

DISPUTE RESOLUTION SERVICE

D000025525

Decision of Independent Expert

IBANFIRST

and

Adam Costin

1. Parties:

Complainant:

IBANFIRST
Avenue Louise 350
Brussels
1050
Belgium

Respondent:

Adam Costin
Strada Filote Claudiu Bloc 445-28
Vaslui
730003
Romania

2. Domain Name:

<ibanfirst.co.uk>

3. Procedural Background:

A Complaint regarding <ibanfirst.co.uk> (the "Domain Name") under Nominet UK's Dispute Resolution Service Policy ("the Policy") was received from the Complainant and forwarded to the Respondent by Nominet on 1 March 2023. A Response was received from the Respondent on 23 March 2023. No Reply was lodged by the Complainant.

The dispute was not resolved by mediation and was referred for a decision by an Independent Expert following payment by the Complainant of the required fee on 18 April 2023. I was

invited to act as Independent Expert. I was appointed as Independent Expert as of 21 April 2023 and confirmed to Nominet I was independent of the parties and knew of no facts or circumstances that might call into question my independence in the eyes of the parties.

4. The Facts

The Complainant is a financial services business which provides third parties with a platform dedicated to multi-currency transactions. It is regulated by the National Bank of Belgium as a payment institution authorised to operate throughout the European Union, is a member of the SWIFT network and SEPA approved. IBANFIRST today serves thousands of customers across Europe and has over 260 employees.

The Complainant is the registered proprietor of: (a) UK trademark number UK00915833379 for IBANFIRST registered in classes 9 and 36 filed on 14 September 2016 (FX4BIX, which has the same address as the Complainant, is a co-owner of this mark); and (b) UK trademark number UK00917317702 for an IBANFIRST device mark registered in classes 9 and 36 filed on 11 October 2017.

The Respondent registered the Domain Name on 11 June 2020. It resolves to a parking page where the Domain Name is also offered for sale.

5. The Parties' Contentions

Complainant

The submissions by the Complainant are:

- The Complainant is the owner of the UK trademark IBANFIRST number UK00915833379 registered since September 14th, 2016 and the European trademark IBANFIRST number UK00917317702 registered on 11 October 2017.
- The Complainant also owns domain names comprising the mark IBANFIRST, including the domain name <ibanfirst.com>, which it registered and has used for its official website since 6 June 2016.
- Thus, the Complainant has relevant rights for the purpose of the DRS Policy.
- The Respondent is not affiliated with the Complainant and has no right nor legitimate interest in the Domain Name.
- At the time of the registration of the Domain Name, the Complainant was on the front of the financial news, as it had raised €21 million for its borderless financial services.
- Given the distinctiveness of the Complainant's IBANFIRST trademark and reputation, it is reasonable to infer that the Respondent registered the Domain Name with full knowledge of the Complainant's marks.
- The Domain Name was registered on 11 June 2020. It resolves to a parking page with commercial links where it is offered for sale for £5000.
- The Respondent is obtaining an unfair advantage by virtue of its usage of the Domain Name by trading off the reputation of the Claimant.
- This is an abusive registration under paragraph 5.1.1 of the Policy, as the circumstances indicate that the Respondent has registered or otherwise acquired the Domain Name primarily for the purposes of selling, renting or otherwise

transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name.

- The Complainant contends that the Respondent's use of the domain name takes unfair advantage of or is detrimental to the Complainant's rights.

Respondent

The Respondent's submission is brief. It urges that the Complaint should fail because:

- The Domain Name was registered in good faith.
- The Domain name consists of two generic and descriptive words, "iban" and "first".
- While preparing and developing a future project, the Domain Name was partially redirected to a parking page.
- Since the time of registration, the Domain Name was never used for commercial purposes.

6. Discussions and Findings

Paragraph 2.2 of the Policy sets out that the Complainant is required to prove to the Expert that both of these elements are present on the balance of probabilities:

2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration. Rights.

Rights

Under paragraph 1 of the Policy, Rights means "rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning." It is well accepted that the question of Rights falls to be considered at the time the Complainant makes its complaint and is a test with a low threshold to overcome.

I am satisfied based on the Complainant's trademark registrations that the Complainant has Rights in the IBANFIRST mark. I consider the IBANFIRST mark to be identical to the Domain Name since it consists of this mark with no additional elements.

