Decision for dispute CAC-UDRP-106444

Case number	CAC-UDRP-106444
Time of filing	2024-04-12 13:32:45
Domain names	bforbk-contact.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	BFORBANK

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	Bitcoinwebhosting.net

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 of the following trademark registration:

- EUTM “BforBank” No. 008335598, registered on 8 December 2009, protected for goods and services in classes 9, 35, 36, 38.

The Complainant proved its ownership of the listed trademark registration by the submitted extract from the EUIPO eSearch database.

FACTUAL BACKGROUND

The Complainant also owns a number of domain names, including the same distinctive wording “BFORBANK”, such as the domain name <bforbank.com>, registered since 16 January 2009 (proved by Whois Information for <bforbank.com>).

The disputed domain name <bforbk-contact.com> (hereinafter “disputed domain name”) was registered on 8 April 2024 as it is apparent from submitted Whois Information for the disputed domain name. According to the Registrar, the Respondent is ‘Todd Reagor’. The Respondent’s provided address as being at Edmond, United States.

PARTIES CONTENTIONS

COMPLAINANT:

A. The Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademark.

The Complainant states that the disputed domain name is confusingly similar to its prior trademark "BFORBANK".

The Complainant asserts that the deletion of the letters "AN" and the addition of the generic term "CONTACT", referring to the Complainant's contact information, is not sufficient to escape the finding that the domain name is confusingly similar to the trademark "BFORBANK". It does not change the overall impression of the designation as being connected to the Complainant's "BFORBANK" trademark. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and the domain name associated.

The Complainant contends that the addition of the gTLD ".COM" does not change the overall impression of the designation as being connected to the Complainant's trademark. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and its domain name associated.

B. The Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain name. 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. Thus, the Respondent is not known as 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 contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant does not carry out any activity for, nor has any business with the Respondent.

The Complainant adds 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 disputed domain name resolves to an inactive page (submitted copy of the website under the disputed domain name). The Complainant contends that the Respondent did not use the disputed domain name, and it confirms that the Respondent has no demonstrable plan to use the disputed domain name.

C. The Complainant contends that the disputed domain name has been registered and is being used in bad faith.

The Complainant contends that the disputed domain name is confusingly similar to its distinctive trademark "BFORBANK".

The Complainant states 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. Indeed, the Complainant is well known, "BFORBANK" offers daily banking, savings, investment and credit (consumer and real estate) services for more than 230 000 customers (provided copy of the website about the Complainant).

The Complainant adds that most results of a Google search of the term "BFORBK CONTACT" refer to the Complainant, and notably to its contact information (furnished copy of the Google search results).

Thus, given the distinctiveness of the Complainant's trademarks and reputation, the Complainant 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.

According to the Complainant, the disputed domain name resolves to an inactive page (copy of the website under the disputed domain name). 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 domain name 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 rights under trademark law.

Finally, the Complainant claims that the disputed domain name has been set up with MX records (copy of the DNS Query) which suggests that it may be actively used for email purposes. 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.

RESPONDENT:

No administratively Complaint 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 UDRP).

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 UDRP).

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 UDRP).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under the UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

In the present case, the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant. Therefore, the Panel proceeds to decide only on the basis of the Complainant's factual statements and the documentary evidence provided in support of them [Paragraph 5(f) of The Rules].

1. CONFUSING SIMILARITY

The Panel finds that the disputed domain name is confusingly similar to the Complainant's "BFORBANK" trademark.

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (hereinafter "The WIPO Overview 3.0") in Paragraph 1.2.1 states: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The WIPO Overview 3.0 in Paragraph 1.7 states: "[…] in cases 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."

The WIPO Overview 3.0 in Paragraph 1.8 states: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element."

The WIPO Overview 3.0 in Paragraph 1.9 states: "A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element."

In the WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin, the panel stated that: "In numerous cases, it has been held that a domain name that wholly incorporates a Complainant´s registered mark may be sufficient to establish confusing similarity for purposes of the UDRP."

In the WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., the panel stated that: "It is also well established that the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar".

In the present case, the Complainant has established that owns EUTM registration consisting of the "BFORBANK" wording, protected for the classes in connection with financial services (evidenced by the extract from the EUIPO eSearch database).

