

ADMINISTRATIVE PANEL DECISION

Banque Palatine v. James Hotka, linkUwant.com
Case No. D2024-2498

1. The Parties

The Complainant is Banque Palatine, France, represented by KALLIOPE Law Firm, France.

The Respondent is James Hotka, linkUwant.com, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <epalatine.com> is registered with eNom, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 19, 2024. On June 20, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 20, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 20, 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 June 24, 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 June 25, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 15, 2024. The Response was filed with the Center on July 2, 2024.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on July 9, 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 Banque Palatine, a French bank with its head office in Paris, France, tracing its origins to 1780, and registered at the Paris trade registry under number 542 104 245. The Complainant specializes in supporting small and medium-sized companies, and asset management. It appears to have adopted the name Banque Palatine in 2005.¹ It is a wholly owned subsidiary of the French banking group Groupe BPCE, which is present in more than 40 countries.

The Complainant is the owner of a variety of trademarks for the word marks PALATINE and EPALATINE, the earliest of which appear to be French Registered Trademark Number 3314051 for the word mark PALATINE registered on September 22, 2004, in Classes 35 and 36; and French Registered Trademark Number 3644175 for the word mark EPALATINE registered on April 15, 2009, in Classes 35, 36, and 38.

The Complainant is also the owner of the domain names <palatine.fr>, registered on October 13, 2004, used for the Complainant's official portal website, and <epalatine.fr>, registered on April 10, 2009, also used to point to said portal website.

The disputed domain name was registered on February 9, 2006. In the Whois record produced by the Registrar in response to the request for verification, the "Address 2" field states "THIS NAME MAY BE FOR SALE". The Respondent appears to be a private individual operating an online advertising business named "linkUwant.com". The Respondent states that its advertising business began in 1999.² A copyright notice on a screenshot of the website associated with the disputed domain name dated December 29, 2018, refers to the period from 1999 to 2018 and notes that "linkUwant.com" is a division of Rainbow Realty Group, Inc., Indianapolis, Indiana, United States. The legend on this screenshot is headed with the disputed domain name in large letters and states "ePalatine.com is a strong, memorable brandable name. This domain could be yours!".

The disputed domain name has been offered for sale at least since 2011, according to the Internet Archive "Wayback" Machine. The entry of January 28, 2011 shows that the website associated with the disputed domain name was used for a series of sponsored links concerning tourism, travel, restaurants, and shopping.

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 its trademarks are well-known and that the disputed domain name is identical to the EPALATINE mark and confusingly similar to the PALATINE mark. The Complainant submits that the "e" will be perceived as referring to the Complainant's online services, adding that it offers various digital banking services under the name "ePalatine" coupled with another word, adding that some of these services are offered from the Complainant's domain name <epalatine.fr>.

The Complainant notes that it has never authorized the Respondent to register or use any domain name incorporating its trademarks, nor has it granted any license to the Respondent do so. The Complainant asserts that because its marks are well-known in France the disputed domain name is obviously calculated to confuse or deceive. The Complainant notes that the disputed domain name has been offered for sale for many years and that this cannot constitute a legitimate noncommercial or fair use of the disputed domain name, nor can it qualify as a bona fide offer of goods or services.

¹Complainant's Annex 5, entry commencing in 1971, as further discussed in section 6C below.

²The Panel notes in this respect that the domain name <linkuwant.com> was registered on August 9, 2000.

The Complainant submits that it and its parent company are well-known in France and throughout the world by financial and banking market consumers. The Complainant states that it is unquestionable that its trademarks predate the registration of the disputed domain name, adding that an elementary Internet search by the Respondent would have disclosed this.

The Complainant notes that its use of “epalatine” has been recognized in a previous case under the Policy and states that any argument concerning the fact that Palatine is a city in the United States is inadmissible, taking into account the uses of “palatine” and “epalatine” by the Complainant. The Complainant concludes that the choice of the disputed domain name does not seem to be a mere coincidence, but on the contrary seems to have been done on purpose to generate a likelihood of confusion between the disputed domain name and the Complainant’s marks.

The Complainant asserts that the disputed domain name has been used in bad faith because it has been offered for sale since at least 2011, citing paragraph 4(b)(i) of the Policy. Finally, the Complainant asserts that the presence of mail exchange (“MX”) records in the delegated DNS servers for the disputed domain name demonstrates use in bad faith because it allows the Respondent to create email addresses using the disputed domain name for phishing attacks, adding that this is a particular risk for entities operating in the field of banking services.

B. Respondent

The Respondent contends that the Complainant has not satisfied the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Respondent contends that its online advertising business commenced in 1999 and enabled customers to place a local business listing on multiple websites. The Respondent’s business acquired websites consisting of geographic regions plus a trade practice, and geographic regions prefixed by the letter “e” in order to provide local businesses with an advertising service. The Respondent maintains 30 domain names representing Palatine, Illinois, United States, the first of which was <palatinerealty.com>, registered by the Respondent on February 22, 2004. The Complainant’s trademarks date from 2004 and post-date the Respondent’s first use of the term. The Respondent searched for trademarks in 2004 and found no record of the Complainant.

