Panel Decision for dispute CAC-ADREU-007039

Case number	CAC-ADREU-007039
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Domain names	ubscapitals.eu

Case administrator

Lada Válková (Case admin)

Complainant

Organization

Respondent

Organization	UBSCAPITALS LTD

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

No other legal proceedings concerning the disputed domain name are currently pending.

FACTUAL BACKGROUND

- The domain name <ubscapitals.eu> was registered by the Respondent on June 8, 2015.

- Barring error, the domain name at issue, ubscapitals.eu, does not currently correspond to any active website.

- The Complainant, UBS AG, invokes different Swiss, International and Community trademark registrations for UBS. It maintains that the Respondent has no rights or legitimate interest in the domain name at issue and has acted in bad faith in registering it.

- The Respondent failed to provide its Response.

A. COMPLAINANT

The Complainant is one of the largest financial services firms in the world, present in all major financial centres worldwide, with offices in more than 50 countries, including, in particular, Switzerland, Germany, France, United States, Brazil and Argentina, China and Japan, Australia and South Africa, to name only a few. The Complainant employs about 60,000 people around the world; about 35% of its employees are working in America, 36% in Switzerland, 17% in the rest of Europe, the Middle East and Africa and 12% in Asia Pacific. The Complainant's services comprise, in particular, the following business divisions: Wealth Management, Wealth Management Americas, Retail & Corporate, Global Asset Management and the Investment Bank. The shares of the Complainant are listed on all major stock exchanges in the world, including the SIX Swiss exchange (Zurich, Switzerland), the New York Stock Exchange (NYSE), CAC 40 (Paris, France), DAX (Frankfurt, Germany), Dow Jones (New York, US), EURO STOXX (Zurich, Switzerland), Hang Seng (Hong Kong, China), NASDAQ 100 (New York, US), SMI (Zurich, Switzerland) and DJ Stoxx 50 (Zurich, Switzerland). The Complainant's operating income has been over 25 billion CHF in the year 2011 until 2013.

Accordingly, the Complainant's company name <UBS> is protected worldwide by many trademark registrations since many decades for the whole range of financial services as well as related services, for instance:

– Swiss trademark no. 510104 <UBS>, filed on November 11, 2002, and international trademark no. 803311 <UBS>, filed on May 7, 2003, on the basis of the Swiss trademark no. 510104, covering each, inter alia, insurances, financial and banking services and, in addition to Switzerland, 78 countries, see copy of the database of the German Patent and Trademark Office of September 7, 2015;

– Swiss trademark no. 451007 <UBS> + device, filed on April 1, 1998 and community trademark <UBS> + device 895003 filed on July 29,

1998, claiming priority of the Swiss trademark no. 451007, covering each, inter alia, insurances, financial affairs, monetary affairs, real estate affairs, see copy of the database of the German Patent and Trademark Office of September 7, 2015;

– Swiss trademark no. 497073 <UBS Global Asset Management>, registered on December 20, 2001, and international registration no. 802565 <UBS Global Asset Management> filed on April 24, 2003, on the basis of the Swiss trademark covering, inter alia, insurances, financial affairs and banking; services in the field of investment management; asset management, real estate business, and, in addition to Switzerland, 85 countries, see copy of the database of the German Patent and Trademark office of September 7, 2015.

– Additionally, the Complainant owns international trademark no. 700406 <UBS Capital>, registered on August 13, 1998, covering, inter alia, insurances, financial, banking and stock exchange and monetary affairs services, including brokerage, and, in addition to Switzerland, 13 countries, see copy of the database of the German Patent and Trademark Office of September 7, 2015.

The trademark <UBS> is famous worldwide, in particular in the EU. This has been recognized e.g. by the WIPO in many UDRP decisions, cf. e.g. UBS AG v. has book publishers, Inc., D2001-0637 and D2001-0639 (WIPO June 29, 2001) ("The panel comes to this view because of the fame of the mark 'UBS' in a banking context."); UBS AG v. Updated Business Solutions Ltd., D2002-0958 (WIPO Dec. 6, 2002) (where the panel referred to "the fame of the Complainant and its UBS marks"); UBS AG v. G.A.S. Ltd., D2006-1181 (WIPO Nov. 10, 2006); and UBS AG v. James Boros / UBSCAPITALS Ltd., on the domain <ubscapitals.com>.

