

## **ADMINISTRATIVE PANEL DECISION**

**ABN AMRO Bank N.V. v. Privacy Service Provided by Withheld for Privacy ehf / Lorenzo Mobali**  
Case No. D2022-0562

### **1. The Parties**

The Complainant is ABN AMRO Bank N.V., Netherlands, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Lorenzo Mobali, France.

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

The disputed domain name <neufelize-asset.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 17, 2022. On February 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 18, 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 February 21, 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 February 22, 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 February 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 16, 2022. The Respondent did not submit any Response. Accordingly, the Center notified the Respondent’s default on March 17, 2022.

The Center appointed Anna Carabelli as the sole panelist in this matter on March 22, 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.

#### 4. Factual Background

The Complainant is an international provider of banking and insurance services to personal, business, and institutional customers. It was formed in 1991, following the merger of Algemene Bank Nederland and Amsterdam-Rotterdam Bank. It employs approximately 18,830 people across five continents; in 2018, its net profit was EUR 2,325 million. The Complainant has won several awards and recognitions including the Global Finance Award for “Best Bank in the Netherlands”, the Finance for Future Award for “Communicating Integrated Thinking” and the “Western Europe’s Best Bank for Sustainable Finance” in 2019, and “The Netherlands’ Best Investment Bank” in 2016, in 2017 and in 2019 (Annex 6.4 to the Complaint).

Neuflize OBC is a subsidiary of the Complainant (Annex 6.6) specialized in private banking in France, and is the owner of various trademark registrations for NEUFLIZE including the following:

| TRADEMARK                              | JURISDICTION/<br>TM OFFICE | REGISTRATION<br>NUMBER | REGISTRATION<br>DATE  | IC CLASS |
|--|----------------------------|------------------------|-----------------------|----------|
| NEUFLIZE                               | European Union /<br>EUIPO  | 003128675              | September 23,<br>2004 | 35, 36   |
| NEUFLIZE                               | United Kingdom /<br>UKIPO  | UK00903128675          | September 23,<br>2004 | 35, 36   |
| NEUFLIZE                               | France / INPI              | 3220177                | April 10, 2003        | 35, 36   |
| NEUFLIZE<br>Private Assets<br>ABN-AMRO | France / INPI              | 3220176                | April 10, 2003        | 35, 36   |
| NEUFLIZE<br>Private Assets<br>ABN-AMRO | WIPO                       | 812325                 | September 19,<br>2003 | 35, 36   |

In 2021, Neuflize OBC was awarded the “Best ESG Private Banking Strategy France Award” by Capital Finance International and the gold trophy in the “2021 Positive Finance Price” category by Heritage and Performance (Annex 6.7 to the Complaint). In 2020, Neuflize OBC reported EUR 523 million in total income as part of ABN AMRO Group (Annex 6.8 to the Complaint).

The Complainant owns the domain name <neuflizeobc.fr> (Annex 4 to the Complaint) which was registered in 2006 and is being used for promoting the services of the Complainant and its subsidiary Neuflize OBC.

The disputed domain name <neuflize-asset.com> was registered on August 14, 2021 through a privacy Whois service. According to the uncontested evidence submitted by the Complainant (Annexes 3.1 and 5), the disputed domain name was redirecting to the Complainant’s official website at “www.neuflizeobc.fr”; currently it does not resolve to an active website.

The cease and desist letters sent by the Complainant in November 2021 had no effect and remained unanswered.

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant asserts and contends that:

- Through its subsidiary Neuflyze OBC, the Complainant is the owner of several trademark registrations consisting of or including NEUFLIZE.
- The disputed domain name is confusingly similar with the mark NEUFLIZE in which the Complainant has rights, since (i) it incorporates the Complainant's trademark simply adding a hyphen and the generic term "asset" and (ii) it represents the Complainant's activities as a private asset manager who is also known under the name and the registered trademark "NEUFLIZE Private Assets ABN-AMRO".
- The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not authorized or somehow given consent to the Respondent to register and use the disputed domain name and the Respondent is not commonly known by the disputed domain name. The disputed domain name carries a risk of implied affiliation with the Complainant, which cannot be considered a fair use of the disputed domain name.
- The disputed domain name was registered in bad faith. By the time the Respondent registered the disputed domain name, the Complainant already had a reputation in its trademark which is fully adopted in the disputed domain name. The Respondent has demonstrated a knowledge and familiarity with the Complainant's brand and business.
- The disputed domain name is also used in bad faith. In this connection, the Complainant highlights that the disputed domain name was redirecting to the Complainant's official website at "www.neuflyzeobc.fr", which indicates that the use of the disputed domain name has been designed to deceive Internet users. The disputed domain name currently resolves to an inactive site. As held by previous UDRP panels, the lack of use of a domain name that coincides with a well-known trademark owned by someone else constitutes use in bad faith. The fact that the Respondent had employed a privacy service to hide its identity upon the registration of the disputed domain name and then has ignored the Complainant's cease & desist letters is further evidence of bad faith registration and use.

