

Decision for dispute CAC-UDRP-104990

Case number CAC-UDRP-104990

Time of filing 2022-11-16 08:59:45

Domain names berenbergcorp.com

Case administrator

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

Complainant

Organization Joh. Berenberg, Gossler & Co. KG

Complainant representative

Organization Rossbach & Beier Rechtsanwälte

Respondent

Name Christian Ekpe

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, amongst others, of the following trademark registrations for BERENBERG:

- International trademark registration No. 1030580 for BERENBERG (word mark), registered on November 26, 2009, in class 36;
 - International trademark registration No. 1167518 for BERENBERG PARTNERSHIP SINCE 1590 (figurative mark), registered on May 23, 2013, in class 36;
 - Germany trademark registration No. 30165313 for BERENBERG BANK (word mark), registered on February 19, 2002, in class 36;
 - United States trademark registration No. 4867482 for BERENBERG CAPITAL MARKETS (figurative mark), registered on December 8, 2015, in international class 36.
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FACTUAL BACKGROUND

The Complainant was founded in 1590 and is one of the oldest private banks in Germany and a CRR credit institution regulated and supervised by, and registered with, the German Federal Financial Supervisory Authority, active and known as "Berenberg".

With a strong presence in the financial centers of Frankfurt, London and New York, the Complainant is represented in 17 locations in Germany, Europe and the USA, from which it offers its services worldwide.

The Complainant owns a number of domain names, including the domain names <berenberg.com> registered on July 19, 1999 and <berenberg.eu> registered on November 21, 2006, both used by the Complainant to promote and provide its services under the trademark BERENBERG.

The disputed domain name <berenbergcorp.com> was registered on August 20, 2022 and currently does not resolve to an active website. According to the screenshot provided as Annex F to the Complaint – which have not been contested by the Respondent -, the disputed domain name previously resolved to a website promoting financial services under the trademark BEREN BERG and using a similar orange color as the Complainant for the second part of the name Beren Berg.

PARTIES CONTENTIONS

Complainant

The Complainant states that the disputed domain name <berenbergcorp.com> is confusingly similar to its trademark BERENBERG, as it reproduces the trademark in its entirety with the mere addition of the descriptive element “corp” (standing for “corporation”) and the generic TLD “.com”, which is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name because i) the Respondent is not a licensee of the Complainant nor has the Complainant granted any permission or consent to the Respondent to use its trademarks or designations confusingly similar to its trademarks; ii) there is no indication that the Respondent is commonly known by the names “Berenberg”, “Beren berg” and “Berenbergcorp” and iii) the Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services.

With reference to the circumstances evidencing bad faith, the Complainant highlights that, considering the designation “Berenberg” is a relatively rare name and since over 400 years the name and nowadays trademark of the Complainant offering banking and financial services, the Respondent was clearly well aware of the Complainant at the time of registering the disputed domain name.

Moreover, the Complainant contends that the circumstances of this case indicate that the Respondent registered and used the disputed domain name primarily with the intention of attempting to attract, for commercial gain, Internet users to its website or other online locations, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of such website or location, or of a product or service on such website or location.

Respondent

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

1. The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark BERENBERG as it reproduces the trademark in its entirety with the mere addition of the word "corp" (abbreviation for the term "corporation") and the generic TLD ".com", which are not sufficient to prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy.

2. With reference to the Respondent's rights or legitimate interests in the disputed domain name, the Panel finds that the Complainant has made a prima facie case and that the Respondent, by not submitting a Response, has failed to provide any element from which a Respondent's right or legitimate interest in the disputed domain name could be inferred.

Indeed, the Complainant stated that the Respondent is not a licensee of the Complainant nor has the Complainant granted any permission or consent to the Respondent to use its trademarks or designations confusingly similar to its trademarks. In addition, there is no evidence that the Respondent, whose name is Christian Ekpe according to the Whois records, might be commonly known by the disputed domain name.

In light of the prior use of the disputed domain name made by the Respondent in connection with a website promoting financial services in direct competition with the Complainant, as demonstrated by the screenshot submitted as annex F to the Complaint, the Panel finds that the Respondent has not used the disputed domain name in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark. The Panel also notes that the disputed domain name, combining the Complainant's trademark with the word "corp", standing for "corporation", carries a high risk of implied affiliation.

3. As to bad faith at the time of the registration, the Panel finds that, in light of i) the prior registration and use of the Complainant's trademark BERENBERG in connection with the Complainant's banking and financial services, ii) the widely known character of the trademark in its sector and iii) the fact that the Respondent's website was promoting services in direct competition with the Complainant and using a trademark almost identical to the Complainant's trademark, the Respondent very likely registered the disputed domain name having the Complainant's trademark in mind.

The Panel also notes that the Respondent's prior use of the disputed domain name in connection with a website offering and advertising banking and financial services identical to those provided by the Complainant amounts to bad faith under paragraph 4(b) (iv) of the Policy, since the Respondent intentionally attempted to attract Internet users to its website for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of its website and the services provided and advertised therein.

The disputed domain name is currently not resolving to an active web site, i.e. is passively held. As established in a number of prior cases, the concept of "bad faith use" in paragraph 4(b) of the Policy includes not only positive action but also passive holding. See i.a. the landmark case *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003.

In view of the above, the Panel finds that the Respondent's registration and use of the disputed domain name amounts to bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **berenbergcorp.com**: Transferred

PANELLISTS

Name	Luca Barbero
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DATE OF PANEL DECISION 2022-12-28

Publish the Decision
