

ADMINISTRATIVE PANEL DECISION

Bank of Valletta p.l.c. v. Pythagoras FZE

Case No. D2024-0940

1. The Parties

The Complainant is Bank of Valletta p.l.c., Malta, internally represented.

The Respondent is Pythagoras FZE, United Arab Emirates.

2. The Domain Name and Registrar

The disputed domain name <bankofvalletta.com> is registered with Communigal Communications Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 4, 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 12, 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 (Unknown registrant) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 12, 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 amendment to the Complaint on March 14, 2024.

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 March 15, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 4, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 9, 2024.

The Center appointed Marilena Comanescu as the sole panelist in this matter on April 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, Bank of Valletta p.l.c., is a credit institution incorporated and existing under the laws of Malta, and licensed to act as a bank by the European Central Bank.

The Complainant owns trademark registrations for or including BANK OF VALLETTA, such as the following:

- the Maltese trademark registration number 55041 for BOV BANK OF VALLETTA (figurative word), filed on January 27, 2016, registered on July 13, 2016, covering services in International class 36; and

- the Maltese trademark registration number 25791 for BANK OF VALLETTA (figurative word), filed on June 6, 1996, and registered on April 24, 1997, covering goods in International class 16.

The disputed domain name was registered on March 28, 2010, and, at the time of filing the Complaint, it was used to resolve to a website listing pay-per-click (“PPC”) links related to financial services.

According to Annex 4 to the Complaint, on April 24, 2023, the Complainant sent a cease-and-desist letter to the Registrar. On July 2, 2023, the Complainant received the Registrar’s response informing it that the Respondent refused to acknowledge that the disputed domain name conflicts with any of the Complainant’s intellectual property rights stating that “It is a parked domain. No reason to think this is BOV. It is generic.”

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 identical to its name and registered trademarks; the Complainant is the only one bank which is named “Bank of Valletta”; the Respondent has no rights or legitimate interest in the disputed domain name and the use of the disputed domain name by the Respondent is misleading, and may lead to suspicious sites which are not related to the Complainant, misleading the customers of the Complainant; the disputed domain name prevents the Complainant from reflecting its mark in a corresponding domain name.

B. Respondent

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

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in 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

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

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 used the disputed domain name in connection with a website displaying PPC links related to services similar to those provided by the Complainant and, in this regard, panels have held that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the Complainant's mark or otherwise mislead Internet users. [WIPO Overview 3.0](#), section 2.9.

Furthermore, the composition of the disputed domain name, being identical to the Complainant's mark and name, carries a high risk of implied affiliation. UDRP panels have largely held that 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 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 considers that the disputed domain name was registered in bad faith, with, more likely than not, knowledge of the Complainant and its trademark. While according to the Registrar's communication the Respondent claimed that the disputed domain name was "generic", the Panel notes the Complainant's claim that "there is only one bank which is named 'Bank of Valletta'", and particularly that the disputed domain name reproduces exactly the Complainant's trademark and bank name, which predates the registration of the disputed domain name.

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.

According to the Complaint and unrebutted by the Respondent, the disputed domain name resolved to a page providing PPC links with services similar to those offered by the Complainant.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "to attract, for commercial gain, Internet users to [the respondent'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 respondent's] website or location or of a product or service on [the respondent's] website or location" is evidence of registration and use in bad faith.

The Respondent was using without permission the Complainant's trademark and name, reproduced exactly, in order to get traffic on its web portal and to misleadingly divert Internet users to third parties' websites, and thus to potentially obtain commercial gain from the false impression created with regard to a potential affiliation or connection with the Complainant. This activity may also disrupt the business of the Complainant, tarnish its trademark and potentially harm the unsuspecting Internet users.

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 <bankofvalletta.com> be transferred to the Complainant.

/Marilena Comanescu /

Marilena Comanescu

Sole Panelist

Date: April 29, 2024