Panel Decision for dispute CAC-ADREU-007248

Case number	CAC-ADREU-007248
Time of filing	2016-12-15 09:33:57
Domain names	rbsbourse.eu

Case administrator

Aneta Jelenová (Case admin)

Complainant

Organization	The Royal Bank of Scotland Group Plc

Respondent

Name	Eric Musquar

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 other legal proceedings, pending or decided, which relate to the disputed domain name.

FACTUAL BACKGROUND

The Complainant was founded in Edinburgh by Royal Charter in 1727 and is one of the oldest banks in the United Kingdom. It was incorporated as a public limited company in the United Kingdom in 1968 and is considered one of the top banks of the country.

The Complainant offers its financial services in several countries across the world under the trademark RBS.

The Complainant is the owner of trademark registrations for RBS covering financial services in the United Kingdom and in the European Union. In particular, the Complainant owns the United Kingdom trademark registration No. UK00002004617 for RBS (word mark), filed on November 23, 1994, in classes 9, 16, 35, 36 and 42; the European Union trademark Nos. 97469 for RBS (word mark), filed on April 1, 1996, in classes 9, 16, 35, 36 and 42; and 3906948 for RBS (figurative mark), filed on June 28, 2004, in classes 9, 35 and 38.

The Complainant operates websites at the domain names <rbs.com>, registered in 1994, <rbs.co.uk>, registered in 1996, and <rbs.eu>, registered in 2006.

The disputed domain name <RBSBOURSE.EU> was registered on April 28, 2016 and is currently not pointed to an active web site.

A. COMPLAINANT

The Complainant states that it has spent a significant amount of money promoting and developing its trademark RBS and submits that the trademark has acquired substantial distinctiveness especially within the United Kingdom, as demonstrated by a Google query for the term “RBS”, showing all top results relating to the Complainant.

The Complainant contends that the disputed domain name is confusingly similar to its trademark RBS as it encompasses the trademark in its entirety with the addition of the descriptive term “bourse” (“stock exchange” in French), which is referred to the business of the Complainant, and the .eu suffix, which does not detract from the overall impression. Therefore, the Complainant concludes that there is a considerable risk that the public will perceive the disputed 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.

The Complainant asserts that the Respondent has no rights or legitimate interest in the disputed domain name since the Complainant has not found that the Respondent has any registered trademarks corresponding to the disputed domain name, is not aware of a Respondent’s use of the disputed domain name that would provide it a legitimate interest, and has granted no license or authorization of

any other kind to the Respondent to use its trademark RBS. The Complainant also highlights that no disclaimer was displayed on the website at the disputed domain name.

The Complainant also points out that the Respondent was certainly aware of the Complainant's famous mark as it used the disputed domain name to offer financial services and to falsely pass itself off as an entity associated with a subsidiary of the Complainant, namely "RBS Asset Management (ACD) Ltd". The Complainant clarifies that RBS Asset Management(ACD) Ltd and the Complainant have no relationship whatsoever with the Respondent and that the Respondent falsely claimed to be regulated by the United Kingdom Financial Conduct Authority (FCA).

The Complainant submits that the Respondent's use of the disputed domain name does not amount to a bona fide offering of goods or services, or a legitimate noncommercial or fair use, since the disputed domain name has been used by the Respondent to pass itself off as an entity associated with the Complainant in order to "phish" for financial information, or similar, in an attempt to defraud the Complainant's customers.

The Complainant informs the Panel that it initially detected a similar domain name, <rbsbourse.com>, which was registered through a privacy service and resolved to the same website as the one previously connected to the disputed domain name. The Complainant tried to contact the Respondent by sending a cease and desist letter to its attention via the privacy service provider, on May 17, 2016, requesting the transfer of the domain name to the Complainant. However, the Respondent did not reply to the Complainant and a website identical to the one displayed at <rbsbourse.com> was found at the disputed domain name. Therefore, the Complainant filed a UDRP complaint to reclaim the domain name <rbsbourse.com> and initiated the present proceeding in order to recover the disputed domain name. In view of the identity of the websites displayed at the two domain names, the Complainant asserts that they were likely operated by the same individual using different type of alias, or by someone associated with that individual.

