

ADMINISTRATIVE PANEL DECISION

Banque et Caisse d'Épargne de l'État, Luxembourg v. Privacy Department,
IceNetworks Ltd.

Case No. D2022-1754

1. The Parties

The Complainant is Banque et Caisse d'Épargne de l'État, Luxembourg, represented by Office Freylinger S.A., Luxembourg.

The Respondent is Privacy Department, IceNetworks Ltd., Iceland.

2. The Domain Name and Registrar

The disputed domain name <bcee-snet.com> is registered with Internet Domain Service BS Corp (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 13, 2022. On May 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 17, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 May 18, 2022. In accordance with the Rules, paragraph 5,

the due date for Response was June 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 9, 2022.

The Center appointed Jon Lang as the sole panelist in this matter on June 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

Created in 1856, the Complainant is a Luxembourg company incorporated on June 7, 1989. It is internationally active in banking services. "BCEE" is an acronym of the Complainant's name ("Banque et Caisse d'Epargne de l'Etat) which is well known to the public and widely used, including by the media.

The Complainant owns several trademark registrations for BCEE in the European Union, Switzerland and the United Kingdom, including European Union trademark (for BCEE), No. 009110537, filed on May 17, 2010 and registered on November 2, 2010; UK trademark (for BCEE), No. UK00909110537, filed on May 17, 2010 and registered on November 2, 2010, and Swiss trademark (for BCEE), No. 615156, registered on May 10, 2011,

The Complainant also owns several trademark registrations for "S-NET" (a mark used in connection with the Complainant's digital banking services) in Benelux, European Union and United Kingdom, including Benelux trademark (for S-NET) No. 936196, filed on April 12, 1999 and registered on August 1, 1999; European Union trademark (for S-NET) No. 009110644, filed on May 17, 2010 and registered on July 1, 2012 and UK trademark (for S-NET) No. UK00003345153, filed on May 17, 2010 and registered on July 1, 2012.

The Complainant is well known in the banking sector, widely exploiting the BCEE and SNET trademarks for banking, insurance and financial services. These trademarks have no meaning in any language and are generally known by the public in Luxembourg to refer to the Complainant and (so far as S-NET is concerned) its digital banking services, in particular its mobile banking application found on Apple Store and Google Play.

Since 2016, the Complainant has also owned the domain name <snet.lu>, and uses it with the sub-domain "bcee" so as to form the URL: "bcee.snet.lu" (through which the Complainant's mobile banking services are also accessible).

The disputed domain name <bcee-snet.com> (the Domain Name) was registered on February 2, 2022, and resolves to an inactive website.

5. Parties' Contentions

A. Complainant

The following is a brief summary of the contentions of the Complainant.

The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The Domain Name reproduces precisely and entirely the Complainant's trademarks BCEE and S-NET, which cannot be a coincidence. As a consequence, there will be a clear risk of confusion in the minds of the

public who will think that they are dealing with a domain name owned, and possibly a website run by the Complainant.

The generic Top-Level Domain (“gTLD”) “.com” is not to be taken into consideration when examining identity or similarity between a complainant’s trademark and disputed domain name, being irrelevant and insufficient to avoid a finding of confusing similarity.

The Domain Name is identical to the said trademarks in which the Complainant has rights.

The Respondent has no rights or legitimate interests in respect of the Domain Name

The Respondent is not affiliated with the Complainant in any way, nor authorized by the Complainant to use and register its trademarks, or to seek registration of any domain name incorporating such trademarks.

The Respondent has no prior rights or legitimate interest in the Domain Name.

Past panels have found that in the absence of any license or permission from a complainant to use its trademarks, no actual or contemplated *bona fide* or legitimate use (of a domain name) can reasonably be claimed.

The Domain name in dispute is identical, or at least almost identical to the Complainant’s trademarks such that the Respondent cannot reasonably pretend it was intending to develop legitimate activity through the Domain Name.

Trademark searches clearly show that the Respondent has no rights to the signs BCEE or SNET.

The Respondent has no rights or legitimate interests in respect of the Domain Name.

