

Decision for dispute CAC-UDRP-106448

Case number **CAC-UDRP-106448**

Time of filing **2024-04-15 16:13:44**

Domain names **biorkbank.com**

Case administrator

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

Complainant

Organization **BFORBANK**

Complainant representative

Organization **NAMESHIELD S.A.S.**

Respondent

Name **Hassen Kadhim**

Respondent representative

Organization **Mr Paolo Maria Gangi Lawyer (Studio Legale Gangi)**

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 owner of different registered trademarks for "BFORBANK", including European Union trademark with registration number 8335598 of December 8, 2009 for, *inter alia*, different financial services.

FACTUAL BACKGROUND

The Complainant is a French online bank which was launched in October 2009 by the Crédit Agricole Regional Banks, and it offers daily

banking, savings, investment and credit services to currently over 230,000 customers.

The Respondent registered the disputed domain name on February 12, 2024. The disputed domain name resolves to a website in English which display the services of "BiorBank" under the header "Be Your Bank, BiorBank is the first ever Web3 banking app, for everyone". According the website "BiorBank's functions" offer, *inter alia*, "interaction with Web2 banks", transfer of cryptocurrency, payment of bills, taking out loans, and tracking of NFTs. The Panel observed, when it visited the Respondent's website, that the download link for the "Web3 banking app" does not work, but rather states "coming soon".

PARTIES CONTENTIONS

A. The Complainant

The Complainant alleges that the disputed domain name is confusingly similar to the Complainant's BFORBANK trademark as the disputed domain name would be an obvious misspelling of the Complainant's BFORBANK trademark as the letter "f" is substituted by the letter "i", which the Complainant alleges to be characteristic of a typosquatting practice intended to create confusing similarity between the Complainant's trademark and the disputed domain name.

The Complainant also alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name because the Complainant is not commonly known by the disputed domain name, and was not licensed or otherwise authorized by the Complainant to use the Complainant's BFORBANK trademark for registration and use of the disputed domain name. The Complainant further alleges that the disputed domain name resolves to a website offering competing banking services under the name "BIORBANK", by which the Respondent profits of the notoriety of the Complainant's BFORBANK trademark in the disputed domain name, which does not constitute a *bona fide* offering of goods or services.

The Complainant alleges that the disputed domain name was registered in bad faith because such registration occurred several years after the registration of the Complainant's BFORBANK trademark, which trademark is distinctive and has established a strong reputation. According to the Complainant it is therefore inconceivable that the Respondent could have registered the disputed domain name without actual knowledge of the Complainant's BFORBANK trademark. Furthermore, the Complainant alleges that the disputed domain name is being used in bad faith by diverting Internet users searching for the Complainant's website to the Respondent's competing website, and thereby creating a likelihood of confusion with the Complainant's BFORBANK trademark for the Respondent's commercial gain by offering competing services. Also the Complainant put forward that the disputed domain name has been set up with MX records, which would suggest that it may be actively used for email purposes, which the Complaint alleges to be 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.

B. The Respondent

The Respondent alleges that the Complainant committed fraud in its Complaint as it submitted a copy of its website in English, while in reality the website is only available in French, thereby falsely demonstrating that the Complainant is active in the international markets while it is not. According to the Respondent the Complainant's market and operation activity is limited to France, or to the EU at its best, and for (traditional) banking products, while the Respondent alleges that it does not operate in the banking sector but in the international crypto assets economic sector. The Respondent alleges that it plans to create a startup company together with other partners, and has spent a considerable amount of time and already invested over USD 12,000 for the designing and creation of software and an app, and the first marketing material of the business. The Respondent alleges that the disputed domain name and associated website are part of a real business project which has required a considerable investment in terms both of time and money and is not a fake website created only to cybersquat the Complainant. According the Respondent this is a case of reverse domain hijacking where the Complainant is intimidating a start up without any sense or real legal ground or merit.

The Respondent denies that the disputed domain name is identical or confusing similar to the Complainant's BFORBANK trademark because it is not a misspelling of the Complainant's trademark, but rather a representation of "Be Your Bank" as indicated in the top of the Respondent's website.

The Respondent asserts to have rights and legitimate interests in respect of the disputed domain name because it has registered the disputed domain name to be used by a startup company and it made demonstrable preparation to use the disputed domain name for its crypto currency activities under the name "BIORBANK". According to the Respondent it lacks a clear economic interest to divert the Complainant's consumers to its own platform as traditional banks customers do no use or don't know how to use a crypto wallet or products and services created and tailored to customers with an higher level of technological expertise who are able to download and put in place a crypto non-custodial wallet and to engage or operate with crypto currencies, and furthermore the Respondent sells its products and services to a market of international, diverse, crypto clients and commercialize them only in the English language, while the Complainant sells its products and services only in the French language to French consumers.

The Respondent alleges that it has not registered and/or use the disputed domain name in bad faith, because it acquired the disputed domain name to offer crypto related services to an international public in English, which it alleges to be entirely different from the traditional banking services to French speaking customers as the Complainant does. Further, the Respondent alleges that it never had contact with the Complainant and was not even aware of the Complainant and its activities. Finally, the Respondent denies that the setting up of MX records is an indication of its bad faith and alleges that the disputed domain name has been set up with MX records because it was created to run a real business activity which requires the use of sending e-mails from 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 Panel does not need to address this requirement in view of its finding that the Complainant did not prove the third element of paragraph 4(a) of the Policy.

