Panel Decision for dispute CAC-ADREU-007728

Case number	CAC-ADREU-007728
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Domain names	banquecaceis.eu

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Caceis Bank

Respondent

Organization	Nichos & Yeo Group

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

According to the Complainant's best knowledge, no other proceedings have been commenced or decided in relation to the disputed domain name.

FACTUAL BACKGROUND

The Complainant, Caceis Bank S.A., is a French financial institution providing asset and investment services to institutional and corporate clients around the world. The Complainant is a subsidiary of the French banking group Crédit Agricole. The Complainant is one of the major European banks for asset servicing, including execution, clearing, depositary and custody, fund administration, middle office outsourcing, forex, securities lending, fund distribution support and issuer services. The Complainant has an international presence in Europe, North America and Asia and has assets under custody amounting to €2.7 trillion and assets under administration amounting to €1.8 trillion.

The Complainant is the holder of a multitude of trademark registrations across various jurisdictions throughout the world for the mark CACEIS, which it uses in connection with its banking services and financial business. The Complainant's trademark portfolio includes, inter alia, the following trademark registrations:

- CACEIS, word mark registered with the European Union Intellectual Property Office ("EUIPO") under No. 004643573 on February 26, 2008 in class 36; and

- CACEIS INVESTOR SERVICES SOLID & INNOVATIVE, combined mark registered with EUIPO under No. 005770391 on February 2, 2008 in class 36.

The disputed domain name <banquecaceis.eu> has been registered by the Respondent on August 29, 2018. The disputed domain name resolves to a standard parking page offered by a third party, Team Internet AG. The parking page displays sponsored pay-per-click (PPC) links primarily related to the Complainant and its business, namely banking, loans and other financial services. Several of these sponsored links refer to the websites of the Complainant's competitors.

A. COMPLAINANT

The Complainant considers the disputed domain name to be confusingly similar to trademarks in which it has rights. The Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name. According to the Complainant, the Respondent does not use the disputed domain name in connection with any legitimate use. Also, according to the Complainant, the Respondent has not been commonly known by the disputed domain name. Finally, the Complainant considers that the disputed domain name was registered and is being used in bad faith. The Complainant contends that the Respondent knew, or at least should have

known, of the existence of the Complainant's trademarks and registered the disputed domain name for the purpose of attracting Internet users, for commercial gain to the Respondent's website or other online location, by creating a likelihood of confusion with a name on which a right is recognized or established, by national and/or Community law and to benefit from the Complainants' established reputation.

B. RESPONDENT

The Respondent did not reply to the Complainant's contentions.

DISCUSSION AND FINDINGS

For the Complainants to succeed in their Complaint, it is required to demonstrate the following under Paragraph B(11)(d)(1) of the ADR Rules:

1. The disputed domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by national law of a Member State and/or Community law; and either

2. The Respondent has no rights or legitimate interests in respect of the disputed domain name; or

3. The disputed domain name has been registered or is being used in bad faith.

The Panel will deal with each of these requirements in turn.

A. Identical or Confusingly Similar to a name in respect of which a right or rights are recognized or established by national law of a Member State and/or Community law

Article 10(1) of the Commission Regulation No 874/2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration specifically provides that prior rights shall be understood to include, inter alia, registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works.

The Complainant has clearly established that there is an EU trademark in which the Complainant has rights. The Complainant's CACEIS mark has been registered and used in connection to its banking and financial services. Additionally, the Complainant has also established that it operates under the trade name CACEIS BANK, which is protected under French law (article L121-1 of the French Consumer Code and article L 711-4 of the French Intellectual Property Code). Therefore, the Complainant has also established that there is a name in respect of which it has rights recognized or established by national law of a Member State and/or Community law.

The disputed domain name incorporates the Complainant's CACEIS name in its entirety, merely adding the non-distinctive prefix "banque". The Panel is of the opinion that the mere addition of non-distinctive text to a complainant's trademark does not avoid confusing similarity, as set out under Paragraph B(11)(d)(1)(i) of the ADR Rules (see Bayer AG v. Zheng Qingying, CAC ADR No. 04661, bayergarden.eu; Bayerische Motoren Werke AG (BMW AG) v. Jiri Svec, CAC ADR No. 07151, bmw-navigation.eu; Peuterey Group S.p.A. v. Rivano Leenen, CAC ADR No. 06886, outlet-peuterey.eu). The term "banque" is a French word translating to "bank" in English, which refers to the Complainant's business and trade name.

It is well established that the applicable .eu country-code Top Level Domain ("TLD") suffix in a domain name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test (see Question 1, Section III of the Overview of CAC Panel Views on Selected Questions of the Alternative Dispute Resolution for .EU Domain Name Disputes, 2nd Edition ("CAC .EU Overview 2.0").

Therefore, the disputed domain name is confusingly similar to the Complainants' registered CACEIS trademark and CACEIS BANK trade name in respect of which it has rights recognized or established by national law of a Member State and/or Community law. Accordingly, the Complainant has made out the first element that it must establish.

