

DISPUTE RESOLUTION SERVICE

D00021927

Decision of Independent Expert

NATIXIS

and

Bruce Hansen

1. The Parties:

Lead Complainant: NATIXIS
NATIXIS
30 avenue Pierre Mendès France
PARIS
Île-de-France
75013
France

Respondent: Bruce Hansen
Calle Valencia 348
Barcelona
08009
Spain

2. The Domain Name(s):

natixiscib.co.uk ('the Domain Name')

3. Procedural History:

3.1. I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might

be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

- 3.2. The dispute was received on 4 October 2019, and subsequently validated and notified to the parties on 7 October 2019. A response reminder was sent on 24 October and, in the absence of any response, notification of no response was sent to the parties on 29 October 2019. Expert decision payment was received on 31 October 2019.
- 3.3. I am satisfied that the complaint was served upon the Respondent in accordance with paragraphs 3 and 6 of the Nominet Dispute Resolution Service Policy ('the Policy').

4. Factual Background

- 4.1. The Complainant is an international corporate, investment management and financial services company registered in France but operating in multiple jurisdictions around the world using the brand name 'NATIXIS'. Documentation annexed to the complaint (all of which is from publicly available sources) reveals that the Complainant is a substantial business, with net revenues of 9.5 billion Euros in 2017, of which 3.6 billion Euros related to its corporate and investment banking line of business, that the Complainant has around 17,000 employees worldwide, and that a search for 'NATIXIS' on google.fr returns around 3.9 million results.
- 4.2. The Complainant is the owner of several domain names that use the 'NATIXIS' name, including <natixis.com>, <natixis.fr>, and <natixis.co.uk>, which the Complainant uses for the purposes of its business. The <natixis.com> domain name was registered on 3 February 2005.
- 4.3. The Complainant uses subdomains to structure its corporate website, including the subdomain <cib.natixis.com>, which hosts the website for its Corporate and Investment banking division.
- 4.4. The Complainant and its subsidiaries are the holders of numerous trademarks around the world in the mark 'NATIXIS'. There are numerous limited companies registered in England & Wales whose registered name includes 'NATIXIS'; the Complainant's uncontested submission is that these are all members of the Complainant's group of companies.
- 4.5. The Domain Name was registered on 1 September 2019. The domain is not active; the Complainant has provided a WHOIS lookup dated 3 October 2019 showing that as at that date its name servers had been set to 'ns1-suspended-for.spam-and-abuse.com' and 'ns2.suspended-for.spam-and-abuse.com'.

5. Parties' Contentions

- 5.1. The Complainant relies on its company name, its ownership of domain names that use the name 'NATIXIS', the presence of its main corporate website at the address www.natixis.com, and its numerous trademarks in the mark 'NATIXIS' (and in a NATIXIS logo) as evidence of Rights in respect of a name or mark which is identical or similar to the Domain Name. The Complainant also points to its company having been registered in 1954, its presence in several countries globally, the large number of results returned by a web search of the name 'NATIXIS', the size of the Complainant's business, and various awards won on recent years, as evidence of considerable goodwill in the name.
- 5.2. The Complainant advances the following propositions in support of its contention that the Domain Name is an Abusive Registration:
 - 5.2.1. That the Respondent has no legitimate interest in the Domain Name because (a) the Complainant is the exclusive proprietor of the trademark 'NATIXIS' and did not authorize the registration (all registered trademarks in the mark 'NATIXIS' that appear on a TMVIEW database search belong to the Complainant); (b) there is no company registered in England & Wales which does not belong to the Complainant; and (c) the Respondent is not using the Domain Name.
 - 5.2.2. The Domain Name is confusingly similar to the earlier rights in 'NATIXIS' because (a) <natixiscib.co.uk> contains the registered trademark 'NATIXIS' in its entirety, and the suffix 'cib' is merely a descriptive contraction of the phrase 'Corporate & Investment Banking'; (b) 'natixiscib' is confusingly similar to the 'cib.natixis' formulation actually used by the Complainant to identify its corporate and investment banking activities; (c) 'natixis' is the distinctive and dominant part of the domain name and *'it is therefore obvious that the internet users will be led to think'* that the Domain Name is associated with the Complainant.
 - 5.2.3. The Domain Name was likely registered with the aim of taking advantage of the well-known trade mark 'NATIXIS' because the mark is sufficiently well-known that it is unlikely that the Respondent was unaware of it or of the Respondent's activities when it was registered, and the addition of the suffix 'cib' renders coincidence even more unlikely.
 - 5.2.4. Although the Domain Name is not active, there is threatened abuse, in that *any* use of the Domain Name by the Respondent would be likely to confuse people into thinking that it is controlled by the Complainant. The Complainant also contends that the addition of 'cib' suggests an intention to mislead. The fact that the name server records have been changed to the Go Daddy Spam and Abuse records

(‘ns1-suspended-for.spam-and-abuse.com’ and ‘ns2.suspended-for.spam-and-abuse.com’) suggests that the Domain Name has at some point been used for improper purposes.

