

ADMINISTRATIVE PANEL DECISION

Investec Bank Limited v. Douglas Newman
Case No. D2023-5206

1. The Parties

The Complainant is Investec Bank Limited, United Kingdom ("UK"), represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Douglas Newman, South Africa.

2. The Domain Name and Registrar

The disputed domain name <investec.website> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 14, 2023. On December 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 15, 2023, 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 (Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 18, 2023, 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 December 19, 2023.

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 January 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 28, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 29, 2024.

The Center appointed Angelica Lodigiani as the sole panelist in this matter on February 14, 2024. 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.

4. Factual Background

The Complainant is an Anglo South-African international banking and wealth management group founded in 1974 and headquartered in London, UK. The Complainant operates in three different areas of business: asset management, wealth and investment, and specialist banking. The Complainant is listed in the London and Johannesburg stock exchanges. The Complainant employs 8,500 people internationally and operates in forty cities on five continents, with over GBP 61 billion funds under management globally. The Complainant was listed in the 2023 Forbes Global 2000 list and has been recognized as one of the Corporate Knight's top 100 most sustainable corporations. The Complainant has also won important awards and was recognized as an "Out of Ordinary" partner to businesses across the UK.

The Complainant is the owner of large portfolio of INVESTEC marks, registered in various jurisdictions, among which the following:

- INVESTEC, UK registration No. UK00001583072, registered on March 8, 1996, for services in class 36;
- INVESTEC, OAPI (African Intellectual Property Organization) registration No. OA/3/2018/000681, registered on May 31, 2018, for services in class 35, 36.

The Complainant is also the owner of the domain name <investec.com>, registered since 1995 and resolving to the Complainant's official website. In the month of September 2023, the Complainant's website has received an average of more than 815,400 visitors. The Complainant's website is the 402nd most popular website in South Africa and the 54,079th globally, and the second in its field.

The Respondent is located in South Africa and registered the disputed domain name on August 5, 2023. The disputed domain name resolves to a parked page displaying the message "Website Coming Soon". The Respondent has activated Mail exchanges ("MX records") for the disputed domain name and has registered the disputed domain name using a privacy protection shield.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is identical to its earlier INVESTEC mark as it reproduces it identically, while the applicable Top-Level Domain ("TLD") should not be taken into account when evaluating the first requirement under the Policy.

The Complainant further maintains that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent did not authorize the Complainant to make use of its trademark in any manner whatsoever, including within the disputed domain name. Moreover, the Respondent is not affiliated to, or sponsored by the Complainant. The Respondent is not commonly known by the disputed domain name and is not a licensee of the Complainant. The disputed domain name is identical to the Complainant's INVESTEC mark. As such, the disputed domain name carries a high risk of implied affiliation with the Complainant, which cannot amount to fair use. The Respondent is using the disputed domain name to redirect Internet users to a parked page that reads "Website Coming Soon". This use of the disputed domain

name does not amount to a bona fide offering of goods or services under the Policy, nor to a legitimate noncommercial or faire use.

Finally, the Complainant contends that its INVESTEC trademark enjoys extensive reputation. The Complainant had already been using its trademark for several decades when the Respondent registered the disputed domain name. The disputed domain name is identical to the Complainant's mark. A mere Internet search against the keyword "investec" returns multiple links referencing to the Complainant and to its business. The composition of the disputed domain name makes it illogical to believe that the Respondent registered the disputed domain name without targeting the Complainant. All considered, it is not possible to conceive a plausible situation in which the Respondent would have been unaware of the Complainant's mark at the time of the registration of the disputed domain name.

Although the disputed domain name currently resolves to a "coming soon" page, the Complainant notes that the Respondent has set up MX records for the disputed domain name. Thus, the Respondent could send emails under the disputed domain name facilitating fraudulent activities such as phishing, impersonating, or passing off.

As the disputed domain name comprises the entirety of the Complainant's trademark with no alteration, addition, or adornment, it causes confusion among Internet users as to the source of the disputed domain name. Accordingly, any use of the disputed domain name could only be in bad faith.

The Complainant also points out that when registering the disputed domain name, the Complainant employed a privacy service to hide its identity, which is further evidence of bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

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 trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. In particular, the Complainant has shown that it owns registered rights over the trademark INVESTEC, which predate the date of registration of the disputed domain name.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the

respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

In the case at issue, the Respondent does not appear to have any relation with the Complainant or to be commonly known by the disputed domain name. The Complainant did not authorize the Respondent to make use of its INVESTEC service mark in any manner whatsoever, including as part of the disputed domain name. The disputed domain name resolves to a parked page displaying the message "Website Coming Soon". The Respondent is therefore not using the disputed domain name in connection with a bona fide offering of goods or services. The Respondent is also not making a fair use of the disputed domain name. The disputed domain name is identical to the Complainant's mark followed by the generic Top-Level Domain ("gTLD") ".website", which adds confusion to the Internet users looking for the Complainant, inducing them to believe that the disputed domain name resolves to the Complainant's main website. Moreover, the Respondent has set up MX records for the disputed domain name, thus permitting the Respondent to send emails under the Complainant's mark.

In light of the above, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has registered a domain name, which is identical to the Complainant's INVESTEC mark. Considering the longstanding and widespread use of this mark, the fact that the Complainant is listed in the London and Johannesburg stock exchanges and has won important awards during the years, the Panel is inclined to believe that the INVESTEC trademark is renown. Moreover, the Complainant operates in South Africa where the Respondent is located and where the Complainant's website is in the high rank of popularity. For all these reasons, the Panel finds that it is very likely that at the time of the registration of the disputed domain name, the Respondent was aware of the Complainant's mark. Given the reputation of the INVESTEC mark and the Respondent's lack of rights or legitimate interests in the disputed domain name, the Panel is of the opinion that the Respondent registered the disputed domain name to profit from, or to exploit the Complainant's mark. Therefore, the Respondent registered the disputed domain name in bad faith.

The disputed domain name leads to a parked page displaying the message "Website Coming Soon".

Panels 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. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although 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, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement).

[WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the reputation of the Complainant's trademark, the composition of the disputed domain name, the fact that the Respondent concealed its identity behind a privacy service shield, and failed to file a Response in this proceeding. Therefore, the Panel finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Moreover, the Respondent has activated MX records for the disputed domain name, which enables him to impersonate the Complainant when sending emails to third parties. This further circumstance is also evidence of bad faith.

In light of the foregoing, the Panel finds that the Complainant has established the third element of the Policy.

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 <investec.website> be transferred to the Complainant.

/Angelica Lodigiani/

Angelica Lodigiani

Sole Panelist

Date: February 28, 2024