

ADMINISTRATIVE PANEL DECISION

**NATIXIS v. WhoisSecure / Whois Privacy Protection Foundation, Hosting
Concepts BV d/b/a Registrar.eu
Case No. D2022-2775**

1. The Parties

The Complainant is NATIXIS, France, represented by Inlex IP Expertise, France.

The Respondent is WhoisSecure, United States of America / Whois Privacy Protection Foundation, Hosting Concepts BV d/b/a Registrar.eu, Netherlands.

2. The Domain Name and Registrar

The disputed domain name <natixisipo.com> is registered with OwnRegistrar, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 28, 2022. On July 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 28, 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 August 5, 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 August 9, 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 August 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 1, 2022.

The Center appointed Torsten Bettinger as the sole panelist in this matter on September 9, 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 a financial services and investment management company based in Paris, France. The Complainant is part of the French BPCE Group, which is the country's second-largest banking group. The Complainant has registered and used marks corresponding to the Natixis name since 2006. According to the Complaint, the Complainant employs over 16,000 people in 36 countries.

The Complainant owns French, European Union, and International trademarks for NATIXIS.

The Complainant provided evidence of the registration of the following trademark registrations:

| Trademark | Jurisdiction | Registration Number | Registration Date |
|------------------|----------------|---------------------|-------------------|
| NATIXIS | European Union | 5129176 | June 21, 2007 |
| NATIXIS (device) | International | 1071008 | April 21, 2010 |

The Complainant also owns and uses numerous domain names incorporating the NATIXIS mark. These include <natixis.com>, registered on February 3, 2005, and <natixis.fr>, registered on October 20, 2006. The disputed domain name was registered on June 1, 2022, and does not resolve to an active website.

5. Parties' Contentions

The Complainant states that it widely uses the NATIXIS trademark in connection with banking and financial services and that the NATIXIS trademark enjoys wide reputation not only in France but also around the world. The Complainant provided evidence of numerous awards the Complainant received for its services.

With regard to the requirement of identity or confusing similarity between the trademark and the disputed domain name pursuant to paragraph 4(a)(i) of the Policy, the Complainant asserts that the disputed domain name is confusingly similar to its registered trademark NATIXIS as the disputed domain name contains the Complainant's complete NATIXIS trademark and that the addition of generic term "ipo", the abbreviation of the terms "initial public offering", does not negate the confusing similarity between the disputed domain name and the Complainant's trademark under the Policy.

With regard to the Respondent having no rights or legitimate interests in the disputed domain name, the Complainant submitted that:

- there is no business or legal relationship between the Complainant and the Respondent, and that the Complainant has neither authorized nor licensed the Respondent to use its trademarks in any way;
- previous UDRP decisions inferred from this lack of license or authorization that the Respondent had no rights or legitimate interests in respect of the disputed domain name;
- the disputed domain name points to an error page, and that it is difficult to imagine a good faith use of the disputed domain name given the reputation of the Complainant's trademark interest.

Finally, with regard to the disputed domain name having been registered and being used in bad faith, the Complainant argues that:

- the disputed domain name has been registered with the aim of taking advantage of the well-known trademark NATIXIS of the Complainant, and that the Respondent was intentionally attempting to take

advantage of the Complainant's trademark in order to generate profits with email services attached to the disputed domain name;

- when registering the contested domain name, the Respondent employed a privacy service in order to hide its identity and to avoid being notified of a UDRP proceeding;
- the fact that the Respondent has made no active use of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding;
- since the MX records for the disputed domain name <natixisipo.com> have been activated, there is a high risk that the disputed domain name will be used for phishing activities, as the Complainant offers financial services.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy states that the Complainant must prove each of the three following elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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.

A. Identical or Confusingly Similar

The Complainant has demonstrated that it owns multiple trademark registrations for the mark NATIXIS prior to the registration of the disputed domain name on June 1, 2022.

It is well-established that the test of identity or confusing similarity under the Policy is confined to a comparison of the disputed domain name and the trademark alone, independent of the products for which the trademark is used or other marketing and use factors usually considered in trademark infringement cases (see sections 1.1.2 and 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

In this case, the disputed domain name contains the disputed domain name in its entirety and only differs from the Complainant's trademark NATIXIS by the addition of the acronym "ipo", which is the abbreviation of the terms "initial public offering" and refers to a public offering in which shares of a company are sold to institutional individual investors.

