Panel Decision for dispute CAC-ADREU-007358

Case number	CAC-ADREU-007358
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Domain names	pictetbank.eu

Case administrator

Aneta Jelenová (Case admin)

Complainant

Organization	Banque Pictet & Cie SA

Respondent

Organization	Omni Fiducia SAH

FACTUAL BACKGROUND

The Complainant is one of the leading private banks in Switzerland and one of the premier independent asset managers in Europe, specialized in asset and wealth management, attracting discerning private clients and is leading financial institution from around the world.
The Complainant provides evidence it is the owner of the registered word-trademark “PICTET” in the class 36 especially in Austria, Poland, Portugal, Spain, Sweden, United Kingdom or Switzerland with priority date 2000 as well as the IR 748934 word-trademark “PICTET” with its basis registration in Switzerland, 17.08.2000, 478932, and designated esp. in AT, BX, CS, DE, ES, FR, HR, IR, IT, PL, RO, SK.
Moreover the Complainant owns several figurative trademarks in the class 36 containing the word “PICTET” especially in Austria, Benelux, Czech Republic, France, Germany, Hungary, Italy, UK and Spain with priority from 1999 onwards.
Between the Complainant and the Respondent is no relevant relationship whatsoever.
The Respondent did not prove or even assert legitimate rights or interests in the domain name at issue; in fact, Respondent offered to sell the domain name at issue to the Complainant (see the Respondent's response). The disputed domain name does not resolve to any website.
The domain name <pictetbank.eu> was registered on October 8, 2016 by the Respondent; it does not resolve to any website.

A. COMPLAINANT

The Pictet Group is one of the leading wealth and asset managers in Europe, established in 1805 in Geneva. Pictet ranks among Switzerland’s leading private banks and is one of the premier independent asset managers in Europe.
The Pictet Group is now established in 26 of the most important financial centers across the world, and employs more than 3700 people. It manages around CHF 390 billion. The PICTET brand has become well-known and enjoys an important goodwill.
The Complainant owns a large number of trademark registrations consisting of or including the name “PICTET” in class 36 of the Nice Classification in numerous jurisdictions.
The Complainant is the owner of the domain name <pictet.com>, as well as many other domain names containing the name “pictet”.
There has been no contact between the Complainant and the Respondent before the submission of the present Complaint.

As far as the legal contentions of the Complainant are concerned, firstly, the Complainant claims the disputed domain name is confusingly similar to its trademarks for it wholly incorporates the Complainant's registered PICTET trademark. Furthermore, the adjunction of "bank" further creates confusion with the prior PICTET trademark. Indeed, the descriptive term "bank" is directly related to the activities of the Complainant, said activities/services being also designated within the PICTET trademark registrations. Indeed, banking is the core business of the Complainant.
Secondly, the Complainant states that the Respondent has no rights or legitimate interests in respect of the domain name. In that regard, the Complainant emphasizes the Respondent is not licensee of the Complainant, nor has the Complainant granted to the Respondent an authorization to use the Infringing domain name. Moreover, there is no indication that the Infringing domain name corresponds to the Respondents' name. In addition, the Respondent does not use the Infringing domain name in connection with a website.
Thirdly, the Complainant claims that the disputed domain name was registered and is being used in bad faith. The Complainant states that given the well-known character of the trademark PICTET and its distinctive character, it is highly likely that Respondent had knowledge of the Complainant's mark when he registered the Infringing domain name. Moreover, the fact that the disputed domain name is not being used shows that it was registered for the purpose of selling or otherwise transferring the domain name. It contends that Respondent, by his inaction, is attempting to disrupt Complainant's business by misleading potential customers and giving them the impression that the Complainant is not operating. It thus is creating confusion with the Complainant's trademark as to source, sponsorship, affiliation or endorsement of the Respondent's website. Last but not least, according to the Complainant the lack of website related to the infringing domain name, coupled with the choice to use the element "Pictet" with connection to the descriptive term "bank" should be considered as elements proving its bad faith.

B. RESPONDENT

The Respondent filed a response merely stating that the Complainant is not situated in a member state of the EU and therefore any complaint against the domain should be addressed to a Luxembourg Court. The Respondent has not been used the domain name at issue in bad faith and EU law is not binding for the Complainant. However, the Respondent is willing to sell the domain to the Complainant at a reasonable price.

DISCUSSION AND FINDINGS

1. With regard to the objection of the Respondent that non-EU-entities like the Complainant may not stand in ADR .eu proceedings this Panel holds that according to Art 22 (1) PPR and Paragraph B 1 (a) of the ADR Rules, any person or entity can initiate an ADR proceeding; therefore also non-EU-entities may have standing in ADR .eu proceedings. However, those entities cannot request a transfer of the domain name, but only revocation (see e.g. SEVEN FOR ALL MANKIND LLC v. Riazul Quadir, CAC 2300, <7forallmankind.eu>, Revocation; WESTAT, Inc v. My Internet Media Ltd, CAC 5325, <westat.eu>, Revocation; Lernco, Inc. v. Andy Ltd., CAC 5332, <lernercatalog.eu>, Revocation; Emirates v. Stichting Roos Beheer,CAC 5405, <emirates.eu>, Revocation).
Following the amendment of the complaint the Complainant claims "revocation" of the domain name at issue which is a valid request under the PPR and the ADR Rules.