The Complainant contends that the Respondent registered and used the disputed domain name in bad faith since: i) the Complainant's trademark RBS in respect of financial services belonging to the Complainant has the status of a well-known and reputed trademark with a substantial and widespread reputation, in particular in the United Kingdom; ii) the failure of a respondent to respond to a cease and desist letter, or a similar attempt of contact, has been considered relevant in a finding of bad faith; iii) the Respondent has been using the disputed domain name to make various false statements and to imply a connection with the Complainant's subsidiary, likely in order to engage in a scam; and iv) by using the Complainant's registered trademark, the Respondent was likely attempting to deceive the Complainant's customers and manipulate them into divulging sensitive financial information.

The Complainant also informs the Panel that the disputed domain name is currently not pointed to an active web site since it was taken down following a Complainant's request to the hosting provider. However, the Complainant notes that the disputed domain name is still "in the hands" of the Respondent and that the Complainant "will not be able to rest until the disputed domain name is removed entirely, in particular as the Respondent keeps changing hosts, and is setting up the same website over and over again".

The Complainant concludes that, even if the website is currently inactive, passive holding could still constitute an act of bad faith under the circumstances of the case, and that any realistic use of the disputed domain name by the Respondent would constitute "passing off" and/or trademark infringement.

B. RESPONDENT

The Respondent did not submit any Response.

DISCUSSION AND FINDINGS

Article 22(10) of Commission Regulation No. 874/2004 (hereinafter "the Regulation") provides that the Respondent's failure to respond to a Complaint may be considered by the Panel as grounds to accept the claims of the Complainant. However, as stated in ADR Case No. 05665 (OANDA), this does not mean that a Complaint will automatically be upheld whenever a Respondent fails to respond, since the Complainant is required to demonstrate that the provisions of Article 21(1) of the Regulation are satisfied.

According to article 22 of the Regulation, an ADR procedure may be initiated by any party where the registration is speculative or abusive within the meaning of Article 21. Article 21 (1) provides that 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 interests in the name; or
(b) it has been registered or is being used in bad faith.

With reference to the first element, the Panel finds that the Complainant has proved its rights in the name RBS within the meaning of the Article 10 (1) of the Regulation. Indeed, the Complainant has provided evidence of ownership of United Kingdom and European Union Registrations for RBS.

The Panel finds that the addition to the Complainant's trademark of the generic term "bourse", meaning "stock exchange" in English, is not sufficient to exclude confusingly similarity. To the contrary, since the term is descriptive of the Complainant's business, the Panel finds that the combination of RBS with the term "bourse" exacerbates the likelihood of confusion. See, along these lines, the ADR Case No. 07280 concerning, amongst others, the domain name <creditmutuel-verification.eu>, in which the panel found that the "descriptive term "VERIFICATION" would not be seen as a differentiating term as the use of online banking often requires a "verification-step" so that the internet user would assume he is confronted with the internet presence of the Complainant".

As to the top level domain ".eu", it is well established that it may be excluded from consideration as being merely functional component of a domain name.

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is confusingly similar to a name in respect of which it has rights, according to the first requirement of Article 21 (1) of the Regulation.

With reference to right or legitimate interest, the Article 21 (2) of the Regulation states that "a legitimate interest may be demonstrated where:
(a) prior to any notice of an ADR procedure, the holder of the domain name has used the domain name or a name corresponding to it in connection with the offering of goods or services or has made demonstrable preparation to do so;
(b) it has been commonly known by the domain name;
(c) it is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name in which a right is recognised or established by national and/or community law.

