

Decision for dispute CAC-UDRP-105648

Case number	CAC-UDRP-105648
Time of filing	2023-07-21 08:43:01
Domain names	beforbank.net, beforbank.org, secure-bforbank.com, secure-bforbank.org

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	BFORBANK
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Organization	LILIANA JOSEFINA SANCHEZ (LILIANA JOSEFINASANCHEZ)
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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 names.

IDENTIFICATION OF RIGHTS

The Complainant conducts business under the company / trade name BforBank.

The Complainant is owner of the European Union trademark (word) "BforBank" no. 8335598, filed on 2 June 2009 and registered since 8 December 2009 in classes 9, 35, 36, and 38.

The Complainant is also owner of the domain name <bforbank.com>, registered since 16 January 2009 and used its main website.

FACTUAL BACKGROUND

The Complainant is a 100% online bank launched in October 2009 by the Crédit Agricole Regional Banks. It offers daily banking, savings, investment and credit (consumer and real estate) services for 240,000 customers.

The disputed domain names were registered on 24 June 2023 by an individual residing in Mexico and resolve to parking or inactive pages.

PARTIES' CONTENTIONS

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COMPLAINANT:

The Complainant contends that the disputed domain names are confusingly similar to its trademark, since the BforBank trademark is reproduced in its entirety and the addition of letters, punctuation, generic and descriptive terms, and the TLDs do not prevent the likelihood of confusion between the disputed domain names and the Complainant's trademark.

The Complainant also contends that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark, or apply for registration of the disputed domain names by the Complainant. The Respondent is not commonly known by the domain names, nor has acquired any rights in a trademark or trade name corresponding to the disputed domain names.

Furthermore, the disputed domain names are not actively used. The Complainant contends that the Respondent has made no demonstrable preparations to use the disputed domain names in good faith. To the contrary, two domain names were previously used to resolve to a website with direct reference to the Complainant's activities. Therefore, the Respondent did not use the disputed domain names for any bona fide offering of goods or services.

Finally, the Complainant contends that the registration of disputed domain names confusingly similar to the well-known trademark of the Complainant and, thus, the constructive knowledge on behalf of the Respondent of the Complainant's potential rights, as well as the previous use and the current passive holding of the disputed domain names, clearly shows the Respondent's bad faith in the registration and use of the disputed domain names.

The Complainant requests the transfer of the disputed domain names.

RESPONDENT:

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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

Under paragraph 4(a) of the UDRP Policy, the Complainant is required to prove each of the following three elements to succeed in the administrative proceeding:

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are being used by the Respondent in bad faith.

I. RIGHTS AND CONFUSING SIMILARITY

In UDRP disputes the test for identity or confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. 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. 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. UDRP panels have also consistently found that the adding, deleting, or substituting letters, numbers, punctuation, or other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) to the relevant trademark, recognizable within the disputed domain name, would not prevent a finding of confusing similarity under the first element. Finally, UDRP panels agree that the TLD is to be ignored for the purpose of determination of confusing similarity between the disputed domain name and the complainant's trademark, as it is a technical requirement of registration (paragraphs 1.7, 1.8, and 1.11.1 WIPO Overview 3.0).

The Complainant has established that it has rights in the BforBank trademark since 2009. All disputed domain names incorporate the entirety of such mark. The disputed domain names <beforbank.net> and <beforbank.org> differ from the Complainant's mark by merely adding the letter "e" between the letters "b" and "f", as well as the TLDs ".net" and ".org". Even adding such letter, there is a phonetic identity between the Complainant's mark and the disputed domain names. The disputed domain names <secure-bforbank.com> and <secure-bforbank.org> differ from the Complainant's mark by adding the generic and descriptive English term "secure" and a hyphen, as well as the TLDs ".com" and ".org". The addition of such generic and descriptive term to the Complainant's mark neither affects the attractive power of such trademark, nor is sufficient to distinguish the disputed domain names from the Complainant's mark.

Hence, this Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain names are confusingly similar to the Complainant's trademark.

II. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAMES

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain names. If 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 (paragraph 2.1 WIPO Overview 3.0).

The Respondent is Liliana Josefina Sanchez, an individual based in Mexico. No evidence is available that the Respondent has been commonly known by the disputed domain names or has acquired any rights in a trademark or trade name corresponding to the disputed domain names.

The Complainant contends to have no relationship whatsoever with the Respondent. The Respondent has never received any approval of the Complainant, expressed or implied, to use the Complainant's trademark or to register and use the disputed domain names.

