

## **ADMINISTRATIVE PANEL DECISION**

Northern Trust Corporation v. Privacy Service Provided by Withheld for Privacy ehf / John Doe, Wepros and Stan Beef, Web Design Agency  
Case No. D2022-1252

### **1. The Parties**

The Complainant is Northern Trust Corporation, United States of America (“United States” or “US”), represented by Dentons US LLP, United States.

The Respondent is Privacy Service provided by Withheld for Privacy ehf, Iceland / John Doe, Wepros, Nigeria, and Stan Beef, Web Design Agency, Turkey.

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

The disputed domain names <northensavingsbnk.com>, <northerntrustltd.com>, and <northern-trustunion.com> (the “Domain Names”) are registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 8, 2022. On April 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on April 13, 2022, providing the registrant and contact information for multiple underlying registrants disclosed by the Registrar, and inviting the Complainant to either amend the Complaint adding the Registrar-disclosed registrants as the formal Respondents and provide relevant arguments or evidence demonstrating that all the named Respondents are, in fact, the same entity and/or that all Domain Names are under common control or indicate which domain names will no longer be included in the current Complaint. The Complainant filed an amended Complaint on April 18, 2022, including comments on the consolidation.

The Center verified that the Complaint together with the amended 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 Respondents of the Complaint, and the proceedings commenced on April 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 9, 2022. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on May 10, 2022. On May 10, 2022, the Center received an email communication from a third party email address.

The Center appointed Mathias Lilleengen as the sole panelist in this matter on May 19, 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 Complainant is an international financial services company that provides asset servicing, fund administration, asset management and banking solutions. It was originally founded as a bank under the name "Northern Trust" in 1889. Today it employs over 18,000 people with offices in the United States and internationally.

The Complainant has used the trademark NORTHERN TRUST in the United States for over 130 years. The Complainant owns numerous trademark registrations that contains the term "Northern Trust", such as US registration no. 5783085 for NORTHERN TRUST SECURITIES, INC. MERIDIAN ACCOUNT, registered on June 18, 2019, and European Union Trade Mark no. 003459153 for NORTHERN TRUST, registered on April 14, 2005. The Complainant also owns domain names that include the Complainant's trademark, e.g. <northerntrust.com>, <northerntrustbank.com>, and <northerntrustbank.net>, all registered long before the Respondents registered the Domain Names in dispute.

The Domain Names were registered on October 28, 2021 (<northern-trustunion.com>), November 8, 2021 (<northern-savingsbnk.com>), and December 20, 2021 (<northerntrustltd.com>). At the time of Complaint and the time of drafting the Decision, the Domain Names resolved to virtually identical websites that purport to be the websites of a local bank. The sites appear to mimic the layout and content of a website for a savings bank.

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

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

The Domain Names were registered within a short period. The Respondents use the Domain Names to resolve to virtually identical websites that purport to be the websites of a bank. The websites are identical in content, format, and function, with the exception of a difference in some contact addresses. The addresses at the websites appear to be fake, and the websites appear to be used for the collection of information likely to be linked to phishing attempts. The header and footer on the websites use the words "Northern Trust Bank" with a green logo similar to the color used by the Complainant. The websites solicit contact information with a form for enrollment in "instant online banking accounts". One of the Respondents is the same as the respondent in the prior UDRP proceeding *Northern Trust Corporation v. Privacy Service Provided by Withheld for Privacy ehf / Stan Beef, Web Design Agency*, WIPO Case No. [D2021-3860](#). The Complainant believes therefore that the Respondents are aliases for the same individual or organization, and the Domain Names are subject to common control or ownership.

The Complainant provides evidence of trademark registrations, and argues that all the Domain Names incorporate the dominant part of the Complainant's trademark. The additions of common words do not prevent a finding of confusing similarity with the Complainant's trademark.

The Complainant asserts that the Respondents are not authorized to use the Complainant's trademark. The Respondents cannot establish rights in the Domain Names, as it has not made any use of, or demonstrable preparations to use, the Domain Names in connection with a *bona fide* offering of goods or services. On the contrary, the Complainant submits that the Respondents' use is fraudulent and evidence of bad faith.

