

ADMINISTRATIVE PANEL DECISION

Banque et Caisse d'Épargne de l'Etat, Luxembourg v. Privacy service provided by Withheld for Privacy ehf /Jim Jones
Case No. D2022-2055

1. The Parties

The Complainant is Banque et Caisse d'Épargne de l'Etat, Luxembourg, represented by Office Freylinger S.A., Luxembourg.

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland /Jim Jones, Netherlands.

2. The Domain Name and Registrar

The disputed domain name <spuerkeess-lu.live> is registered with NameCheap, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 7, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. Also on June 7, 2022, 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.

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 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 12, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 13, 2022.

The Center appointed Daniel Peña as the sole panelist in this matter on July 18, 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 a Luxembourgish company, incorporated in 1989 and internationally active in the banking services.

The Complainant is exploiting the trademark SPUERKEESS for banking, insurance and financial services.

The Complainant owns different SPUERKEESS trademark registrations in the European Union, Benelux, Switzerland and the United Kingdom ("U.K.").

The Complainant is in particular the owner of the following trademark registrations:

- European Union trademark SPUERKEESS No. 009110552, filed on May 17, 2010 and registered on November 2, 2010, covering goods and services in classes 9, 16, 25, 35, 36, 38, 39, 41, 42, 43, and 45;
- Benelux device trademark SPUERKEESS No. 0796132, filed on January 27, 2006 and registered on May 5, 2006, covering services in class 36;
- Benelux device trademark SPUERKEESS No. 0796133, filed on January 27, 2006 and registered on May 5, 2006, covering services in class 36.
- Swiss trademark SPUERKEESS No. 615157, filed on December 30, 2010 and registered on May 10, 2011, covering goods and services in classes 9, 16, 25, 35, 36, 38, 39, 41, 42, 43, and 45;
- UK trademark SPUERKEESS No. UK00909110552, filed on May 17, 2010 and registered on November 2, 2010, covering goods and services in classes 9, 16, 25, 35, 36, 38, 39, 41, 42, 43, and 45;
- UK trademark SPUERKEESS No. UK00003345153 filed on October 12, 2018 and registered on December 28, 2018, covering services in class 36.

The disputed domain name was registered on May 14, 2022, and resolves to an inactive website.

5. Parties' Contentions

A. Complainant

The Complainant is well known in the bank sector.

The Complainant has become aware of registration of the disputed domain name which entirely reproduces its trademarks SPUERKEESS.

The expression "spuerkeess" is particularly distinctive and no other trademark containing this term exists, even in relation to activities unrelated to those protected in the Complainant's trademarks.

The disputed domain name reproduces precisely and entirely the trademarks SPUERKEESS.

The additional expression "lu" will be understood by the public as "Luxembourg" as it is a commonly used abbreviation, throughout the world, of this country, and is the international standard code for Luxembourg according to ISO 3166 Standard. As such, it is also the country code extension for Luxembourgish domain names.

As the Complainant is a Luxembourgish company, the element "lu" will only lead to an increase in the risk of confusion in the minds of the public who will think that they are dealing with a domain name owned and

possibly a website run by the Complainant.

The generic Top-Level Domain (“gTLD”) “.com” is not to be taken into consideration when examining the identity or similarity between the Complainant’s trademark and the disputed domain name. The mere adjunction of a gTLD is irrelevant as it is well established that the gTLD is insufficient to avoid a finding of confusing similarity.

The Respondent is not affiliated with the Complainant in any way nor has he been authorized by the Complainant to use and register its trademarks, or to seek registration of any domain name incorporating said trademark.

The Respondent has no prior rights or legitimate interest in the disputed domain name.

The trademark searches performed on the specialised platform FOVEA shows that the Respondent has no rights worldwide on the sign “spuerkeess” or derivatives.

It is implausible that the Respondent was unaware of the Complainant’s trademark rights when the Respondent registered the disputed domain name. The trademark SPUERKEESS does not exist in the English language and it is a pure Luxembourgish trademark, which establishes therefore a clear and evident link with the state bank of Luxembourg.

The term “spuerkeess” is generally known by the public in Luxembourg as being the Luxembourgish state saving bank.

The Complainant is well known by the public worldwide, being ranked among the 10 safest banks in the world in 2019.

Bad faith can be found where the Respondent “knew or should have known” of the Complainant’s trademark rights and, nevertheless registered domain name in which it had no rights or legitimate interest.

