

ADMINISTRATIVE PANEL DECISION

Bluestep Bank AB/Bluestep Holding AB v. Kim Jong
Case No. D2023-2544

1. The Parties

The Complainant is Bluestep Bank AB/Bluestep Holding AB, Sweden, represented by Ports Group AB, Sweden.

The Respondent is Kim Jong, United States of America.

2. The Domain Name and Registrar

The disputed domain name <bluesteponline.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 June 13, 2023. On June 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 14, 2023, 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 (Not available from registry / Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 21, 2023 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 June 22, 2023.

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 July 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 25, 2023.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on July 27, 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 a bank company incorporated in Stockholm, Sweden and operates in Scandinavia, providing bank services.

It results from the Complainant's documented allegations, which remained undisputed, that it holds European Union trademark registration No. 009018896, BLUESTEP registered on September 2, 2010 for services in class 36.

The disputed domain name was registered on February 23, 2023. The language of the Registration agreement is English.

The Complainant has provided – undisputed – evidence demonstrating that the disputed domain name resolved to a website, which purports to advertise banking services under the Complainant's BLUESTEP mark.

On April 11, 2023, the Complainant sent a cease-and-desist letter to the Respondent via the Registrar asking for the transfer of the disputed domain name. According to the Complainant's undisputed allegations, the Respondent did not reply to this letter, despite several reminders.

5. Parties' Contentions

A. Complainant

Firstly, the Complainant contends that the disputed domain name is at least confusingly similar to the Complainant's mark. The disputed domain name incorporates the Complainant's BLUESTEP mark in full. The only difference is the added ending of "online", which does not have any decisive impact on the visual and conceptual similarity between the Complainant's trademark and the disputed domain name.

The Complainant, secondly, submits that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not a licensee of the Complainant, and the Complainant has not given the Respondent any permission to register the trademark as a domain name, nor is there any evidence that the Respondent has been commonly known by the disputed domain name. According to the Complainant, the Respondent is neither making a non-commercial fair use of the disputed domain name, nor is the Respondent making a *bona fide* offering of goods or services. Rather, the Respondent's use of the corresponding site, gives Internet users the false impression that it is endorsed, authorised or otherwise connected to the Complainant.

Thirdly, the Complainant contends that the Respondent registered and uses the disputed domain name in bad faith. It is obvious for the Complainant that the Respondent was well aware of the Complainant's trademarks and business when registering the disputed domain name and this must be interpreted as an attempt to mislead the public into believing that the disputed domain name is linked to the Complainant's trademarks. In the Complainant's opinion the Respondent's use of a privacy service, the identical business to which the disputed domain name referred, in the context of the surrounding circumstances as described above, should be considered evidence of bad faith use of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to “decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name should be transferred or cancelled:

- (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.

The Panel is satisfied that the registrant of record for the disputed domain name is the Respondent and will, therefore, proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided that the Complainant is the registered owner of European Union trademark registration No. 009018896, BLUESTEP registered on September 2, 2010 and therefore largely predating the registration of the disputed domain name.

Many UDRP panels have found that a disputed domain name is confusingly similar to a complainant’s trademark for purposes of the first element where the relevant trademark is recognizable within the disputed domain name. Under such circumstances, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (*cf.* section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). This Panel shares the same view and notes that the disputed domain name contains the Complainant’s registered trademark BLUESTEP, which is placed at the beginning of the disputed domain name. In particular, the Panel considers the addition of the term “online” to the Complainant’s trademark in the disputed domain name would not prevent a finding of confusing similarity under the first element of the UDRP.

Finally, the generic Top-Level Domain (“gTLD”) “.top” of the disputed domain name may be disregarded under the first element confusing similarity test (see section 1.11.1 of the [WIPO Overview 3.0](#)).

In light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

The Complainant has therefore satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent’s rights or legitimate interests to the disputed domain name. In the Panel’s view, based on the undisputed allegations stated above, the Complainant has made a *prima*

facie case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name:

According to the Complaint, which has remained unchallenged, the Complainant has not authorized the Respondent's use of the trademark BLUESTEP, e.g., by registering the disputed domain name comprising said mark entirely.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Finally, it results from the Complainant's undisputed allegations that the disputed domain name resolved to a website which purports to advertise banking services under the Complainant's BLUESTEP mark. The Panel assesses this use as being commercial, so that it cannot be considered a legitimate, noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue pursuant to paragraph 4(c)(iii) of the Policy.

Furthermore, such use as described above cannot be qualified as a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy. In fact, this Panel considers that a registrant has no legitimate interest in a domain name that identically includes to a third party's mark, where the composition of the domain name is associated to the business of the trademark holder, and that is being used to address consumers in the same business as the trademark holder operates ([WIPO Overview 3.0](#) at section 2.5).

Finally, previous UDRP panels have found that once the panel finds a *prima facie* case is made by a complainant, the burden of production under the second element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds, in the circumstances of this case, that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith.

One of these circumstances is that the respondent by using the disputed domain name, 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 its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy).

It is the view of this Panel that these circumstances are met in the case at hand. It results from the Complainant's documented allegations that the disputed domain name has been connected to a website which purports to advertise banking services under the Complainant's BLUESTEP mark. For the Panel, it is therefore evident that the Respondent positively knew the Complainant's BLUESTEP mark. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain name included the Complainant's trademark when it registered the disputed domain name, having registered it due to its similarity with the Complainant's BLUESTEP mark. Registration of the disputed domain name which contains a third party's mark, in awareness of said mark, to take advantage of its similarities with the mentioned mark, and in the absence of rights or legitimate interests amounts to registration in bad faith.

The finding of bad faith registration and use is supported by the further circumstances resulting from the case at hand, which are:

- (i) the Respondent's failure to reply to the cease-and-desist letter;
- (ii) the Respondent's failure to submit a response;
- (iii) the Respondent's failure to provide any evidence of actual or contemplated good-faith use;
- (iv) the implausibility of any good faith use to which the disputed domain name may be put;
- (v) the Respondent hiding his identity behind a privacy shield and
- (vi) the fact that the details disclosed for the Respondent by the Registrar were incomplete, noting the mail courier's inability to deliver the Center's written communications.

In the light of the above the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to 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, <bluesteponline.com> be transferred to the Complainant.

/Tobias Malte Müller/

Tobias Malte Müller

Sole Panelist

Date: August 10, 2023