

## **ADMINISTRATIVE PANEL DECISION**

### **Monabanq SA v. DESIGNITION LIMITED**

#### **Case No. D2023-5193**

#### **1. The Parties**

The Complainant is Monabanq SA, France, represented by MEYER & Partenaires, France.

The Respondent is DESIGNITION LIMITED, Poland.

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

The disputed domain name <web-monabanq.com> (“Disputed Domain Name”) is registered with Eranet International Limited (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 13, 2023. On December 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On December 15 and 18, 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 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 December 22, 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 January 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 28, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 31, 2024.

The Center appointed Gabriela Kennedy as the sole panelist in this matter on February 2, 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 a French banking Société Anonyme established in 2006, offering online banking and insurance services to individuals and professionals. The Complainant owns various word and figurative trademarks for or containing “MONABANQ” (“Complainant’s Trademark”) in various jurisdictions.

The relevant trademark registrations include, inter alia, International Trademark Registration No. 943266 for “monabanq.com” registered on October 9, 2007 in Classes 9, 16, 35, 36 and 38 designating the Benelux Office for Intellectual Property; European Union (“EU”) Trademark Registration No. 18064036 for “monabanq” registered on November 6, 2019 in Classes 9, 16, 35, 36 and 38; and EU Trademark Registration No. 5601224 for “monabanq” registered on November 21, 2007 in Classes 9, 16, 35, 36 and 38.

The Complainant’s Trademark is also fully incorporated in the Complainant’s domain name <monabanq.com> which the Complainant registered on March 23, 2006, and resolves to the Complainant’s website. Apart from this, the Complainant also owns the following domain names featuring the Complainant’s Trademark, including inter alia, <monabanq.fr>, <monabanq.net>, <monabanq.eu>, <monabanq.org>, <monabanq.credit> and <monabanq.finance>.

The Disputed Domain Name was registered on May 23, 2023. Prior to the filing of the Complaint, the Disputed Domain Name redirected to a website at “bedandy.fr” displaying information of a French advertising company named Be Dandy and this company’s purported work for the Complainant (“Be Dandy Website”). At the time of filing of the Complaint and at the time the Panel was rendering her decision, the Respondent’s Website resolved to a page that could not be reached due to the server IP address not being found.

#### 5. Parties’ Contentions

##### 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:

(a) The Disputed Domain Name is confusingly similar to the Complainant’s Trademark. The only differences between the Disputed Domain Name and the Complainant’s Trademark are the presence of the term “web” and the generic Top-Level Domain (“gTLD”) “.com”. The term “web” is a generic and descriptive term referring to online access to the Complainant’s activities, and the gTLD may be disregarded. Moreover, MONABANQ is a unique and original word representing the Complainant, which increases the likelihood of consumer confusion between the Disputed Domain Name and the Complainant’s Trademark.

(b) The Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent has not obtained any license or authorization from the Complainant to use the Complainant’s Trademark as part of a domain name or otherwise. The Respondent is not commonly known by the Disputed Domain Name. Moreover, the Disputed Domain Name appears to be registered by the Respondent for the purposes of generating illegitimate commercial gain from the Complainant by misleading Internet users that the Disputed Domain Name is linked to the Complainant. The Respondent’s contact details are fictitious and likely usurped. The contents of the Be Dandy Website may have been stolen from a third party.

This does not constitute a bona fide offering of goods or services or legitimate noncommercial or fair use of the Disputed Domain Name.

(c) Both the Respondent's registration and use of the Disputed Domain Name establish the Respondent's bad faith. Given the publicity and reputation of the "MONABANQ" brand, the previous display of "MONABANQ" on the Be Dandy Website and the distinctiveness of the mark, the Respondent must have been fully and actually aware of the existence of the Complainant's rights in the Complainant's Trademark when the Respondent registered and used the Disputed Domain Name. The Respondent used fictitious contact details that are likely to have been usurped to register the Disputed Domain Name. The Respondent is a cyber squatter that attempts to generate Internet traffic by illegitimately copying the Complainant's Trademark and Be Dandy's website content. The Respondent is currently passively holding the Disputed Domain Name, which should not prevent a finding of bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three 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 by the Respondent in bad faith.

### **A. Identical or Confusingly Similar**

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 confusingly similar to the Complainant's Trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of the term "web" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant's Trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

UDRP panels have consistently found that the addition of other terms to a mark (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity under the first element. See section 1.8 of the [WIPO Overview 3.0](#). Furthermore, it is well established that the gTLD, ".com" in this case, may be disregarded. See section 1.11.1 of the [WIPO Overview 3.0](#).

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

## **B. Rights or Legitimate Interests**

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.

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 Respondent’s failure to file a Response may result in the Panel drawing appropriate inferences from such default. The Panel may also accept all reasonable and supported allegations and inferences flowing from the Complainant as true (see *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. [D2009-1437](#); and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#)).

The Panel agrees with the Complainant that there is no evidence to show that the Respondent has trademark rights corresponding to the Disputed Domain Name, or that the Respondent has become known by the Disputed Domain Name.

There is no evidence to suggest that the Respondent’s use of, or demonstrable preparations to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name, is in connection with a bona fide offering of goods or services or be regarded as legitimate noncommercial or fair use.

Moreover, the composition of the Disputed Domain Name, which incorporates the Complainant’s Trademark with the addition of the term “web”, carries a risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant or its online banking business. See section 2.5.1 of the [WIPO Overview 3.0](#).

Panels have held that the use of a domain name for illegal activity, such as in this case the impersonation or passing off by the Respondent as Be Dandy and/or the Complainant using the mark MONABANQ here, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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 it is difficult to conceive of any plausible use of the Disputed Domain Name that would amount to good faith use, given that it has incorporated the Complainant’s Trademark in its entirety. The Respondent intentionally registered the Disputed Domain Name to attract Internet users to the Respondent’s Website for commercial gain by creating a likelihood of confusion with the

Complainant's Trademark. See section 3.1 of the [WIPO Overview 3.0](#). Also, as discussed above, the Respondent lacks any rights or legitimate interests in the Disputed Domain Name (see *Washington Mutual, Inc. v. Ashley Khong*, WIPO Case No. [D2005-0740](#)). Further, the Respondent failed to respond to the Complainant's contentions and has provided no evidence of its actual or contemplated good faith use of the Disputed Domain Name.

Panels have held that the use of a domain name for illegal activity, such as in this case, the impersonation or passing off as Be Dandy and/or the Complainant using the mark MONABANQ, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and past use of the Disputed Domain Name constitutes bad faith under the Policy.

Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the current 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. Again, 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 current passive holding of the Disputed Domain Name does not prevent a finding of bad faith under the Policy.

Accordingly, the Panel finds that the Complainant has 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 <web-monabanq.com> be transferred to the Complainant.

*/Gabriela Kennedy/*

**Gabriela Kennedy**

Sole Panelist

Date: February 16, 2024