

## **ADMINISTRATIVE PANEL DECISION**

Landesbank Baden-Württemberg (LBBW) v. mouad gabriel  
Case No. D2022-0330

### **1. The Parties**

The Complainant is Landesbank Baden-Württemberg (LBBW), Germany, represented by Bird & Bird LLP, Germany.

The Respondent is mouad gabriel, France.

### **2. The Domain Name and Registrar**

The disputed domain name <bw-bankonline.com> is registered with Hosting Concepts B.V. d/b/a Registrar.eu. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 31, 2022. On January 31, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 1, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on February 8, 2022, 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 February 8, 2022.

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, and the proceedings commenced on March 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 24, 2022.

The Center appointed Peter Burgstaller as the sole panelist in this matter on April 21, 2022. 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 disputed domain name was registered on November 19, 2021. The disputed domain name is inactive and resolves to a security error webpage "Deceptive site ahead".

The Complainant owns the following trademarks:

- European Union Trade Mark registration for BW-BANK (word), reg.- no. 4988929, registered October 18, 2007, for the international Classes 35, 26, 28, and 42;
- United States of America trademark registration for BW BANK (design mark), reg.-no. 5742979, registered May 7, 2019, for the international Classes 9, 14, 16, 35, 36, 38, and 42.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant is a mid-sized universal bank under public law and provides its services to companies, retail and institutional customers, and savings banks. The Complainant is owned by the German Federal State of Baden-Württemberg, the Savings Bank Association of Baden-Württemberg and the City of Stuttgart. The Complainant is mainly focused on providing financial services for companies, but it also caters to a wide range of customers. Further, the Complainant fulfils the role of a central bank for the savings banks in the German federal states of Baden-Württemberg, Rhineland-Palatinate, and Saxony.

The Complainant conducts its entire retail customer business and most of its corporate customer business with a focus on Baden-Württemberg through its operationally independent subsidiary "BW-Bank". In addition to traditional financing, the Complainant's product portfolio also includes payment transactions and asset management.

The Complainant is the owner of numerous trademark registrations that protect the term "BW-Bank", *inter alia* in Germany, in the United States of America, and the European Union.

In addition, the Complainant has also registered the domain name <bw-bank.de> under which the main website is available and where its banking and finance services are offered.

Furthermore, the Complainant has always concluded its retail customer business and most of its corporate customer business under its commercial name BW-Bank since the establishment of this branch in 2005.

The disputed domain name is identical or at least confusing similar to the Complainant's trademarks, domain registration, and company name.

The Respondent does not have any rights or legitimate interests in respect of the disputed domain name. The Complainant has not granted any license or authorization of any other kind to the Respondent to use its trademarks or company name. There has never been any kind of business relationship between the Complainant and the Respondent. Rather, the disputed domain falsely suggests an affiliation with the Complainant.

Finally, the Respondent has registered the disputed domain in bad faith, merely to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademarks, domain names and company name of the Complainant.

The disputed domain name is also being used in bad faith, even though there is no content available under the disputed domain, since non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding.

## **B. Respondent**

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

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, the Complainant must prove that

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

### **A. Identical or Confusingly Similar**

The Complainant submitted evidence, which incontestably and conclusively establishes rights in the trademark BW-BANK.

The disputed domain name is highly confusingly similar to the Complainant's registered trademark BW-BANK since it entirely contains this mark and only adds the word "online".

It has long been established under previous UDRP decisions that where the relevant trademark is recognizable within the disputed domain name the mere addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity under the first element of the Policy (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition "[WIPO Overview 3.0](#)").

Finally, it has also long been held that the generic Top-Level Domain ("gTLD") (*i.e.*, ".com") is generally disregarded when evaluating the confusing similarity of a disputed domain name.

The Panel therefore finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

### **B. Rights or Legitimate Interests**

While 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 often impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element (see section 2.1 of the [WIPO Overview 3.0](#)).

Here, the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent.

Furthermore, the nature of the disputed domain name, comprising the Complainant's mark in its entirety together with the term "online", cannot be considered fair as it falsely suggests an affiliation with the Complainant that does not exist (see section 2.5 of the [WIPO Overview 3.0](#)).

Noting the above, and in the absence of any Response or allegations from the Respondent, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

As stated in many decisions rendered under the Policy (e.g., *Robert Ellenbogen v. Mike Pearson*, WIPO Case No. [D2000-0001](#)) both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainant must show that:

- the disputed domain name was registered by the Respondent in bad faith; and
- the disputed domain name is being used by the Respondent in bad faith.

(i) The Complainant is the owner of the registered trademark BW-BANK, and has registered and used such trademarks in many jurisdictions, long before the registration of the disputed domain name.

It is inconceivable for this Panel that the Respondent registered or has used the disputed domain name without knowledge of the Complainant's rights, which leads to the necessary inference of bad faith. This finding is supported by the fact that the disputed domain name incorporates the Complainant's trademark entirely together with the merely descriptive term "online". In fact, the use of the term "online" in connection with the mark BW-BANK rather strengthen the impression that the disputed domain name is in some way connected to the Complainant or the Complainant's services, and at least the Respondent may be seen to free ride on the reputation of the Complainant and its name and trademark BW-BANK.

Therefore, the Panel is convinced that the disputed domain name was registered in bad faith by the Respondent.

(ii) Although there is no evidence that the disputed domain name is being actively used, previous UDRP panels have found that bad faith use under paragraph 4(a)(iii) does not necessarily require a positive act on the part of the respondent – inaction is within the concept of paragraph 4(a)(iii) (see especially *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *Ladbroke Group Plc v. Sonoma International LDC*, WIPO Case No. [D2002-0131](#)).

This Panel also concludes that the present passive holding of the disputed domain name, constitutes a bad faith use, putting emphasis on the following:

- the Respondent has failed to present any evidence of any good faith use with regard to the disputed domain name;
- the disputed domain name incorporates the Complainant's trademark in its entirety and is thus suited to divert or mislead potential web users from the website they are actually trying to visit (the Complainant's site);
- the disputed domain name moreover contains the term "online" which refers to a relevant service of the Complainant which is providing banking and finance services online; and
- there is no conceivable plausible reason for good faith use with regard to the disputed domain name.

Taking all these facts and evidence into consideration this Panel finds that the disputed domain name has been registered and is being used in bad faith under paragraph 4(a)(iii) 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, <bw-bankonline.com>, be transferred to the Complainant.

*/Peter Burgstaller/*

**Peter Burgstaller**

Sole Panelist

Date: April 29, 2022