

ADMINISTRATIVE PANEL DECISION

Bluestep Holding AB v. Jack Smith

Case No. D2022-4793

1. The Parties

The Complainant is Bluestep Holding AB, Sweden, represented by AWA Sweden AB, Sweden.

The Respondent is Jack Smith, United States of America.

2. The Domain Name and Registrar

The disputed domain name <bluestepbanking.com> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 14, 2022. On December 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 14, 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 (PrivacyGuardian.org) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 15, 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 December 19, 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 January 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 26, 2023.

The Center appointed Nayiri Boghossian as the sole panelist in this matter on January 30, 2023. 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 part of the Blue Step group, which is a specialized mortgage bank. The Complainant owns many trademark registrations for BLUESTEP such as:

1. Swedish trademark registration No. 381575 registered on June 16, 2006; and
2. European Union trademark registration No. 009018896 registered on September 2, 2010.

The disputed domain name was registered on June 27, 2022, and resolves to a website which advertises banking services.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to a trademark or service mark in which the Complainant has rights. The only difference between the disputed domain name and the Complainant's trademark is the word "banking". Furthermore, the beginning of the disputed domain name and the dominant part is the Complainant's trademark. The term "banking" is descriptive of the use made of the Complainant's trademark.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has not acquired any rights in the disputed domain name. The Respondent is attempting to create a false connection with the Complainant, which cannot constitute faire use. The disputed domain name is not being used in connection with a legitimate business as there are no information on the party offering the advertised banking services. The disputed domain name is not a secured site and as such it cannot be offering legitimate banking services. The Respondent is not making a noncommercial or fair use of the disputed domain name as banking services are being advertised. The Respondent is not affiliated with the Complainant nor authorized to use its trademark. The webpage does not state that there is no relationship between the Complainant and the Respondent.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. The disputed domain name was registered 16 years after the Complainant first registered its trademark in Sweden. The Complainant's trademark is highly distinctive and the Respondent is advertising services similar to those offered by the Complainant. The Respondent must have been aware of the Complainant's trademark. The Complainant contacted the Respondent but received no answer. The Respondent is concealing its identity and most likely using false contact details. The disputed domain name is being used for commercial purposes with the intent to attract and redirect Internet users by misrepresenting the existence of a connection with the Complainant.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant owns trademark registrations for BLUESTEP. The Panel is satisfied that the Complainant has established its ownership of the trademark BLUESTEP.

It is established by prior UDRP panels that when a domain name incorporates a complainant's registered trademark, such incorporation is sufficient to establish identity or confusing similarity for the purposes of the Policy even if other words are added as part of the disputed domain name. *E.g., Oki Data Americas, Inc v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) ("*Oki Data*"). The disputed domain name incorporates the Complainant's trademark BLUESTEP in its entirety. The word "banking" does not prevent the fact that the disputed domain name is confusingly similar to the Complainant's trademark.

The generic Top-Level Domain ".com" should generally be ignored when assessing confusing similarity as established by prior UDRP decisions.

Consequently, the Panel finds that the disputed domain name is confusingly similar to the trademark of the Complainant and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent does not have any rights or legitimate interests in the disputed domain name. Once such showing is made, the burden of production shifts to the respondent. In the instant case, the Complainant asserts that the Respondent is not affiliated with nor authorized by the Complainant to use its trademark. The Respondent should prove that it has rights or legitimate interests.

The Panel finds it necessary to assess whether there is a *bona fide* offering of goods or services as the disputed domain name resolves to a website through which banking services are seemingly being advertised. In this respect, the Panel notes a prior UDRP decision which explains that "[t]he use of a domain name which is identical or confusingly similar to the Complainant's trademark with an intention of deriving advantage from user confusion and diverting Internet users to other commercial sites does not confer legitimate rights on the Respondent". See *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). The Panel finds that the Complainant's submissions and evidence indicate that the Respondent is not using the disputed domain name to actually offer banking services and that the disputed domain name does not appear to be used in connection with a legitimate business (Annexes 7 to 9 of the Complaint). The Panel is of the view that the use on the Respondent's website of a logo "Bluestep", very similar to the Complainant's trademark, confirms an intention to derive advantage from the confusion that may be caused to consumers. As such, this does not constitute a *bona fide* offering of goods or services.

Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Respondent must have known of the Complainant's business and trademark as the Complainant's trademark was first registered 16 years before the creation of the disputed domain name. The disputed domain name resolves to a website offering banking services. Such services are similar if not identical to the Complainant's services. Therefore, it is highly likely that the Respondent was aware of the Complainant's trademark.

The website of the Respondent shows the trademark of the Complainant, which indicates that the Respondent is trying to pass off as being connected with the Complainant. The Panel finds that it is more

likely than not, that the Respondent registered the disputed domain name in the knowledge of the Complainant's trademark and business with the intention of taking unfair advantage of the Complainant's goodwill attached to its trademark. It is the Panel's view that the Respondent has used the Complainant's trademark in order to create confusion in the minds of consumers for the purpose of attracting Internet traffic for commercial gain.

Such conduct falls squarely within the meaning of paragraph 4(b)(iv) of the Policy, and accordingly, the Panel finds that the Complainant has satisfied 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, <bluestepbanking.com> be transferred to the Complainant.

/Nayiri Boghossian/

Nayiri Boghossian

Sole Panelist

Date: February 6, 2023