The Panel finds that the Complainant has proven the Respondent's lack of any rights or legitimate interests in the disputed domain name. The Respondent, by not submitting a Response, has failed to rebut the Complainant's contentions. As stated in ADR Case N. 04040, "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 has no rights or legitimate interests in respect of the Domain Name".

There is no relation, disclosed to the Panel, between the Respondent and the Complainant and Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's trademarks under any circumstance. In addition, there is no evidence that the Respondent might be commonly known by the mark RBS or the disputed domain name.

The disputed domain name is not pointed to any active website at the time of the drafting of the decision. However, the screenshots of the website to which the disputed domain name previously resolved submitted by the Complainant show that the Respondent promoted financial services under the mark RBS and falsely claimed to be affiliated with the Complainant's subsidiary RBS Asset Management(ACD) Ltd.

Based on this evidence, the Panel finds that the Respondent's use of the disputed domain name does not amount to a good faith offer of goods or services or to a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of the Complainant's trademark.

As highlighted in prior decisions, including the ADR Case No. 06413, the Complainant's trademark RBS is well-known worldwide in the banking and financial service sector. Therefore, the Respondent must have known the Complainant at the time of the registration of the disputed domain name. Moreover, the Respondent's use of the disputed domain name in connection with financial services and its reference to a Complainant's subsidiary on the website to which the disputed domain name resolved, demonstrate that the Respondent was indeed actually aware of the Complainant's trademark. Therefore, the Panel concludes that the Respondent registered the disputed domain name in bad faith.

As to the use of the disputed domain name, the Panel notes that it is not pointed to an active web site as a result of the Complainant's take down request to the web hosting provider. However, based on the documents submitted by the Complainant, the Panel is satisfied that the disputed domain name was used to attempt to attract potential customers to a website offering financial services without authorization, pretending to act as an affiliated company of a Complainant's subsidiary, as such substantially increasing the risk of consumer deception.

Therefore, the Panel finds Article 21 (3) (d) to be applicable in this case since the Respondent clearly used the disputed domain name to attract Internet users, for commercial gain, to its website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site and the financial services promoted therein.

Moreover, in view of the circumstances of the case and in accordance with Paragraph B10 of the ADR Rules, the Panel considers the failure of the Respondent to comply with its obligation and time periods under the ADR Rules as grounds to accept the claims of the Complainant.

Since the Complainant is an entity eligible to be the holder of .eu domain name in accordance with the Paragraph 4(2) (b) of Regulation 733/2002, the Panel orders that the domain name <rbsbourse.eu> be transferred to the 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 RBSBOURSE.EU be transferred to the Complainant.

PANELISTS

Name	**Dr. Luca Barbero**

DATE OF PANEL DECISION 2016-12-12

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: rbsbourse.eu

II. Country of the Complainant: United Kingdom, country of the Respondent: France

III. Date of registration of the domain name: April 28, 2016

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

- United Kingdom trademark registration No. UK00002004617 for RBS (word mark), filed on November 23, 1994, in classes 9, 16, 35, 36 and 42;
- European Union trademark No. 97469 for RBS (word mark), filed on April 1, 1996, in classes 9, 16, 35, 36 and 42;
- European Union trademark No. 3906948 for RBS (figurative mark), filed on June 28, 2004, in classes 9, 35 and 38.

V. Response submitted: No

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

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. No
2. Why: The Complaint has made a prima facie case that the Respondent has no rights or legitimate interest in the disputed domain name and the Respondent, by not submitting a Response, has failed to rebut the Complainant's contentions.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: In light of the well-known character of the Complainant's trademark, the Respondent could not ignore it at the time of registration. The use of the disputed domain name made in the past by the Respondent demonstrates that the Respondent had actual knowledge of the Complainant's trademark and registered the disputed domain name with the intention to attract users to its web site for commercial gain by causing confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website and the financial services promoted therein.

IX. Other substantial facts the Panel considers relevant: -

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: the failure of the Respondent to comply with its obligation and time periods under the ADR Rules

XII. Is Complainant eligible? Yes