

ADMINISTRATIVE PANEL DECISION

NATIXIS v. James Micheal

Case No. D2022-2756

1. The Parties

Complainant is NATIXIS, France, represented by Inlex IP Expertise, France.

Respondent is James Micheal, South Africa.

2. The Domain Name and Registrar

The disputed domain name is <natixisprivateuk.com> which is registered with Porkbun LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 27, 2022. On July 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 27, 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 those in the Complaint. The Center sent an email communication to Complainant on July 28, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on July 29, 2022.¹

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 Respondent of the Complaint, and the proceedings commenced on August 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 21, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on August 23, 2022.

¹ The original Complaint was filed against Whois Privacy / Private by Design, LLC, which appeared as registrant in the corresponding Whois report. The amended Complaint was filed against Respondent, as per the information disclosed by the Registrar.

The Center appointed Gerardo Saavedra as the sole panelist in this matter on August 26, 2022. This Panel finds that it was properly constituted. This 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

Complainant is a French company that forms part of Groupe BPCE, and is engaged in the provision of financial services, namely asset & wealth management, corporate & investment banking, insurance, and payments.

Complainant has rights in the NATIXIS mark for which it holds, *inter alia*, French registration No. 3416315 registered on March 14, 2006, in classes 9, 16, 35, 36, and 38; European Union registration No. 005129176 registered on June 21, 2007, in classes 9, 16, 35, 36, and 38; and, International registration No. 1071008 registered on April 21, 2010, in classes 9, 16, 35, 36, and 38.

Complainant is the registrant of the domain names <natixis.com> registered on February 3, 2005, and <natixis.fr> registered on October 20, 2006.

The disputed domain name was registered on May 31, 2022. At the time the Complaint was filed, the disputed domain name did not resolve to an active website since it returned an error message in French showing, among others, “Hum, nous ne parvenons pas à trouver ce site” (in English: “hum, we can’t manage to find this site”), “Impossible de se connecter au serveur à l’adresse natixisprivateuk.com” (“impossible to connect to the server of the address natixisprivateuk.com”).

5. Parties’ Contentions

A. Complainant

Complainant’s assertions may be summarized as follows.

With more than 16,000 employees in 36 countries, Complainant is part of Groupe BPCE, which is the second largest banking group in France. Complainant widely uses its NATIXIS marks in connection with banking and financial services. Complainant’s NATIXIS marks are well-known and enjoy a wide reputation in France and in several other countries; many UDRP decisions have recognized the notoriety of Complainant and its NATIXIS marks. Complainant has received a number of awards and recognitions, such as the Latin America MLA of the Year Award in 2020, was ranked No. 4 for European Fixed Income Research by the yearly Euromoney Fixed Income Research Survey, and was ranked by Dealogic as first bookrunner for syndicated real estate finance loans in the EMEA region in 2017.

The disputed domain name should be considered as confusingly similar to Complainant’s marks. The disputed domain name is composed of Complainant’s NATIXIS mark placed in leading position associated with the word “private” and the geographic identifier “uk” (which is the shorthand for United Kingdom). The NATIXIS mark has no meaning and is highly distinctive. Internet users will recognize the NATIXIS mark at the beginning of the disputed domain name. The term “private” confirms such recognition by the Internet users since it will be understood as an indicator for a special service line dedicated to private customers, while the geographic term “uk” identifies a location where Complainant is commercially active and offers its services.

Respondent has no rights or legitimate interests in respect of the disputed domain name. There is no relationship between Complainant and Respondent, and Complainant has neither authorized nor licensed Respondent to use its marks in any way. According to public searches, Respondent is not commonly known as NATIXIS or by the disputed domain name, and holds no trademark rights over “natixis”.

Respondent does not appear to engage in any legitimate noncommercial or fair use of the disputed domain name, nor any use in connection with a *bona fide* offering of goods and services. At some point, the disputed domain name was used as an almost exact copy of Complainant's official website offering financial services. Such website linked to the disputed domain name is no longer active as Complainant immediately took appropriate steps to get its deactivation. Thus, the disputed domain name is no longer associated with an active website.²

Where a domain name consists of a trademark plus an additional term, UDRP decisions have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. Given the NATIXIS reputation, it would be difficult to imagine an actual use of the disputed domain name that would not be aimed to free ride on the reputation of Complainant and its mark. Consequently, any use of the disputed domain name would misleadingly divert consumers into thinking that Respondent is, in some way, connected to, sponsored by or affiliated with Complainant and its business or that Respondent's activities are approved or endorsed by Complainant.

When registering the disputed domain name, Respondent employed a privacy service in order to hide its identity and avoid being notified of a UDRP proceeding, which is an inference of bad faith recognized in UDRP decisions.

The disputed domain was registered with the aim of taking advantage of the reputation of the NATIXIS mark. Respondent was perfectly aware of Complainant's marks and activities. The only reason for having registered the disputed domain name was to create confusion in the public's mind and to carry out unlawful activities.

Respondent linked the disputed domain name to a website that was a pure copy of Complainant's website, using Complainant's NATIXIS marks and offering financial services. Consumers were led to believe that there was a link between Complainant and said website. After receiving the takedown notice, the Registrar immediately deactivated the website associated with the disputed domain name. Email servers were activated and, following Complainant's takedown request, the Registrar suspended all services associated with the disputed domain name.³ Although the disputed domain name no longer resolves to an active website, it is in the public interest to transfer the disputed domain name to Complainant in order to avoid that it be used to mislead consumers.