The Respondent registered four domain names, all of them incorporating the Complainant's BforBank trademark adding a letter ("e"), or punctuation ("-") and a generic and descriptive term ("secure"), and, thus confusingly similar to such mark. UDRP panels have found that domain names identical or confusingly similar to a complainant's trademark carry a high risk of implied affiliation. A domain name consisting of a trademark plus an additional term at the second- or top-level is seen as tending to suggest sponsorship or endorsement by the trademark owner. Thus, UDRP panels have largely held that such composition cannot constitute fair use (paragraph 2.5.1 WIPO Overview 3.0).

Moreover, there is no evidence that, before any notice to the Respondent of the dispute, the Respondent used, or demonstrably prepared to use, the domain names or names corresponding to the domain names in connection with a bona fide offering of goods or services. Indeed, the disputed domain names are inactive.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain names.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain names.

III. REGISTRATION AND USE OF THE DISPUTED DOMAIN NAMES IN BAD FAITH

The disputed domain names have been registered and are being used in bad faith for the following reasons.

The Respondent has used a privacy or proxy service when registering the disputed domain names. Although the use of such service is not in and of itself an indication of bad faith, the circumstances and the manner in which such service is used may however impact the Panel's assessment of bad faith (paragraph 3.6 WIPO Overview 3.0).

The disputed domain names are to be considered confusingly similar to the Complainant's BforBank trademark, since they all incorporate such mark in its entirety and differ from it merely by adding the TLDs ".net", ".org" ".com", which are disregarded for the purpose of determination of confusing similarity between the disputed domain names and the trademarks of the Complainant as they are a technical requirement of registration, a letter (in the cases of <beforbank.net> and <beforbank.org>) and a hyphen and a non-distinctive and descriptive term referring to the Complainant's business activities (in the cases of <secure-bforbank.com> and <secure-bforbank.org>).

UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (paragraph 3.1.4 WIPO Overview 3.0).

Given the distinctiveness and the reputation of the Complainant's prior mark acquired over the years, also confirmed in other UDRP disputes (see WIPO Case No. D2023-2583 Bforbank v. M Verschoor <beforebnk.com> et al.), it is inconceivable that the Respondent could have registered the disputed domain names confusingly similar to the Complainant's trademark for a mere chance without actual knowledge of the Complainant and its mark and the intention to exploit such reputation by diverting traffic away from the Complainant's website.

Even assuming that the Respondent had no knowledge of the Complainant's prior mark at the time of registration of the disputed domain names (which is quite unlikely), she omitted to verify that the disputed domain names would have infringed the Complainant's earlier rights or, even worse, she verified it and deliberately proceeded with the infringing registration. Under paragraph 2 of the Policy, it is the Respondent's responsibility to determine whether a domain name registration infringes or violates third party's rights. By registering the disputed domain names confusingly similar with the Complainant's well-known mark, the Respondent has violated, inter alia, the cited provision of the Policy.

Furthermore, since the Respondent registered four domain names confusingly similar to the Complainant's trademark, the Panel finds that the Respondent is engaged in a pattern of abusive conduct (paragraph 4(b)(ii) of the Policy).

The disputed domain names do not resolve to any active website. UDRP panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding (see 3.3 WIPO Overview 3.0 and in particular Telstra Corporation Limited v. Nuclear Marshmallows WIPO Case No. D2000-0003).

The following factors were considered by the Panel when applying the passive holding doctrine in the present case:

- (i) the degree of distinctiveness and/or reputation of the Complainant's trademark;
- (ii) the failure of the Respondent(s) to submit a response or to provide any evidence of actual or contemplated good faith use;
- (iii) the Respondent's concealing its identity (privacy or proxy service) or use of false contact details;
- (iv) the implausibility of any good faith use to which the disputed domain names may be put.

Taken into account all circumstances of this case, the Panel finds that it is not possible to conceive of any plausible actual or contemplated active use of the domain names by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's trademark under trademark law.

The Panel, thus, finds that the Complainant has discharged the burden of proof to show that the disputed domain names have been registered and are being used in bad faith (paragraph 4(a)(iii) of the Policy).

Therefore, the disputed domain names are to be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **beforbank.net**: Transferred
2. **beforbank.org**: Transferred
3. **secure-bforbank.com**: Transferred
4. **secure-bforbank.org**: Transferred

PANELLISTS

Name	Ivett Paulovics
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DATE OF PANEL DECISION 2023-09-11

Publish the Decision
