Panel Decision for dispute CAC-ADREU-006623

Case number	CAC-ADREU-006623
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Domain names	bankofamericacorp.eu

Case administrator

Lada Válková (Case admin)

Complainant

Organization	Bank of America Corporation

Respondent

Name	Oksana Lonu

FACTUAL BACKGROUND

The Complainants, Bank of America Corporation and Merrill Lynch International, contest the registration of domain name BANKOFAMERICACORP.EU (hereinafter "the Disputed Domain Name"). The Disputed Domain Name was registered by Oksana Lonu ("the Respondent") on June 27, 2013. Thereafter, the registrar of the Disputed Domain Name, GoDaddy Software, Inc., has suspended the Disputed Domain Name on November 15, 2013. A WHOIS report thereof concluded that the Disputed Domain Name was suspended for spam and abuse. The Complainants filed a complaint regarding the Disputed Domain Name on November 19, 2013.

Jonas Gulliksson was appointed as a sole panelist on February 14, 2014 ("the Panel").

A. COMPLAINANT

The first Complainant, Bank of America Corporation ("the first Complainant"), is one the world's largest financial institutions, serving customers, from private individuals to large corporations, with a wide range of banking, investment, asset management and other financial services. The first Complainant has its head office in Charlotte, North Carolina, US, and a presence in at least 40 countries throughout the world, with offices in all of the major financial markets, and also on of the largest credit card issuers in the world. The second Complainant, Merrill Lynch International ("the second Complainant"), a wholly owned subsidiary of the first Complainant and user of the Bank of America Mark in the United Kingdom and other countries throughout the world under the authorization and supervision of the first Complainant, have had a presence in Europe since 1922. The second Complainant was incorporated in England and Wales in November 1988 under company No. 02312079, and has its registered office in London, UK.

The first Complainant is the proprietor of the trade mark BANK OF AMERICA in relation to a wide variety of goods and services, in particular banking and financial services. The first Complainant is also the proprietor or applicant throughout the world of the mark BANK OF AMERICA (words) including the following marks in the United Kingdom and the European Community:

1) UK Trade Mark Registration for the term BANK OF AMERICA, no. UK00001291406, filed on 29 October 1986, registered on

17 May 1991, in respect of goods and services in class 36.
2) UK Trade Mark Registration for the term BANK OF AMERICA, no. UK00002178103, filed on 24 September 1998, registered on 06 April 2001, in respect of goods and services in classes 9, 35, 36 and 38.
3) Community Trade Mark Registration, word, for the term BANK OF AMERICA, no. 000118588, filed on 01 April 1996, registered on 20 April 1998, in respect of goods and services in classes 9, 16 and 36
4) Community Trade Mark Registration, word, for the term BANK OF AMERICA, no. 000944009, filed on 23 September 1998, registered on 16 November 2000, in respect of goods and services in classes 9, 16, 35, 36 and 38.

There is a very high degree of similarity between the Disputed Domain Name and the first Complainant's marks. The Disputed Domain Name incorporates, in its entirety, the BANK OF AMERICA Marks. The addition of "corp" at the end of the Disputed Domain Name does not substantially differentiate the Disputed Domain Name from the first Complainant's BANK OF AMERICA Marks; it is merely a shortened version of "Corporation" to describe the nature of business entity. The first Complainant's full name is "Bank of America Corporation".

The Respondent's registration and use of the Disputed Domain Name dilutes and blurs the distinctiveness of the BANK OF AMERICA mark.

The Disputed Domain Name was registered by the Respondent on June 27, 2013, which was almost 27 years after the date of filing of the first Complainant's UK Trade Mark Registration no. UK00001291406.

The Disputed Domain Name's website was contended by numerous sponsored links related either to financial institutions or financial related products. The Respondent has only displayed a "parking page" with no signs of any preparation to offer such goods or services. No one of the sponsored links on the website relates to the Complainants, but in some cases they relate to direct competitors of the Complainants. This indicates that the Disputed Domain Name was registered primarily for the purpose of selling the Disputed Domain Name to the Complainants or extracting some other payment from the Complainants.

The Complainants can only assume the Disputed Domain name was used by the Respondent in a harmful way regarding Go Daddy Software's suspension. It is clear that the registration of the Disputed Domain Name was not made for a legitimate, bona fide purpose, and thereby was made in bad faith.

