

Decision for dispute CAC-UDRP-104615

Case number	CAC-UDRP-104615
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Time of filing	2022-06-02 10:01:19
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Domain names	delubac-ifc.com
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Case administrator

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

Organization	BANQUE DELUBAC ET CIE
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Organization	Patrick Fabrice
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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 is the owner of European Union Trademark Registration No. 017978583 for the name DELUBAC, registered on March 16, 2019.

FACTUAL BACKGROUND

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

The Complainant was founded in 1924 in France by Maurice Delubac. Banque Delubac Et Cie is an independent financial institution providing specialized banking services. It operates its business under the trademark DELUBAC and is the owner of European Union Trademark Registration No. 017978583 for this name dating to March 16, 2019. The Complainant also owns the domain name <delubac.com> which was registered in 1998 and is used by the Complainant to display its website that promotes its specialist banking and other financial services. The word DELUBAC has no meaning in any language.

Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark. The disputed domain name was registered on May 21, 2022 and resolves to a registrar parking page with commercial links of the

pay-per-click variety, and these are related to Complainant's activity. The letters "IFC", as used in the disputed domain name, refer to the phrase "International Finance Corporation".

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

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate 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; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Paragraph 15(a) of the Rules directs the Panel to decide this case on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Further, as UDRP proceedings are administrative in nature, the standard of proof is the balance of probabilities (i.e., more likely than not). *Simyo GmbH v. Domain Privacy Service FBO Registrant / Ramazan Kayan*, D2014-2227 (WIPO February 27, 2015); *LoanDepot.com v. Liu Yuan*, FA 1762239 (FORUM January 15, 2018).

Confusing Similarity

The Complainant has established its rights to the DELUBAC trademark through its submission into evidence of screenshots from the European Union Intellectual Property Office reflecting a registration of the trademark, as well as through submission of a screenshot of its own www.delubac.com website home page showing actual use of the trademark. The disputed domain name combines an identical copy of the Complainant's trademark with a hyphen, the letters "ifc", and the ".com" gTLD. These additions are very minor and do not dispel the confusing similarity between the disputed domain name and the Complainant's trademark. An example of a recent decision involving the addition of a few characters and a gTLD to a trademark is found in *Jas Hennessy & Co v. Ivan Karalenko*, 104599 (CAC June 26, 2022). Addressing the domain name hennessy24.biz the Panel found that, "In the present case, the number "24" has no impact on the distinctive part "HENNESSY". It is well established that where

the relevant trademark is recognizable within the domain name, the addition of other elements like random numbers would not prevent a finding of confusing similarity." Id.

Therefore, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy because the disputed domain name is confusingly similar to the trademark of the Complainant.

Rights or Legitimate Interests:

Paragraph 4(c) of the Policy sets out certain circumstances which, if proven by the evidence presented, may demonstrate a respondent's rights or legitimate interests in respect of a disputed domain name.

The Panel concludes, on the basis of the Complainant's undisputed contentions, that the Respondent has not made use of the disputed domain name in connection with a bona fide offering of goods or services as noted in paragraph 4(c)(i) of the Policy. The Complainant asserts that the Respondent has not been authorized to use the DELUBAC trademark, either as domain name or in any other way, and the Respondent does not contest this by its silence. Rather, the Respondent is using the disputed domain name to resolve to a registrar parking page that contains pay-per-click links which, in turn, redirect Internet users to a variety of third-party websites that are not associated with the Complainant. Therefore, this Panel concludes that the disputed domain name fully incorporates the Complainant's DELUBAC trademark and that the Respondent is using the disputed domain name to seek pay-per-click revenue through those diverted Internet users who are trying to reach the Complainant but, due to the confusing similarity of the disputed domain name with the Complainant's trademark, end up at the Respondent's website instead. Past decisions under the Policy have held that such use of the disputed domain name is not a bona fide offering of goods or services. See, e.g., *Loro Piana S.p.A. v. Y. v. Oostendorp*, 101335 (CAC March 26, 2018) (use of a disputed domain name that copies the complainant's trademark to resolve to a pay-per-click website "cannot be considered a bona fide offering of goods or services....").

