

ADMINISTRATIVE PANEL DECISION

BANCO BICE v. Alejandro Mesa, blackbiz13

Case No. D2023-5111

1. The Parties

The Complainant is BANCO BICE, Chile, represented by Sargent & Krahn Procuradores Internacionales de Patentes y Marcas Ltda., Chile.

The Respondent is Alejandro Mesa, blackbiz13, Chile.

2. The Domain Name and Registrar

The disputed domain name <bancobice.net> is registered with eNom, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 7, 2023. On December 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 7, 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 December 8, 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 December 12, 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 December 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 9, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 12, 2024.

The Center appointed Felipe Claro as the sole panelist in this matter on January 19, 2024. 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 widely known in the Chilean market regarding banking services. It was founded in 1979 by an important group of Chilean investors linked to one of the country's main export companies.

From its beginnings, its permanent objective has been to offer banking services of excellence, oriented to both companies and individuals. In addition to traditional financing, deposit-taking and other banking services, its high level of specialization in foreign trade, the financing of investment projects and its advisory role in the field of corporate investments stand out.

The trademarks and domain names of the Complainant have plenty of recognition and prestige in the domestic and international market.

Its rapid expansion has allowed the Complainant to broaden its horizons and enter the international market by offering its services to international clients and to national clients in other countries.

The fame and reputation of its trademark BANCO BICE is evidenced by numerous publications and a Google search for "BANCO BICE NET" shows main results all referred to the Complainant.

The Complainant owns several trademark registrations in Chile and abroad for the trademark BANCO BICE or BICE that predate the disputed domain name.

The Complainant is the holder of over 80 trademark registrations that contains the term BICE in Chile. Some of these Trademarks are detailed below:

- (i) Registration No. 843.524, BANCO BICE, registered on March, 9 2009, class 36, in Chile.
- (ii) Registration No. 846.062, BANCO BICE, registered on April 8, 2009, class 16, in Chile.
- (iii) Registration No. 857.830, BANCO BICE, registered on August 17, 2009, class 16, in Chile.
- (iv) Registration No. 846.438, BANCO BICE, registered on April 13, 2009, class 36, in Chile.
- (v) Registration No. 875.809, BANCO BICE, registered on February 11, 2010, class 36, in Chile.

Additionally, the Complainant is the registered owner of the following domain names, among many others, all of which are structured upon the word BICE and predate the disputed domain name:

- (i) <bancobice.cl>
- (ii) <bcobice.cl>
- (iii) <afpbancobice.cl>
- (iv) <bicefunds.com>
- (v) <bice.cl>
- (vi) <bice-bnk.com>

The disputed domain name was registered on October 2023 and resolves to an inactive page.

5. Parties' Contentions

No information or documentation was provided by the Respondent.

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name <bancobice.net> is identical to its registered trademark BANCO BICE.

B. Respondent

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

6. Discussion and Findings

In view of the lack of a response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding based on the Complainant's undisputed representations. In that regard the Panel makes the following specific findings.

A. Identical or Confusingly Similar

The Complainant has numerous trademark registrations containing the well-known name BANCO BICE or similar, all of which predate the registration of the disputed domain name.

The disputed domain name <bancobice.net> is identical to the mark BANCO BICE, registered in Chile and abroad.

The behavior of registering a domain name that is identical to a well-known banking trademark has already been addressed in the following decisions: (i) *Banco Inter S.A. of Belo Horizonte vs. Anderson Santos, leaodechacara.com*, WIPO Case No. [D2018-1926](#) <bancointer.app> "In view of the above, the Panel finds that the disputed domain name is identical to Complainant's BANCO INTER unregistered trademark. The Panel understands that the disputed domain name carries the word elements "banco inter", which are identical to the Complainant's domain name and the trademarks Complainant uses since 2017 to identify their activities. (...) The Panel, therefore, finds that Complainant has properly established the first condition of the paragraph 4(a) of the Policy."

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

There is no evidence that the Respondent is commonly known as "BANCOBICE", nor it is related in any way to the Complainant, and therefore it has no rights or legitimate interests in the disputed domain name <bancobice.net>.

There is not information about the Respondent's ownership of any trademarks that resemble BICE or BANCO BICE.

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name. The Respondent has submitted no response in this case.

Although 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 difficult 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 (although the burden of proof always remains on the Complainant). If the Respondent fails to come forward with such relevant evidence, the Complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent knew or should have known that "BANCO BICE" is a well-known trademark that belonged to a well-known Chilean bank. The creation of the word "bancobice" is not of common occurrence and it is obvious that it emerged out of an intended appropriation of the Complainant's mark BANCO BICE.

The Respondent should have identified the risk of registering a third party's mark when registering the domain name. This is further evidence of bad faith.

The disputed domain name resolves an inactive website.

In addition, the Complainant has provided evidence that the disputed domain name was resolving to the Registrar's page where it stated that the disputed domain name "was taken and Domain Agents might be able to help". At this point, it seems important to refer to the a previous decision *Turner Network Television, Inc. vs. Expired Domain Resource c/o Dynadot*, WIPO Case No. [D2018-1036](#), where the bad faith of the Respondent was declared, since Dynadot, LLC. offered to sell the disputed domain name: "the Domain Name previously resolved to a website advertising the Domain Name for sale at a listed price of USD 988 through Escrow.com and shortly after Complainant communicated with Dynadot, the Domain Name no longer resolved to this content, but instead began resolving to a blank page. Furthermore, the underlying beneficial registrant's use of a proxy service to obscure its identity further evidence bad faith registration and use of the Domain Name".

In *Banco Bice vs. Junior Hessou, Hessou Junior*, WIPO Case No. [D2023-2107](#) <bice-bnk.com> the panel decided “In light of the use of the Complainant’s BICE mark and the nature of the Respondent’s website, the Panel is in no doubt that the Respondent had the Complainant and its rights in the BICE mark in mind when it registered the Domain Name.”

It is clear that at the time of registering the disputed domain name <bancobice.net> the Respondent was of should have been fully aware of the existence of the Complainant and its trademarks, BANCO BICE.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although 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, and (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant’s trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds the third element of the Policy has been established.

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 <bancobice.net> be transferred to the Complainant.

/Felipe Claro/

Felipe Claro

Sole Panelist

Date: February 2, 2024