Based on the use of the Domain Names, the Complainant argues that the Respondents must have been aware of the Complainant and its trademarks when the Respondents registered the Domain Names. Moreover, the use proves that the Respondents have intentionally attempted to attract Internet users, for commercial gain, by creating confusion with the Complainant's trademark, more specifically, to lure potential targets into phishing or other fraudulent activity. The Complainant asserts that one of the listed Respondents is connected to a prior UDRP proceeding filed by the Complainant; see *Northern Trust Corporation v. Privacy Service Provided by Withheld for Privacy ehf / Stan Beef, Web Design Agency*, WIPO Case No. [D2021-3860](#).

## **B. Respondent**

The Respondents did not reply to the Complainant's contentions. However, the Center received a third party communication on May 10, 2022 from a purported banking entity (operating under a mark entirely unrelated to the Complainant's trademarks) indicating that the websites resolving from the Domain Names are cloned and make use of contact information relating to the third party, but that the Domain Names and websites are not owned, operated, or affiliated with the third party.

## **6. Discussion and Findings**

### **A. Procedural matters**

The Complainant argues that the Domain Names are under common control. The Panel has carefully examined the evidence in the case file and notes that the Respondents have not – despite being given the opportunity – argued or filed any evidence to rebut the Complainant's case for consolidation. The Panel notes in particular the use of the Domain Names to very similar websites that purport to be the websites of a bank. Based on the evidence and consideration of procedural efficiency, the Panel orders consolidation of the Domain Names. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

### **B. Identical or Confusingly Similar**

The Complainant has established that it has rights in the trademark NORTHERN TRUST. The test for confusing similarity involves a comparison between the trademark and the Domain Names. The Domain Names incorporate the dominant part of the Complainant's trademarks, with the addition of terms such as "savingsbnk", "union", or "ltd". These additions do not prevent a finding of confusing similarity between the Domain Names and the trademarks.

For the purpose of assessing under paragraph 4(a)(i) of the Policy, the Panel may ignore the generic Top-Level Domains ("gTLDs"), see [WIPO Overview 3.0](#), section 1.11.

The Panel finds that the Domain Names are confusingly similar to a trademark in which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

### **C. Rights or Legitimate Interests**

The Complainant has made un rebutted assertions that it has not granted any authorization to the Respondents to register the Domain Names containing the Complainant's trademark or otherwise make use of the Complainant's mark. There is no evidence that the Respondents have registered the Domain Names as a trademark or acquired unregistered trademark rights. The Respondents have not made use of, or

demonstrable preparations to use, the Domain Names in connection with a *bona fide* offering. The Respondents use of the Domain Names is clearly not *bona fide*, but rather evidence of bad faith.

Accordingly, the Panel finds that the Respondents have no rights or legitimate interests in respect of the Domain Names in accordance with paragraph 4(a)(ii) of the Policy.

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

The Panel finds it evident from the use of the Domain Names that the Respondents must have been aware of the Complainant and its trademarks when the Respondents registered the Domain Names. The Respondents' use also indicates an attempt to attract Internet users for commercial gain, by creating confusion with the Complainant's trademark. It seems likely that the Respondents have used or will use the Domain Names in phishing or other fraudulent activity. Moreover, one of the listed Respondents is connected to a prior UDRP proceeding filed by the Complainant; see *Northern Trust Corporation v. Privacy Service Provided by Withheld for Privacy ehf / Stan Beef, Web Design Agency*, WIPO Case No. [D2021-3860](#).

For the reasons set out above, the Panel concludes that the Domain Names were registered and are being used in bad faith, within the meaning of 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 Domain Names, <northern-savings-bnk.com>, <northern-trust-ltd.com>, and <northern-trust-union.com>, be transferred to the Complainant.

*/Mathias Lilleengen/*

**Mathias Lilleengen**

Sole Panelist

Date: May 31, 2022