

## **ADMINISTRATIVE PANEL DECISION**

Banque Palatine v. Domain ID Shield Service, Domain ID Shield Service CO., Limited / Domain eRegistration  
Case No. D2022-3142

### **1. The Parties**

The Complainant is Banque Palatine, France, represented by DBK Law Firm, France.

The Respondent is Domain ID Shield Service, Domain ID Shield Service CO., Limited / Domain eRegistration, United Kingdom.

### **2. The Domain Name and Registrar**

The disputed domain name <banqepalatinefr.com> is registered with OnlineNic, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 25, 2022. On August 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 26, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on August 26, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on August 29, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 18, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 19, 2022.

The Center appointed Mihaela Maravela as the sole panelist in this matter on October 3, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

#### **4. Factual Background**

According to information in the Complaint, the Complainant is a French bank founded in 1780 and specialized in small and medium-sized companies and in asset management. The Complainant is a wholly owned subsidiary of Groupe BPCE, one of the largest banking groups in France and which is present in more than 40 countries via its various subsidiaries.

The Complainant owns numerous trademarks, including:

- the International semi-figurative trademark BANQUE PALATINE L'ART D'ÊTRE BANQUIER (logo) registered under number 1066933 on January 12, 2011, for services in class 35 and 36;
- the French trademark BANQUE PALATINE registered under number 3644179 on April 15, 2009, for services in class 35, 36, and 38;
- the European Union Trade Mark PALATINE registered under number 004353223 on July 31, 2006, for goods and services in class 9, 16, 35, 36, 38, 41, and 42.

The Complainant is also the owner of the domain name <palatine.fr> registered in 2004 which it uses as the official website.

The disputed domain name was registered on August 4, 2022 and does not resolve to an active website.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant argues that the disputed domain name incorporates its trademark PALATINE, to which the descriptive misspelled word "banqe" and "fr" which stands for a geographical indication have been added. The use of the word "banqe" will be understood as the misspelling of the French word "banque" which directly refers to the Complainant's banking activities. The addition of other terms to a trademark in a domain name does not prevent a finding of confusing similarity, especially when the relevant trademark is recognizable within the disputed domain name.

As regards the second element, the Complainant contends that it has not granted any license, nor any authorization for the Respondent to use its trademarks and that the Complainant has never authorized the Respondent to register and/or use any domain name incorporating its PALATINE trademarks. The Respondent has not made a legitimate noncommercial or a fair use of the disputed domain name, which leads to an inactive website with an error message "404 Not Found".

With respect to the third element, the Complainant argues that it is well-known in France and through the world, notably by the financial and banking market consumers, and that the Complainant's trademarks registrations pre-date the registration of the disputed domain name. Consequently, the choice of the disputed domain name by the Respondent does not seem to be a mere coincidence, but on the contrary seems to have been done on purpose to generate a likelihood of confusion with the trademarks of the Complainant. As regards the use, the Complainant argues that the MX server was activated for the disputed domain name which poses the risk for phishing attack. Moreover, the non-use of the disputed domain name

would not prevent a finding of bad faith under the doctrine of passive holding. In addition, the Complainant argues that the Respondent has registered other domain names consisting of or including trademarks in the banking sector, and that it was also a respondent in a UDRP case involving the domain name <banquepalatinefr.com>, where the panel ordered the transfer of the said domain name to the Complainant.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

### **6.1 Preliminary Matters**

No communication has been received from the Respondent in this case. However, given that notice of the Complaint was sent to the relevant addresses disclosed by the Registrar, the Panel considers that this satisfies the requirement in paragraph 2(a) of the Rules to "employ reasonably available means calculated to achieve actual notice". Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules and to draw inferences from the Respondent's failure to file any Response.

The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", and the Panel can draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

### **6.2 Substantive Matters**

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following elements:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name was registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

The Complainant has provided evidence of its rights in the PALATINE and PALATINE BANQUE trademarks. The trademark PALATINE is reproduced in its entirety in the disputed domain name. The addition of "banque", which is a misspelling of the French word "banque", does not prevent a finding of confusing similarity with the Complainant's trademark PALATINE, which is easily recognizable in the disputed domain name. Also, the addition of the letters "fr" does not prevent a finding of confusing similarity with the Complainant's trademark PALATINE. The fact that a domain name wholly incorporates a complainant's trademark is sufficient to establish identity or confusing similarity for the purpose of the Policy, despite the addition of other words to such trademarks. The addition of another term (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity. See section 1.8 of the [WIPO Overview 3.0](#).

