

Decision for dispute CAC-UDRP-104555

Case number CAC-UDRP-104555

Time of filing 2022-05-05 09:46:29

Domain names berenbergholdings.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization Joh. Berenberg, Gossler & Co. KG

Complainant representative

Organization Rossbach & Beier

Respondent

Organization Domain Registrar

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 owns various trade mark registration for its BERENBERG mark including international registration 1030580 registered on November 26, 2009 which is designated inter alia in the European Union, Switzerland, Russia and Turkey.

FACTUAL BACKGROUND

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

The Complainant, founded in 1590, is one of the oldest private banks in Germany. It has a strong presence in the financial centers of Frankfurt, London and New York and is represented in 17 locations in Germany, Europe and the United States from which it offers services worldwide. It owns the domain names <berenberg.com>, <berenberg.de> and <berenberg.eu> from which it operates websites promoting its business.

The disputed domain name was registered on March 4, 2022. It resolves to a website which purports to offer and advertise a range of banking services, including a credit card allegedly provided or issued by or similar to that provided by the Complainant. The website features the Complainant's trade mark and uses the same colour scheme as used on the

Complainant's website.

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

The Complainant has demonstrated that it owns registered trade mark rights for its BERENBERG mark, namely under international registration 1030580 registered on November 26, 2009 which is designated inter alia in the European Union, Switzerland, Russia and Turkey. As the disputed domain name wholly incorporates the Complainant's BERENBERG mark it is confusingly similar to that mark. The addition in the disputed domain name of the word "holdings" does not prevent a finding of confusing similarity and therefore the Complaint succeeds under paragraph 4(a)(i) of the Policy.

The Complainant has submitted that the Respondent has no rights or legitimate interests in the disputed domain name, since the Respondent is not a licensee of the Complainant and the Complainant has not granted any permission or consent to the Respondent to use its BERENBERG trade mark. It has also submitted that the Respondent has no rights or legitimate interests in the disputed domain name, since there is no indication that the Respondent is commonly known by the distinctive name "Berenberg" or "Berenbergholdings", or that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services. The Panel notes that the website at the disputed domain name uses the Complainant's BERENBERG mark and also offers banking services and financial services such as credit card services as though it is or has some affiliation with the Complainant, when according to the Complainant this is not the case.

The Panel finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. As the Respondent has failed to respond to or to rebut the Complainant's case and also for the reasons described below, the Panel finds that the Complaint also succeeds under paragraph 4(a)(ii) of the Policy.

The Complainant's BERENBERG trade mark is very distinctive and appears to have been used over a very long period of time by the Complainant in relation to its banking business. In any event the disputed domain name was registered on March 4, 2022 long after the registration of the Complainant's trade mark in 2009. It resolves to a website that features the Complainant's trade mark and also a credit card product offered by the Complainant and overall appears to be represented as belonging to, or being associated with or permitted by, the Complainant. As a result, there is an overwhelming inference that the Respondent was well aware of the Complainant's mark when it registered the disputed domain name.

Under paragraph 4(b)(iv) of the Policy there is evidence of registration and use of a disputed domain name in bad faith

where a Respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trade marks as to the source, sponsorship, affiliation or endorsement of the website.

In this case it appears that the Respondent is attempting to use the disputed domain name to confuse and attract Internet users seeking the Complainant's website site or services to the Respondent's website for its own purposes. When Internet users arrive at the website to which the disputed domain name resolves they could equally be confused into thinking that it is the Complainant's website or is affiliated to it or endorsed by the Complainant as the Complainant's trade mark and a similar credit card product are featured on the site. It is apparent that the Respondent is using the disputed domain name to attract Internet users and fraudulently masquerade as, or as having a connection with, the Complainant when this is not the case and for its own purposes, whether commercial or fraudulent.

The Panel's view of the Respondent's use of the disputed domain name in bad faith is only reinforced by the fact that the Respondent has remained registered as "Domain registrar" and has otherwise tried to hide its identity using a privacy service and also failed to respond to the letter sent by the Complainant's legal representatives requesting the transfer of the disputed domain name.

Accordingly, the Panel finds that the disputed domain name has been registered and used in bad faith in accordance with paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BERENBERGHOLDINGS.COM**: Transferred

PANELLISTS

Name	Alistair Payne
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DATE OF PANEL DECISION 2022-06-07

Publish the Decision
