

## **ADMINISTRATIVE PANEL DECISION**

Royal Bank of Canada - Banque Royale du Canada v. Domain Admin,  
Privacy Protect, LLC (PrivacyProtect.org) / Adam Markson, Round Balance  
Company  
Case No. D2022-0587

### **1. The Parties**

The Complainant is Royal Bank of Canada - Banque Royale du Canada, Canada, represented by Gowling WLG (Canada) LLP, Canada.

The Respondent is Domain Admin, Privacy Protect, LLC (PrivacyProtect.org), United States of America ("USA") / Adam Markson, Round Balance Company, Spain.

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

The disputed domain name <rbc-gam-funds.com> 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 February 18, 2022. On February 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 23, 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 23, 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 amendment to the Complaint on February 23, 2022.

The Center verified that the Complaint together with the amendment to the 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 Daniel Peña as the sole panelist in this matter on March 25, 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 the owner of registrations on the trademark registries of the Canadian Intellectual Property Office ("CIPO"), the European Union Intellectual Property Office ("EUIPO") and the United Kingdom Intellectual Property Office ("UKIPO"), among other trademark offices, for the trademark RBC, and for various RBC-formative trademarks, including ROYAL BANK, RBC LION & GLOBE Design, RBC GLOBAL ASSET MANAGEMENT, RBC ASSET MANAGEMENT, RBC FINANCIAL GROUP. At the CIPO, these include for the word mark RBC, registration number TMA673134, registration dated September 22, 2006, in international classes ("ICs") 35 and 36, covering financial services of various types; registration number TMA424800, registration dated March 4, 1994, in IC 36, covering insurance services; and registration number TMA369496, registration dated June 15, 1990, in ICs 36 and 42, covering various financial and real estate investment services. At the EUIPO, for the word mark RBC, these include registration number 2026375, registration dated January 21, 2004, in ICs 9, 35, 36, 38 and 42, covering business consultancy, various financial services, Internet management and database services. At the UKIPO, for the word mark RBC, these include registration number 2276921, registration dated August 30, 2002, in ICs 9, 35, 36, 38 and 42, covering various financial consultancy and management services.

The Complainant is one of the largest private banking institutions in Canada, with over 86,000 full and part-time employees, and serving 17 million clients in Canada and the USA and in 34 other countries worldwide. The Complainant operates its primary commercial website at "www.rbc.com". The Complainant uses RBC Global Asset Management Inc. as its trade name, and also operates its RBC Global Asset Management website at "www.rbcgam.com".

The disputed domain name <rbc-gam-funds.com> was registered on January 19, 2022, and does not resolve to any active website.

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

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

The Complainant argued that the disputed domain name is confusingly similar to the Complainant's trademark as the disputed domain name incorporates the entirety of the trademark, the terms "gam" and "funds", and hyphens.

The Complainant stated that the terms "gam" and "funds" do not militate against a finding of confusion similarity between the disputed domain name and the Complainant's trademark. Furthermore, the Complainant added that the generic Top-Level Domain ("gTLD") ".com" is not sufficient to prevent the confusing similarity.

The Complainant also indicated that considering the brand awareness of the trademark RBC worldwide, an Internet user would most probably assume a connection with the Complainant and its business when seeking information on a website or receiving an email communication associated with the disputed domain name.

Furthermore, the Complainant indicated that the Respondent has no rights to or legitimate interests in respect of the disputed domain name based on the Complainant's prior use of its trademark RBC, and that the Respondent is not affiliated or related to the Complainant in any way, or licensed or otherwise authorized to use the RBC mark in connection with a website or for any other purpose. Also, the Complainant indicated that the Respondent is not using the disputed domain name in connection with any legitimate noncommercial or fair use without intent for commercial gain, is not commonly known by the disputed domain name, and has not acquired any trademark or service mark rights in that name or mark.

The Complainant indicated that the Respondent could not have chosen or subsequently used the word "rbc" in the disputed domain name for any reasons other than to take unfair advantage of the reputation of the Complainant's famous trademark.

The Complainant alleged that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services. On the contrary, the Respondent has used the disputed domain name in an unlawful attempt to impersonate the Complainant, by way of an email scam. More specifically, a fraudulent email communication was sent from the email address "[...][@rbc-gam-funds.com](mailto:[...]@rbc-gam-funds.com)".

The Complainant argues that the disputed domain name was registered and is being used in bad faith since the same was used for the purpose of an unlawful and fraudulent email scam.

## **B. Respondent**

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

## **6. Discussion and Findings**

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied:

- (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.

