Panel Decision for dispute CAC-ADREU-006413

Case number	CAC-ADREU-006413
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Domain names	irbsc.eu

Case administrator

Lada Válková (Case admin)

Complainant

Organization	Royal Bank of Scotland PLC

Respondent

Organization	Navilive Private Limited

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is not aware of any other legal proceedings which are pending or decided that relate to the disputed domain name.

FACTUAL BACKGROUND

1. The Royal Bank of Scotland public limited company, (Company number 90312) is a company incorporated in Scotland. The Royal Bank of Scotland is an international banking and financial services company, widely known by its name RBS.

2. The Royal Bank of Scotland Group public limited company owns numerous trade mark registrations for RBS around the world, including Community trade mark number 97469, registered on 23 March 1998 for goods and services in classes 9, 16, 35, 36 and 42.

3. The Complainant has a large number of domain name registrations incorporating its trade mark RBS. The Complainant's official website operates under the domain name rbs.com.

4. The disputed domain name irbsc.eu (Domain Name) was registered on 22 February 2012. The expiry date of the Domain Name is 28 February 2013 and its status is currently shown as 'On Hold'.

5. The Domain Name previously resolved to a page featuring the Complainant’s RBS trademark and displaying contents related to financial services and as well as a log in feature seeking Account number and Account pin.

6. On 31 October 2012 the Complainant sent the Respondent a cease and desist letter and requested the voluntary transfer of the domain name. No response was received to this or to a follow up email.

A. COMPLAINANT

In summary the Complainant contents that:
A. Identical or confusingly similar
The dominant part of the domain name irbsc.eu, comprises the term RBS, which is identical to the Complainant's trade mark RBS.

The Complainant owns trade mark registrations for RBS around the world and uses RBS in domain names that are registered in numerous countries around the world.

The Domain Name is confusingly similar to the Complainant’s trademark RBS. The fame of the trade mark has been confirmed in numerous previous UDRP decisions including WIPO Case No. D2002-0155, D2001-0626 and NAF case no: 660550, 728805 671079, 787945, 813065, 849147, 986696, 992134, 1045991, 1106036, 1128875, 1189004, and 1199346.

The addition of the prefix “i” and the suffix “c” has no impact on the overall impression of the dominant part of the name, RBS which is instantly recognizable as a world famous trade mark. The suffix and prefix strengthen the impression that the domain name belongs to, or is affiliated with the Complainant and is confusingly similar with the Complainant’s trade mark.

The Complainant submits that anyone who sees the Domain Name is bound to mistake it for a name related to the Complainant. The likelihood of confusion includes an obvious association with the trade mark of the Complainant. With reference to the reputation of the trade mark RBS there is a considerable risk that the public will perceive the Respondent’s Domain Name either as a domain name owned by the Complainant or that there is some kind of commercial relationship between the Respondent and the Complainant.

By using the Complainant's trademark as a dominant part of the Domain Name, the Respondent exploits the goodwill and the image of the trademark, which may result in dilution and other damage for the Complainant’s trademark.

B. Registered by the Respondent without rights or legitimate interests

The Respondent has no rights or legitimate interest in the Domain Name.

The Respondent registered the domain name on 22 February, 2012, but the mere registration of a domain name does not give the owner a right or a legitimate interest in respect of the Domain Name.
There is no evidence that the Respondent has registered a trade mark or that the Respondent is commonly known by the Domain Name. The Respondent has not established rights or legitimate interests in the Domain Name.

The Respondent has used the Domain Name to pass itself off as the Complainant in order to defraud the Complainant’s customers through a website identical to the Complainant’s. The Respondent used the Domain Name to “phish” for financial information in an attempt to defraud the Complainant’s customers. The Respondent’s attempt to pass itself off as the Complainant and “phish” for customers’ financial information is neither a bona fide offering of goods or services, nor a legitimate non-commercial or fair use.

