

## **ADMINISTRATIVE PANEL DECISION**

**BPCE v. Emmanuel Asamoah**

**Case No. D2022-3866**

### **1. The Parties**

The Complainant is BPCE, France, represented by DBK Law Firm, France.

The Respondent is Emmanuel Asamoah, Ghana.

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

The disputed domain name <bpceinvestment.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 14, 2022. On October 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 17, 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 October 18, 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 October 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 13, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 15, 2022.

The Center appointed Andrea Jaeger-Lenz as the sole panelist in this matter on November 29, 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 French joint stock company acting as the central institution responsible for the two banking networks Banque Populaire and Caisse d'Epargne. It is the second largest banking group in France and pursues a full range of banking, financing and insurance activities, working through Banque Populaire and Caisse d'Epargne and through its different subsidiaries. The Complainant's 105,000 employees worldwide serve a total of thirty-six million customers. It is present in more than forty countries via its various subsidiaries.

The Complainant, among others, is the owner of the following trademarks for the term BPCE:

- the European Union trademark BPCE (word with logo) registered under number 8375875 on January 12, 2010, for financial services in class 36;
- the European Union trademark BPCE (word) registered under number 8375842 on January 12, 2010, for financial services in class 36
- the French trademark BPCE (word) registered under number 3653852 on May 29, 2009, for services in classes 9, 16, 35, 36, 38, 41, and 45;
- the International trademark BPCE (word with logo) registered under number 1033662 on December 15, 2009, for financial services in class 36;

The Complainant is also the owner of domain names incorporating "BPCE", directly and also via its subsidiary GCE TECHNOLOGIES, such as "www.bpce.fr" registered in 2008 and "www.groupebpce.fr" or "www.groupebpce.com" registered in 2009, and corresponding to an active website, the institutional portal of the Complainant.

The disputed domain name has been registered on August 22, 2022, anonymously and with the registrant being designated as "Privacy service provided by Withheld for Privacy ehf". It resolved to a website in English offering concurrent banking and financial services using the trademarks (Annexes 8 and 16 to the Complaint).

The Complainant sent a cease-and-desist letter on September 21, 2022, which remained unanswered.

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

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

On the first element, the Complainant argues as follows:

The Complainant is the owner of various trademarks consisting of BPCE for banking and financial services in classes 36. The disputed domain name reproduces identically its trademarks which it claims to be well-known and which is sufficient to establish confusing similarity. The addition of the word "investment" as a suffix and the generic Top Level Domain ("gTLD") ".com" do not prevent a finding of confusing similarity with the trademarks.

On the contrary, the addition of the word "investment" is descriptive and directly refers to the Complainant's financial and investment activities including its corporate and investment banking activities which thus contributes to emphasize the likelihood of confusion. Therefore, the Internet users will believe that the disputed domain name is related to the Complainant.

The addition of the gTLD ".com" will not be taken into account to assess the likelihood of confusion between the signs.

Thus, this use of the trademarks in the disputed domain name leads the public to believe that it belongs to the Complainant and is an expansion of its services.

On the second element, the Complainant states the following:

The Complainant has never authorized the Respondent to register and/or use any domain name incorporating its trademark.

The Complainant has not granted any license, nor any authorization to use the trademarks, included as a domain name.

Thus, the Respondent has no right to use the disputed domain name. Besides, the term "BPCE" has no meaning in English or in French. The trademarks are well-known in France and throughout the world. The disputed domain name is leading to a website offering concurrent banking and financial services as the Complainant. Therefore, the disputed domain name is obviously calculated to confuse or deceive, as it falsely suggests that any services provided thereunder are linked to the Complainant.

