Anonymized decision for dispute CAC-UDRP-106429

Case number	CAC-UDRP-106429
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Domain names	BFORBK-ONLINE.COM

Case administrator

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

Complainant

Organization	BFORBANK

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	[redacted]

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 registrant of the EU trademark registration No. 8335598 “BFORBANK", registered on December 8, 2009, for goods and services in classes 9, 35, 36 and 38.

The disputed domain name was registered on March 1, 2024.

FACTUAL BACKGROUND

The Complainant is an online bank created in October 2009. The Complainant offers daily banking, savings, investment and credit services for more than 230.000 customers.

The Complainant is the owner of several trademark registrations and of a number of domain names, including the same distinctive wording BFORBANK, such as the domain name <bforbank.com>, registered on January 16, 2009.

The disputed domain name, registered on March 1, 2024, redirects to a parking page. Furthermore, MX records had been set for the disputed domain name.

An individual whose name matches the name of the individual identified by the Registrar as the holder of the disputed domain name,

using the response form declared that he was victim of a scam, that he is convinced that he has been a victim of an identity theft and that he was not the registrant of the disputed domain name. He submitted the receipt of a complaint filed with the competent authority.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant states that the disputed domain name is confusingly similar to its trademark BFORBANK. The Complainant considers that the deletion of the letters “AN” and the addition of the generic term “ONLINE”, referring to the Complainant’s online activities, is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark BFORBANK. The Complainant contends that the addition of the suffix “.COM” does not change the overall impression of the designation as being connected to the trademark BFORBANK.

The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain name. The Complainant underlines that past panels have held that a Respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name.

The Complainant states that the Respondent is not known by the Complainant. The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant considers that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant points out that it does not carry out any activity for, nor has any business with the Respondent.

The Complainant states that neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark BFORBANK, or apply for registration of the disputed domain name.

The Complainant adds that the disputed domain name resolves to a parking page. The Complainant contends that the Respondent did not make any use of the disputed domain name since its registration, and it confirms that the Respondent has no demonstrable plan to use it.

For these reasons, the Complainant considers that the Respondent has no rights or legitimate interests on the disputed domain name.

The Complainant recalls that the disputed domain name is confusingly similar to the Complainant's trademark BFORBANK. The Complainant stresses that the Respondent has registered the disputed domain name several years after the registration of the trademark BFORBANK by the Complainant, which has established a strong reputation while using this trademark. The Complainant considers itself as a well known banking entity. The Complainant underlines that the term "ONLINE" relates to the Complainant's online banking activities.
The Complainant observes that the majority of the results of a Google search of the term “BFORBK ONLINE” refer to the Complainant.
The Complainant, given the distinctiveness of its trademark and reputation, contends that it is inconceivable that the Respondent could have registered the disputed domain name without actual knowledge of the Complainant's rights in the trademark.
The Complainant underlines that the disputed domain name resolves to a parking page. The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate.

The Complainant adds that the disputed domain name has been set up with MX records which suggests that it may be actively used for email purposes. The Complainant considers that this is also indicative of bad faith registration and use because any email emanating from the disputed domain name could not be used for any good faith purpose.

In the light of the above, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

RESPONDENT:

The Respondent has not contested any of the Complainant's arguments.

The Response consists in a declaration from an individual whose name matches the name of the individual identified by the Registrar as the holder of the disputed domain name. This individual declared that he was victim of a scam, that he is convinced that he has been a victim of an identity theft and that he was not the registrant of the disputed domain name.

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.

The Respondent appears to have used the name and contact details of a third party when registering the disputed domain name. In light of the potential identity theft, in line with the approach taken by other panels in similar cases (see for example WIPO Case No. D2017-1520), the Panel requests that the Respondent's name is redacted from the public version of this Decision. Indeed, the publication of the third party's name in these circumstances might adversely affect him.

Given the limited scope of the Policy, the Panel is not in a position to verify the third party's contentions. However, regardless of the possible outcome of any verification of them, the outcome of this proceeding would still be the same. Indeed, none of the facts declared in the Response would deprive of plausibility the Complainant's arguments. On the contrary, in case of identity theft, the latter would constitute further evidence of bad faith (see for example CAC Case No. 104698).

PRINCIPAL REASONS FOR THE DECISION

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the disputed domain name, the Complainant has to demonstrate that:

(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.

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark or service mark rights.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademark "BFORBANK", identified in section "Identification of rights" above.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain name itself to the Complainant's trademark.

The disputed domain name differs from the Complainant's trademark "BFORBANK" only by the deletion of the letters "AN", by the addition of a hyphen, by the addition of the term "ONLINE" and by the top-level domain ".COM".

