

ADMINISTRATIVE PANEL DECISION

Banque BIA v. Roosevelt Powel Tessy
Case No. D2024-0887

1. The Parties

The Complainant is Banque BIA, France, represented by INSCRIPTA, France.

The Respondent is Roosevelt Powel Tessy, Benin.

2. The Domain Name and Registrar

The disputed domain name <bia-inter.com> (the “Disputed Domain Name”) is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 29, 2024. On March 5, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 6, 2024, 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 (Privacy Protect, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 7, 2024, 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 March 8, 2024.

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 March 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 1, 2024. The Respondent sent an email communication to the Center on March 18, 2024.

The Center appointed Flip Jan Claude Petillion as the sole panelist in this matter on April 16, 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, Banque BIA (formerly “Banque Intercontinentale Arabe”), is a French bank specialised in the development of commercial relations between France and the Arab countries.

The Complainant is the owner of several trademarks including the following:

- B.I.A., French word mark registered under No. 1424276 on June 23, 1986, in classes 35 and 36;
- BANQUE BIA, French word mark registered under No. 3430329 on May 23, 2006, in classes 36 and 38;
- BANQUE BIA, French figurative mark registered under No. 3430331 on May 17, 2006, in classes 36 and 38:



The Complainant appears to operate through the domain name <bia-paris.fr>.

The Disputed Domain Name was registered on September 19, 2023. According to the Complainant's evidence, the Disputed Domain Name appeared to resolve to a website similar to the Complainant's website. At the Complainant's request, the Registrar put the Disputed Domain Name on "ClientHold" on February 24, 2024, and the hosting provider suspended the account holder of the Disputed Domain Name on February 23, 2024. The Panel observes that the Disputed Domain Name currently resolves to an inactive web page.

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 the Disputed Domain Name is confusingly similar to the B.I.A. trademark in which it claims to have rights.

The Complainant further claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name, as, according to the Complainant:

- The Respondent has no trademark rights corresponding to the Disputed Domain Name;
- The construction of the Disputed Domain Name is likely to mislead or cause confusion;
- The Disputed Domain Name is not being used in connection with a bona fide offering of goods and services;
- The Respondent has been using a privacy shield that makes it almost impossible to be contacted and that makes it even more difficult to hold it responsible for its actions.

Finally, the Complainant claims that the Disputed Domain Name was registered and is being used in bad faith, as, according to the Complainant:

- The Disputed Domain Name was registered after the Complainant's trademarks were filed and registered;

- The Disputed Domain Name is highly and confusingly similar to the B.I.A. trademarks;
- When registering the Disputed Domain Name, the Respondent decided to use a privacy shield;
- Initially the Disputed Name has been used to resolve to a mirror site of the Complainant's website;
- The Disputed Domain Name may have been used or may be used in the future by the Respondent to send and receive emails from email addresses created with the Disputed Domain Name, as part of a phishing scheme.

B. Respondent

The Respondent did not reply formally to the Complainant's contentions. However, on March 18, 2024, the Respondent stated the following in an e-mail addressed to the Center: "I have not initiated any proceedings concerning the domain bia-inter.com. The domain was recently suspended by my host, and I would also like it to be deleted and available to anyone who wants to buy it. I tried this manually from my host without success".

6. Discussion and Findings

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.

Based on the available record, the Panel finds 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 Panel observes that the entire B.I.A. mark of the Complainant is reproduced within the Disputed Domain Name. In the Panel's view, the term "BIA" is also the dominant (textual) element of the other marks invoked by the Complainant, which have been referred to previously in this Decision. In such cases, the domain name will normally be considered confusingly similar to the incorporated mark for purposes of UDRP standing. [WIPO Overview 3.0](#), section 1.7.

Additionally, the Panel finds that the addition of a hyphen and another term – here, "inter" – does not prevent a finding of confusing similarity between the Disputed Domain Name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

It is well established that generic Top-Level-Domains ("gTLDs"), here ".com", may be disregarded when considering whether the Disputed Domain Name is confusingly similar to a trademark in which the Complainant has rights. [WIPO Overview 3.0](#), section 1.11.1.

Based on the available record, 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 Panel notes that the Respondent has not apparently been commonly known by the Disputed Domain Name, and that the Respondent does not seem to have acquired trademark or service mark rights over it. According to the information provided by the Registrar, the Respondent is "Roosevelt Powel Tessy". The Respondent's use and registration of the Disputed Domain Name was not authorized by the Complainant.

Fundamentally, a respondent's use of a domain name will not be considered "fair" if it falsely suggests affiliation with the trademark owner. The correlation between a domain name and the complainant's mark is often central to this inquiry. Even where a domain name consists of a trademark plus an additional term, such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

The Disputed Domain Name incorporates the Complainant's B.I.A trademark in its entirety and merely adds a hyphen and the descriptive term "inter". In the Panel's view, the term can be easily linked to the former name of the Complainant, BANQUE INTERCONTINENTALE ARABE. Therefore, the Panel finds that the Disputed Domain Name carries a risk of implied affiliation with the Complainant and cannot constitute fair use.

Beyond looking at the domain name and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, including the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not. [WIPO Overview 3.0](#), sections 2.5.2 and 2.5.3.

The Disputed Domain Name appeared to resolve a website similar to the Complainant's website and displaying legal information related to the Complainant such as the address of the registered office, the company registered number and the company VAT number. The Panel finds that this does not amount to a bona fide offering of goods or services, or a legitimate noncommercial or fair use of the Disputed Domain Name. UDRP panels have categorically held that the use of a domain name for illegal activity (e.g. impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.

Finally, the Respondent had the opportunity to demonstrate his rights or legitimate interests but did not do so. The Respondent simply asserted it wanted the Disputed Domain Name to be deleted and make it "available to anyone who wants to buy it". In the absence of a formal Response from the Respondent, the prima facie case established by the Complainant has not been rebutted.

Based on the available record, 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.

The Disputed Domain Name appeared to resolve a website similar to the Complainant's website and mentioning legal information related to the Complainant. In the Panel's view, the circumstances of this case

indicate that the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trademark. [WIPO Overview 3.0](#), section 3.1.4.

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.

In the present case, the Panel finds that the Respondent must have been aware of the Complainant's existence and its trademark rights when it registered the Disputed Domain Name, as:

- Some of the Complainant's trademarks predate the registration of the Disputed Domain Name by more than 35 years;
- The Disputed Domain Name incorporates the Complainant's trademark in its entirety, and combines it with a term referring to the Complainant's former name, BANQUE INTERCONTINENTALE ARABE;
- The website linked to the Disputed Domain Name used to mention legal information related to the Complainant.

The Panel observes that the Respondent did not provide any evidence of actual or contemplated good faith use. During the present proceedings, the Respondent indicated its intention to delete the Disputed Domain Name and make it available "to anyone who wants to buy it".

Based on the available record, 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 <bia-inter.com> be transferred to the Complainant.

/Flip Jan Claude Petillion/

Flip Jan Claude Petillion

Sole Panelist

Date: April 30, 2024