

## **ADMINISTRATIVE PANEL DECISION**

BforBank v. bernhard baumann

Case No. D2023-2584

### **1. The Parties**

The Complainant is BforBank, France, represented by Nameshield, France.

The Respondent is bernhard baumann, Germany.

### **2. The Domain Name and Registrar**

The disputed domain name <secure-bforbank.net> is registered with PSI-USA, Inc. dba Domain Robot (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 15, 2023. On June 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 19, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 20, 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 amended Complaint on June 20, 2023.

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 July 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 27, 2023.

The Center appointed Mladen Vukmir as the sole panelist in this matter on July 31, 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**

- (i) The Complainant is BFORBANK, a 100% online bank, launched in 2009;
- (ii) The Complainant holds several BFORBANK trademarks, including the European Union trademark no. 008335598 registered on December 8, 2009 (“BFORBANK trademark”);
- (iii) The Complainant registered the domain name <bforbank.com> on January 16, 2009.
- (iv) The disputed domain name <secure-bforbank.net> was registered on June 12, 2023, and it resolves to a parking page.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant essentially, asserts the following:

- (i) it provides various financial services since October 2009, and serves approximately 240,000 customers;
- (ii) the disputed domain name is confusingly similar to its BFORBANK trademark, while it includes BFORBANK trademark in its entirety. The addition of word “secure” is not sufficient to escape the finding that the disputed domain name is confusingly similar to the BFORBANK trademark;
- (iii) the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not affiliated with nor authorized by the Complainant in any way to use the Complainant’s BFORBANK trademark. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license, nor authorization has been granted to the Respondent to make any use of the Complainant’s BFORBANK trademark. The Respondent is not known by the Complainant;
- (iv) the disputed domain name resolves to a parking page, the Respondent did not use the disputed domain name, and it confirms that the Respondent has no demonstrable plan to use the disputed domain name;
- (v) the Respondent has registered and is using the disputed domain name in bad faith. The Respondent has registered the disputed domain name several years after the registration of BFORBANK trademark which has established strong reputation while using this trademark. The Complainant is well known, while it offers daily banking, saving etc. services for 240,000 customers, and all the results of google search of words “secure-bforbank” refer to the Complainant. Given the distinctiveness of the Complainant’s trademark and reputation, the Complainant states that it is inconceivable that the Respondent could have registered the disputed domain name without actual knowledge of the Complainant’s rights in BFORBANK trademark. The disputed domain name resolves to a parking page. The Respondent has not demonstrated any activity in respect of the disputed domain. Email Exchange (“MX”) servers are configurated to suggest that the disputed domain name may actively be used for email purposes.

##### **B. Respondent**

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

## 6. Discussion and Findings

The Panel now proceeds to consider this matter on the merits in light of the Complaint, the lack of the Response, the Policy, the Rules, the Supplemental Rules, and any rules and principles of law that it deems applicable pursuant to paragraph 15(a) of the Rules.

Paragraph 4(a) of the Policy provides that the Complainant must prove, with respect to the disputed domain name, each of the following:

- (i) the disputed domain name is confusingly similar to a trademark 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

Section 1.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)) provides that it is generally accepted that ownership of a registered trademark by a complainant is sufficient to satisfy the threshold requirement of having the trademark rights for purposes of standing to file a UDRP case.

The Complainant has submitted evidence to show that it is the holder of earlier BFORBANK trademark registered before the European Union Intellectual Property Office. Accordingly, this trademark provides to the Complainant all the exclusive rights that are granted with such trademark registration.

It is well established that the threshold test for confusing similarity under the UDRP involves a reasoned but relatively straightforward comparison between the textual components of the relevant trademark and the disputed domain name. To satisfy this test, the relevant trademark would generally need to be recognizable as such within the disputed domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing (see section 1.7 of the [WIPO Overview 3.0](#)).

After comparing the disputed domain name and the Complainant’s BFORBANK trademarks, it is evident to this Panel that the disputed domain name incorporates the Complainant’s BFORBANK trademark in its entirety. The only difference between the disputed domain name and the Complainant’s BFORBANK trademarks is the addition of the word “secure” followed by a hyphen in the disputed domain name.

Prior UDRP panels have found confusing similarity in a number of cases based on the circumstances involving domain names comprised of a well-known trademark and a descriptive term (section 1.8. of the [WIPO Overview 3.0](#)). Where the trademark in question is recognizable within the disputed domain name, the addition of other terms (whether descriptive, etc.) does not prevent a finding of confusing similarity between the disputed domain name and trademark in question. In this particular case, added word “secure” followed by a hyphen does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s BFORBANK trademarks.