In addition, the Complainant puts forth that the Respondent cannot have been known under the disputed domain name either. The Registrant information on the disputed domain name was, in the first place, anonymized by using a privacy service. The information displayed on the website, into which the disputed domain name resolved, referred to a fake German address. In contrast, the information about the registrant on the Whois-information referred to an address in Iceland, and later on, the Respondent was revealed as having an address in Ghana with no relation whatsoever with Germany. According to the search undertaken in the commercial register a company by the Complainant, a company by the name of "BPCE Investment" does not exist in Germany.

On the third element, the Complainant puts forth the following arguments:

The Complainant's trademark registrations pre-date the registration of the disputed domain name.

The Complainant is well-known in France and throughout the world, notably by financial and banking market consumers. The Center has already recognized the reputation of the Complainant in previous decisions (*BPCE v. Withheld for Privacy Purposes, Privacy services provided by Withheld for Privacy ehf/pascale kiss, cherhgi*, WIPO Case No. [D2021-1251](#) regarding <caissedepargne-particulier.com>; *BPCE v. WhoisGuard Protected, WhoisGuard, Inc. / Fransis Coarno, Danstic*, WIPO Case No. [D2020-0967](#) regarding <bpce-investment.com>; *BPCE v. Pierre Agou Michel*, WIPO Case No. [D2020-2361](#) regarding <bpceii.com>).

Consequently, the choice of the disputed domain name is not a mere coincidence, but has been done on purpose to generate a likelihood of confusion with the domain names and the trademarks of the Complainant. The Complainant's trademarks are well-known, so in application of the previous case law, it shall be deemed that the registration of the disputed domain name has been done *per se* in bad faith.

By its website, the Respondent has been using the disputed domain name in bad faith. It creates confusion with the Complainant because it offers identical banking and financial services. The website into which the disputed domain name resolves, reproduces the trademarks indicating the following "Private bank with expertise since 1999 Founded 11 in 1999, BPCE Investment Bank which was created out of BPCE is one of Europe's leading privately owned Investment bank today with its Wealth and Asset Management, Investment Bank and Corporate Banking divisions" to mislead the Complainant's consumers. Neither the email address indicated on the website nor the alleged address do exist, which is an indication that the Respondent uses the disputed domain name in bad faith, in order to attract the Internet users and customers of the Complainant known in Europe. By doing this, the Respondent is taking advantage of the reputation and goodwill of the Complainant's trademark and image in an effort to attract users and generate traffic on his website and possibly revenue by eventually obtaining confidential information.

## **B. Respondent**

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

## 6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove that each of the following three elements is present:

- (i) the disputed domain name is identical or confusingly similar to the Complainant's trademarks; and
- (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.

In the following, the Panel will discuss in consecutive order whether each of these requirements are met.

### A. Identical or Confusingly Similar

On the first element, the test for identity or confusing similarity under paragraph 4(a)(i) of the Policy is limited in scope to a direct comparison between the Complainant's marks and the textual string which comprises the disputed domain name.

The Complainant has demonstrated registered trademark rights in the term BPCE. The disputed domain name consists of the word "bpceinvestment" and the gTLD ".com".

Thus, the disputed domain name contains the trademark in its entirety, only adding the term "investment", which is descriptive of the services for which the disputed domain name is used, and the gTLD ".com". With the gTLD being disregarded, the additional term "investment" does not prevent a finding of confusing similarity either. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8.

The disputed domain name wholly incorporates the distinctive trademark BPCE and the addition of "investment" does not prevent the Complainant's trademarks from being recognizable in the disputed domain name.

In view of the above, the Panel finds that the disputed domain name is confusingly similar to the BPCE trademarks, in which the Complainant has rights. The requirements of paragraph 4(a)(i) of the Policy are, therefore, satisfied.

### B. Rights or Legitimate Interests

On the second element, under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the panel, shall demonstrate that the respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

- (i) before any notice to respondent of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the disputed domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

It is a consensus view under the UDRP that it is sufficient for the Complainant to make a *prima facie* showing that the Respondent has no rights or legitimate interests in the disputed domain name in order to place the burden of production on the Respondent ([WIPO Overview 3.0](#), section 2.1). If the Respondent fails to come forward with such relevant evidence, the Complainant is deemed to have satisfied the second element.

