

## **ADMINISTRATIVE PANEL DECISION**

Banque Palatine v. Domain ID Shield Service CO., Limited / Domain eRegistration, Domain eRegistration  
Case No. D2022-1321

### **1. The Parties**

The Complainant is Banque Palatine, France, represented by DBK – Société d’avocats, France.

The Respondent is Domain ID Shield Service CO., Limited, China / Domain eRegistration, Domain eRegistration, United Kingdom.

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

The disputed domain name <banquepalatinefr.com> is registered with OnlineNic, Inc. d/b/a China-Channel.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 12, 2022. On April 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 14, 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 April 19, 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 amended Complaint on April 20, 2022.

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 Respondent of the Complaint, and the proceedings commenced on April 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 17, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 19, 2022.

The Center appointed Eva Fiammenghi as the sole panelist in this matter on June 7, 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, Banque Palatine is a French bank founded in 1780 and specialized in small and medium-sized companies and in asset management.

The Complainant holds numerous trademark registrations in many jurisdictions that comprise the term “palatine”, including, among the others, the following:

- French trademark Registration No. 3644179, BANQUE PALATINE, registered on April 15, 2009, for services in class 35; 36; 38;
- European Union trademark Registration No. 004353223, PALATINE, registered on July 31, 2006, for goods and services in class 9, 16, 35, 36, 38, 41, 42;
- French trademark Registration No. 3338990, PALATINE, registered on February 2, 2005, for goods and services in classes 9, 16, 38, 41, 42, and 45.

Moreover, the Complainant is also the owner of the domain name <palatine.fr> registered in 2004.

The disputed domain name was registered on March 30, 2022, and at the time of filing the Complaint did not resolve to an active website.

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

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

The Complainant argues that the disputed domain name is almost identical to the Complainant's trademarks and domain name and highlights how the PALATINE mark is well known around the world in the field of finance and banking industry.

The disputed domain name incorporates the PALATINE mark in its entirety, adding the generic terms “banque” and “fr”. The Internet users may believe that the disputed domain name is other official website of the Complainant's, and more specifically a portal which would permit to access to all the Complainant's services.

The Complainant asserts that the disputed domain name leads to an inactive website with an error message “403” and that the Respondent has activated the MX servers of the disputed domain name probably for phishing purposes.

The Respondent is not affiliated with the Complainant and there is no evidence to suggest that the Respondent has registered the disputed domain name to advance legitimate interests.

The Complainant has never licensed or otherwise permitted the Respondent to use its trademark or to register any domain name including its trademark.

The Complainant requests that the disputed domain name be transferred to it.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, to succeed 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 in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

These elements are discussed in turn below. In considering these elements, paragraph 15(a) of the Rules provides that the Panel shall decide the Complaint on the basis of statements and documents submitted and in accordance with the Policy, the Rules and any other rules or principles of law that the Panel deems applicable.

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

In the present case, the disputed domain name incorporates the term "palatine", which is identical to the Complainant's registered trademarks PALATINE.

It is clear that the disputed domain name incorporates in its entirety the PALATINE trademark to which the terms "banque" and "fr" have been added.

It is well-established that the addition of other terms to a trademark in a domain name does not prevent a finding of confusing similarity. Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The disputed domain name also incorporates in its entirety the BANQUE PALATINE trademark. For the same reason, the addition of the term "fr" does not prevent a finding of confusing similarity.

The Panel finds that the first element of the Policy has been met.

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

According to the Policy, paragraph 4(a)(ii), the Complainant has to demonstrate that the Respondent has no rights or legitimate interests in the disputed domain name. 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](#).

The Respondent is not in any way affiliated with the Complainant, nor has the Complainant authorized or licensed the Respondent to use its trademarks, or to seek registration of any domain name incorporating its

trademarks.

Based on the available record, the Panel finds that 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 made any submissions or any demonstrations that it has rights or legitimate interests in the disputed domain name.

In *Guerlain S.A. v. Peikang*, WIPO Case No. [D2000-0055](#), the panel stated that: “in the absence of any license or permission from the Complainant to use any of its trademarks or to apply for or use any domain name incorporating those trademarks, it is clear that no actual or contemplated bona fide or legitimate use of the domain name could be claimed by Respondent.”

The Panel finds no evidence that the Respondent has used, or undertake any demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services.

Likewise, no evidence has been adduced that the Respondent has been commonly known by the disputed domain name; nor, for the reasons mentioned above, is the Respondent making a legitimate noncommercial or fair use of the disputed domain name.

Moreover, the Panel finds that the nature of the disputed domain name carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

The Panel concludes that the second element of the Policy has, therefore, been met.

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

The Panel, based on the evidence presented, accepts, and agrees with the Complainant’s contentions that the disputed domain name was registered and is being used in bad faith.

Previous UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity, as is the case here, can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4

Under section 3.3 of the [WIPO Overview 3.0](#), the non-use of a domain name, would not prevent a finding of bad faith under the doctrine of passive holding. Previous UDRP panels have held that the passive holding of a domain name that incorporates a well-known trademark may infer bad faith in appropriate circumstances (see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

Here, the Panel finds that the passive holding of the disputed domain name in the circumstances of this case does not prevent a finding of bad faith registration and use (see section 3.3 of the [WIPO Overview 3.0](#)), and further constitutes a disruption of the Complainant’s business.

The bad faith registration and use of the disputed domain name is also affirmed by the fact that the Respondent has not denied, or even responded to, the assertions of bad faith made by the Complainant in this proceeding.

Furthermore, the Panel notes that previous UDRP panels inferred, also, a bad faith behavior from the activation of MX-servers by the Respondent, which enable the creation of email addresses for commercial emailing, spamming or phishing purposes (see *Robertet SA v. Marie Claude Holler*, WIPO Case No. [D2018-1878](#)).

Accordingly, the Panel finds, based on the evidence presented, that the Respondent registered and is using the disputed domain name in bad faith. Therefore, the Complainant has satisfied 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, <banquepalatinefr.com> be transferred to the Complainant.

*/Eva Fiammenghi/*

**Eva Fiammenghi**

Sole Panelist

Date: June 21, 2022