The disputed domain name is also a misspelled version of the Complainant's PALATINE BANQUE trademark, to which "fr" has been added. It is accepted by UDRP panels that a domain name which consists of a common, obvious or intentional misspelling of the trademark does not prevent a finding of confusing similarity for purposes of the first element of the Policy. See section 1.9 of the [WIPO Overview 3.0](#).

It is well accepted by UDRP panels that a generic Top-level-Domain (“gTLD”), such as “.com”, is typically ignored when assessing whether a domain name is identical or confusingly similar to a trademark. See section 1.11 of the [WIPO Overview 3.0](#).

This Panel concludes that the disputed domain name is confusingly similar to the Complainant’s trademarks and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

### **B. Rights or Legitimate Interests**

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* case demonstrating that the Respondent has no rights or legitimate interests in the disputed domain name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

In the present case, the Complainant has established a *prima facie* case that it holds rights over the trademarks PALATINE and BANQUE PALATINE and claims that the Respondent has no rights, legitimate interest or any legitimate reason to acquire and use the disputed domain name.

There is no evidence that the Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services, nor does the Respondent appear to engage in any legitimate noncommercial or fair use of the disputed domain name. Also, there is no evidence that the Respondent is commonly known by the disputed domain name. The Respondent has not replied to the Complainant’s contentions, claiming any rights or legitimate interests in the disputed domain name.

With the evidence on file, the Panel finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

### **C. Registered and Used in Bad Faith**

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, “in particular but without limitation”, be evidence of the disputed domain name’s registration and use in bad faith.

According to the unrebutted assertions of the Complainant, its PALATINE and BANQUE PALATINE trademarks were widely used in commerce well before the registration of the disputed domain name and are reputed. The disputed domain name includes the Complainant’s trademark PALATINE, in addition to the relevant gTLD and the misspelled version of the French word “banque” which directly refers to the Complainant’s banking activities and a geographical term. Under these circumstances, it is most likely that the Respondent was aware of the Complainant’s trademark at the registration date of the disputed domain name. The Respondent provided no explanations for why it registered the disputed domain name.

As regards to the use, the disputed domain name is passively held.

Section 3.3 of the [WIPO Overview 3.0](#) describes the circumstances under which the passive holding of a domain will be considered to be a bad faith registration: “While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.”

The Panel finds that passive holding of the disputed domain name does not in the circumstances of this case prevent a finding of bad faith. There is no evidence in the record of a legitimate use of the disputed domain name. The trademark of the Complainant is distinctive and widely used in commerce. UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

Moreover, the Respondent has not formally participated in these proceedings and has failed to rebut the Complainant's contentions and to provide any evidence of actual or contemplated good faith use and indeed none would seem plausible. An additional element is the DNS setup of the disputed domain name (with active MX records). Also, there appears to be a pattern of abusive registrations by the Respondent, as the un rebutted statements in the Complaint (verified by the Panel), show that the Respondent was involved in other UDRP proceedings where similar factual situations caused the concerned UDRP panels to decide in favor of the complainants (see e.g., *Accenture Global Services Limited v. Domain eRegistration*, WIPO Case No. [D2018-1994](#); *Banque Palatine v. Domain ID Shield Service CO., Limited / Domain eRegistration, Domain eRegistration*, WIPO Case No. [D2022-1321](#)). This fact also supports a finding grounded on paragraph 4(b)(ii) of the Policy, referring to a respondent registering "the 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 you have engaged in a pattern of such conduct".

In the Panel's view, the circumstances of the case represent evidence of registration and use in bad faith of the disputed domain name. The Respondent failed to bring evidence as to the contrary. Consequently, the Panel concludes that the condition of paragraph 4(a)(iii) of the Policy is fulfilled.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <banqepalatinefr.com> be transferred to the Complainant.

*/Mihaela Maravela/*

**Mihaela Maravela**

Sole Panelist

Date: October 17, 2022