Therefore, the Disputed Domain Name is being used in a manner which has taken unfair advantage or has been unfairly detrimental to the first Complainant's rights.

In accordance with Article 4(2)(b) of Regulation EC No. 733/2002, the Complainants confirm that the second Complainant is eligible to be registered with the Disputed Domain Name as it is an undertaking with its registered office in the European Union.

B. RESPONDENT

The Respondent did not submit a response.

DISCUSSION AND FINDINGS

According to Article B11(d)(1) of the ADR Rules, the Panel shall issue a decision granting the remedies requested under the Procedural Rules in the event that Complainant proves in the ADR proceeding that:

(i) the domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or Community law and; either

(ii) the domain name has been registered by the Respondent without rights or legitimate interest in the name; or

(iii) the domain name has been registered or is being used in bad faith.

The Disputed Domain name incorporates the first Complainant's trade marks in its entirety and combines it with "Corp" in the end. "Corp" seems to be a shortened version of "corporation"; a term used in the end of the first Complainant's business entity. The Panel finds that the addition of such term to a distinctive trade mark does not, in this case, remove similarity between the trade mark and the Disputed Domain Name. Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the first Complainants' trade marks.

The Complainants have submitted that the Respondent registered the Disputed Domain Name without rights or legitimate interests and that it was registered in bad faith. The first Complainant's right to the trade marks predates the registration of the Disputed Domain Name by several years. The Complainants have made at least a prima facie case that the Respondent lacks rights and legitimate interests to the Disputed Domain Name and that it was registered in bad faith. The Respondent had an opportunity to respond to these allegations but has not responded. Therefore, the Panel finds that the Respondent has registered the Disputed Domain Name without rights or legitimate interests.

Furthermore, it is clear from the submitted evidence that the Disputed Domain Name was registered with no bona fide purpose. The website has contented both related sponsored links and has sent spam. The Respondent has therefore used the first Complainant's trade marks both to take advantage of the first Complainant's rights and in a harmful way. The Panel finds that this is sufficient evidence of use and registration of the Disputed Domain Name in bad faith.

To be an owner of an .eu TLD a Complainant would have its registered office, central administration or principal place of business within the Community in accordance with Article 4, paragraph 2 (b)(i) of Regulation (EC) 733/2002. The first Complainant does not possess the requisite legitimacy to be the owner of an .eu TLD. The Complainants have, however, stated that the second Complainant has rights to use the Bank of America Mark in the United Kingdom and other countries throughout the world. The second Complainant has its business within the Community. The Panel is of the opinion that the fact that the second Complainant is a wholly owned subsidiary of the first Complainant means that the prior trade mark rights of the parent company may be relied upon by the second Complainant.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the domain name BANKOFAMERICACORP.EU be transferred to the second Complainant.

PANELISTS

Name	**Jonas Gulliksson**

DATE OF PANEL DECISION 2014-02-18

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: BANKOFAMERICACORP.EU

II. Country of the Complainants: United States of America and Great Britain (UK), country of the Respondent: Great Britain (UK)

III. Date of registration of the domain name: 27 June 2013.

IV. Rights relied on by the Complainants (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:

1) UK Trade Mark Registration for the term BANK OF AMERICA, no. UK00001291406, filed on 29 October 1986, registered on 17 May 1991, in respect of goods and services in class 36.
2) UK Trade Mark Registration for the term BANK OF AMERICA, no. UK00002178103, filed on 24 September 1998, registered

on 06 April 2001, in respect of goods and services in classes 9, 35, 36 and 38.
3) Community Trade Mark Registration, word, for the term BANK OF AMERICA, no. 000118588, filed on 01 April 1996, registered on 20 April 1998, in respect of goods and services in classes 9, 16 and 36
4) Community Trade Mark Registration, word, for the term BANK OF AMERICA, no. 000944009, filed on 23 September 1998, registered on 16 November 2000, in respect of goods and services in classes 9, 16, 35, 36 and 38.

V. Response submitted: No.

VI. Domain name is confusingly similar to the protected rights of the Complainants

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):

1. No

2. Why: No response.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):

1. Yes

2. Why: Use of confusingly similar domain name to distract Internet users for commercial gain and to send spam.

IX. Other substantial facts the Panel considers relevant: None

X. Dispute Result: Transfer of the disputed domain name to the second Complainant.

XI. Procedural factors the Panel considers relevant: None

XII. Is Complainant eligible? Yes, but only the second Complainant.