



香港國際仲裁中心

Hong Kong International Arbitration Centre

.cn Domain Name Dispute Resolution

ADMINISTRATIVE PANEL DECISION

Case No. DCN-0600086

Complainant	:	Caixa D'estalvis I Pensions De Barcelona ("La Caixa")
Respondent	:	Catalanhost.com
Domain Name(s)	:	lacaixa.cn; la-caixa.cn
Registrar	:	CSL Computer Service (d.b.a. Joker.com)

1. THE PARTIES AND CONTESTED DOMAIN NAME

The Complainant is Caixa D'estalvis I Pensions De Barcelona ("La Caixa"). Av. Diagonal 621-629, 08028 Barcelona (SPAIN). The authorized representative of the Complainant in this matter is Jordi Kohn, Caixa D'estalvis I Pensions De Barcelona ("La Caixa") Av. Diagonal 621-629, 08028 Barcelona (SPAIN).

The Respondent is Catalanhost.com, C/Gavarre, 8A 08756 La Palma.

2. PROCEDURAL HISTORY

A complaint (dated 26th October 2006) in respect of "lacaixa.cn" and "la-caixa.cn" was filed with the Hong Kong International Arbitration Centre ("HKAC") in terms of the prescribed Form C under the China Internet Network Information Centre ("CNNIC") Domain Name Dispute Resolution Policy ("the Policy"), the Rules for CNNIC Domain Name Dispute Resolution Policy ("the Rules") and the HKIAC Supplemental Rules therefor ("the Supplemental Rules").

On 3 November 2006, the complaint was received by the HKIAC.

On 14 November 2006, HKIAC sent an email to the complainant requesting the contact details of the Registrant of the disputed domain names “lacaixa.cn and la-caixa.cn”.

On 17 November 2006, the HKIAC sent an email to the Registrar Officer for confirmation that the domain name is registered with CSL Computer Service.

On 17 November 2006, the Registrar Officer responded to the HKIAC by email confirming that the domain name is registered with CSL Computer Service.

On 27 November 2006, the HKIAC sent an email to inform the Respondent of the commencement of the proceedings and to submit a response within 20 business days (by 18 December 2006) to the HKIAC.

On 21 December 2006, the HKIAC sent an email to inform the Respondent that its response to dispute has not been received by the HKIAC within the required period of time (on or before 18 December 2006).

On 22 December 2006, the Respondent sent an email with the Statement of Response attached to the HKIAC.

On 3 January 2007, Mr. Norris Yang was confirmed to act as a Panelist in this case.

3. FACTUAL BACKGROUND

For Complainant

The Complainant is an entity formed by the merger in 1990 of Caja de Pensiones para la Vejez y de Ahorros de Cataluña y Baleares (founded in 1904) and Caja de Ahorros y Monte de Piedad de Barcelona (founded in 1844).

It is registered under number 1 in the Register of Catalan Savings Banks of the Directorate-General of Financial Policy of the Department of Economy and Finance of the Catalonia Autonomous Community Government (“Generalitat of Catalonia”).

For Respondent

The Respondent registered the Disputed Domain Name via CSL Computer Service on 26-06-2005 for the duration of two years.

4. PARTIES' CONTENTIONS

For Complainant

The Complainant is an entity formed by the merger in 1990 of Caja de Pensiones para la Vejez y de Ahorros de Cataluna y Baleares (found in 1904) and Caja de Ahorros y Monte de Piedad de Barcelona (found in 1844).

It is registered under number 1 in the Register of Catalan Savings Banks of the Directorate-General of Financial Policy of the Department of Economy and Finance of the Catalonia Autonomous Community Government ("Generalitat of Catalonia"). On November 16, 1990, it was entered under number 3003 in the Barcelona Mercantile Register, in volume 20.397, page 1, sheet B-5614, first entry. It is registered with code number 2100 in the Bank of Spain's Special Register of General Savings Banks.

"LA CAIXA" is presently the leading Spanish savings bank. It is also ranked third in the European savings bank sector, with 9.6 million clients. The "LA CAIXA" Group manages a total of 169,470 million euros in client resources. It has a commercial network throughout Spain which at the end of 2005 included 5,053 branches staffed by 25,254 employees.