The disputed domain name <bforbk-contact.com> contains the Complainant's trademark "BFORBK" dominant element. Only the absence of the letters "AN" differs the disputed domain name from the Complainant's trademark wording. Moreover, the disputed domain name adds the general word "CONTACT". No further adjustments were made to distinguish it from the Complainant's trademark. The addition of the gTLD <.com> does not change the overall impression of the disputed domain name either.

The absence of "AN" letters can be understood as an intentional misspelling. This argument might be supported by the fact that according to Merriam-Webster Online Dictionary, "BK" might stand as an abbreviation for "BANK". The general word "CONTACT" also suggests the connection of the disputed domain name with some institution – bank in this case – and does not change the overall impression of the disputed domain name.

Past panels have declared that when the trademark is recognizable within the disputed domain name, the misspelling and the addition of a general term cannot prevent a finding of confusing similarity.

Therefore, the disputed domain name is considered to be confusingly similar to the relevant trademark.

As a result, the Panel finds that the Complainant has satisfied Paragraph 4(a)(i) of the UDRP.

2. THE RESPONDENT´S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME

The Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to Paragraph 4(a)(ii) of the UDRP, the Complainant shall make a case that the Respondent lacks rights and legitimate interests in the disputed domain name. If the Complainant fulfills this demand the burden of proof shifts to the Respondent and so the Respondent shall demonstrate rights or legitimate interests in the disputed domain name. If the Respondent fails to prove its rights or legitimate interests, it is assumed that the Complainant satisfied the element of Paragraph 4(a)(ii) of the UDRP (see CAC Case No. 102430, Lesaffre et Compagnie v. Tims Dozman). Moreover, past panels were of the view that it is difficult or sometimes impossible to prove negative facts, i.e., absence of rights or legitimate interest on the part of the Respondent. In this respect, past panels referred to the WIPO Case No. D2000-1769, Neusiedler Aktiengesellschaft v. Vinayak Kulkarni. Within the meaning of Paragraph 4(a)(ii) of the UDRP, once the complainant has made something credible (prima facie evidence), the burden of proof shifts to the Respondent to show that he has rights or legitimate interests in the domain name at issue by providing concrete evidence.

In the CAC Case No. 102279, FileHippo s.r.o. v. whois agent, the panel stated that “[i]n the absence of a response, the Panel accepts the Complainant's allegations as true that the Respondent has no authorization to use the Complainant’s trademarks in the disputed domain name. Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under Paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of Paragraph 4(a)(ii) of the Policy.”

In the Forum Case No. FA 1781783, Skechers U.S.A. Inc. v. Chad Moston / Elite Media Group, the panel stated that: “where a response is lacking, WHOIS information can support a finding that the respondent is not commonly known by the disputed domain name”.

In the present case, the Complainant claims that the Respondent is neither affiliated with nor authorized by the Complainant in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. 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 “BFORBANK” trademark or apply for registration of the disputed domain name.

The Complainant submitted an extract from the EUIPO Database declaring its EUTM registration for the wording “BFORBANK” with priority right since 2009, predating the date of the disputed domain name registration on 8 April 2024 (proved by the extract from the EUIPO eSearch database and by the Whois Information for the disputed domain name).

The Complainant also stated that owns the <bforbank.com> domain name, registered since 16 January 2009 and consisting of the same distinctive “BFORBANK” verbal element as the Complainant’s trademark (evidenced by the Whois Information for <bforbank.com>).

By its online activities, the Complainant reaches more than 230 000 customers (proved by the copy of the website about the Complainant).

A simple Google search for “BFORBK CONTACT” mostly leads to the Complainant’s trademark, domain names associated and the Complainant’s contact information (evidenced by the copy of the Google search results).

All the mentioned supports the finding of the Complainant’s exclusive rights in the “BOFRBANK” sign and the high degree of recognition of this mark.

There is no evidence that would lead to the conclusion that the Respondent is known by the disputed domain name. The Respondent is not identified in the Whois information as it is apparent from the Whois Information for the disputed domain name.

Furthermore, the disputed domain name resolves to an inactive website (proved by the copy of the website under the disputed domain name). It means that the Respondent is not using the disputed domain name but is passively holding it. Furthermore, it is clear that the Respondent does not have any demonstrable business plan to use the disputed domain name.

