Decision for dispute CAC-UDRP-106691

Case number	CAC-UDRP-106691
Time of filing	2024-07-12 13:49:35
Domain names	contact-bforbk.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	BFORBANK

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	Murielle Tidonni

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

In this proceeding the Complainant relies on the following trademark registration:

- European Union trademark registration No. 008335598 “BforBank” (word), registration date is December 8, 2009.

The Complainant also refers to its portfolio of domain names that include the “bforbank” element including <bforbank.com>, registered since January 16, 2009.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant states that it is an online bank launched in October 2009 by “Crédit Agricole Regional Banks”.

The Complainant offers daily banking, savings, investment and credit (consumer and real estate) services and claims to employ 400

employees and serve 230 000 clients.

The disputed domain name was registered on March 28, 2024 and is inactive. MX servers are configured.

The Complainant asserts that the deletion of the letters “AN” and the addition of the generic term “CONTACT” in the disputed domain name is not sufficient to escape the finding that the domain name is confusingly similar to its “BFORBANK” trademark. It does not change the overall impression of the designation as being connected to the Complainant’s trademark.

The Complainant also contends that the addition of the suffix “.COM” does not change the overall impression of the designation.

The Complainant refers to previous UDRP decisions that recognized the similarity of a domain name sharing the same structure as the disputed domain name, with the Complainant’s trademark, in particular **CAC Case No. 106444** (<bforbk-contact.com>).

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.

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.

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 name.

The disputed domain name resolves to an inactive page and the Complainant contends that the Respondent did not use the disputed domain name. This confirms that the Respondent has no demonstrable plan to use the disputed domain name.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND BEING USED IN BAD FAITH

The Complainant claims the disputed domain name is confusingly similar to its distinctive “BFORBANK” trademark.

The Respondent registered the disputed domain name several years after the registration of the trademark by the Complainant, which has established a strong reputation while using this trademark.

The Complainant provides “Google” search results as a separate annex and such search results are related to the Complainant and its clients’ interface. 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 Complainant's rights.

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.

The Complainant relies on the “passive holding” doctrine and previous UDRP decisions where panels held that the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use.

The fact that “MX” servers are configured, in the Complainant’s view, indicates that the disputed domain name may be actively used for e-mail purposes, and this is an additional indication of bad faith.

Therefore, the Complainant states the disputed domain name was registered and being used in bad faith.

PARTIES CONTENTIONS

The Complainant's contentions are summarized in the Factual Background section above.

No administratively compliant 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 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.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or confusingly similar

The Complainant provides evidence of the EU trademark registration for the word mark “BforBank”.

As confirmed by the “WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition” (“WIPO Overview 3.0”): “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” (see sec. 1.2.1).

Therefore, the Complainant proved it has trademark rights.

The test for confusing similarity under the UDRP is relatively straightforward and 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 (see sec. 1.7).

The disputed domain name includes the “bforbk” element of the Complainant’s mark “BforBank” and the “contact” element that can be seen as descriptive in relation to the Complainant’s banking services.

While this case may not be too obvious, the Panel nevertheless finds that the Complainant’s mark is recognizable within the disputed domain name since the element “bforbk” can be seen as either a short form of the Complainant’s mark (where “bk” stands for “bank”) or a typo-squatted version of the Complainant’s mark with the omission of the letters “a” and “n” plus a descriptive element ("contact").

As noted in WIPO Overview 3.0: “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” (see sec. 1.8).

This Panel also agrees with the reasoning of the previous UDRP Panels in **CAC Case No. 106444** (<bforbk-contact.com>): “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”... 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” and in **CAC Case No. 106653** (<bforbk.com>): “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", the relevant trademark is recognizable within the disputed domain name”.

The gTLD “.com” is to be disregarded under the confusing similarity test as it does nothing to eliminate confusion.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and

(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see **"Julian Barnes v. Old Barn Studios", WIPO Case No. D2001-0121** and sec. 2.1 of WIPO Overview 3.0.

The disputed domain name was registered on March 28, 2024. It does not resolve to any active website.