The Respondent has registered the domain name <ubscapitals.eu> on June 8, 2015. This domain name resolves to a web site which offers financial, banking and brokerage services,

Prior to the present dispute, the Respondent's organization, UBSCAPITALS LTD, had registered the domain name <ubscapitals.com>, which has been transferred to the Complainant according to a Forum Decision dated May 27, 2015 for bad faith registration and use according to the UDRP Policy.

Legal contentions

1. Confusing similarity
Article 21(1) of Regulation (EC) No. 874/2004

The domain name <ubscapitals.eu> is confusingly similar to the trademark <UBS>, as the term "capitals" is only generic, leaving only "UBS" as non-generic part, see LEGO Juris a/s v. Milton Alfredo, WIPO case no. D2012-1992; Grupo Televisa, SA v. registrant info@fashionid.com, WIPO case no. D2003-0735; British Broadcasting Corporation v. registrant (187640) info@fashionid.com, WIPO case no. D2005-1143.

Further, the gTLD ".eu" does nothing to create a different overall impression, cf. Trip Network Inc. v. Alviera, FA 914943 (Nat. Arb. Forum Mar. 20, 2007).

Furthermore, the disputed domain name is nearly identical to the trademark <UBS CAPITAL>, as the use of the lower case letter format in the domain name, elimination of the space between words and addition of the letter "s" at the end of the name are differences without legal significance from the standpoint of comparing the disputed domain name with the Complainant's trademark, cf. Keystone Publ'g., Inc. v. UtahBrides.com, D2004-0725 (WIPO Nov. 17, 2004) (finding that utahwedding.com was confusingly similar to the complainant's UTAHWEDDINGS.COM trademark in spite of the trivial omission of the letter "s"); Am. Eagle Outfitters, Inc. v. Admin, FA 473826 (WIPO Nat. Arb. Forum June 22, 2005) (finding that americaneaglestores.com as domain name is confusingly similar to the complainant's AMERICAN EAGLE OUTFITTERS trade mark).

Therefore, the requirement of Article 21(1) of Regulation (EC) No. 874/2004 is met.

2. No rights or legitimate interests
Article 21(1)(a) of Regulation (EC) No. 874/2004

The Respondent has neither rights nor legitimate interests in the domain name <ubscapitals.eu>. The Respondent has no trademark or similar intellectual property rights to the name "UBSCAPITALS" or "UBS". The Respondent is no licensee of the Complainant, nor does the Respondent have any other commercial or non-commercial connections to the Complainant. The Respondent is not making a bona fide offering of goods or services, nor is his domain name protected as fair use, as the only use of the domain name is to create the impression of a connection between the Respondent and the Complainant: Prior to the UDRP action on <ubscapitals.com>, the organization owning the disputed domain name used the name UBS (without "capitals") and even the UBS logo on the website under the

previous domain name <ubscapitals.com> and falsely claimed to be partnered with the Complainant. The website under the disputed domain name still offers services under the Complainant's <UBS> trademark (without "capitals"), e.g. "UBS premium account".

The organization owning the disputed domain name has not seriously used and is not using in a serious manner the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so. This becomes obvious when considering that the English text under the website contains Russian phrases, which obviously by negligence have been omitted from translation ("Все Счета", meaning "All Accounts" in English), cf. e.g. copy of the section "Accounts/Classic" of the website <ubscapitals.eu>).

Therefore the requirement of Article 21(1)(a) is met.

3. Bad faith
Article 21(1)(b), (3)(d) of Regulation (EC) No. 874/2004

Additionally, the Respondent has engaged in bad faith registration and use. By, as stated above, using the disputed domain name to give Internet users the impression that the Respondent is partnered with the Complainant, the Respondent has created a likelihood of confusion, and is likely receiving commercial profit as a result.

The Respondent's bad faith registration becomes even more obvious when considering the fact that, according to the eurID WHOIS search, he is claiming his address to be the same as the Complainant's.

Further, there is no contact or imprint page on the organization's website; the website does not indicate any address, postal or email or telephone to contact the Respondent, cf. copy of the webpage.

In addition, on the Respondent's website, the Respondent adds to the confusion of internet users by promoting their own services as e.g. "UBS premium account" or "UBS platinum account" instead of using the alleged company name UBSCAPITALS.