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

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

The lack of Response from Respondent does not automatically result in a favorable decision for Complainant (see *Berlitz Investment Corp. v. Stefan Tinculescu*, WIPO Case No. [D2003-0465](#), and section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The burden for Complainant, under paragraph 4(a) of the Policy, is to show: (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; (ii)

² Complainant supplied no evidence of such alleged prior use of the disputed domain name and the content of the website formerly linked to it.

³ Complainant supplied no evidence of such alleged takedown request or of the email servers activation.

that 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.

In examining the record of the present case, this Panel wonders whether Complainant could have put forward better arguments and more evidence. As set forth in other UDRP cases, this Panel reiterates that it is the Parties' responsibility to present their case with appropriate arguments and evidence.⁴

A. Identical or Confusingly Similar

It is undisputed that Complainant has rights over the NATIXIS mark.

Since the addition of a generic Top-Level Domain ("gTLD") *i.e.* ".com" in a domain name is technically required, it is well established that such element may be disregarded where assessing whether a domain name is identical or confusingly similar to a mark. The disputed domain name reflects the NATIXIS mark in its entirety, albeit followed by "privateuk". It is clear to this Panel that the NATIXIS mark is recognizable in the disputed domain name and that the addition of such characters in the disputed domain name does not avoid its confusing similarity with said mark (see sections 1.7 and 1.8 of the [WIPO Overview 3.0](#)).

Thus, this Panel finds that Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Complainant contends that it has not authorized Respondent to use its NATIXIS mark, that Respondent is not commonly known by the disputed domain name, that Complainant has no relationship with Respondent, that Respondent is not using the disputed domain name in connection with any *bona fide* offer of products or services, and that the disputed domain name creates confusion with Complainant and its mark. The evidence in the file shows that there is no active website linked to the disputed domain name. The disputed domain name reflects Complainant's name and mark in its entirety, and thus it seems to this Panel that the composition of the disputed domain name carries a risk of implied affiliation (see section 2.5.1 of the [WIPO Overview 3.0](#)).

This Panel considers that Complainant has established a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain name (see, *Casio Keisanki Kabushiki Kaisha (Casio Computer Co., Ltd.) v. Jongchan Kim*, WIPO Case No. [D2003-0400](#), and section 2.1 of the [WIPO Overview 3.0](#)). In the file there is no evidence of circumstances of the type specified in paragraph 4(c) of the Policy, or of any other circumstances, giving rise to a possible right to or legitimate interest in the disputed domain name by Respondent.

Based on the aforesaid, this Panel concludes that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

It is uncontested that Complainant's NATIXIS mark is well known internationally. Taking into consideration that Complainant's registration and use of the NATIXIS mark preceded the creation of the disputed domain name, that such mark appears to be a coined term, and Complainant's international presence, this Panel is of the view that Respondent should have been aware of the existence of Complainant and its NATIXIS mark at the time Respondent obtained the registration of the disputed domain name.

As previously noted, the Complainant has claimed that the disputed domain name was previously connected to a website that impersonated the Complainant, which would be *per se* evidence of bad faith, however no

⁴ See, *Koninklijke Philips Electronics N.V. v. Relson Limited*, WIPO Case No. [DWS2001-0003](#): "Mere 'assertions' are nothing more than argument and must in each case be based on facts proved through evidence". See also, *The Skin Store, Inc. v. eSkinStore.com*, WIPO Case No. [D2004-0661](#): "The Panel suspects [...] that further evidence could have been produced, but it is not the job of the Panel to hunt it out".

evidence has corroborated such prior use. The evidence supplied by Complainant shows that the disputed domain name does not resolve to an active website. The concept of a domain name “being used in bad faith” is not limited to a domain name with an active website on the Internet. Several UDRP decisions have held that the passive holding of a domain name that incorporates a well-known mark, without obvious legitimate purpose, does not prevent a finding of bad faith under paragraph 4(a)(iii) of the Policy.⁵

It seems to this Panel that there is no basis to conceive a legitimate use of the disputed domain name by Respondent. In reaching that conclusion, this Panel has taken into account, in addition to the circumstances mentioned above, the following: (i) Complainant is a well-established company; (ii) Respondent is using Complainant’s name and NATIXIS mark at the disputed domain name without Complainant’s authorization; (iii) the risk of implied affiliation of the disputed domain name with Complainant’s name and mark, which makes this Panel consider that the disputed domain name may potentially be used for fraudulent activities; (iv) Respondent’s use of a privacy service to hide its name and contact details; and (v) Respondent’s failure to appear in this proceeding, which is indicative that Respondent lacks arguments and evidence to support its holding of the disputed domain name.

In sum, the overall evidence indicates that Respondent’s choice of the disputed domain name was deliberate for its confusing similarity with, and with the likely intention to benefit from the reputation and goodwill of, Complainant’s NATIXIS mark, which denotes bad faith.

In light of the above, this Panel finds that 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, this Panel orders that the disputed domain name <natixisprivateuk.com> be transferred to Complainant.

/Gerardo Saavedra/

Gerardo Saavedra

Sole Panelist

Date: September 9, 2022

⁵ See, *Ferrari S.p.A. v. Ms. Lee Joohee (or Joo-Hee)*, WIPO Case No. [D2003-0882](#): “Respondent has provided no evidence or suggestion of a possible legitimate use of the Domain Name. Thus, in the words of Telstra, it is not possible to conceive of any plausible actual or contemplated active use of the Domain Name by the Respondent that would not be illegitimate”. See also section 3.3 of the [WIPO Overview 3.0](#).