Further, as the Whois record for the disputed domain name identifies the Registrant as Patrick Fabrice and, as the Respondent has submitted no Response nor made any other submission in this case, there is no evidence before this Panel to suggest that the Respondent is commonly known by the disputed domain name or that it has any trademark rights associated with the name "Delubac" under paragraph 4(c)(ii) of the Policy.

Finally, it cannot be said that the Respondent has made a legitimate non-commercial or fair use of the disputed domain name without intent for commercial gain as noted in paragraph 4(c)(iii) of the Policy. There is no evidence of record to show, and this Panel is not aware of any information to indicate that the word "Delubac" has any generic or descriptive meaning apart from its reference to the Complainant and its founder. Nor does it appear that the disputed domain name and its resulting pay-per-click parked website are referring to the Complainant's trademark in any nominative or other classic fair use manner such as for the purpose of commentary, news reporting, grievance, education, or the like.

Therefore, the Panel finds that the Complainant has made out a prima facie case under paragraph 4(a)(ii) of the Policy, which has not been rebutted by the absent Respondent, and has demonstrated that the Respondent has no rights or legitimate interests in the disputed domain name.

Bad Faith Registration and Use:

In order to prevail in a dispute, paragraph 4(a)(iii) of the Policy requires that a Complainant prove that the domain name has both been registered and is being used in bad faith.

The Complainant states that it is an independent financial institution providing specialized banking services. It submits into evidence a screenshot of its own <delubac.com> website home page, at which its services are promoted, as well as an online search for the terms "delubac" and "ifc", the results of which refer to the Complainant. It further notes that the trademark has been recognized in at least one prior case brought by the Complainant. *Banque Delubac et Cie v. Global Domain Privacy /*

MichelVivier, D2020-0925, (“Since DELUBAC is a distinctive trademark and there is no evidenced relationship between the Parties, and since the disputed domain name is a combination of the trademark DELUBAC and the word “patrimoine” which directly refers to one of the Complainant’s activities (“gestion de patrimoine”, in English “assets management”), it may be assumed that the Respondent was aware of the Complainant’s trademark at the time it registered the disputed domain name.”) This, combined with the disputed domain name’s use of the acronym “IFC” which is highly relevant to the Complainant’s business, leads this Panel to it highly likely that the Respondent registered the disputed domain name with knowledge of the Complainant’s trademark. It has been held in prior decisions that such activity supports a finding of bad faith domain name registration. 7-Eleven, Inc. v. charles rasputin, FA 1829082 (FORUM March 9, 2019) (in relation to the domain name 7eleven delivered.com and others, “Respondent had actual knowledge of Complainant’s rights in the 7 ELEVEN mark at the time of registering the infringing domain names. Actual knowledge of a complainant’s rights in a mark prior to registering a confusingly similar domain name can evince bad faith under Policy 4(a)(iii).”).

As for use, the Complainant has submitted evidence that the disputed domain name resolves to a registrar parking page with pay-per-click links to various third-party companies in the fields of banking, investment, and finance who have no relationship to the Complainant. Such activity has routinely been held to demonstrate bad faith use of a domain name that is confusingly similar to a complainant’s trademark. Arla Foods Amba v. I S / ICS INC, 101764 (CAC December 22, 2017) (bad faith is found in a case where “the Disputed domain name is pointing to a pay-per click website using advertisements and is not used with real content.”). The Panel in this case finds that, in accordance with paragraph 4(b)(iv) of the Policy, the disputed domain name has been used in bad faith as it creates a likelihood of confusion with the DELUBAC trademark and resolves to a website for the commercial gain of either the Respondent or of those entities to whom the pay-per-click links resolve. In Focus Do It All Group v. Athanasios Sermbizis, D2000-0923 (WIPO October 12, 2000) the Panel found that “[I]t is enough that commercial gain is being sought for someone” for a use to be commercial.

In light of the above, the Panel finds that the Complainant has satisfied paragraph 4(a)(iii), by a preponderance of the evidence, and that the disputed domain name has been registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **DELUBAC-IFC.COM:** Transferred

PANELLISTS

Name	Steven M. Levy, Esq.
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DATE OF PANEL DECISION	2022-07-04
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Publish the Decision