B. Rights or Legitimate Interests

Under Paragraph B(11)(d)(1)(ii) of the ADR Rules, the Complainants have the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is an established consensus view of previous panels that it is sufficient for the Complainant to make a prima facie showing that the Respondent has no rights or legitimate interests in the disputed domain name in order to place the burden of production on the Respondent (see Question 5, Section IV of the CAC .EU Overview 2.0).

The Panel notes that the Respondent has not been commonly known by the disputed domain name and that the Respondent has not acquired trademark or service mark rights. The Whois records relating to the disputed domain name indicate that the Respondent is known as “Nichos & Yeo Group, Hin Cox” The Respondent’s use and registration of the disputed domain name was not authorized by the Complainant. There are no indications that a connection between the Complainant and the Respondent existed.

Moreover, the Panel is of the opinion that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name. It appears that the Respondent has been using the disputed domain name to refer to a standard parking page with sponsored links that refer directly to the Complainant or promote products and services of third parties which are either competing with or closely related to the products and services offered by the Complainant. According to the Panel, such use cannot be considered as fair use of the disputed domain name. The use of a domain name to post parking pages or mere pay-per-click links does not of itself confer rights or legitimate interests, especially if links lead to websites of the right holder’s competitors (see Question 11, Section IV of the CAC .EU Overview 2.0).

The Respondent has been given the opportunity to demonstrate its rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the prima facie case established by the Complainant has not been rebutted.

Based on the available record, the Panel finds that the Complainant has established a prima facie case, which was not refuted, and that the Respondent lacks rights or legitimate interests in the disputed domain name. Therefore, the Complainant has satisfied the second requirement that the Respondent has no rights or legitimate interests in the disputed domain name, under Paragraph B(11)(d)(1)(ii) of the ADR Rules.

C. Registered or Used in Bad Faith

Under Article 21(1) of the Regulation and Paragraph of the ADR Rules (ii) lack of rights or legitimate interests and (iii) registration or use in bad faith are considered alternative requirements.

As the Panel has found that the Respondent lacks rights or legitimate interests in the disputed domain name for the reasons explained under 6.B. above, no further discussion on bad faith registration or use is necessary (see Question 7, Section V of the CAC .EU Overview 2.0). Nevertheless, the Panel will briefly address this third element.

Paragraph B(11)(f) of the ADR Rules provides a non-exclusive list of factors, any one of which may demonstrate bad faith. Among these factors demonstrating bad faith registration or use is the use of a domain name to attract Internet users, for commercial gain to the Respondent’s website or other online location, by creating a likelihood of confusion with a name on which a right is recognized or established, by national and/or Community law, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the Respondent.

The Respondent has been using the disputed domain name in relation to a standard parking page displaying sponsored PPC links. While the intention to earn click through-revenue is not in itself illegitimate, the Panel finds that the use of a domain name that is deceptively similar to a trademark to obtain click-through-revenue is found to be bad faith use (see Mpire Corporation v. Michael Frey, WIPO Case No. D2009-0258; L'Oréal, Biotherm, Lancôme Parfums et Beauté & Cie v. Unasi, Inc, WIPO Case No. D2005-0623). The Panel finds that by using the disputed domain name incorporating the Complainant's trademark in connection with a website containing links directly referring to the Complainant or to products and services relating to the Complainant and its business, the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trademark.

Additionally, the Respondent cannot disclaim responsibility for PPC links appearing on the website associated with its domain name (nor would such links ipso facto vest the Respondent with rights or legitimate interests). Neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith (see Section 3.5. of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions,

Third Edition (“WIPO Jurisprudential Overview 3.0”).

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the disputed domain name was registered or is being used in bad faith.

DECISION

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

As the Complainant is established and located within the European Union, namely France, it satisfies the general eligibility criteria for registration of the disputed domain name set out in Article 4(2)(b) of the Regulation (EC) No 733/2002. The decision shall be implemented by the Registry within thirty (30) days after the notification of the decision to the Parties, unless the Respondent initiates court proceedings in a Mutual Jurisdiction.

PANELISTS

Name	**PETILLION, Flip Petillion**

DATE OF PANEL DECISION 2019-03-25

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: BANQUECACEIS.EU

II. Country of the Complainant: France, country of the Respondent: Belgium

III. Date of registration of the domain name: 29 August 2018

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

- CACEIS, word mark registered with the European Union Intellectual Property Office (“EUIPO”) under No. 004643573 on February 26, 2008 in class 36; and

- CACEIS INVESTOR SERVICES SOLID & INNOVATIVE, combined mark registered with EUIPO under No. 005770391 on February 2, 2008 in class 36.

- trade name / company name: CACEIS BANK

V. Response submitted: No

VI. 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 disputed domain name is used to refer to a parking page with sponsored PPC links referring to the Complainant and its competitors.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: Constructive knowledge of the Complainant and its rights at the time of registration of the disputed domain name and the disputed domain name is used to refer to a parking page with sponsored PPC links referring to the Complainant and its competitors.

IX. Other substantial facts the Panel considers relevant: N/A

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant: N/A

XII. Is Complainant eligible? Yes, As the Complainant is established and located within the European Union, namely France, it satisfies the general eligibility criteria for registration of the disputed domain name set out in Article 4(2)(b) of the Regulation (EC) No 733/2002.