2. For assessing identity or confusing similarity of a domain name with a name for which a right is recognized (esp. trademarks) the .eu suffix has to be disregarded. Concerning confusing similarity the panel´s review consists of a comparison between the disputed domain name and the name for which a right is recognized or established by national and/or community law.
This Panel follows the consensus view of other panels that domain names which include a name for which a right is recognized or established by national and/or community law combined with descriptive or generic terms are confusingly similar to that name, especially in situation where the descriptive or generic terms describe the goods and/or services or the right holder (see e.g. Monster Finance Limited, Rahat Kazmi v. Monster Worldwide Ireland Limited, CAC 5356, <monsterfinance.eu>, Transfer).
In the present case the Complainant is owner of the registered trademark "PICTET" in the class 36 for financial and monetary affairs. The descriptive term "BANK" used as suffix to "PICTET" describes exactly the services provided by the Complainant to third parties.
The Panel therefore finds that the disputed domain name is confusingly similar to the Complainant's trademark "PICTET"

and the Complainant therefore has satisfied Paragraph B 11 (d) (1) (i) of the ADR Rules.

3. Any registered trademark that is recognized and/or established by either community law or national law in a Member State is sufficient to initiate an ADR procedure. Following the assertions in the complaint the Complainant is the owner of several registered trademarks in Member States.
The Complainant asserts that there has been no contact between Complainant and Respondent and therefore Respondent has no legitimate rights or interests in the domain name at issue. The Respondent did not contest this assertion.
Concerning the burden of proof regarding a lack of legitimate rights or interests, in contrast to the exact wording of Paragraph B 11 (d) (1) and in analogy to the rules developed by UDRP panels, the complainant only needs to establish a prima facie case. Then, the onus shifts to the respondent to rebut the assertion that the respondent lacks legitimate rights or interests.
Since the Respondent did not contest the lack of legitimate interest or delivered proofs to the contrary it brings the Panel to the conclusion that the Complainant has made out an undisputed prima facie case so that the conditions set out in Paragraph B 11 (d) (1) (ii) of the ADR Rules have been met by the Complainant.

4. Although there is no need to show bad faith if there is no legitimate interest to make out a successful case for the Complainant (see ANDREAS I. KANNAS & SONS LIMITED v. Zheng Qingying, CAC 5941, <kannas.eu>, Transfer; Noonan Services Group v. OEEO NETWORKS LIMITED, CAC 5578, <noonan.eu>, Transfer) this Panel wants to point out that this case also shows bad faith: It is not necessary to prove both registration and use in bad faith; it is sufficient if evidence illustrates one of the two elements discussed in order to comply with article 21 (1) of the PPR. The domain name at issue does not resolve to any website - most panels consider passive holding of a disputed domain name (i.e. non-use) a proof of bad faith; however, in this particular case it is not that important whether non-use alone is enough to prove bad faith or not, for from the Panel's view it is sufficient that it at least indicates bad faith. Together with the fact that the Respondent offers to sell the domain name at issue to the Complainant the Panel is convinced that it shows bad faith under Paragraph B 11 (d) (1) (iii) (see also Jager & Polacek GmbH v. Redtube, CAC 5891, <redtube.eu>, Transfer); the mere statement by the Respondent that it is not using the domain name at issue in bad faith unsupported by any evidence whatsoever lacks any substance and is therefore not a decisive argument for this Panel in favour of the Respondent.
It is therefore the Panels conviction that the domain name at issue is registered or/and used in bad faith by the Respondent.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name PICTETBANK.EU be revoked

PANELISTS

Name	**Peter Burgstaller**

DATE OF PANEL DECISION 2016-12-23

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: pictetbank.eu

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

III. Date of registration of the domain name: 8 October 2016

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. word trademark registered in CH, reg. No. 478934, for the term PICTET, registered on 17 August 2000 in respect of services in class 36 and used as basis registration for IR 748934 designated especially in AT, BX, DE, FR, ES, IT, PL, RO, SK.

V. Response submitted: Yes

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: Respondent did not even assert or give proofs to show legitimate interests

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: Nonuse and offer to sell the disputed domain name to the Complainant.

IX. Other substantial facts the Panel considers relevant: No

X. Dispute Result: Revocation of the disputed domain name

XI. Procedural factors the Panel considers relevant: Complainant is a non-EU-entity

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