The Respondent’s primary place of business is Indianapolis, Indiana and it has never traveled to France. The Respondent took reasonable steps in 2004 to ensure that there were no trademarks for “Palatine”. In about 2009, due to a downturn in the economy, the Respondent began to park its domain names and had to offer many for sale in order to recoup its investment and cover the annual renewal costs. The Respondent makes a handful of sales each year but operates at a loss. However, the Respondent wishes to return its domains to commercial use and hired a software development company in November 2023 to rebuild its advertising platform. The Respondent plans to continue this work but has placed its updated platform on hold due to the Respondent requiring to deal with hurricane damage dating from September 2022.

The name “Palatine” is a dictionary word and geographic term with multiple meanings. Advertising content relating to local businesses in Palatine, Illinois, United States, would not be confused with the Complainant’s business, under reference to a screenshot of the advertising website used in connection with the disputed domain name prior to it being parked in 2009. Said page also provided a disclaimer stating that it was not affiliated with any business of a similar name. There are dozens of live, dead and cancelled United States trademarks using the PALATINE mark falling into seven categories from beer to banking services.

The Respondent had no knowledge of the Complainant when it registered the disputed domain name. The Complainant’s marks were acquired after the Respondent’s first use of the term “Palatine”. The disputed domain name was acquired for a bona fide offering of goods or services, namely advertising services offered to Palatine businesses for several years. All of the Respondent’s domain names are offered for sale to help offset the costs of registration. Offering a domain name for sale does not void a prior legitimate interest.

The Respondent can show 130 domain names with a similar format to that of the disputed domain name, including 30 using “Palatine”. This demonstrates that the disputed domain name was in no way related to the Complainant’s business or trademarks. As further evidence of its advertising business, the Respondent references its “Ad Builder Studio”, namely an advertisement design tool available at its various websites which allows customers to build their own advertisements from various fonts and graphics.

The Respondent’s use of the disputed domain name and related business plan does not take unfair advantage of or otherwise abuse the Complainant’s mark. The Respondent did not register the disputed domain name to sell it to the Complainant or to prevent the Complainant from reflecting its mark in a corresponding domain name. The Respondent offering the disputed domain name for sale does not void its previous good faith use thereof. The Respondent had no knowledge of the Complainant’s business until this dispute and did not register the disputed domain name to disrupt the business of a competitor. The Parties are not competitors. The Respondent has not attempted to compete in any way with the Complainant’s website.

No email service is active for the disputed domain name according to the Registrar’s information. The Respondent has owned the disputed domain name for nearly 20 years and has not activated or changed MX records since it was registered. The Respondent was unaware of any active MX records and there is no evidence that phishing has occurred.

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.

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

The requirements of paragraph 4(a) of the Policy are conjunctive. A consequence of this is that failure on the part of a complainant to demonstrate one element of the Policy will result in failure of the complaint in its entirety. Accordingly, in light of the Panel’s findings in connection with the third element under the Policy, no good purpose would be served by addressing the issue of the Respondent’s rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The evidence in the case file as presented does not indicate that the Respondent’s aim in registering the disputed domain name was to profit from or exploit the Complainant’s trademark.

In the absence of any evidence suggesting that the Respondent acquired the disputed domain name at a later date, the date at which the question of registration in bad faith is assessed is the date of registration of the disputed domain name. [WIPO Overview 3.0](#), section 3.9. In this case, the date of registration of the disputed domain name is February 9, 2006.

A finding that a domain name has been registered and is being used in bad faith typically requires an inference to be drawn that the respondent has registered and is using such domain name to take advantage of its significance as a trademark owned by (usually) the complainant (see, for example: *British Airways Plc v. Softline Studios*, WIPO Case No. [D2023-2188](#)). It follows that the Complainant, on whom the burden of proof lies, must show on the balance of probabilities that when the Respondent registered the disputed domain name on February 9, 2006, it did so in the knowledge of and with intent to target the Complainant and/or its rights in the trademark concerned.

There is no evidence before the Panel as to the extent or reach of the Complainant's PALATINE trademark as at the date of registration of the disputed domain name (noting that its EPALATINE trademark was not registered until some three years later). As far as the Panel can tell, the Complainant did not adopt the name Banque Palatine within its French business until late 2004 to early 2005. The extract from the Complainant's website (Complainant's Annex 5) states "1971 - Banque Vernes and Banque Commerciale de Paris merged their organizations to form Banque Vernes & Commerciale de Paris (BVCP), which would subsequently become Banque SanPaolo in 1988 and Banque Palatine in 2005".