C. Registered or used in bad faith

The Complainant asserts that:

The Respondent has registered and used the Domain Name in bad faith.

The trade mark RBS is a famous trade mark with a substantial and widespread reputation throughout the world in respect of financial services.

The awareness of the trade mark RBS is significant and substantial and that there is considerable value and goodwill in the trade mark RBS.

When the Respondent registered the Domain Name it was aware of the rights which the Complainant has in the RBS trade mark and of its value. The Complainant submits that this is what made the Respondent register the Domain Name.

There is no connection between the Respondent and the Complainant. The Complainant sent the Respondent a cease and desist letter, informing the Respondent that the use of the RBS trade mark within the Domain Name was not authorized and that it violated the Complainant’s rights in its trade mark, RBS. The Complainant requested a voluntary transfer of the Domain Name, but despite reminders the Complainant received no response.

The Respondent used the Domain Name to engage in a phishing scam using the Complainant’s registered trade mark, RBS to deceive the Complainant’s customers and manipulate them into divulging sensitive financial information.

The web site is currently not active but it is still “in the hands” of the Respondent and the Complainant will not be able to rest until the Domain Name is removed entirely. Even if the website is currently inactive, such passive holding could still constitute an act of bad faith and any realistic use of the Domain Name by the Respondent would constitute “passing off” and/or trademark infringement.

B. RESPONDENT

The Respondent did not file a Response.

DISCUSSION AND FINDINGS

Procedural History

1. The original Complaint, dated 14 December 2012, named EURid as the Respondent and identified the domain name holder (the registrant) as the registrar. The ADR Centre notified the Complainant of deficiencies in the Compliant on 9 January 2013.

2. The amended Complaint was filed on 10 January 2013 by a representative of Melbourne IT DBS as the Complainant's representative.

3. Under the Paragraph B1 (b) (15) of the ADR Rules, the Complaint is required to be signed by the Complainant or its authorized representative. The Power of Attorney filed with the Complaint authorising Melbourne IT DBS in the UK to act as it representative expired on 31 December 2012.

4. On 26 April 2013 the Panel made a request under paragraph 8 of the ADR Rules which:

(i) requested further information from the Complainant
(ii) directed that the Respondent be given 7 days from the date of delivery of the Complainant's submission within which to make a submission in response; and
(iii) directed that the Panel file the decision within seven (7) days of the Respondent's submission or within seven (7) days after the period for its submission has ended.

5. On 2 May 2013 the Complainant filed a Non-Standard Communication of which:

(i) Annex 1 states:

'AMENDMENT Case Number 06413
Notice of Change in Registrant Information
The Complainant in the above referenced proceeding was originally named 'The Royal Bank of Scotland PLC'. The term 'Group' was accidently left out from the name of the Complainant in the filed Complaint. The Complainant would like to make the following amendment concerning the identity of the Complainant:
Legal Entity: The Royal Bank of Scotland Group Plc.'

(ii) Annex 2 sets out a list of Melbourne IT DBS office locations, including its address in Sweden which is the Complainant's Representative's address set out in the Complaint.

(iii) a new Power of Attorney was referred to as being attached to the Complainant's Non-Standard Communication.

6. On 5 May 2013 the Case Administrator notified the Complainant that no Power of Attorney was attached it its Non-Standard Communication dated 2 May 2013.

7. On 10 May 2013, the Complainant filed a further Non-Standard Communication to which was annexed a Power of Attorney, appointing Melbourne IT Digital Brand Services to act on The Royal Bank of Scotland Group plc's behalf on domain name dispute resolution and recovery until 31 December 2013.

8. Regarding the Complainant's submission on the error in the Complainant's name, the Complaint is treated as having been made by joint Complainant's, the Royal Bank of Scotland plc and The Royal Bank of Scotland Group plc.