The Panel notes that it has long been established under the UDRP case law that the addition of a term or letters to a trademark in a domain name does not prevent a finding of confusing similarity under the first element of the UDRP (see section 1.8 of [WIPO Overview 3.0](#)). The Panel therefore agrees with the Complainant's assertion that the addition of the term "ipo" does not prevent a finding of confusing similarity of the disputed domain name from the Complainant's trademark.

Furthermore, it is well accepted under the UDRP case law that the specific generic Top-Level Domain ("gTLD") designation such as ".com", ".net", ".org" is not to be taken into account when assessing the issue of identity and confusing similarity, except in certain cases where the applicable Top-Level suffix may itself form part of the relevant trademark (see [WIPO Overview 3.0](#) section 1.11).

For the foregoing reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's NATIXIS trademarks in which the Complainant has exclusive rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy a respondent may establish its rights or legitimate interests in the domain name, among other circumstances, by showing any of the following elements:

- “(i) before any notice to you [the Respondent] 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 [the Respondent] (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 [the Respondent] 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.”

The Complainant provided evidence of its extensive use of its NATIXIS trademark and stated that the Respondent is not a licensee, authorized agent of the Complainant, or in any other way authorized by the Complainant to register the disputed domain name.

These assertions and evidence are sufficient to establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

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 disputed domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent chose not to contest the Complainant’s allegations and has failed to come forward with any evidence to refute the Complainant’s *prima facie* showing that the Respondent lacks rights or legitimate interests. The Panel therefore accepts these allegations as undisputed facts.

From the record in this case, the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use.

On this basis and in light of the fact that the disputed domain name, except for the addition of the descriptive designation “ipo”, contains the Complainant’s trademark in its entirety and thus carries a risk of implied affiliation contrary to the fact, the Panel concludes that the Respondent lacks rights and legitimate interests in the disputed domain name and that, accordingly, the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if any one is found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the Respondent has registered the disputed 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) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, the Respondent has intentionally attempted 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 the Respondent's website or location.

The Complainant holds multiple trademark registrations for the NATIXIS trademark in various countries that predate the registration of the disputed domain name. The NATIXIS mark is distinctive and is clearly associated with the Complainant and its financial services through widespread and intensive use.

It is therefore more likely than not from the record of the evidence in this proceeding that the Respondent did not coincidentally register the disputed domain name, but registered the disputed domain name with knowledge of the Complainant's rights in the NATIXIS mark in bad faith. Indeed, prior UDRP panels have found that the mere registration of a domain name that is identical or 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 fact that the disputed domain name has not yet been actively used to show any substantive content does not prevent a finding of bad faith use.

UDRP Panels have consistently found that, in certain circumstances, passive holding does not prevent a finding of bad faith under the Policy. (See, e.g., *Teachers Insurance and Annuity Association of America v. Wreaks Communications Group*, WIPO Case No. [D2006-0483](#); *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); see also [WIPO Overview 3.0](#), section 3.3.)

While UDRP panels 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 *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); see also [WIPO Overview 3.0](#), section 3.3.)

The circumstances of the present case are sufficiently similar to those present in *Telstra* to establish bad faith passive holding of the disputed domain name.

Based on the record in this proceeding, the Panel is satisfied that the Complainant's NATIXIS mark is distinctive and widely known.

Given that the disputed domain name consists of the Complainant's NATIXIS mark in combination with the descriptive term "ipo", the disputed domain name is also not susceptible to be used in a good faith manner.

Furthermore, the Respondent has not replied to the Complaint nor provided any evidence of actual or contemplated good faith use of the disputed domain name. On the contrary, since the MX records attached to the disputed domain name have been activated, the Panel agrees that there is a high risk that the

disputed domain name is likely to be used for phishing activities, especially considering the Complainant's financial business.

The Panel therefore finds that the circumstances, as described above, show that the Respondent's registration and passive holding of the disputed domain name equals a bad faith registration and use of the disputed domain name, and therefore the Complainant also 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, <natixisipo.com>, be transferred to the Complainant.

/Torsten Bettinger/

Torsten Bettinger

Sole Panelist

Date: September 23, 2022.