The Complainant's French registered trademark for the word mark PALATINE was registered on September 22, 2004. Its corresponding French domain name, <palatine.fr>, was registered on October 13, 2004. Its EPALATINE mark and corresponding domain name were not registered until 2009. It is not known when the Complainant began to use the name internationally. There is no evidence suggesting that the Respondent, an individual based in Indiana, United States, would have been aware of the Complainant's French PALATINE trademark when it registered the disputed domain name in 2006, and even if it was aware this fact would not obviate the pattern of the Respondent's portfolio.

The Respondent asserts that it was unaware of the Complainant when it registered the disputed domain name. This assertion is reasonably plausible on the basis of the present record. The Respondent explains that the disputed domain name was registered for use as part of a network of domain names and websites providing an online advertising service linked to the geographical areas named in the domain names. The Panel is aware from its own knowledge that such directory services were popular on the Internet in the early 2000s, prior to the rise in availability and widespread adoption of Internet search engines.

The Respondent did not produce unmasked Whois records for the 108 domain names listed in its Annex 1, being a list of domain names which it claimed to have registered featuring the "e" prefix coupled with a geographic location (mainly if not exclusively in the United States as far as the Panel can tell) in the ".com" generic Top-Level Domain ("gTLD"). Consequently, the Panel conducted Whois lookups in respect of a representative sample of some 20 of these domain names, randomly selected, and noted that they all appeared to be assigned to the same registrar of record (the Registrar), were assigned to the same nameservers, and were all registered on February 9, 2006, being the same day as the registration date of the disputed domain name. Restricted contact details were disclosed in several of the examples, which indicated that the registrant was an undisclosed individual in Indiana, United States. Based upon the outcome of this research, the Panel is prepared to accept the Respondent's submission that it registered the disputed domain name as part of a pattern of geographic domain names intended for its online advertising business.³ The genuine, non-pretexual nature of that business is also supported by the Respondent's screenshot of what it says is the pre-2009 advertising landing page for the disputed domain name, and its "Link U Want ad Builder Design Studio" where users could build advertisements of various pixel sizes for hosting on its network of websites.

Accordingly, the evidence as a whole tends to suggest that the Respondent did not register the disputed domain name in the knowledge of the Complainant's rights nor with intent to target these. While this would be sufficient to dispose of the Complaint, the Respondent goes further in terms of offering to prove that it adopted the geographic term "Palatine" in the manner of the disputed domain name at a much earlier date,

³With reference to the Panel conducting independent research of publicly available sources, see the [WIPO Overview 3.0](#), section 4.8. The Panel considered putting its findings to the Parties and decided not to do so as it regards these as largely non-controversial Whois lookups, and considers that this would have unduly delayed the proceeding.

namely from the date of registration of its domain name <palatinerealty.com> on February 22, 2004 (erroneously listed by the Respondent in its list of annexes as February 9, 2004). Such use, if demonstrated, predates the Complainant's registered trademarks and/or domain names corresponding to the PALATINE mark.

With regard to <palatinerealty.com>, the Panel again noted that the Respondent did not provide an unmasked Whois record for such domain name. Nevertheless, the Panel can see from the supplied Whois record that this particular domain name is held in a similar way to the others listed by the Respondent, namely the same Registrar and nameservers, coupled with an undisclosed registrant contact in Indiana, United States. Furthermore, the domain name concerned follows a pattern asserted by the Respondent of geographic area + trade, in the ".com" space.

The Panel decided to consult the Internet Archive "Wayback Machine" in respect of this particular domain name, with a view to determining whether there is any clear or obvious link between the domain name and the Respondent's alleged advertising business at or around the material date. The archived entry for June 6, 2004 in respect of this domain name shows that it was using an HTTP 302 response at crawl time redirecting to the domain gateway for the Respondent's "www.linkuwant.com" business, thus confirming the Respondent's interest in the term "Palatine" at the material date. In these circumstances, the Panel accepts on the balance of probabilities the Respondent's assertion that it was using the term "Palatine" in a domain name before any of the Complainant's trademark rights came into being.

With regard to the present use of the disputed domain name, namely that it has been offered for general sale, the Panel finds no evidence that this activity was targeted to the Complainant or a competitor thereof along the lines of paragraph 4(b)(i) of the Policy. The earliest date that the disputed domain name was offered for sale, as far as the Complainant has been able to identify, is 2011. This corresponds to the Respondent's submission that it began to offer the disputed domain name and others in its portfolio for general sale following a downturn in the economy in 2009. There is no evidence before the Panel tending to suggest that this was the Respondent's primary purpose (and that in so doing, it had the Complainant or a competitor of the Complainant in its sights) when it registered the disputed domain name in 2006.

The Panel finds the third element of the Policy has not been established.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Andrew D. S. Lothian/

Andrew D. S. Lothian

Sole Panelist

Date: July 23, 2024