

ADMINISTRATIVE PANEL DECISION

Banca Akros S.P.A v. Privacy Service Provided by Withheld for Privacy ehf /
Bancaakros Bancaakros
Case No. D2022-0898

1. The Parties

The Complainant is Banca Akros S.P.A, Italy, represented by Bugnion S.p.A., Italy.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Bancaakros Bancaakros, Benin.

2. The Domain Name and Registrar

The disputed domain name <mybancaakros.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 March 17, 2022. On March 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 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 March 24, 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 March 28, 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 April 4, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 24, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 10, 2022.

The Center appointed Manuel Moreno-Torres as the sole panelist in this matter on May 16, 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, an Italian company established in 1997, operates as an investment and private banking firm. Since 2017, it became part of Banco BPM Group. Through the years, the Complainant has received awards and has sponsored events in its field. The Complainant enjoys a high reputation and renown in the financial sector.

The Complainant is the owner of the Italian BANCA AKROS trademark with registration number 36202000016633 filed on August 6, 1999, and the European Union trademark AKROS before the European Union Intellectual Property Office with registration number 001317817, filed on September 22, 1999.

The Complainant owns a portfolio of domain names comprising its trademark, for example <bancaakros.it> registered on January 24, 1997, or <bancaakros.org> registered on March 15, 2021.

The Complainant has provided evidence in connection to BANCA AKROS trademark to be considered well known for the purposes of the UDRP.

The disputed domain name <mybancaakros.com> was registered on June 21, 2021, and directs to a financial website.

5. Parties' Contentions

A. Complainant

The Complainant alleges that the disputed domain name is identical to the Complainant's BANCA AKROS trademark. The addition of the adjective "my" is not relevant to avoid confusion. Indeed, the Complainant insists that the confusing similarity arises from the distinctiveness from "akros" term rather than "banca" term which is descriptive. Under these circumstances, the Complainant highlights the risk of relation between the Parties by the public.

Further, the Complainant considers that following the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11.1, the applicable generic Top-Level Domain ("gTLD") <.com> must be disregarded under confusing similarity test.

With regard to the second element, the Complainant asserts that has never give authorization to registered the disputed domain name to any company located in Benin. Likewise, neither the Respondent or any of its allegedly connected companies (e.g., Diamond Group Social) have ever been representatives or licensees of the Complainant.

The Complainant also show the result of a trademark search through TMview where it seems to be no trademarks corresponding to the wording "my banca akros".

Finally, the Complainant believes that AKROS being highly known in the financial sector, the disputed domain name identical to the Complainant's trademark and, the term "akros" inherently distinctive, the Respondent cannot credibly claim to have been unaware of its trademark. Under such contentions, the Complainant asserts that the Respondent knew or should have known that his registration would be identical to the Complainant's trademarks.

Besides, the Complainant is of the opinion that the use of the disputed domain name in a website focused on banking services may confused members of the public, including the Complainant's customers. The disputed domain name and the website contents are likely to lead internet users to think that the Respondent is associated with the Complainant. Such a practice is disruptive and therefore the used of the disputed domain name is in bad faith.

The Complainant also reports several websites where the design appearance displayed is identical to the disputed domain name except for the name and logos. While the Complainant recognizes a lack of evidence to show whether the Respondent is undertaking such practice, however, highlights the common elements of these sites to be considered the use in bad faith. As such, every sites display the same information at the "mentiones legales" namely, legal terms, with regard the General Director, the capital stock of the company, and the Publication Director.

The Respondent is disrupting the Complainant's business since it is appropriating another's sign for its own business

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel that:

- (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 was registered and is being used in bad faith.

There are no exceptional circumstances within paragraph 5(f) of the Rules to prevent the Panel from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to file a Response. Under paragraph 14(a) of the Rules in the event of such a "default" the Panel is still required "to proceed with a decision on the complaint", whilst under paragraph 14(b) it "shall draw such inferences there from as it considers appropriate". This dispute resolution procedure is accepted by the domain name registrant as a condition of registration.

A. Identical or Confusingly Similar

The Complainant has established trademarks rights for the purposes of the UDRP. Noting that due to the global nature of the Internet and Domain Name System, the jurisdiction where the trademark is valid is not considered relevant to the Panel assessment under the first element. Thus, the test focuses on the comparison between the trademark and the disputed domain name. Since the reproduction of the BANCA AKROS is evident, the test of the first requirement is met. The Panel also notes that the addition of a term, such as "my", to the disputed domain name does not prevent a confusing similarity finding under the first element. See [WIPO Overview 3.0](#), section 1.8.