### **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules instructs the Panel to decide the Complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the Complainant must prove each of the following:

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

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii) of the Policy, shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the Respondent, shall be evidence of the Respondent's rights to or legitimate interests in the disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy above.

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

The Panel shares the consensus view that a complainant is considered to have protectable rights in a trademark, although it is not the holder of any registrations for the trademark, if the complainant has established that it is a related company such as a subsidiary or parent to the registered holder of the trademark. See section 1.4 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

In the present case, the registered holder of the trademark NEUFLIZE is Neuflyze OBC, a subsidiary of the Complainant, as per the affiliate information in Annex 6.6 to the Complaint. Accordingly, the Panel finds that the Complainant has established its rights in the mark NEUFLIZE by virtue of the evidence of the trademark registrations owned by its subsidiary company, referred to in section 4 above and the related trademark certificates submitted as Annex 1 to the Complaint.

The disputed domain name entirely incorporates the Complainant's mark NEUFLIZE and this is a sufficient element to establish confusing similarity, as held by previous UDRP panels (e.g., *Banca Mediolanum S.p.A. v. Domains By Proxy, LLC / Marzia Chiarello*, WIPO Case No. [D2020-1955](#); *Virgin Enterprises Limited v. Domains By Proxy LLC, Domainsbyproxy.com / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2020-1923](#); *Patagonia, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1409](#)).

As recorded in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms does not prevent a finding of confusing similarity under the first element.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark, as it entirely incorporates the Complainant's mark NEUFLIZE. The addition of the word "asset" and a hyphen does not prevent a finding of confusing similarity when comparing the disputed domain name and the Complainant's trademark.

The addition of the Top-Level Domain ".com" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. (See section 1.11 of the [WIPO Overview 3.0](#)).

In the light of all the above, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks and the Complainant has established element 4(a)(i) of the Policy.

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

The Complainant states that it has not authorized, licensed or permitted the Respondent to use the Complainant's trademarks and that the Respondent is not commonly known by the disputed domain name. The Complainant has provided evidence that the disputed domain name was redirecting to the Complainant's official website at "www.neuflyzeobc.fr" and presently does not resolve to an active site. These are neither a *bona fide* use nor legitimate noncommercial or fair use of the disputed domain name.

The word "asset" is closely linked and associated with the Complainant's activities and may be perceived by Internet users as suggesting that the disputed domain name resolves to content relating to the Complainant. Thus, the nature of the disputed domain name is such to carry a risk of implied affiliation, which in the circumstances cannot confer rights or legitimate interests on the Respondent (See section 2.5.1 of the [WIPO](#)

[Overview 3.0](#)).

The Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. As stressed by many previous UDRP decisions, in such a case the burden of production shifts to the Respondent to rebut the evidence (see section 2.1 of the [WIPO Overview 3.0](#)).

By not submitting a Response, the Respondent has failed to invoke any circumstance, which could have demonstrated any rights or legitimate interests in the disputed domain name under paragraph 4(c) of the Policy.

Therefore, the Panel finds that the Complainant has established paragraph 4(a)(ii) of the Policy.

### **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. Paragraph 4(b) of the Policy sets out, without limitation, circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The disputed domain name incorporates the NEUFLIZE mark and was registered long after this mark became known through its consistent and intensive use since 2006. The fact that the disputed domain name had been used by the Respondent to redirect Internet users to the Complainant's official website indicates that the Respondent targeted the Complainant when it registered the disputed domain name. Such fact suggests that the disputed domain name was registered in bad faith (see section 3.2.2 of the [WIPO Overview 3.0](#)) with a deliberate intent to create an impression of an association with the Complainant and its NEUFLIZE mark.

The Respondent's attempt to pass off the disputed domain name as being affiliated with the Complainant also supports the finding of use in bad faith.

The currently inactive status of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding. As stressed by many previous UDRP decisions, "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." (see section 3.3 of the [WIPO Overview 3.0](#); *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

Each of these considerations points to the Respondent's passive holding of the disputed domain name being in bad faith. Specifically; (i) the Complainant's NEUFLIZE mark is distinctive and well-established, (ii) the Respondent has failed to submit a response to the Complaint or provide any evidence of good-faith use, (iii) the Respondent has taken steps to conceal its identity through use of a privacy service, and (iv) there is no conceivable good faith use to which the disputed domain name could be put by the Respondent.

Therefore, the Complainant has established paragraph 4(a)(iii) 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 <neufize-asset.com> be transferred to the Complainant.

*/Anna Carabelli/*

**Anna Carabelli**

Sole Panelist

Date: April 5, 2022