9. The Panel is satisfied that the Provider has used reasonable available means to achieve actual notice of the Complaint to the Respondent. The Panel is further satisfied that in accordance with Art. 2 (b) of the ADR Rules the Provider has discharged its obligation to achieve actual notice of the Complaint to the Respondent.

Discussions and findings

The Panel is obliged under Rule 11(a) of the ADR Rules to decide a Complaint on the basis of the statements and documents submitted and in accordance with the ADR Rules, the Supplemental ADR Rules and Regulations 733/2002 and 874/2004.

Article 22 of Commission Regulation (EC) number 874/2004 ('the Regulation') provides that an ADR procedure may be initiated by any party where the registration is speculative or abusive within the meaning or Article 21.

Under Article 21 of the Regulation, a registered domain name shall be subject to revocation where the name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or community law and where:

(a) it has been registered by its holder without rights or legitimate interest in the name; or

(b) it has been used in bad faith.

Once the Complainant has established that the Domain Name is identical or confusingly similar to a name in respect of which a Right is recognised or established by national law of a member state and/or Community law, the Complainant has only to prove one of the elements set out in Article 21 1.(a) or (b), namely, that it is registered without rights or legitimate interests in the name or has been registered or used in bad faith.

The Respondent has not filed a Response. Under Article 22(10) of the Regulations, failure of any of the parties involved in an ADR proceeding to respond within the given deadlines may be considered grounds for accepting the claims of the other party. Rule 10(a) of the ADR Rules states that in the event of a default, the Panel shall proceed to a decision and may consider the failure to comply as grounds to accept the claims of the other party. Under Rule 10(b) of the ADR Rules, the Panel shall draw such inferences from a default as it considers appropriate.

RIGHTS

The Domain Name consists of letters 'irbsc' plus the addition of the suffix .eu. It is accepted practice to ignore the .eu suffix when determining whether the disputed domain name is identical or confusingly similar to a name in respect of which a right is recognised or established by national or Community law.

Rights that can be asserted in respect of a name include national and Community trade marks, unregistered trade marks, trade names, business identifiers and company names (Article 10 (1) of the Regulation).

The Royal Bank of Scotland Group plc holds an extensive portfolio of trade mark registrations throughout the world for the mark RBS, including CTM number 97469, registered on 23 March 1998 in respect of goods and services in classes 9, 16, 35, 36 and 42. RBS is a well-known brand throughout the world in connection with banking and financial services.

Determining whether the Domain Name is identical to a name in respect of which the Complainant has Rights needs to be viewed in context. The likelihood of confusion should consider all the surrounding circumstances.

Viewed in isolation RBS may not be instantly recognisable as the dominant part of the Domain Name. However, the Doman Name linked to a website which featured the Complainant's trade mark RBS and was being used to 'phish' for customer information. In this context the letters 'RBS' take on greater significance and are an influential feature of the Domain Name.

The Complainant submits that the addition of the prefix 'i' and the suffix 'c' to the RBS trade mark to form the Domain Name does not detract from the overall impression that the Domain Name is connected to the Complainant and is confusingly similar to its RBS trade mark. In not filing a response the Respondent has chosen not to challenge the Complainant's submission.

In the overall assessment of the Domain Name, the letters 'RBS' are dominant within the Domain Name in that visitors to the website are likely to pay more attention to the letters 'RBS' in connection with the banking services that appear to be offered via the website using the Domain Name.

As stated by the Panel in Royal Bank of Scotland v Arbechay, Adalbrecht Engelbert (<rbs-lines.com> D2012-0665) 'In the Panel’s view, the owner of a well-known trademark does not have to tolerate to be brought into connection with an individual or legal entity with which it has no connection. This rule is also valid for ordinary trademarks, but the risk of an indirect connotation is heightened by the fame surrounding a well-known trademark.

Considering all the surrounding circumstances, the Panel finds that the Domain Name is confusingly similar to a name in respect of which a right is recognised or established by national and/or community law.