The disputed domain name resolves to an inactive website.

The fact that the Respondent is using the identical term “spuerkeess” leads to strongly believe that he will use it for phishing.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (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. Considering these requirements, the Panel rules as follows:

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant has provided evidence of its rights in the SPUERKEESS trademarks on the basis of its multiple trademark registrations in several countries. A trademark registration provides a clear indication that the rights in the

trademark belong to the Complainant (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#), section 1.2.1”). It has also been established by prior UDRP panels that incorporating a trademark in its entirety into a domain name can be sufficient to establish that the domain name is confusingly similar to a trademark. Such finding is confirmed, for example, within section 1.7 of [WIPO Overview 3.0](#).

The Respondent’s incorporation of the Complainant’s mark in full in the disputed domain name is sufficient to establish that the disputed domain name is confusingly similar to the Complainant’s marks. Mere fact of the addition of the geographic acronym “lu”, which corresponds to Luxembourg as the name of this country as well as the country-code of the ccTLD and a hyphen, to the Complainant’s trademark SPUERKEESS do not prevent a finding of confusing similarity with the Complainant’s marks. Furthermore, the addition of the gTLD “.live” does not prevent a finding of confusing similarity either.

The Panel is satisfied that the disputed domain name is identical or confusingly similar to the Complainant’s mark and the Complainant has satisfied the requirement of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant bears the burden of proof in establishing this requirement. In view of the difficulties inherent in proving a negative and because the relevant information is mainly in the possession of the Respondent, it is enough for the Complainant to establish a *prima facie* case which, if not rebutted by sufficient evidence from the Respondent, will lead to this ground being set forth.

Refraining from submitting any Response, the Respondent has brought to the Panel’s attention no circumstances from which the Panel could infer that the Respondent has rights to or legitimate interests in the disputed domain name.

The Panel will now examine the Complainant’s arguments regarding the absence of rights or legitimate interests of the Respondent in connection with the disputed domain name. The Complainant claims that the Respondent has no connection or affiliation with the Complainant and has not received any license or consent, express or implied, to use the Complainant’s trademarks in a domain name or in any other manner. Furthermore, the disputed domain name direct to an inactive website.

The Panel also finds that the nature of the disputed domain name carries a risk of implied affiliation with the Complainant’s trademarks (see [WIPO Overview 3.0](#), section 2.5.1).

The Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain names, and the Panel draws adverse inferences from this failure, where appropriate, in accordance with the Rules, paragraph 14(b). The Panel finds the Respondent has no rights or legitimate interests in respect of the disputed domain name and that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy stipulates that any of the following circumstances, *inter alia*, shall be considered as evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent’s documented out-of-pocket costs directly related to the domain name; or

(ii) circumstances indicating that the respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the

respondent has engaged in a pattern of such conduct; or

(iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on its website or location.

With regard to the bad faith at the time of registration, the Panel notes that "spuerkeess" is not a common or descriptive term, but a renowned trademark in and to which the Complainant has demonstrated has rights.

The disputed domain name reproduces, without any authorization or approval, the Complainant's registered trademarks, and this is the only distinctive component of the disputed domain name. Moreover, the disputed domain name is inherently misleading as it reproduces the Complainant's SPUERKEESS trademark together with geographic acronym "lu", which corresponds to Luxembourg, the country of the Complainant.

In addition, owing to the substantial presence established worldwide, it is at the least very unlikely that the Respondent was not aware of the existence of the Complainant's trademarks when registering a domain name that entirely reproduces the Complainant's trademark together with the geographic acronym of Luxembourg.

Therefore, it is more likely than not that the Respondent, when registering the disputed domain name, had knowledge of the Complainant's earlier rights to the SPUERKEESS trademark.

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 finds that the passive holding of the disputed domain name in the circumstances of the case does not prevent a finding of bad faith registration and use. On the contrary, this Panel agrees with the Complainant's assertion that in the case of domain names containing well-known earlier marks, passive holding can constitute an indication of bad faith.

Here the Panel finds that the Respondent's passive holding of the disputed domain name does not prevent a finding of bad faith (see section 3.3 of the [WIPO Overview 3.0](#)). In the circumstances, the Panel finds that the passive holding of the disputed domain name disrupts the Complainant's business.

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, <spuerkeess-lu.live> be transferred to the Complainant.

/Daniel Peña/

Daniel Peña

Sole Panelist

Date: July 29, 2022