Considering these requirements, the Panel rules as follows:

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

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant has provided evidence of its rights in the trademarks RBC on the basis of its multiple trademark registrations in Canada, the European Union, and the United Kingdom. A trademark registration provides a clear indication that the rights in the trademark belong to the Complainant (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.2.1).

It has also been established by prior UDRP panels that incorporating a trademark in its entirety into a domain name can be sufficient to establish that the domain name is confusingly similar to a trademark. Such findings were confirmed, for example, within section 1.7 of the [WIPO Overview 3.0](#).

The Respondent's incorporation of the Complainant's RBC trademark in full in the disputed domain name is evidence that the disputed domain name is confusingly similar to the Complainant's mark. Mere addition of the terms "gam" (which may be the acronym of "Global Asset Management") and "funds" as well as hyphens in the disputed domain name does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's RBC mark because the Complainant's RBC mark remains clearly recognizable in the disputed domain name. As noted in [WIPO Overview 3.0](#), section 1.8: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element." Furthermore, the addition of the gTLD ".com" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademark in which the Complainant has rights, meaning that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

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

In accordance with paragraph 4(a)(ii) of the Policy, the Complainant must prove that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel observes that there is no relationship, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Panel also finds that there is no indication that the Respondent is commonly known by the disputed domain name because the Respondent's name is "Adam Markson, Round Balance Company" which has no apparent connection with the RBC trademark, and the disputed domain name does not resolve to any active website.

The Respondent used the disputed domain name in an unlawful attempt to fraudulently impersonate the Complainant by way of an email scam. Specifically, the Respondent used the disputed domain name to execute a well-deliberated fraud that included the sending of an email to a third party. The fraudulent email did not come from the Complainant or any of its employees, and has used the extension based on the disputed domain name. In this regard, the Panel finds that use of the disputed domain name for an email scam cannot under any circumstances constitute a *bona fide* or legitimate use of the disputed domain name. Section 2.13.1 of the [WIPO Overview 3.0](#) provides that use of a domain name for illegal activity (including fraud) can never confer rights or legitimate interests on a respondent.

The Panel concludes that the Respondent deliberately chose to include the Complainant's RBC trademark in the disputed domain name, in order to achieve commercial gain by misleading third parties, and that such use cannot be considered as a legitimate noncommercial or fair use. The Panel further finds that the disputed domain name carries a risk of implied affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Complainant has satisfied the requirement under paragraph 4(a)(ii) of the Policy.

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

Paragraph 4(b) of the Policy stipulates that any of the following circumstances, *inter alia*, shall be considered as evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) circumstances indicating that the respondent registered 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 the respondent has engaged in a pattern of such conduct; or

(iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on its website or location.

With regard to the bad faith at the time of registration, the Panel notes that it is not likely that the Respondent was not aware of the Complainant and its RBC trademark. On the contrary, the Panel finds that it is likely that the Respondent was aware of the Complainant and its rights and reputation in the RBC mark at the time the disputed domain name was registered. UDRP panels have consistently found that the mere registration of a domain name that is confusingly similar (particularly domain names 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. See section 3.1.4 of the [WIPO Overview 3.0](#).

The Panel further notes that the Complainant operates its RBC Global Asset Management website at the domain name <rbcgam.com>. It should also be bear in mind that the fraudulent manner in which the disputed domain name was used indicates that the Respondent registered the disputed domain name with the intention to impersonate the Complainant, which makes it impossible that the Respondent was not aware of the Complainant's rights at the time of registration of the disputed domain name.

The disputed domain name does not resolve to any active website. However, based on the evidence provided by the Complainant, the disputed domain name was still actively used for email services, *i.e.*, for sending emails which impersonate the Complainant. Moreover, the Respondent's fraudulent emails included the RBC trademark, the RBC logo and some of the details of the Complainant. Such use of the disputed domain name can only be observed as clear evidence of the Respondent's bad faith (see, in particular, sections 3.1.4 and 3.4 of the [WIPO Overview 3.0](#)).

Considering all of the above circumstances, the Panel concludes that the Respondent has used the disputed domain name in an unlawful attempt to impersonate the Complainant, by way of an email scam. This clearly constitutes evidence of bad faith registration and use.

The Panel concludes that the disputed domain name was registered and is being used in bad faith and that consequently, the Complainant has satisfied the requirement under 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 <rbc-gam-funds.com> be transferred to the Complainant.

*/Daniel Peña/*

**Daniel Peña**

Sole Panelist

Date: April 8, 2022