

## **ADMINISTRATIVE PANEL DECISION**

Helaba Invest Kapitalanlagegesellschaft mbH v. Host Master, 1337 Services LLC

Case No. D2024-2539

### **1. The Parties**

The Complainant is Helaba Invest Kapitalanlagegesellschaft mbH, Germany, represented by Harmsen Utescher, Germany.

The Respondent is Host Master, 1337 Services LLC, Saint Kitts and Nevis.

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

The disputed domain name <helabainvest.com> is registered with Tucows Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 21, 2024. On June 21, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 22, 2024, 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 28, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 18, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 22, 2024.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on July 31, 2024. 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 was founded on January 30, 1991 and is a wholly-owned subsidiary of the Sparkasse-Group in Germany.

The Complainant is an investment management business providing portfolio and real estate management services to a range of pension funds, insurance companies, credit institutions, companies social security institutions and others in Germany. The Complainant manages assets in the order of 231 billion EUR.

Amongst other things, it promotes its services from a website at "www.helaba-invest.de". Its LinkedIn account has 3,000 followers and says it has between 200 and 500 employees.

According to the Whois report, the disputed domain name was registered on June 22, 2023.

When the Complaint was filed, it resolved to a website which featured an image resembling a graph showing a stock price tracker and various USD amounts. To the right of the image was the heading "H Helaba Invest" and a login function with further links to register or for a lost password.

According to the Complaint, if one clicked on the link to create an account, one was redirected to a message that the website cannot be found.

In around January 2024, the Complainant was contacted by a person who claimed to have placed USD 130,000 in an account with the Complainant. Upon further investigation, the person identified the Respondent's website through which the person said they had made the deposit.

The Complainant reported this activity to the German police. On March 27, 2024, however, the Public Prosecutor discontinued the complaint as it was unable to identify the perpetrator. The Public Prosecutor advised that the complaint would be re-opened if further information clarifying the claim could be provided.

#### **5. Discussion and Findings**

No response has been filed. The Complaint and Written Notice have been sent, however, to the Respondent at the electronic and physical coordinates confirmed as correct by the Registrar in accordance with paragraph 2(a) of the Rules. Bearing in mind the duty of the holder of a domain name to provide and keep up to date correct Whois details, therefore, the Panel finds that the Respondent has been given a fair opportunity to present his or its case.

When a respondent has defaulted, paragraph 14(a) of the Rules requires the Panel to proceed to a decision on the Complaint in the absence of exceptional circumstances. Accordingly, paragraph 15(a) of the Rules requires the Panel to decide the dispute on the basis of the statements and documents that have been submitted and any rules and principles of law deemed applicable.

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; 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.

## A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

It is well accepted that the first element functions primarily as a standing requirement. 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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant does not hold a registered trademark. Instead, it relies on its rights under section 12 of the German Civil Code and in its trade name under section 5(2) of the German Trademark Act arising from its long and extensive use.

According to the Complainant, the German Supreme Court has held that registration of a domain name, even without use, is sufficient to confer protection on a name under section 12 of the German Civil Code. This may be in contrast with the position under section 5(2) of the German Trademark Act which the Complainant characterises as turning on use and distinctiveness.

It is well-established that rights in an unregistered trademark can qualify as a trademark for the purposes of the first element under the Policy. See e.g. [WIPO Overview 3.0](#), section 1.3.

Bearing in mind the global operation of the Policy, panels have generally accepted that a complainant in a civil law country may establish rights in an unregistered trademark for the purposes of the Policy on the same basis as a complainant in a common law country by establishing acquired distinctiveness through use and promotion. See e.g. *Land Sachsen-Anhalt v. Skander Bouhaouala* WIPO Case No. [D2002-0273](#), *S.N.C. Jesta Fontainebleau v. Po Ser*, WIPO Case No. [D2009-1394](#) and *GSB Gold Standard Banking Corporation AG and Josip Heit v. Domain Administrator d/b/a privacy.cloudns.net, Cloud DNS Ltd.*, WIPO Case No. [D2021-1441](#).

In the present case, the Panel finds the Complainant has satisfied the requirements to establish rights in an unregistered trademark having regard to:

1. the distinctive nature of the trademark HELABA INVEST as a coined term (being a contraction of "Landesbank Hessen-Thüringen" and the word "invest");
2. the length of user, having been established and operating since 1991;
3. the apparently wide extent of institutions and persons in Germany who are customers or clients of the Complainant;
4. the scale of the Complainant's operation with some EUR 2.3 billion under management; and
5. as discussed below, the Respondent's intention to attract users to the Respondent's website by reference to the Complainant's trademark.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties, the date they were acquired and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such

matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g. [WIPO Overview 3.0](#), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top-Level-Domain (“gTLD”) component as a functional aspect of the domain name system ([WIPO Overview 3.0](#), section 1.11).

Disregarding the “.com” gTLD, the only difference between the disputed domain name and the Complainant’s trademark is the insertion of a hyphen between “helaba” and “invest”. This is far too insignificant to avoid a finding of at least confusing similarity. See e.g. *Telstra Corporation Limited v Ozurils* WIPO Case No. [D2001-0046](#).

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is at least confusingly similar to the Complainant’s trademark and the requirement under the first limb of the Policy is satisfied.

## **B. Rights or Legitimate Interests**

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name. These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

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 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. [WIPO Overview 3.0](#), section 2.1.

In the present case, the Respondent registered the disputed domain name well after the Complainant began using its trademark.

It is not contested between the parties that the Complainant has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

So far as can be gleaned from the record in this case, the disputed domain name is not derived from the Respondent’s name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain name could be derived.

It appears that the Respondent’s website was not functional when the Complaint was submitted. It is not therefore being used in connection with a good faith offering of goods or services. If it were functioning previously, the evidence would suggest it was being used in connection with some sort of fraud or scam. In any event, the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name.

These matters, taken together, are sufficient to establish a prima facie case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain name. The basis on which the Respondent has adopted the disputed domain name, therefore, calls for explanation or justification. The

Respondent, however, has not sought to rebut that prima facie case or advance any claimed entitlement. Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

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

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: See e.g. *Group One Holdings Pte Ltd v. Steven Hafto* WIPO Case No. [D2017-0183](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

The content of the website to which the disputed domain name resolved indicates that the Respondent was well aware of the Complainant and its trademark when registering the disputed domain name which, apart from the gTLD, consists of a coined and distinctive term.

Having regard to those matters, it more than amply appears that the Respondent registered the disputed domain name at the very least to target the Complainant's trademark and, given the case of the allegedly "lost" USD 130,000 to commit fraud. Accordingly, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

Accordingly, the Complainant has established all three requirements under the Policy.

## **6. 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 <helabainvest.com> be transferred to the Complainant.

*/Warwick A. Rothnie/*

**Warwick A. Rothnie**

Sole Panelist

Date: August 14, 2024