In the present case, the Complainant has not licensed or otherwise consented to the Respondent's use of the BPCE trademark in connection with the disputed domain name.

Indeed, the Complainant has provided evidence that it is the legitimate holder of BPCE trademark rights and having used those trademarks in commerce before the registration of the disputed domain name. Conversely, there is no evidence in the case file that the Respondent holds any unregistered rights in a mark corresponding to the disputed domain name. Therefore, paragraph 4(c)(ii) of the Policy does not apply.

Furthermore, the Complainant has provided evidence that the website which the disputed domain name resolved to was used to offer services identical to those the Complainant is offering, namely corporate banking investment services and online banking.

The Panel does not consider either use of the disputed domain name as covered by legitimate interests because the Respondent effectively suggested a non-existing affiliation with the Complainant. This neither constitutes a use in connection with a *bona fide* offering of goods or services under paragraph 4(c)(i) of the Policy, nor a fair or legitimate noncommercial use without intent for commercial gain to misleadingly divert customers under paragraph 4(c)(iii) of the Policy.

Rather, the Panel holds that the Respondent's use was designed to take unfair advantage of the Complainant's reputation by diverting customers away from the Complainant's website in order to profit from a false association with the Complainant's trademarks and for the purpose of making its own commercial gain.

Considering the above, the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks any rights or legitimate interests in the disputed domain name. Although given the opportunity, the Respondent has not replied to the Complainant's contentions and therefore failed to invoke any circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy or otherwise, any rights or legitimate interests in respect of the disputed domain name.

Thus, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(ii) of the Policy.

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

Under paragraph 4(a)(iii) of the Policy, the Complainant has to establish that the Respondent registered and is using the disputed domain name in bad faith. Paragraph 4(b) of the Policy provides that certain circumstances, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The fourth circumstance is as follows:

"(iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's 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 registrant's website or location or of a product or service on the registrant's website or location."

As regards registration, the disputed domain name was registered in August 2022, about 13 years after the Complainant obtained its first trademark registration for the BPCE trademark. Furthermore, the Panel accepts the Complainant's contention that, offering its services on a worldwide basis via the banking networks Banque Populaire and Caisse d'Epargne on its website, it has grown into a well-known and reputable service provider in the area of banking and finance with customers all around the world long before the disputed domain name was registered.

According to [WIPO Overview 3.0](#), section 3.1.4, the registration of a domain name that is identical or confusingly similar to a widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Given the reputation of the Complainant's BPCE trademark, the timing of the registration of the disputed domain name, and the close connection of the disputed domain name and the trademark,

reinforcing the association between the disputed domain name and the website, into which it resolved, with the services, for which the trademark of the Complainant is used, by the descriptive term “investment” in its textual string, the Panel concludes that the disputed domain name has not been chosen coincidentally but consciously in order to take advantage of the Complainant’s trademarks (see also *Canva Pty Ltd v. Varinder Rajoria, KnotSync Ltd*, WIPO Case No. [D2021-2577](#)).

This point is further confirmed by the Respondent’s use in bad faith. As discussed above, the Panel takes the view that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website by consciously creating a likelihood of confusion with the Complainant’s trademark. The disputed domain name has been used for a website where services identical to those of the Complainant have been offered. The website featured both an overview of the services provided and, among other, an “email us” button, which suffices to establish the intention of commercial gain.

In conclusion, the Panel determines that, for all of the above reasons, the disputed domain name has been registered and is being used in bad faith and, accordingly, that the Complainant has satisfied the requirement of paragraph 4(a)(iii) of the Policy.

## **10. 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 <bpceinvestment.com> be transferred to the Complainant.

*/Andrea Jaeger-Lenz/*

**Andrea Jaeger-Lenz**

Sole Panelist

Date: December 13, 2022