Moreover, the disputed domain name has MX servers configured in the background (proved by the copy of the DNS Query) and thus, it may be used for e-mail purposes. This Panel assumes that such use of the disputed domain name cannot be understood as a legitimate non-commercial fair use of the disputed domain name.

The Respondent did not reply to the Complaint and so failed to demonstrate his rights or legitimate interests in the disputed domain name.

Therefore, the Panel finds that the Complainant has satisfied requirement under Paragraph 4(a)(ii) of the UDRP.

3. THE REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME IN BAD FAITH

The Panel finds that the Respondent registered and used the disputed domain name in bad faith.

The WIPO Overview 3.0 in Paragraph 3.1.1 states: “If on the other hand circumstances indicate that the respondent’s intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant’s trademark, panels will find bad faith on the part of the respondent. While panel assessment remains fact-specific, generally speaking such circumstances, alone or together, include: (i) the respondent’s likely knowledge of the complainant’s rights, (ii) the distinctiveness of the complainant’s mark, […], (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name, […].”

The WIPO Overview 3.0 in Paragraph 3.1.4 states: “Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or 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.”

The WIPO Overview 3.0 in Paragraph 3.3 states: “From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding.”

In the WIPO Case No. D2006-1440, National Football League v. Thomas Trainer, the panel stated: “when a registrant, such as the Respondent here, obtains a domain name that is confusingly similar to a famous mark, with no apparent rights or legitimate interests in the name, and then fails to respond to infringement claims and a UDRP Complaint, an inference of bad faith is warranted.”

In the WIPO Case No. D2015-1167, Valero Energy Corporation and Valero Marketing and Supply Company v. Sharad Bhat, the panel stated that: “In accordance with previous UDRP decisions, inactive or passive holding of a domain name, under the circumstances does not prevent a finding of bad faith use.”

In the Forum Case No. FA 1773444, Ashley Furniture Industries, Inc. v. Joannet Macket / JM Consultants, the panel stated that: “The Panel finds that Respondent’s lack of content at the disputed domain shows the lack of a bona fide offering of goods or services or a legitimate noncommercial or fair use per Policy ¶¶ 4(c)(i) and (iii).”

In the present case, the Complainant has established that owns EUTM registration comprising of the “BFORBK” sign, protected for the classes in connection with financial services, with the priority right since 2009. The disputed domain name consists of the Complainant’s trademark in its “BFORBK” dominant element. The addition of the “CONTACT” verbal element does not change the overall impression same as the intentional misspelling in the absence of “AN” letters. Therefore, the disputed domain name is confusingly similar to a highly distinctive earlier trademark of the Complainant.

A simple Google search for “BFORBK CONTACT” leads Internet users mostly to the Complainant’s name, its domain names associated and its contact information, as it is clear from the presented copy of the Google search results.

The Complainant's online business activities reach hundreds of thousands of customers (proved by the copy of the website about the Complainant).

This Panel states that the Respondent must have been aware of the Complainant’s trademark and its reputation before the registration of the disputed domain name on 8 April 2024.

The Respondent is not identified in the Whois information and so cannot be recognized under the disputed domain name (evidenced by Whois Information for the disputed domain name). Moreover, the Respondent did not reply to the Complaint and so failed to demonstrate his rights or legitimate interests in the disputed domain name.

This Panel is of the view that the Respondent is passively holding the disputed domain name. This conclusion is supported by the submitted copy of the website under the disputed domain name from which it becomes clear that there is no content on the website. Non-use of the disputed domain name cannot prevent a finding of bad faith.

Finally, the disputed domain name has MX servers configured in the background (proved by the copy of the DNS Query), thus the disputed domain name can be used for e-mail purposes. It is inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an e-mail address (CAC Case No. 102827, JCDECAUX SA v. Handi Hariyono).

Following the above-mentioned, the Panel finds that the Complainant has satisfied conditions pursuant to Paragraph 4(a)(iii) of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **bforbk-contact.com**: Transferred

PANELLISTS

Name	Radim Charvát

DATE OF PANEL DECISION 2024-05-14

Publish the Decision