The Domain Name was registered and is being used in bad faith

Registration in bad faith – given the circumstances earlier described, it is implausible that the Respondent was unaware of the Complainant’s trademark rights when the Respondent registered the Domain Name. The Complainant, owned by the State of Luxembourg, has a 160-year history, and has acquired throughout the years a reputation in the international financial markets. It is well-known by the public worldwide, being ranked among the 10 safest banks in the world in 2019. That the Respondent registered a domain name identical or nearly identical to the Complainant’s distinctive BCEE and S-NET marks cannot be coincidence. Bad faith can be found where a respondent “knew or should have known” of the complainant’s trademark rights but nevertheless registered the domain name in which it had no rights or legitimate interest.

The fact that the Domain Name presents almost the same structure as the URL used by the Complainant for access to its banking application, *i.e.* “bcee.snet.lu/” also suggests bad faith registration. The Respondent has tried to create a similarity with the URL used by the Complainant.

The Respondent has registered the Domain Name in bad faith.

Use in bad faith - Paragraph 4(b)(iv) of the Policy provides, *inter alia*, that if “...by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location” such circumstances shall be evidence of the registration and use of a domain name in bad faith.

The fact that the Respondent is using the BCEE and SNET signs in the Domain Name leads to the belief that he will use it for phishing purposes. It was stated in a past WIPO UDRP case that “the potential for ‘phishing’ and obtaining information by deception, is not just evidence of bad faith, but possibly suggestive of criminal activity” (see, WIPO Case No. [D2019-0093](#), *Virgin Enterprises Limited v. Eric Johnson, Eric Johnson Group*).

The similarity between the Complainant’s URL (“bcee.snet.lu”) and Domain Name (<bcee-snet.com>) clearly indicates an attempt to deceive the Complainant’s customers about the origin of a corresponding website and/or emails.

It is more than likely that the Respondent’s primary motive in registering and using the Domain Name was to capitalize on it by phishing. The potential for phishing activities confirms that the Domain Name was registered and is being used in bad faith.

Furthermore, it is likely that the Respondent registered the Domain Name to prevent the Complainant from itself using its trademarks in a domain name, or to try to sell it.

The Domain Name is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy requires a complainant to prove that a respondent has registered a domain name which is: (i) identical or confusingly similar to a trademark or service mark in which a complainant has rights; and (ii) that the respondent has no rights or legitimate interests in respect of the domain name; and (iii) that the domain name has been registered and is being used in bad faith. A complainant must prove each of these three elements to succeed.

A. Identical or Confusingly Similar

The Complainant is the registered owner of the BCEE and S-NET trademarks and clearly has rights for the purposes of the Policy.

Ignoring the gTLD “.com” (as the Panel may do for comparison purposes), the Domain Name incorporates both the BCEE and S-NET trademarks save for the hyphen in the S-NET mark, which is removed and brought forward to separate the two marks, thus forming “bcee-snet”. Given that the Domain Name is not identical to either mark, the issue of confusing similarity must be considered. Application of the confusing similarity test under the UDRP typically involves “*a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name*” (section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the “[WIPO Overview 3.0](#)”). Section 1.7 of the [WIPO Overview 3.0](#) goes on to provide “[...] *in cases where a domain name incorporates the entirety of a trademark, [...] the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing*”.

Both the BCEE and S-NET trademarks are incorporated in their entirety within the Domain Name albeit the S-NET mark appears without its hyphen. Despite this, each are clearly recognizable within the Domain Name. Neither the combination of marks, particularly given that they are separated by a hyphen and thus

kept distinct, nor the removal of the hyphen from S-NET, prevents a finding of confusing similarity.

The Panel finds that the Domain Name is confusingly similar to the BCEE and S-NET trademarks for the purposes of the Policy and thus paragraph 4(a)(i) of the Policy has been established.

B. Rights or Legitimate Interests

By its allegations, the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name.

Accordingly, the burden of production shifts to the Respondent to come forward with arguments or evidence demonstrating that it does in fact have such rights or legitimate interests. The Respondent has not done so and accordingly, the Panel is entitled to find, given the *prima facie* case made out by the Complainant, that the Respondent indeed lacks rights or legitimate interests in the Domain Name. Despite the lack of any answer to the Complainant's contentions however, the Panel is entitled to consider whether there would be anything inappropriate in such a finding.