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows the Panel to draw such inferences as it considers appropriate, see paragraph 14(b) of the Rules and **CAC Case No. 101284**: "A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable inferences may be drawn from the information provided by the complainant".

The Complainant has made a prima facie case of Respondent's lack of rights or legitimate interests.

The Respondent is not known by the disputed domain name and is identified as an individual from France with no apparent connection to the Complainant's business, the disputed domain name or any name corresponding to the disputed domain name.

The Complainant has not granted any license or authorization to use its trademark registered many years prior to the registration of the disputed domain name to the Respondent and the Complainant is not doing any business with the Respondent.

Passive holding in the circumstances of the present dispute does not create any rights or legitimate interest of the Respondent.

Therefore, the Panel finds that the Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith. These circumstances are non-exhaustive and other factors can also be considered in deciding about the bad faith element.

It is well established that bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark (see sec. 3.1 of WIPO Overview 3.0). Targeting with an intent to take an unfair advantage of the complainant's mark is important in establishing bad faith under the UDRP.

The Panel finds that the disputed domain name was registered and is being used in bad faith based on the following:

1. The nature of the disputed domain name – confusingly similar to Complainant's trademark plus a term descriptive of Complainant's services and the timing of the registration of the disputed domain name – March 28, 2024, many years after the Complainant obtained protection for its trademark in the EU and started its business under the "BforBank" mark.

2. Passive holding of the disputed domain name in the circumstances of this case indicates both registration and use in bad faith. The WIPO Overview 3.0 states that "from the inception of the UDRP, panelists have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding" and the panelists "will look at the totality of the circumstances in each case" (sec. 3.3). The Panel notes that passive holding per se does not establish bad faith. The Complainant provided only limited evidence that its trademark is well-known, namely a screenshot of its own website with some information and numbers. This evidence alone is insufficient to prove that a mark is highly distinctive. The Complainant also provides "Google" search results for the terms corresponding to the disputed domain name that are primarily related to the Complainant and its trademark. The Panel exercising its powers under par. 10 of the UDRP Rules and in accordance with sec. 4.8 of WIPO Overview 3.0 conducted its own "Google" search for the terms corresponding to the disputed domain name and the search results were indeed related mainly to the Complainant. The Panel also conducted "Google" search for the term corresponding to the Complainant's mark to verify the alleged distinctive character and reputation of the Complainant's trademark and such search results confirm the Complainant's assertations. The Panel also takes note of the early UDRP decisions in respect of the same Complainant and the same trademark, including the following: **CAC Case No. 106444**, **CAC Case No. 106429**, **CAC Case No. 106430** and **CAC Case No. 105883**. The fact that MX servers are configured and that the disputed domain name may be used for email purposes, in the circumstances of this dispute, is an additional indication of bad faith (see e.g. **CAC Case No.106429**). This Panel notes that the Complainant provides banking and financial services and banking and financial companies, and their clients are particularly vulnerable to possible phishing and other fraudulent activities. Based on the above, the Panel finds that, despite some shortcomings in the Complainant's evidence, the passive holding doctrine applies to this dispute, as articulated in **"Telstra Corporation Limited v. Nuclear Marshmallows", WIPO Case No. D2000-0003, <telstra.org>** and sec. 3.3 of WIPO Overview 3.0 as the Complainant's mark is distinctive, the Respondent failed to respond and provide any evidence of actual or contemplated good-faith use of the disputed domain name and taking into account all of the above, any good faith use of the disputed domain name by the Respondent is implausible. The Panel notes that the Respondent is identified as an individual from France and the Complainant is a French company and is a popular provider of financial services in France. This is an additional indication of targeting with an intent to take an unfair advantage.

3. Based on the above, the Panel finds that Respondent's behavior falls within, at least, par. 4 b (iv) of UDRP and the Respondent by using the disputed domain name has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement and that the Respondent targeted the Complainant with an attempt to take unfair advantage of the Complainant's mark.

The Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Igor Motsnyi**

DATE OF PANEL DECISION 2024-08-07

Publish the Decision