Likewise, the gTLDs are generally irrelevant to the consideration of identity or confusing similarity between a trademark and a domain name

Therefore, the first requirement is met under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant is committed to prove that the Respondent has no rights or legitimate interests in the disputed domain name. Paragraph 4(c) of the Policy determines several circumstances for the Respondent that may demonstrate rights or legitimate interests in the disputed domain name:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

A panel’s assessment will normally be made on the basis of the evidence presented in the complaint and any filed response. While the overall *onus* proving is on the complainant, in the present case the Respondent did not answer the Complaint although he has been duly notified to do so. Previous panel decisions have reached the conclusion that “proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of ‘proving a negative’, requiring information that is often primarily within the knowledge or control of the respondent”. See [WIPO Overview 3.0](#), section 2.1. Accordingly, it is well established that 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.

Therefore, the Panel has to determine whether the Complainant has raised a *prima facie* case against the Respondent and if so, to shift the evidential burden of production to the Respondent to stand against such finding.

The Complainant asserts that it has never provided authorization to register the disputed domain name to any company in Benin. A trademark search shows no results in favor to the Respondent. Neither does a trademark search in relation to “my banca akros” yield any results. Moreover, the Complainant states not to have licensed to “aakrosbank”, the Respondent, or to “Diamond group social”, mentioned in the terms of the site to which the disputed domain name directs.

Moreover, the disputed domain name is used to host a financial services website in direct competition the services offered by the Complainant and does so under the Complainant’s trademark that is incorporated not only in the construction of the disputed domain name but also replicated in the website content itself too. Further, the website provides no clear information as to its owner or relation (and lack thereof) to the Complainant, which cannot constitute fair use. Moreover, noting the parallel content found on other financial services websites of questionable ownership, the Panel finds it suspicious whether any services are truly offered and whether any such websites are genuine, including that found at the disputed domain name. Accordingly, the Panel considers the Respondent’s silence indicative of its lack of rights or legitimate interests.

Under these circumstances, the Panel finds that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interest in the disputed domain name. Accordingly, the burden of production evidence shifts to the Respondent. Unfortunately, the Respondent did not file an answer to the Complaint to rebut the *prima facie* case.

Therefore, the Panel is convinced that the second element under paragraph 4(a) of the Policy has been met by the Complainant.

C. Registered and Used in Bad Faith

Under the UDRP, the complainant is required to prove that the respondent registered and used the disputed domain name in bad faith.

While BANCA AKROS trademark is well known and the disputed domain name incorporates it in its entirety, the Respondent is using the disputed domain name to direct to a website in connection to the same services provided by the Complainant, e.g. banking. Besides, the Panel notes that the Respondent is an unaffiliated entity to the Complainant. All these circumstances leads the Panel to conclude that the Respondent was aware of the Complainant and its trademarks when registering the disputed domain name.

To support such finding, the Panel also notes that the Complainant has come with a number of banking and financial websites links purportedly related or in connection with the Respondent or its affiliates. Such wide knowledge of the banking system, added with the global reach of the Internet, and the current use of the disputed domain name, tantamount to actual knowledge of the BANCA AKROS trademark at the moment of the registration of the disputed domain name.

As stated in the [WIPO Overview 3.0](#), section 3.1: “[B]ad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark”. In the present case, the disputed domain name reproduces the Complainant’s trademark and the website to which directs focus on the same activity and business as the Complainant. However, the site lacks trustworthy information about the owner. Accordingly, the Respondent appears to have registered the disputed domain name primarily to attract for commercial gain Internet users to its website by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website. This is evidence of registration and use in bad faith in accordance with paragraph 4(b)(iv) of the Policy.

To sum up, the Panel has looked at the file and have found no indication of the Respondent’s good faith and the Respondent has failed to participate by any means. By contrast, the Panel finds that the Respondent has tried to take advantage of the BANCA AKROS trademark.

Therefore, the Panel finds that the third requirement of the Policy is met.

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, <mybancaakros.com>, be transferred to the Complainant.

/Manuel Moreno-Torres/

Manuel Moreno-Torres

Sole Panelist

Date: May 30, 2022