

ADMINISTRATIVE PANEL DECISION

Oney Bank v. Liu Fen

Case No. DCO2023-0049

1. The Parties

The Complainant is Oney Bank, France, represented by SafeBrands, France.

The Respondent is Liu Fen, China.

2. The Domain Name and Registrar

The disputed domain name <smartney.co> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 10, 2023. On May 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 12, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details and contact information in the Complaint.

The Center verified that 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 June 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 22, 2023.

On June 2, 2023, the Respondent sent an informal email to the Center. On June 8, 2023 the Center acknowledged receipt of this informal email and specified to the Parties that a suspension of the proceeding was possible if the Parties wanted to explore settlement talks. On June 16, 2023, the Complainant confirmed to the Center that it wished the proceeding to be continued.

On June 29, 2023, the Center notified the Parties of the Commencement of Panel appointment process.

The Center appointed Piotr Nowaczyk as the sole panelist in this matter on July 7, 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 a French bank specialized in consumer credit, electronic payments, and payment card management. In 2018, the Complainant created its subsidiary – Smartney, which offers customers the possibility of borrowing money on favorable terms using the latest technology.

The Complainant is the owner of several SMARTNEY trademark registrations, including:

- the European Union Trademark Registration SMARTNEY (figurative) No. 017975703, registered on June 7, 2019; and
- the European Union Trademark Registration SMARTNEY (word) No. 017975683, registered on July 5, 2019.

The Complainant is also the owner of domain names incorporating its SMARTNEY trademark, including <smartney.com>.

The Domain Name was registered on November 23, 2022.

On February 23, 2023, the Complainant sent the Respondent a cease and desist letter requesting transfer of the Domain Name to the Complainant. In its response, the Respondent offered to sell the Domain Name to the Complainant.

As of the date of this Decision, as well as at the time of submitting the Complaint, the Domain Name has resolved to a parking page indicating that the Domain Name is for sale.

5. Parties' Contentions

A. Complainant

The Complainant requests the transfer of the Domain Name. According to the Complainant, each of three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainant submits that the Domain Name is identical to the trademark in which the Complainant has rights.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the Domain Name.

Third, the Complainant submits that the Domain Name was registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

6.1. Preliminary Matter – Suspension of the Proceedings

On June 2, 2023, the Respondent sent an informal email to the Center stating, “pause”. In the Panel’s view, this informal email might be considered to be a request to suspend the present proceedings. On June 8, 2023, the Center acknowledged receipt of the Respondent’s email and specified to the Parties that a suspension of the proceeding was possible if the Parties want to explore settlement talks. On June 16, 2023, the Complainant confirmed to the Center that it wished the proceeding to be continued.

Paragraph 17 of the Rules makes clear that a proceeding may be suspended to facilitate settlement negotiations, or to implement a settlement agreement between the parties. Where, before appointment of the administrative panel, the complainant (or both parties jointly) submits a suspension request to the WIPO Center, the proceedings will be suspended to allow the parties to explore settlement options. See section 4.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

In the present case, it was the Respondent who submitted the suspension request to the Center. However, in light of the Respondent’s failure to communicate or cooperate with the Complainant, the Complainant requested that the proceedings continue.

Accordingly, the present proceedings shall continue and the Panel will consider the substantive merits of the Complaint.

6.2. Substantive Matters – Three Elements

Paragraph 4(a) of the Policy places a burden on the Complainant to prove the presence of three separate elements, which can be summarized as follows:

- (i) the 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 the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

The requested remedy may only be granted if the above criteria are met. At the outset, the Panel notes that the applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”. See section 4.2, [WIPO Overview 3.0](#).

A. Identical or Confusingly Similar

Under the first element, the Complainant must establish that the Domain Name is identical or confusingly similar to the trademark in which the Complainant has rights.

The Complainant holds valid SMARTNEY trademark registrations. The Domain Name incorporates this trademark in its entirety. As numerous UDRP panels have held, incorporating a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to that trademark (see *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS)*, WIPO Case No. [D2003-0696](#)).

The generic Top-Level Domain (“gTLD”) “.co” in the Domain Name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See section 1.11.1 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Domain Name is identical to the Complainant's SMARTNEY trademark. Thus, the Complainant has proved the requirements under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second element, the Complainant must prove that the Respondent has no rights or legitimate interests in the Domain Name.

The Respondent may establish a right or legitimate interest in the Domain Name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that it has used or made preparations to use the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services prior to the dispute; or
- (ii) that it is commonly known by the Domain Name, even if it has not acquired any trademark rights; or
- (iii) that it is making a legitimate noncommercial or fair use of the Domain Name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

Although given the opportunity, the Respondent has not submitted any evidence indicating that any of the circumstances foreseen in paragraph 4(c) of the Policy are present in this case.

On the contrary, it results from the evidence on record that the Complainant's SMARTNEY trademark registrations predate the Respondent's registration of the Domain Name. There is no evidence in the case record that the Complainant has licensed or otherwise permitted the Respondent to use the SMARTNEY trademark or to register the Domain Name incorporating this trademark. There is also no evidence to suggest that the Respondent has been commonly known by the Domain Name.

Moreover, it results from the evidence on record that the Respondent does not make use of the Domain Name in connection with a *bona fide* offering of goods or services, nor does it make a legitimate noncommercial or fair use of the Domain Name. On the contrary, the Domain Name resolves to the parking page indicating that the Domain Name is for sale. Such use of the Domain Name does not confer rights or legitimate interests on the Respondent.

Furthermore, the composition of the Domain Name, wholly incorporating the SMARTNEY trademark by itself, carries a high risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

Given the above, the Respondent has failed to invoke any circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in respect of the Domain Name. Thus, there is no evidence in the case file that refutes the Complainant's *prima facie* case. The Panel concludes that the Complainant has also proved the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under the third element, the Complainant must prove that the Domain Name has been registered and is being used in bad faith.

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. See section 3.1 of the [WIPO Overview 3.0](#).

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use includes without limitation:

- (i) circumstances indicating the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of a trademark or

to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or

- (ii) circumstances indicating that the domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding domain name, provided it is a pattern of such conduct; or
- (iii) circumstances indicating that the domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with a trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on a website or location.

It results from the evidence on record that the Respondent registered the Domain Name primarily for the purpose of selling it to the Complainant – the owner of the SMARTNEY trademark, for valuable consideration likely in excess of the out-of-pocket costs directly related to the Domain Name.

Generally speaking, UDRP panels have found that the practice as such of registering a domain name for subsequent resale (including for a profit) would not by itself support a claim that the respondent registered the domain name in bad faith with the primary purpose of selling it to a trademark owner (or its competitor). See section 3.1.1 of the [WIPO Overview 3.0](#). However, the Panel considers that such circumstances as the composition of the Domain Name wholly incorporating the Complainant's SMARTNEY trademark, the distinctiveness of the SMARTNEY trademark, the failure of the Respondent to present a credible evidence-backed rationale for registering the Domain Name despite sending an email in reply to the Complainant's notification thereby demonstrating the Respondent's awareness of this proceeding and the Complaint, and the Respondent's provision of seemingly false or incomplete registrant contact details (considering that the courier was unable to deliver the Center's written communication on account of the "bad address") indicate that the Domain Name was registered for the bad-faith purpose of selling it to the Complainant.

For the reasons discussed above, the Panel finds that the Complainant has proved the requirements 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 Domain Name <smartney.co> be transferred to the Complainant.

/Piotr Nowaczyk/

Piotr Nowaczyk

Sole Panelist

Date: July 21, 2023