

## **ADMINISTRATIVE PANEL DECISION**

**Basler Kantonalbank v. John Kiroso, TaS Box**  
**Case No. D2023-2093**

### **1. The Parties**

The Complainant is Basler Kantonalbank, Switzerland, represented by Rentsch Partner Ltd., Switzerland.

The Respondent is John Kiroso, TaS Box, United Kingdom.

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

The disputed domain names <bkb-ch.cc>, <bkb-ch.cloud>, <bkb-ch.com>, <bkb-ch.me>, <bkb-ch.net>, and <bkb-ch.org> are registered with NameSilo, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 11, 2023. On May 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On May 11, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 12, 2023, 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 May 16, 2023.

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 May 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 13, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 21, 2023.

The Center appointed Marilena Comanescu as the sole panelist in this matter on June 28, 2023. 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**

Founded in 1899, the Complainant is a well-established Swiss cantonal bank headquartered in Basel and is providing retail and business banking products to its customers, having a government guarantee and a AA+ rating from Standard & Poor's, and being one of the ten largest Swiss banks in terms of total assets.

The Complainant holds trademark registrations for BKB, such as the following:

- the Swiss Trademark registration No. 2P-449714 for BKB DIRECT, filed/registered on August 25, 1997, and covering services in Nice classes 36 and 38; and
- the Swiss Trademark registration No. 697603 for MYBKB, filed/registered on December 23, 2016, and covering goods and services in Nice classes 16, 35, 36, 38, and 42.

The Complainant's official website at <bkb.ch> is active since 1998, and on this website the Complainant markets and advertises its financial services in business transactions, and offers its customers services to log into their banking accounts.

The disputed domain names were registered as follows:

- <bkb-ch.com>, <bkb-ch.net>, and <bkb-ch.org> were registered on June 13, 2022; and
- <bkb-ch.cc>, <bkb-ch.cloud>, and <bkb-ch.me> were registered on June 14, 2022.

At the time of filing the Complaint, the disputed domain names do not resolve to active webpages.

According to the evidence provided as Exhibits 24-25 to the Complaint, the disputed domain name <bkb-ch.com> was used to redirect to display an imitation of a jewelry manufacturer website.

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

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

The Complainant contends that the disputed domain names are confusingly similar to its domain name and distinctive trademark BKB with the additional element "ch" which is a direct geographical term (country code) for Switzerland and corresponds to the Swiss Top-Level-Domain ".ch"; the Respondent has no rights or legitimate interests in the disputed domain names; and the Respondent registered and is using the disputed domain names in bad faith by using them in the past for a phishing scheme to redirect Internet users on fake e-banking login pages or to imitate third parties' websites. The Complainant requests the transfer of the disputed domain names to it.

##### **B. Respondent**

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

#### **6. Discussion and Findings**

In view of the absence of a Response, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent. Under paragraph 4(a) of the Policy, the Complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (i) the disputed domain names are 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 the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The Panel will further analyze the potential concurrence of the above circumstances.

#### **A. Identical or Confusingly Similar**

The Panel finds that the Complainant holds rights in the BKB trademark.

All the disputed domain names incorporate the Complainant's trademark BKB followed by a dash and the additional term "ch".

However, such additions do not prevent a finding of confusing similarity as the Complainant's trademark is clearly recognizable within the disputed domain names. Numerous UDRP panels have considered that the addition of other terms (whether geographical, descriptive, pejorative, meaningless, or otherwise) to trademarks in a domain name does not prevent a finding of confusing similarity. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Further, it is well established in decisions under the UDRP that the Top-Level Domain ("TLD") (e.g., ".com", ".net", ".org", ".cloud", ".cc", or ".me") may typically be disregarded for the purposes of consideration of confusing similarity between a trademark and a domain name. See section 1.11.1 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the disputed domain names are confusingly similar to the trademark BKB, pursuant to the Policy, paragraph 4(a)(i).

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

The Complainant asserts that the Respondent does not hold any trademark rights, license, or authorization whatsoever to use the mark BKB, that the Respondent is not commonly known by the disputed domain names and that the Respondent has not used the disputed domain names in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods or services.

In line with the case law, "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". See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has put forward a *prima facie* case that the Respondent does not have any rights or legitimate interests in the disputed domain names. The Respondent has not replied to the Complainant's contentions and has not come forward with relevant evidence to rebut the Complainant's *prima facie* case. There is nothing in the record suggesting that the Respondent has ever been commonly known by the disputed domain names or that the Respondent made a *bona fide* offering of goods or services or a legitimate noncommercial use under the disputed domain names.

At the time of filing the Complaint, all six disputed domain names are kept inactive and this, together with all the circumstances in this case, does not amount to a *bona fide* or legitimate use.

According to the evidence provided in the Complaint, at least one disputed domain name was fraudulently used to copy a third party's commercial website. In this regard, UDRP panels have categorically held that the use of a domain name for illegal activity (such as swindle, fraud, identity theft, phishing, and impersonation/passing off) can never confer rights or legitimate interests in a respondent. See section 2.13 of the [WIPO Overview 3.0](#).

Moreover, the composition of the disputed domain names (trademark plus the Complainant's country code) cannot constitute fair use as they carry a risk of implied affiliation to the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

For all these reasons, the Panel finds that the second element of the Policy is established, and the Respondent has no rights or legitimate interests in respect of the disputed domain names, pursuant to the Policy, paragraph 4(a)(ii).

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

The Complainant holds trademark rights for more than a quarter of a century and promotes its business under the domain name <bkb.com> since 1998.

The disputed domain names were registered in June 2022 and incorporate the Complainant's trademark with the additional geographical term "ch", Switzerland being the country where the Complainant is based and renowned in its industry.

From the above, the Panel finds that the Respondent was aware of the Complainant, its business, and trademark at the time of registration of the disputed domain names.

At the time of filing the Complaint, all six disputed domain names resolved to error pages. From the inception of the UDRP, panels have found that the non-use of a domain name (including a blank or "coming soon" or other similar inactive page) would not prevent a finding of bad faith under the doctrine of passive holding. The Panel must examine all the circumstances of the case to determine whether the Respondent is acting in bad faith. Examples of what may be relevant circumstances found to be indicative of bad faith include the degree of distinctiveness or reputation of the complainant's mark and the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good faith use. See section 3.3 of the [WIPO Overview 3.0](#).

As previously mentioned, the disputed domain names incorporate the Complainant's trademark with the additional term, the country code of the Complainant's country of origin; and the Respondent failed to participate in this proceeding and to put forward any argument in its favor.

Paragraph 4(b)(ii) of the Policy provides another circumstance of bad faith registration and use when the respondent registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct. The Panel finds that registering for at least six disputed domain names reflecting the Complainant's trademark, within a two consecutive day time span, can be considered a pattern of abusive conduct and registration of the disputed domain names in bad faith. See section 3.1.2 of the [WIPO Overview 3.0](#).

The Respondent has not participated in the present proceeding and provided inaccurate contact information in the WhoIs. Such facts, together with all the other elements in this case, supports, in the eyes of this Panel, a further finding of bad faith behavior.

For all the above reasons, the Panel finds that the Respondent registered and is using the disputed domain names in bad faith, pursuant to the Policy, paragraph 4(a)(iii).

## 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 names <bkb-ch.cc>, <bkb-ch.cloud>, <bkb-ch.com>, <bkb-ch.me>, <bkb-ch.net>, and <bkb-ch.org> be transferred to the Complainant.

*/Marilena Comanescu/*

**Marilena Comanescu**

Sole Panelist

Date: July 6, 2023