There is no plausible explanation for why "UBS" was chosen by the Respondent as domain name and alleged business identifier other than the intention to mislead internet users into assuming a commercial affiliation between the Complainant and the Respondent's organization. "UBS" is not a vocabulary word and is by no standard a common or natural way of combining the letters, cf. Reuters Ltd. V. Teletrust IPR Ltd., D2000-0471 (WIPO Sept. 8, 2000).

In summary, registration and use in bad faith is obviously established when considering all relevant factors in this case in the aggregate:

- the Complainant's <UBS>-trademarks and company name were registered and used decades before the registration of the disputed domain name;

- the Complainant's <UBS>-trademarks and company name are famous worldwide;

- the <UBS>-trademarks and company name are distinctive and have no relevant inherent meaning or significance and the website on the disputed domain name does not show any meaning or significance as an abbreviation for any different term;

- the organization owning the disputed domain name has in the past owned a domain name only differing in the gTLD, that was found to be registered in bad faith, and registered the disputed domain name two weeks after the former domain name had been found to be registered and used in bad faith;

- the organization owning the domain name used on their former website the unaltered name and trademark of the Complainant, including the famous logo.

Each of these factors is supportive of a conclusion of bad faith registration and all these factors, considered in the aggregate, are conclusive for the finding of bad faith use and registration, cf. e.g. Clarins v. André Schneider / DomCollect AG, WIPO case no. D-2014-0595).

It is inconceivable under these circumstances that the Respondent was unaware of the Complainant's <UBS>-trademarks and company name and its goodwill when registering the domain name and that the Respondent, by using the domain name, aims at something else than tarnishing and misleadingly using the Complainant's brand in order to eventually make a profit from the Complainant's brand

reputation.

B. RESPONDENT

The Respondent did not reply to the complaint.

DISCUSSION AND FINDINGS

When regulating ADR proceedings article 22 (10) Regulation (EC) No. 874/2004 states the following:

"Failure of any of the parties involved in an ADR procedure to respond within the given deadlines or appear to a panel hearing may be considered as grounds to accept the claims of the counterparty."

The fact that the Respondent did not submit a reply could lead directly to acceptance of the Complainant's claims. However, in the interest of equity, the undersigned panelist will reach his decision after assessing the circumstances surrounding the case.

Pursuant to Paragraph 11 (d)(1) of the .eu Alternative Dispute Resolution Rules, the Panel shall grant the remedies requested if the Complainant proves "in ADR Proceedings where the Respondent is the holder of a .eu domain name registration in respect of which the Complaint was initiated 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."

1. Domain name identical or confusingly similar to a name in respect of which a right is recognized.

The Complainant invokes several trademark registrations in Switzerland which in principle may not be taken into account as bases for the Complaint. However, it has proved that it is also the owner of a number of international trademarks with effects in numerous member states of the European Union and, similarly, of various Community trademarks consisting of the signs UBS, UBS logo, UBS Global Asset Management and UBS CAPITAL.

It is evident that the contested domain name, <ubscapitals.eu>, is confusingly similar to the Complainant's principal mark, UBS, and also to its UBS CAPITAL mark.

The Panel therefore considers that the first of the requirements for the Complaint to be accepted is met.

2. Absence of Rights or Legitimate Interest

The Respondent has not submitted any reply. Therefore, it has submitted no information on possible rights or legitimate interests it might hold. On its part, the Complainant has submitted information and arguments which allow it to be reasonably assumed that the Respondent has no rights or legitimate interest in the name in dispute since the name clearly corresponds to the Complainant's UBS and UBS CAPITAL marks.

As the WIPO Arbitration and Mediation Center pointed out in UDRP case No. D2002-0856:

"As mentioned above in section 3, the Respondent has not filed a Response and is therefore in default. In those circumstances when the Respondent has no obvious connection with the disputed Domain Names, the prima facie showing by the Complainant that the Respondent has no right or legitimate interest is sufficient to shift the burden of proof to the Respondent to demonstrate that such a right or legitimate interest exists. WIPO Case No. D2002-0273 <sachsen-anhalt>; WIPO Case No. D2002-0521 <volvovehicles.com>"

The fact that the Respondent's name is apparently UBSCAPITALS LTD could give rise to doubts as regards the absence or presence of a legitimate interest, as that corporate name matches the disputed domain name. However, the Complainant has provided sufficient prima facie evidence that the Respondent does not appear to carry on any legitimate business activity under that name. Furthermore, the Complainant has shown that, prior to the present dispute, the Respondent's organization, UBSCAPITALS LTD, had registered the domain name <ubscapitals.com>, which has been transferred to the Complainant pursuant to a Forum Decision dated May 27, 2015 for bad faith

registration and use according to the UDRP Policy.

