulfilled in this case.

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

The Complainant has failed to meet its three-fold burden under the Policy:

“(i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) you have no rights or legitimate interests in respect of the domain name; and

(iii) your domain name has been registered and is being used in bad faith.

In the administrative proceeding, the complainant must prove that each of these three elements are present."

The burden was not met for (iii) and the findings made in relation to (i) were in part, insufficient.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **BANC-DE-SWISS.COM**: Remaining with the Respondent
2. **BDESWISS.COM**: Remaining with the Respondent
3. **BDSSWISS.COM** : Remaining with the Respondent
4. **BDSWIS.COM** : Remaining with the Respondent
5. **BD-SWISS.COM**: Remaining with the Respondent
6. **BDSWISSS.COM** : Remaining with the Respondent
7. **WWWBDSWISS.COM**: Remaining with the Respondent

PANELLISTS

Name	**Nathalie Dreyfus**

DATE OF PANEL DECISION 2015-12-30

Publish the Decision