Regarding the generic Top-Level Domain (“gTLD”) “.net” in the disputed domain name, as a standard registration requirement, should be disregarded under the confusing similarity test (section 1.11.1 of the [WIPO Overview 3.0](#)).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s BFORBANK trademarks under paragraph 4(a)(i) of the Policy.

## B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out a number of circumstances which, without limitation, may be effective for the Respondent to demonstrate that it has the rights to, or legitimate interests in the disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy. Those circumstances are:

“(i) Before any notice to [the respondent] of the dispute, [use by the respondent] of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) [Where the respondent] (as an individual, business, or other organization) [has] been commonly known by the domain name, even if [the respondent has] acquired no trademark or service mark rights; or

(iii) [Where the respondent is] making a legitimate non-commercial 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.”

As noted by the previous UDRP panels on the onus of proof under paragraph 4(a)(ii) of the Policy, and as summarized in section 2.1 of the [WIPO Overview 3.0](#): “[...] While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized 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. As such, 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.”

The Panel finds that, in this case, the Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Panel concludes that there is neither any relation, between the Respondent and the Complainant, nor does it arise that the Complainant has ever licensed or otherwise permitted the Respondent to use its BFORBANK trademarks or to apply for or use any domain name incorporating the same trademarks.

There is no evidence that the Respondent has been commonly known by the disputed domain name. Also, there is no evidence that the Respondent has been using the disputed domain name in connection with a *bona fide* offering of goods or services or making a legitimate noncommercial or fair use of the disputed domain name.

The Respondent has failed to provide any substantive reply to the Complaint and accordingly failed to rebut the Complainant's *prima facie* showing that the Respondent has no rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the requirements set forth in paragraph 4(a)(ii) of the Policy have been fulfilled by the Complainant's *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and by the Respondent's failing to produce any arguments or evidence to the contrary.

## C. Registered and Used in Bad Faith

For the purpose of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular, but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of the disputed domain name in bad faith:

(i) circumstances indicating that the holder has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the

complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the holder's documented out-of-pocket costs directly related to the domain name; or

- (ii) the holder has registered the 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 holder has engaged in a pattern of such conduct; or
- (iii) the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's 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 holder's website or location or of a product or service on the holder's website or location.

The Panel accepts the Complainant's arguments that the Respondent has registered and used the disputed domain name in bad faith.

Previous UDRP panels have found that the incorporation of a well-known trademark in a domain name having no plausible explanation for doing so is in itself an indication of bad faith (see *Intel Corporation v. The Pentium Group*, WIPO Case No. [D2009-0273](#)). This Panel is of opinion that the Complainant's BFORBANK trademarks are well known and distinctive, and it is unlikely that the Respondent was unaware of the Complainant and its well-known BFORBANK trademark when it registered the disputed domain name. The Respondent did not provide any evidence that it has rights and/or legitimate interests in a disputed domain name, nor did it present a credible evidence for registering and using the disputed domain name. Based on the evidence submitted by the Complainant, the Panel concludes that it is more likely than not that the Respondent's motive in relation to the registration and use of the disputed domain name was to take advantage from the Complainant's well-known trademark rights.

The disputed domain name resolves to a parking page, the Respondent has not demonstrated any plan for a *bona fide* use in relation to the disputed domain name. From the inception of the UDRP, prior panelists have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding (see section 3.3 of the [WIPO Overview 3.0](#)). In this case noting (i) the degree of distinctiveness and reputation of the Complainant's BFORBANK trademark, (ii) the failure of the respondent to submit a response, and (iii) the implausibility of any good faith use to which the inherently misleading disputed domain name may be put.

The Panel believes that the Respondent must have been aware of the Complainant and its BFORBANK trademark when it registered the disputed domain name on June 12, 2023. By that time, the Complainant's trademark had been registered and used for over 14 years. This Panel finds it unlikely that the Respondent did not google searched word "bforbank" before registering the disputed domain name. All top results of google search are related to the Complainant. By registering the disputed domain name, the Respondent was most likely aware of the Complainant and its business by incorporating the Complainant's distinctive trademark BFORBANK. The descriptive word "secure" included in the disputed domain name contributes to increase confusion among Internet users who very likely will be misled to believe that the website created under the disputed domain name belongs to or is affiliated with the Complainant.

Given the above, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith, and that the Complainant has fulfilled the third element under 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, <secure-bforbank.net>, be transferred to the Complainant.

*/Mladen Vukmir/*

**Mladen Vukmir**

Sole Panelist

Date: August 14, 2023