The Panel therefore considers that the Respondent has not evidenced legitimate rights.

3. Bad Faith

The Complainant has clearly proved its right to the contested name, whereas the Respondent has not given any kind of reason for having adopted it. The Complainant has also proved that its UBS marks are well-known, as recognized by WIPO in several UDRP decisions.
As previously mentioned, the Complainant has shown that, prior to the present dispute, the Respondent's organization, UBSCAPITALS LTD, had registered the domain name <ubscapitals.com>, which has been transferred to the Complainant pursuant to a Forum Decision dated May 27, 2015 for bad faith registration and use according to the UDRP Policy.

From the foregoing it may be gathered that the Respondent has engaged in a pattern of conduct which may without doubt be regarded as amounting to bad faith and is, indeed, specifically included among the circumstances denoting bad faith listed in Paragraph 11(f)(2)(i) of the ADR Rules.

The Complainant has submitted copies of pages from the Respondent's website which reveal an intention to create confusion with the Complainant. Currently, however, the website has no content, as has previously been mentioned.

It is also to be noted that in the particulars of the domain name the address of the Respondent is given as Zurich, Austria (sic). This might simply be a mistake, but it could also reflect a deliberate attempt to forge a false association with the Respondent, which does have its place of business in Zurich, Switzerland.

The Panel therefore considers it proved that the Respondent acted in bad faith when registering the contested domain name.

4. As to the remedies requested

Article 22(11) of Commission regulation No. 874/2004 states that in the case of a procedure against a domain name holder, the ADR panel shall decide that the domain name shall be revoked if it finds that the registration is speculative or abusive as defined in Article 21. Furthermore, the domain name is to be transferred to the complainant if the complainant applies for it and satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002.

To satisfy those general eligibility criteria the Complainant must be one of the following:

1. an undertaking having its registered office, central administration or principal place of business within the European Community;

2. an organisation established within the European Community without prejudice to the application of national law; or

3. a natural person resident within the European Community.

In this case the Complainant requests that the contested domain name be transferred to it. However, the Complainant is a Swiss company and has not supplied any evidence to the Panel indicating that it satisfies any of the requirements laid down in Article 4(2)(b) of Regulation (EC) No 733/2002. Consequently, in accordance with article 22, the domain name may not be transferred but only revoked.

DECISION

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

the domain name UBSCAPITALS be revoked

PANELISTS

Name	**Luis de Larramendi**

DATE OF PANEL DECISION 2015-12-21

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: UBSCAPITALS.EU

II. Country of the Complainant: Switzerland, country of the Respondent: Austria

III. Date of registration of the domain name: 8 June 2015.

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. UBS (word) international trademark registered in many countries of the European Union reg. No. 803311, registered on 7 May 2003 in respect of goods and services in classes 3, 6, 9, 11, 12, 14, 15, 16, 18, 20, 21, 24, 25, 27, 28, 30, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45.
2. UBS (fig) CTM, reg. No. 895003, filed on 29 July 1998, registered on 16 July 2004 in respect of goods and services in classes 9, 14, 36, 38 and 42.
3. UBS Global Asset Management (word) international trademark registered in many countries of the European Union reg. No. 802565, registered on 24 April 2003 in respect of services in class 36.
4. UBS CAPITAL (word) international trademark registered in many countries of the European Union reg. No. 700406, registered on 13 August 1998 in respect of services in class 36.

V. Response submitted: No

VI. Domain name is confusingly similar to the protected right/s of the Complainant

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

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: no response submitted. Pattern of conduct.

IX. Other substantial facts the Panel considers relevant: false contact information

X. Dispute Result: Revocation of the disputed domain name

XI. Procedural factors the Panel considers relevant:

XII. [If transfer to Complainant] Is Complainant eligible? No