

ADMINISTRATIVE PANEL DECISION

Caceis Bank v. Name redacted¹

Case No. D2023-4303

1. The Parties

The Complainant is Caceis Bank, France, represented by Gevers Legal NV, Belgium.

The Respondent is Name Redacted.

2. The Domain Name and Registrar

The disputed domain name ("Disputed Domain Name") <rh-caceis.com> is registered with Squarespace Domains II LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 17, 2023. On October 17, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 17, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent (Anonymous Party) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 18, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on October 24, 2023.

The Respondent sent an informal email communication on October 24, 2023.

On October 18, 2023, the Center informed the parties in French and English, that the language of the registration agreement for the Disputed Domain Name is French. On October 18, 2023, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not submit any comment on the Complainant's submission.

¹ The Respondent appears to have used the name of a third party when registering the disputed domain name. In light of the potential identity theft, the Panel has redacted the Respondent's name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the Disputed Domain Name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).


In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint in both French and English, and the proceedings commenced on October 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 14, 2023. The Respondent sent an informal communication email to the Center on October 27, 2023. The Center notified the parties of the commencement of Panel appointment on November 15, 2023.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on November 24, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is an asset servicing bank dedicated to asset managers, banks, institutional and corporate clients. It is the subsidiary of a well-known French bank.

The Complainant is the owner of several registered trademarks incorporating the term “CACEIS” (the “CACEIS Trademarks”) including:

- the European union word mark CACEIS No. 004643573 registered on February 26, 2008, for services in class 36;
- the European union semi-figurative mark  No. 005770391 registered on February 28, 2008, for services in class 36;
- the international word mark CACEIS No. 879274 registered on September 21, 2005, for products and services in classes 9, 16, 35, 36, 38, 41 and 42.

The Disputed Domain Name was registered on October 9, 2023, and at the time of the filing of the complaint and the decision resolved to an inactive webpage.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name.

Notably, the Complainant contends that the Disputed Domain Name is confusingly similar to its CACEIS Trademarks since it incorporates them in their entirety with the addition of a hyphen and of the acronym “rh” which in French refers to “human resources”. The Complainant asserts that this addition does not prevent a finding of confusing similarity since the CACEIS Trademarks remains sufficiently recognizable.

Then, the Complainant submits that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant asserts that the Respondent does not own any trademark comprising of the Disputed Domain Name. The Complainant adds that it has never authorized nor licensed the Respondent to use its CACEIS Trademarks to register the Disputed Domain Name.

Then, the Complainant stands that the Respondent is not commonly known under the Disputed Domain Name and that the Disputed Domain Name used to resolve to a page containing sponsored links thus demonstrating that the Disputed Domain Name is not used in a *bona fide* offering of goods and services or a legitimate noncommercial or fair use.

Finally, the Complainant asserts that the Disputed Domain Name was registered and being used in bad faith. The Complainant demonstrates that the registration of the CACEIS Trademarks well predates the registration of the Disputed Domain Name. Furthermore, the Complainant highlights that the Respondent neither has a relationship with the Complainant nor received any approval or endorsement by the latter. The Complainant asserts that the Respondent should have known of its existence and of its CACEIS Trademarks. Finally, the Complainant contends that the Disputed Domain Name resolves to an inactive page and had been set up with active MX records enabling the Respondent to send emails from the Disputed Domain Name.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions. The Respondent has addressed two informal email communications to the Center, in English, requesting information on how to "delete everything".

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that the Complainant shall prove the following three elements:

- (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

A. Language of the Proceeding

The language of the Registration Agreement for the Disputed Domain Name is French. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that translating the Complaint would unfairly disadvantage and burden the Complainant and cause significant delays in the proceeding. The Complainant highlights that English is a common language in business and that the Respondent has opted for an American registrar whose website is primarily in English. The Complainant finally points out that the Respondent has used the English language when writing emails to the Center which demonstrates it is proficient in the English language.

The Respondent did not comment on the Complainant's request for the language of the proceeding be English but sent email communications in English.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

B. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the Disputed Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of a hyphen and of the letters, "rh" which refers to "human resources" in French, may bear on assessment of the second and third elements, the Panel finds the addition of such elements does not prevent a finding of confusing similarity between the Disputed Domain Name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

C. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a Disputed Domain Name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name such as those enumerated in the Policy or otherwise.

Indeed, it appears that the Respondent has not received any authorization to use the CACEIS Trademarks in any manner, including for the registration of domain names.

Moreover, it appears from the non-use of the Disputed Domain Name, which resolves to an inactive page, that the Respondent is not using or has not prepared to use the Disputed Domain Name with a *bona fide* offering of goods or services, nor is the Respondent making a legitimate noncommercial or fair use of the Disputed Domain Name without intent for commercial gain. There is also no evidence on record showing that the Respondent is commonly known by the Disputed Domain Name or the name "rh caceis".

Based on the available record, the Panel finds the second element of the Policy has been established.

D. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has registered the Disputed Domain Name well after the registration of the CACEIS Trademarks.

The Panel also notes that the Disputed Domain Name is inactive and has been set up which MX records which may be used to send emails while trying to pass off as the Complainant as part of a phishing scheme.

Panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the Disputed Domain Name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant’s trademark, and the composition of the Disputed Domain Name, and finds that in the circumstances of this case the passive holding of the Disputed Domain Name does not prevent a finding of bad faith under the Policy.

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Name <rh-caceis.com> be transferred to the Complainant.

/Christiane Féral-Schuhl/

Christiane Féral-Schuhl

Sole Panelist

Date: December 6, 2023