Decision for dispute CAC-UDRP-106058

Case number	CAC-UDRP-106058
Time of filing	2023-12-11 10:42:05
Domain names	bfkbank.com, bfebank.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	BFORBANK

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	PERSONA FISICA CON ACTIVIDAD EMPRESARIAL

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 owns the EU Trademark No. 8335598 "BforBank", registered since June 02, 2009 (hereinafter referred to as the "Trademark").

The Respondent has not provided any evidence of rights.

FACTUAL BACKGROUND

The Complainant is an online bank launched in October 2009 by the Crédit Agricole Regional Banks.

The Complainant provides information on its services online at <bforbank.com>, which is registered since January 16, 2009.

The disputed domain names <bfkbank.com> and <bfebank.com> were both registered on December 05, 2023. At the time of filing of this complaint and according to Complainant's Annexes the disputed domain name <bfkbank.com> is used in connection with a parking website displaying relevant pay-per-click links and the disputed domain name <bfebank.com> is used in connection with a parking website without any links or relevant content. However, at the present moment both disputed domain names are displaying ppc links relevant to the Complainant's business.

The Respondent is a domain name investor.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain names are confusingly similar to the Trademark.

Furthermore, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain names. In this regard, the Complainant states that the Respondent is not commonly known by the disputed domain names, that it is not affiliated with nor authorized by the Complainant in any way, that the Complainant does not carry out any activity for, nor has any business with the Respondent, and that neither license nor authorization has been granted to the Respondent to make any use of the Trademark or apply for registration of the disputed domain names by the Complainant.

Finally, the Complainant contends that the disputed domain names were registered and are being used in bad faith. It contends that the Respondent must have been aware of the Complainant and its Trademark, at the time of registration of the disputed domain names and that the use of the disputed domain names cannot be for any bone fide offerings. More particularly, there are present circumstances indicating that, by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his website.

RESPONDENT:

The Responded submitted his Response and contends that:

- The disputed domain names are not confusingly similar to the Trademark, as there are visual and sound differences. Furthermore, he contends that if the word "bank" would be disregarded the remaining characters are not similar to the "bfor" part as they contain other letters and that there could be a lot of combinations of letters before the word "bank" and these cannot be all typosquatting cases.
- The Complainant could not prove that the Respondent does not have legitimate interests in the disputed domain names. The Respondent mentions that he is working on his business and that is why he bought the disputed domain names.

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 name 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 Policy, the Complainant must prove that each of the following three elements is present:

(i) the disputed domain name is identical or confusingly similar to the Complainant's trademark; 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.

1. The Panel has carefully reviewed the evidence and accepts that the disputed domain names are confusingly similar to the Trademark.

First, it is well established that the applicable Top Level Domain (“TLD”) in a domain name, such as ".com” in the present case, is a standard registration requirement and as such is generally disregarded under the first element.

Second, determining whether a disputed domain name is confusingly similar to Complainant's trademark requires the Panel's inquiry as limited to a “mechanical (though reasoned) comparison of the appearance, spelling, sound, and other objective characteristics of the disputed domain name against those of the mark, without regard to the content of the site.” (see Joseph Dello Russo M.D. v. Michelle Guillaumin, WIPO Case No. D2006-1627). It is well established that the similarity test of the first element 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. In some cases, such assessment may also entail a more holistic aural or phonetic comparison of the complainant’s trademark and the disputed domain name to ascertain confusing similarity.

Complainant argues that the comparison between the disputed domain names and the Trademark "BforBank" is making it clear that it is a case of an obvious misspelling of the Trademark. Complainant is also providing for examples in this regard where in the first case the disputed domain name was <bforbank.pro> (WIPO Case No. D2023-0096, Bforbank v. philippe harignordoquy) and in the second case the disputed domain name was <bforbankfrance.net> (WIPO Case No. D2022-1972, BFORBANK v. alexandre Monserrat <bforbankfrance.net>). However, it is apparent that the present case differs from the examples in the sense that in those examples the Trademark was fully incorporated and they were not cases of misspelling of the Trademark.