A respondent can show it has rights to or legitimate interests in a domain name in various ways even where, as is the case here, it is not licensed by or affiliated with a complainant. For instance, it can show that it has been commonly known by the domain name or that it is 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. Here, however, there is no evidence to suggest that the Respondent is commonly known by the Domain Name. Nor can it be said that there is legitimate noncommercial or fair use. There appears to be no active use at all.

A respondent can also show that it is using a domain name in connection with a *bona fide* offering of goods or services. As no use is being made of the Domain Name at present, there can be no *bona fide* offering either. The inevitability of a false impression being created if the Domain Name were to be used in the future would make any finding in favour of the Respondent on this basis, even if it were sought, extremely improbable.

There is no evidence before this Panel that the Respondent has rights or legitimate interests in the Domain Name. The Respondent has not come forward with a Response and it can only be assumed that there is nothing it could say that might support such an assertion.

The contentions of the Complainant, by which it has made out a *prima facie* case that the Respondent has no rights or legitimate interests, have not been contradicted or cast into doubt by the brief analysis set out above. Accordingly, the Panel finds that the Complainant has fulfilled the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides a number of non-exclusive scenarios which may evidence a respondent's bad faith. They include, for instance, a respondent registering a domain name in order to prevent an owner of the trademark or service mark to which it is said to be confusingly similar or identical, from reflecting the mark in question in a corresponding domain name (provided that the respondent has engaged in a pattern of such conduct). A respondent registering a domain name primarily for the purposes of disrupting the business of a competitor is another scenario, as is a respondent intentionally attempting to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or of products or services on it.

Sometimes, particularly in cases where it appears no use is being made of a domain name, it is not possible for a complainant to demonstrate a precise literal application of one of the paragraph 4(b) scenarios. However, the paragraph 4(b) scenarios are non-exclusive and simply illustrative, and thus other circumstances demonstrating that a respondent seeks to take unfair advantage of, or to abuse a complainant's trademark (such behaviour being broadly understood to constitute bad faith for the purposes of the Policy) are usually enough to establish this third limb of paragraph 4(a) of the Policy (even if not falling within one of the paragraph 4(b) scenarios).

The Respondent must have known of the Complainant. To combine its two trademarks, each an invented sign (in the case of BCEE, an initialism), is beyond coincidence. It must have known that the Complainant would have rights in these well-known trademarks.

It is difficult to see how the Respondent would not appreciate that any use by it of the Domain Name would be anything other than inherently deceptive and would likely mislead Internet users into believing that the Domain Name or any website or email address associated with it, was that of (or associated with) the Complainant. The combination of marks and/or the shifting hyphen would hardly ameliorate the risk of Internet users being deceived, as the Respondent must well have known. Indeed, the configuration might well enhance the risk of deception.

The Domain Name has the hallmarks of bad faith registration and use. It is inherently deceptive and ripe to be used in a phishing scam or other illegitimate activity.

The fact that no active use is being made of the Domain Name at present (and hence currently can be treated only as being passively held), does not prevent a finding of bad faith registration and use. Indeed, a passive holding of a domain name can support a finding of bad faith. UDRP panels must examine all the circumstances of the case.

Section 3.3 of the [WIPO Overview 3.0](#), provides:

“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 Domain Name is confusingly similar to the well-known and distinctive BCEE and S-NET trademarks. No Response was filed or evidence of actual or contemplated good faith use provided. Indeed, any good faith use of the confusingly similar, indeed inherently deceptive Domain Name would seem highly implausible. The Respondent uses a privacy service, not in itself necessarily indicative of bad faith but here nonetheless supportive of such a finding.

The Panel finds that there are circumstances suggesting that the Respondent has sought to take unfair advantage of the Complainant's trademark and/or abuse its trademark and thus, for the purposes of the Policy, there is evidence of both registration and use of the Domain Name in bad faith. The passive holding of the Domain Name in the circumstances of this Complaint supports a finding of bad faith.

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 Domain Name <bcee-snet.com> be transferred to the Complainant.

/Jon Lang/

Jon Lang

Sole Panelist

Date: June 24, 2022