5.3. As recorded above, the Respondent did not respond to the Complaint.

6. Discussions and Findings

6.1. In order to succeed in its complaint, the Complainant must prove on the balance of probabilities that (i) it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and (ii) the Domain Name, in the hands of the Respondent, is an Abusive Registration (paragraph 2 of the Policy).

Rights

6.2. The DRS defines Rights as *‘rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning’*.

6.3. There is no doubt that the Complainant has Rights in the name or mark ‘NATIXIS’. As recorded above, the Complainant has presented evidence of numerous relevant trademarks, of continued use of the name for a considerable period of time, of goodwill associated with the name, and of active use of the domain name ‘natixis.com’ for the Complainant’s corporate website.

6.4. The only question that arises, therefore, is whether the name ‘NATIXIS’, in respect of which the Complainant has Rights, is to be characterised as identical or similar to the Domain Name given that the Domain Name is a concatenation of the word ‘natixis’ with the suffix ‘cib’. I have reached the clear view that it is. ‘natixis’ is a highly distinctive word, and it is the dominant part of the Domain Name. As the Complainant correctly observes, ‘cib’ is a descriptive suffix, because in a financial services context it is a contraction of the phrase ‘Corporate & Investment Banking’. The Complainant has presented evidence that it uses the contraction ‘cib’ itself in conjunction with ‘natixis’ in the context of its Corporate and Investment Banking services, whose website is ‘https://cib.natixis.com/home/’.

Abusive Registration

6.5. The DRS defines Abusive Registration as a Domain Name which either *‘i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s Rights; or ii. is being or has been used in a*

manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights'

- 6.6. I agree with the Complainant that the Domain Name is not only similar to the Complainant's mark 'NATIXIS' but that it is *confusingly* similar. That is to say, if the Domain Name were used, people or businesses would likely be confused into believing that it is registered to, operated or authorised by, or otherwise connected with the Complainant. For example, a business user receiving an email sent from the Domain Name would likely be confused into believing that the sender of the email was connected with the Complainant's Corporate and Investment Banking division.
- 6.7. In the absence of any explanation from the Respondent as to why it registered the Domain Name or any evidence it had legitimate grounds to do so, I agree with the Complainant that it may be inferred that the Respondent's purpose in registering a domain name confusingly similar to Complainant's mark, and including in the domain name the suffix 'cib', (which is itself associated with services provided by the Complainant) was to take unfair advantage or to be unfairly detrimental to the Complainant's Rights. It follows that I consider the registration to be an Abusive Registration under the first limb of the definition. I agree with the Complainant that the name 'NATIXIS' is sufficiently distinctive, and the suffix 'cib' so pertinent to the Complainant's services, that it is implausible that the Respondent could have stumbled upon the word 'natixiscib' by accident or in ignorance of the Complainant's Rights.
- 6.8. Although the Domain Name is not currently being used to host a website (and, at least as at 3 October 2019, was suspended), the very fact of its existence, in the absence of any evidence that it was registered for a legitimate purpose, seems to me to give rise to the threat that it will in the future be used in a way that is likely to confuse people or businesses into believing that it is registered to, operated or authorised by, or otherwise connected with the Complainant. Such threat arises owing to the difficulty of conceiving of a legitimate use to which the Domain Name might be put (and the failure of the Respondent to adduce any evidence in that regard). Paragraph 5.1.2 of the Policy provides that the threat of confusion is a factor that may be evidence of an Abusive Registration. I consider that it is a persuasive factor in this case.
- 6.9. I reject the Complainant's argument that the fact that the Domain Name is not currently being used leads, of itself, to the inference that the Respondent has no legitimate interest in it. In that regard, I note that paragraph 5.2 of the Policy specifically provides that failure to use a domain name is not in itself evidence of an Abusive Registration. However, given my view on the issues of confusion and threat, my rejection of this particular argument has no bearing on my overall view that the registration is an Abusive Registration.
- 6.10. The evidence that the Domain Name's name server records have been set to 'ns1-suspended-for.spam-and-abuse.com' and 'ns2.suspended-for.spam-and-

abuse.com' gives further cause for concern. It suggests that the Domain Name has previously been used either to host a website containing malware or for the purposes of phishing. Given the likely association in the mind of any visitor to such a website or recipient of such an email with the Complainant's business, these name server records suggest that the Domain Name has in the past been used in a manner which has been unfairly detrimental to the Complainant's Rights. In the absence of any evidence from the Respondent, I find that on the balance of probabilities this is so. I therefore find that the registration of the Domain Name is an Abusive Registration under the second limb of the definition as well as the first.

6.11. I do not consider that any of the factors which may be evidence that the Domain Name is not an Abusive Registration under paragraph 8 of the Policy apply.

7. Decision

7.1. The Expert finds that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. Accordingly, the Expert directs that the Domain Name <natixscib.co.uk> should be transferred to the Complainant.

Matthew Lavy

18th November 2019