Moving on to the similarity test, with respect to the visual aspect, the Panel finds the following:

- The disputed domain name <bfkbank.com> and the Trademark <BforBank> are similar in the sense that most of the letters are the same letters except for the letter "k" replacing the letters "or".
- The disputed domain name <bfebank.com> and the Trademark <BforBank> are similar in the sense that most of the letters are the same letters except form the letter "e" replacing the letters "or".

The word "bank" is not be separated for this comparison as it is part of the Trademark and there is no reason for it not to be included when comparing the disputed domain names with the Trademark.

With respect to the sound aspect, the Panel finds the following:

- The disputed domain name <bfkbank.com> and the Trademark <BforBank> do not sound similar, as "k" is a consonant and gives a specific sound that cannot be confused with the sound of the letters "or" or of the word "for" that is clearly giving the meaning to the Trademark "B stands for Bank" or in another interpretation "before bank".
- The disputed domain name <bfebank.com> and the Trademark <BforBank> do not sound similar, even though the letter "e" is a vowel and hence creates a softer sound. Nonetheless when hearing the sound of the disputed domain name there is not a high chance of hearing something similar to the Trademark ("B stands for Bank" or "before bank").

As both disputed domain names could be indeed cases of misspeling of a trademark and typosquatting, it is questionnable if they are cases of misspelling of the Complainant's Trademark. As Respondent rightly mentioned, there can be numerous possible combinations of words and even numbers that would result in a typosquatting case of the Trademark. However, from the side-by-side comparison of the disputed domain names and the Trademark one can see that it is quite obvious that out of all the possibilities the Respondent has chosen the same starting letters "b" and "f" and the same ending "bank". Thus, the Complainant has on balance established the first element of the Policy.

2. The Complainant has made a prima facie case that Respondent lacks rights or a legitimate interest in the disputed domain names by showing that it has never authorized Respondent to use its trademarks and that Respondent has never been commonly known by the disputed domain names. Respondent counters by saying that the Complainant does not have any insights in the business of the Respondent. On the one hand Respondent claims that he is a domain name investor and on the other hand he states that "Complainant does not have information to determine the situation about respondent business. Respondent is own a big bank net for business. Working on it." Without submitting any proof on these assertions Respondent has not satisfied its burden of proof.

Therefore, the Panel finds that the Complainant has fulfilled its obligations under paragraph 4(a)(ii) of the Policy.

3.1 The Panel is satisfied that the Respondent registered the disputed domain name with full knowledge of the Complainant and its rights in the Trademark. The Respondent is a domain name investor (according to his own statement) and registered the domain name quite recently. With a simple google search and due dilligence exercise he could have guessed, on the balance of probabilities, that the disputed domain names may infringe Complainant's Trademark. It would have been a different case if the Respondent would have submitted more proof to convince the Panel that it has indeed a portfolio of domain names that have a certain investment value and maybe some that are connected to his alleged banking business that is in the progress.

3.2 Furthermore, the Panel accepts Complainant's contentions that the disputed domain names have been used in bad faith, since the placeholder websites of both dipsuted domain names are providing for ppc links that are related to the business sector where

the Complainant is active, namely the banking sector. The Panel is convinced that the use of the disputed domain names by the Respondent, is intentionally attempting to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the Complainant's Trademark as to the source, sponsorship, affiliation, or endorsement of his website (para. 4(b)(iv) of the Policy). Moreover, Respondent has offered to sell the disputed domain names to the Complainant. Whilst the registration and resale of domain names in and of itself is a legitimate activity provided that such activity does not trade off of the goodwill of trademark owners, the Respondent is contradicting himself with that statement since earlrier he mentioned that he acquired the disputed domain names in order to establish and promote his business.

All the above circumstances lead the Panel to conclude that the Complainant has satisfied also the third element of the Policy, namely para. 4(a)(ii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **bfkbank.com**: Transferred
2. **bfebank.com**: Transferred

PANELLISTS

Name	**Stefanie Efstathiou LL.M. mult.**

DATE OF PANEL DECISION 2024-01-31

Publish the Decision