I therefore find that the Complainant has Rights in a name or mark, IBANFIRST, which is identical to the Domain Name.

Abusive Registration

Under paragraph 1 of the Policy, Abusive Registration means 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.

It is sufficient to satisfy either limb for there to be a finding of an Abusive Registration. Paragraph 5 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration. The relevant factors under paragraph 5 are:

"5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.1 for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant.

5.1.2 Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

5.1.6 The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name."

Dealing first with the factor under paragraph 5.1.6 of the Policy, that factor clearly applies in this case. Disregarding the .co.uk suffix, the Domain Name is an exact match for the IBANFIRST name and mark in which the Complainant has Rights. In addition, given the extensive use by the Complainant of its IBANFIRST name, the name has achieved a reputation in the financial services industry for the purposes of paragraph 5.1.6.

The term IBAN has a specific meaning in relation to cross-border financial services, as it refers both to an "international bank account number" and a standardised international numbering system developed to identify an overseas bank account. The number starts with a two-digit country code, then two numbers, followed by several more alphanumeric characters.

The Complainant adduced a sampling of the results of a 27 February 2023 Google® search of the term IBANFIRST, which yielded "about 106,000 results", the first 50+ of which refer exclusively to the Complainant.

The Complainant also submitted in evidence an article published on the "Fintech" website bearing the headline "*iBanFirst raises \$23.8 million for its borderless financial services*", which announced: "*The company has been doing well, with close to \$20 million in annual revenue: iBanFirst says its payment volume tripled between March 2019 and March 2020. The company now has 180 employees and 4,000 customers across Europe. In total, the startup has raised \$52.2 million (€46 million)*". The new item notes that the Complainant's account holders can make cross-border payments in thirty currencies at far less cost than would be incurred using a corporate bank account.

I note the date of publication of the Fintech article is 11 June 2020, *the same day the Respondent registered the Domain Name*. There is nothing to support any argument that the Respondent had any reasonable justification for having registered the Domain Name.

When a distinctive brand name is reproduced in a domain name, the normal presumption is there is no bona fide reason for the registration of that domain name. I find this presumption applies in this case. The Respondent's vague references to "preparing and developing a future project", fall far short of evidencing "fair use" of the IBANFIRST mark, or preparation for any particular use.

It is also inevitable that, when a domain name is identical to the well-known name of another business, at least some people encountering that domain name will mistakenly believe that it is connected with the owner of the well-known name, even if this is only on an initial impression (so-called "initial interest confusion"). I therefore find that the factor under paragraph 5.1.2 of the Policy also applies in this case.

The Respondent registered and then offered to sell the Domain Name for amounts up to £5,000. It is therefore clear that the Respondent registered the Domain Name primarily to sell it to the Complainant or a competitor of the Claimant for a profit. Thus, the factor under paragraph 5.1.1.1 of the Policy applies.

Having found these factors apply, including that the Respondent intended to sell the Domain Name for a profit, I conclude that the registration of the Domain Name therefore took unfair advantage of and was unfairly detrimental to the Complainant's Rights. There is nothing in this case which could lead to a conclusion that such purpose could be anything other than unfair.

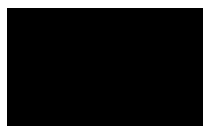
Finally, I note that the Respondent here, Adam Costin of Vaslui, Romania, was found by the expert to have made an earlier Abusive Registration in *Advanced New Technologies Co., Ltd. v Adam Costin*, D00022867 (finding that the registration of the domain name <alipay.uk>, which incorporated the well-known name ALIPAY and connected the domain to a parking page where it was offered for sale at amounts up to £30,000 was an Abusive Registration).

While this single instance of a prior Abusive Registration by the same Respondent falls short of the "three (3) or more DRS cases in the two (2) years before the complaint was filed" that would give rise to a rebuttable *presumption* of Abusive Registration under Policy paragraph 5.3, I nonetheless consider it an additional relevant factor in the present inquiry that the Respondent had been found in an earlier case to have made an Abusive Registration under virtually identical facts.

7. Decision

Having found that the Complainant has Rights regarding a name and mark identical to the Domain Name, and that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name <ibanfirst.co.uk> be transferred to the Complainant.

Signed:



Dated:

24 April 2023