It is well established that where the relevant trademark is recognizable within the disputed domain name, minor changes usually do not prevent a finding of confusing similarity under the first element (see, for example, WIPO Case No. D2021-2571). In particular, the addition of a generic term would not prevent a finding of confusing similarity (see, for example, WIPO case No. D2022-0073).

It is well accepted that the hyphen is not relevant in the confusing similarity test (see, for example, WIPO case No. D2016-0676).

It is also well established that the top-level domain may generally be disregarded in the confusing similarity test (for example WIPO

case No. D2016-2547).

The Panel observes that, due to its phonetic similarity and to the fact that the word "BK" indicates "BANK" (see, for example CAC Case No. 103352), notwithstanding the deletion of the letters "AN", and the addition of the hyphen and of the generic term "ONLINE", the relevant trademark is recognizable within the disputed domain name.

The Response does not contain any argument in relation with the above-mentioned identity or confusing similarity.

In the light of the above, the Panel considers that the disputed domain name is confusingly similar to the Complainant's trademark.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the respondent has rights or legitimate interests in a domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or

(iii) [the Respondent] [is] making a legitimate non-commercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of "proving a negative".

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in a domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name.

In particular, the Complainant states that:

- the Respondent is not identified in the Whois database as the disputed domain name;

- the Respondent is not known by the Complainant;

- the Respondent is not affiliated with nor authorized by the Complainant in any way;

- the Respondent 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 BFORBANK or apply for registration of the disputed domain name;

- the disputed domain name resolves to a parking page and the Respondent did not make any use of the disputed domain name since its registration.

There is no indication in the present case that the Respondent is commonly known by the disputed domain name.

Furthermore, the Response does not contain any arguments as regards the second element of the Policy.

The Respondent does not appear to make any legitimate non-commercial or fair use of the disputed domain name, nor any use in connection with a bona fide offering of goods or services.

The Panel considers that, on the balance of probability, the Respondent knew the Complainant's trademark and registered the disputed domain name with knowledge of the Complainant's rights. Indeed, it is not conceivable that the Respondent did not have the Complainant's trademark in mind, when registering and using the disputed domain name. Under these circumstances, it cannot be concluded that the Respondent is making a "fair" use of the disputed domain name.

Taking into account that the Respondent is not commonly known by the disputed domain name, that the disputed domain name resolves to a parking page and that no authorization has been granted to apply for registration of the disputed domain name, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any

explanation that demonstrates any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent.
Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:
(i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or
(ii) [the Respondent] [has] registered the [disputed] domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent] [has] engaged in a pattern of such conduct; or
(iii) [the Respondent] [has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or
(iv) by using the [disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.
The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the disputed domain name was registered in bad faith and that it has been used in bad faith.
Taking into account the fact that the trademark “BFORBANK" is distinctive and well-known, as also recognized by other panels (see for example CAC Case No. 104625), the Panel agrees that it is inconceivable that the Respondent was not aware of the Complainant's rights in the Complainant's trademark when registering the disputed domain name.
Other panels considered that knowledge of a corresponding mark at the time of the domain name’s registration can suggest bad faith (see WIPO Case No. D2017-0100). The Panel shares this view.

Furthermore, other panels considered that a passive holding of a disputed domain name combined with a well-known complainant may indicate bad faith use (see, for example, CAC Case No. 105960). The Panel agrees with this view and considers that this applies to the circumstance of this case.

Moreover, other panels considered that the risk that a domain name is used for the sending and receiving of phishing emails may exist where a domain name that is confusingly similar to the Complainant’s well-known trademark has been created by the Respondent, and in the absence of the Respondent's explanation as regards the creation of the MX record (see CAC Case No. 104862). The Panel agrees with this view and considers that, in the present circumstances, the existence of a MX record for the disputed domain name supports a finding of bad faith.

The Response does not contain any argument in relation with the third element of the Policy. However, the fact that a third party declared in the Response that he was victim of an identity theft, if proved, it might constitute further evidence of bad faith. Indeed, in similar cases other panels have considered that concealing the Respondent's identity or use of false contact details might be considered as further evidence of bad faith (see for example CAC Case No. 104698).
The Panel, having taken into account the Respondent's knowledge of the Complainant's well-known and distinctive trademark at the time of the disputed domain name's registration, the passive holding of the disputed domain name, the existence of a MX record and the content of the Response, considers that the disputed domain name was registered and is being used in bad faith.
Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

PANELLISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2024-04-29

Publish the Decision