NO LEGITIMATE INTERESTS

In the absence of a Response or any evidence showing a legitimate interest or fair use of the Domain Name by the Respondent, the Panel finds that the Respondent had no rights or legitimate interests in the Domain Name.

BAD FAITH

Having determined that the Respondent has no rights or legitimate interest in the Domain Name it is not necessary to determine whether it has been registered in bad faith as alleged by the Complainant. However, for completeness it is proposed to address this issue.

Under Article 21(3)(d) of the Regulations, bad faith may be demonstrated in a number of ways, including where:
" the domain name was intentionally used to attract Internet users, for commercial gain to the holder of the domain name website… by creating a likelihood of confusion with a name on which a right is recognised or established by national or Community law,… such likelihood arising from the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the holder of the domain name ”

The Respondent used the Domain Name to engage in 'phishing' using the Complainant’s registered trade mark, RBS to deceive the Complainant’s customers and manipulate them into divulging sensitive financial information. Although the website is currently inactive and the Doman Name is 'on hold' the Respondent has given no assurances it will refrain from using the Domain Name in a way which suggests and affiliation with the Complainant or the RBS brand.

The Panel finds, on the evidence submitted, that the Domain Name was used to attract internet users for commercial gain by creating a likelihood of confusion with a name in which a right is recognised or established by national or Community Law as set out in Article 21 3. (d) of the Regulation.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the Domain Name IRBSC be transferred to the Complainant, The Royal Bank of Scotland Group plc.

PANELISTS

Name	**Veronica Marion Bailey**

DATE OF PANEL DECISION 2013-04-23

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: irbsc.eu

II. Country of the Complainant: GREAT BRITAIN, country of the Respondent: GREAT BRITAIN

III. Date of registration of the domain name: 22 February 2012

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision is CTM, reg. No. 97469, for RBS, registered on 23 March 1998 in respect of goods and services in classes 9, 16, 35, 36 and 42

V. Response submitted: No

VI. The Domain Name is confusingly similar to the protected rights of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. No
2. Why:The Respondent did not file a Response and there is no evidence to suggest a legitimate use of the Doman Name.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why:The Respondent used the Domain Name to suggest a connection with RBS in order to obtain RBS customers' account number and account pin details. The Respondent is not authorised to use the RBS trade mark and has no connection with the Complainant. The Domain Name was used to attract internet users for commercial gain by creating a likelihood of confusion with a name in which a right

is recognised or established by national or Community Law as set out in Article 21 3.(d) of the Regulation.

IX. Other substantial facts the Panel considers relevant: None

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant:
1. The original Complaint, dated 14 December 2012, named EURid as the Respondent and identified the domain name holder (the registrant) as the registrar. The Provider notified the Complainant of deficiencies in the Complaint.

2. On 10 January 2013 the amended Complaint was filed by a representative of Melbourne IT DBS as the Complainant's representative. The Complainant's name was shown as 'Royal Bank of Scotland plc, Royal Bank of Scotland plc, Royal Bank of Scotland plc'.

3. Under the Paragraph B1 (b) (15) of the ADR Rules, the Complaint is required to be signed by the Complainant or its authorized representative. The Power of Attorney filed with the Complaint authorising Melbourne IT DBS to act as The Royal Bank of Scotland Group PLC's representative had expired on 31 December 2012.

4. On 26 April the Panel made a request under paragraph 8 of the ADR Rules for further information from the Complainant. The Respondent was given 7 days in which to respond to any further submission made by the Complainant and the Decision date was postponed until that period had expired.

5. On 2 May 2013 the Complainant filed a Non-standard communication seeking to amend the name of the Complainant to The Royal Bank of Scotland Group PLC.

6. On 10 May 2013, the Complainant filed a new Power of Attorney valid until 31 December 2013, appointing Melbourne IT Digital Brand Services to act on behalf of The Royal Bank of Scotland Group plc's for domain name dispute resolution and recovery.

XII. Is Complainant eligible? Yes