

ADMINISTRATIVE PANEL DECISION

LO IP SA and Banque Lombard Odier & Cie SA v. Mike, SummerFis
Case No. D2022-3918

1. The Parties

The Complainants are LO IP SA and Banque Lombard Odier & Cie SA, Switzerland, represented by Baker & McKenzie Zurich, Switzerland.

The Respondent is Mike, SummerFis, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <lombardodiers.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 19, 2022. On October 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 20, 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 Complainants on October 20, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on October 25, 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 November 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 23, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 24, 2022.

The Center appointed Zoltán Takács 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 Complainants are both members of the Lombard Odier group of companies (“Lombard Odier”). Lombard Odier is a renowned Swiss private bank founded in Geneva, Switzerland in 1796 and is one of the leading providers of wealth management services worldwide.

The Complainant LO IP SA is owner of the Swiss Trademark Registration No. 2P-412721 for the word mark LOMBARD ODIER & CIE covering financial and monetary affairs of class 36 of the Nice Agreement Concerning the International Classification of Good and Services for the Purpose of the Registration of Marks (the “Nice Classification”). This trademark has the filing priority of June 28, 1994, but according to the trademark certificate issued by the Swiss Federal Institute of Intellectual Property its priority based on its use dates back to 1830.

The Complainant LO IP SA also owns the International Trademark Registration (“IR”) No. 627468 for the word mark LOMBARD ODIER & CIE, registered in a number of jurisdictions since October 13, 1994 for financial and monetary affairs of class 36 of the Nice Classification.

Lombard Odier has presence on the Internet through its website “www.lombardodier.com”. The corresponding domain name <lombardodier.com>, owned by the Complainant Banque Lombard Odier & Cie SA, has been registered since July 29, 1996.

The disputed domain name <lombardodiers.com>, registered on September 1, 2022, does not display any content and there is no evidence it was ever put to any use.

5. Parties’ Contentions

A. Complainants

The Complainants contend that the disputed domain name is confusingly similar to the Complainant LO IP SA’s trademark, since it fully incorporates the distinctive element of the trademark (LOMBARD ODIER), with mere addition of the letter “s” to it.

The Complainants argue that the Respondent has no rights or legitimate interests in respect of the disputed domain name and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii) or (iii) of the Policy.

The Complainants claim that the Respondent’s registration and anticipated use of the disputed domain name creates a risk of confusion with Lombard Odier’s business and intellectual property rights, which is showing of bad faith.

The Complainants request that the disputed domain name <lombardodiers.com> be transferred from the Respondent to the Complainant LO IP SA.

B. Respondent

The Respondent did not reply to the Complainants’ contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "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".

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that;

- (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.

A. Identical or Confusingly Similar

Under paragraph 4(a)(i) of the Policy, there are two requirements which a complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain name is identical or confusingly similar to the trademark or service mark.

It has been a consensus view among UDRP panels that "where the complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case" (see section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

The Complainants produced proper evidence of having rights in the LOMBARD ODIER & CIE trademark, and for the purpose of this proceeding, the Panel establishes that the Swiss Trademark Registration No. 2P-412721 and IR No. 627468 satisfy the requirement of having trademark rights for the purpose of the Policy.

Having determined the presence of the Complainants' trademark rights in the LOMBARD ODIER & CIE mark, the Panel next assesses whether the disputed domain name is identical or confusingly similar to the Complainants' trademark.

According to section 1.7 of the [WIPO Overview 3.0](#), the standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

According to section 1.8 of the [WIPO Overview 3.0](#), 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.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable Top-Level Domain ("TLD") in a domain name (in this case ".com") is viewed as a standard registration requirement and as such is generally disregarded under the first element confusingly similar test.

The disputed domain name fully incorporates the dominant feature of the trademark LOMBARD ODIER & CIE, *i.e.*, "lombard odier". The Respondent's addition of the letter "s" to the dominant feature of the LOMBARD ODIER & CIE trademark does not prevent a finding of confusing similarity.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the LOMBARD ODIER & CIE trademark and that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

According to section 2.1 of the [WIPO Overview 3.0](#), 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 the 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.

In the present case, the Complainants have submitted sufficient and uncontested evidence of holding well-established rights in the LOMBARD ODIER & CIE trademark.

The Respondent is not connected or affiliated with the Complainants and has not received license or consent to use the trademark in any way, which priority precedes the date of registration of the disputed domain name. The disputed domain name does not display any content and there is no evidence it was ever put to any use.

The Respondent chose not to respond to the Complaint, to the facts and circumstances brought forward by the Complainants. By doing so, the Respondent failed to offer the Panel any type of evidence set forth in paragraph 4(c) of the Policy, or otherwise counter the Complainants’ *prima facie* case.

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name in accordance with paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

- (i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.

The dominate feature of the Complainants' trademark, "lombard odier", is unique to the Complainants. A basic Internet search against the disputed domain name returns solely the Complainants and their businesses.

The Respondent has registered the disputed domain name that fully incorporates the term "lombard odier", the dominant feature of the Complainants' trademark, and in view of the Panel, such composition of the disputed domain in all likelihood cannot refer to anyone else but the Complainants and suggests that the Respondent clearly had in mind the Complainants and their businesses at the time of obtaining the disputed domain name. This finding has been reinforced by the fact that the disputed domain name is almost identical to the Complainants' domain name <lombardodier.com>.

The Panel cannot conceive any other reason for the Respondent's decision to register the disputed domain name other than to exploit the reputation behind the Complainants' business and trademark without any authorization or rights to do so.

There is no evidence that the disputed domain name has been used in any active way. Nevertheless, from the inception of the UDRP, panels have found that the non-use of a domain name (including a blank page) would not prevent a finding of bad faith under the doctrine of passive holding (see section 3.3 of the [WIPO Overview 3.0](#)). The Panel cannot foresee any legitimate use of the disputed domain name by the Respondent other than deliberately targeting the Complainants' business and trademark, which establishes bad faith considering the totality of the circumstances present here.

Accordingly, the Panel finds that paragraph 4(a)(iii) of the Policy is satisfied.

8. 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 <lombardodiers.com> be transferred to the Complainant LO IP SA.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: December 11, 2022