BAD FAITH

The Complainant failed to show that 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

After the Response was filed the Complainant sent the Center an unsolicited supplemental filing with a short reply to the Response. The Rules do not provide that parties can submit supplemental filings after the submission of the Complaint and Response. According to paragraph 12 of the Rules the Panel may request, in its sole discretion, further statements or documents from either of the Parties in addition to the Complaint and the Response. Although the Rules only grant the Panel the right to request supplemental filings, it does not explicitly deny the Complainant and Respondent to submit such filings. It is therefore for the Panel to decide if such submission is admissible. Because of the nature of these panel proceedings, which require a fast decision on the basis of limited possibilities to investigate all details of the dispute, the Panel considers it undesirable that submissions are easily admissible. In this respect, the Panel agrees with the reasoning of the panel in *Delikommat Betriebsverpflegung Gesellschaft m.b.H. v. Alexander Lehner* (WIPO Case No. D2001-1447), which observed that it is appropriate to consider the circumstances of each case before deciding whether to admit unsolicited additional submissions, but respectfully disagrees with the panel in the aforementioned case that it is sufficient that the supplemental filings “do not address topics which the Complainant could have addressed in its Complaint”. This should certainly be a *conditio sine qua non* for admissibility of unsolicited supplemental filings, but such filings can still not be admitted if they do not contain information which, at first impression, is crucial to the decision of the pending case. Obviously, in such a case, the other party must be given a reasonable term to submit a response to the supplemental filing. In this case, the Complainant did not assert that the Response held anything which the Complainant could not have reasonably anticipate before the Complaint was filed. The submission of the supplemental filing is therefore not admissible and shall not be taken into account.

The Panel is further 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. It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s BFORBANK trademark and the disputed domain name (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 1.7). Based on the available record, the Panel finds the first element of the Policy has been established. The Panel finds the disputed domain name only differs one letter from the Complainant’s BFORBANK trademark, which difference does not prevent a finding of confusing similarity. The Panel finds the first element of the Policy has been established.

2. Paragraph 4(a) of the Policy lists the three elements, each of which the Complainant must prove to be present in the pending matter. As the Panel finds that the Complainant failed to prove that the disputed domain name has been registered and is being used in bad faith, it did not succeed in proving the third element of paragraph 4(a) of the Policy. Consequently, the Panel does not need to discuss the second element.

3. The fact that the disputed domain name is confusingly similar to the Complainant’s BFORBANK trademark as meant in paragraph 4(a)(i) of the Policy does not per se result into a finding the registration of the disputed domain name in bad faith. The disputed domain name resolves to a website which the Respondent’s intended activities under the name “BiorBank” which would represent “Be Your Bank”. As the Complainant submitted a copy of the Respondent’s website with the Complaint, the Panel infers that the Respondent made demonstrable preparations to use the disputed domain name in connection with an offering of goods or services. According to the Complainant the Respondent’s offering of services competes with those of the Complainant, and is therefore not *bona fide*, while the Respondent asserts that the crypto related services it offers (or at least intends to offer) in English are not similar to the traditional banking services which the Complainant offers in French. The Policy is not designed to solve such dispute, and the Panel will therefore confine itself to finding that both parties provide certain financial services. However the Complainant has failed to show that it is

plausible that the Respondent, which has after all demonstrated that it has made preparations to offer its own services using the disputed domain name, was aware of the Complainant's BFORBANK trademark at the time of the registration of the disputed domain name, and that the intended use of the disputed domain name would be (wholly or partly) intended to divert the Complainant's customers to the Respondent's website for commercial gain. Furthermore, as the Panel considers the Respondent's (intended) offering of services to be *bona fide*, and concurs with the Respondent that setting up MX records is a normal activity under circumstances because the Respondent must be able to send emails from the domain name for the purpose of his own activities.

To the extent that the dispute between Complainant and Respondent revolves around whether the disputed domain name and the name of Respondent's proposed services and business, "BIORBANK," infringe the Complainant's BFORBANK trademark, and whether the Complainant could persuade another tribunal applying standards broader than those set forth in the Policy to order the transfer of the disputed domain, are questions beyond the scope of this proceeding.

Reverse Domain Name Hijacking

The Respondent has sought a finding of reverse domain name hijacking against the Complainant. Paragraph 15(e) of the Rules provides that "[i]f after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding." And paragraph 1 of the Rules defines "Reverse Domain Name Hijacking" to be "using the Policy in bad faith to attempt to deprive a registered domain name holder of a domain name". The fact that a complaint fails is not in itself a basis for a finding of reverse domain name hijacking. Indeed, UDRP panels have consistently found that the mere lack of success of a complaint is not itself sufficient for a finding of Reverse Domain Name Hijacking (WIPO Overview 3.0, section 4.16).

In the present case, the Complainant must have been aware that it filed a copy of its website in English, while its actual website is only available in French, which is an indication of the Complainant not being entirely truthful as it did not mention this and offer an explanation. While the Panel does not give much weight to this, the Complainant's arguments were further merely based on its allegation that the Respondent was a cyber squatter, without real evidence and ignoring facts which could point in a different direction, such as the contents of the website which was already available at the time of the Complaint, the parties' possibly different markets, and without contacting the Respondent first to obtain a better understanding of the facts. Although the Panel considers it possible that another tribunal in a commercial or trademark dispute could reach a different conclusion, under the circumstances of this procedure the Panel makes a finding of reverse domain name hijacking.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **biorkbank.com**: Remaining with the Respondent

PANELLISTS

Name	Alfred Meijboom
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DATE OF PANEL DECISION 2024-05-08

Publish the Decision