The symbol of "LA CAIXA" was created by the renowned international artist Joan Miró. It consists of an irregular 5-pointed blue star with two rounded shapes of different sizes –the smaller one is yellow, and the larger one is red– with the name "LA CAIXA" appearing under. Since they appear frequently on the streets and in advertising, the "LA CAIXA" star and the "LA CAIXA" name are very well-known throughout Spanish territory.

As evidence of its financial soundness and its presence in Spanish territory, a copy of the 2005 Annual Report was submitted, (also obtainable on the <http://www.lacaixa.es> Web site).

LA CAIXA has been a pioneering company in the Internet banking sector in Spain. It offers an extensive products and services portal that can be accessed on Web sites such as: <http://www.lacaixa.com>, <http://www.lacaixa.es>, <http://www.lacaixa.net> and <http://www.lacaixa.org>. Electronic banking services are also offered through the “Línea Abierta” or “Línia Oberta” [Open Line] links which can be accessed from the “la Caixa” portal or directly on the <http://www.lineaabierta.com> and <http://www.liniaoberta.com> Web sites.

With “LA CAIXA”’s advanced ATM technology, the Complainant has approximately 7,200 ATM terminals available. This makes it the leading banking services entity as regards number of ATM terminals, and also the leading payment network in Spain.

LA CAIXA is an entity whose company name is well-known on the market, as demonstrated by its frequent appearance in newspaper articles. A copy of several newspaper articles related to the LA CAIXA company name. These articles have been printed in well-known Spanish and foreign newspapers, and in all cases the entity is identified by the “La Caixa” name.

As a result of introduction of the entity throughout Spanish territory and its position in the European financial ranking, as well as its participation in socio-cultural and charitable activities, it is impossible to imagine that its renown on the market has gone unnoticed.

“la Caixa” is presently based in France and Andorra through its subsidiaries CAIXABANK FRANCE and CAIXABANK, S.A.

As proof of LA CAIXA’s renown, the Complainant submitted copies of the results of a search on the <http://www.google.com>, <http://www.yahoo.com/>, <http://www.altavista.com> Web sites demonstrating that when the term “LA CAIXA” is entered in the search engine, most of the results which appear refer to the Complainant.

In WIPO Case No. D2000-0647, *Société Le Monde interactif vs. Monsieur Elphège Frèmy*, the panelist indicates in his decision that “if the principal search engines (Yahoo, Alta Vista, Lycos) show the “Le Monde” newspaper Web site in the first place on the list of search results; this constitutes proof of its implementation on the international level and on the Internet.”

The Complainant is known as “la Caixa” in Spain as well as internationally, and that it is famous and renowned.

The LACAIXA.CN and LA-CAIXA.CN domain names registered by the Respondent are confusingly similar to the trademarks registered by the Complainant, as demonstrated by the search carried out on May 9, 2006 in the CNNIC WHOIS data base. This search showed that the domain names appearing at that time were registered with the name of the Respondent.

THE DISPUTED DOMAIN NAMES, LACAIXA.CN AND LA-CAIXA.CN, ARE IDENTICAL TO THE LA CAIXA REGISTERED TRADEMARK AND OTHER MARKS

The Complainant is owner of the "LA CAIXA" trademark in Mexico and Andorra, as demonstrated by the certificate issued by the Mexican Institute of Industrial Property, and the certificate issued by the Trademark Office of the Principality of Andorra, both of which are attached.

The Complainant, holds the "LA CAIXA" trademark in Andorra, number 3.008 for classes 16, 35, 36 and 38, registered on January 24, 1997, and the "LA CAIXA" trademark in Mexico, number 364.159 for classes 35 and 36, which was registered on May 24, 1988.

The Complainant also holds the composite "LA CAIXA" trademark registered with the Spanish Patent and Trademark Office on November 14, 1986. The certificate granting the composite trademark 1.168.636. An application for registration of the same company name and graphic design as a Community trademark has also been submitted previously in Chile.

As mentioned at the beginning of this complaint, the "la Caixa" entity has acquired prestige and renown, and is recognized as such. The article "la" has been added. This gives it singularity, while other entities must always identify themselves with their complete company name. Therefore, any name which includes the term "la Caixa" evokes the Catalan bank CAIXA D'ESTALVIS I PENSIONS DE BARCELONA in the mind of the consumer.

This name has been used in the sector for over 25 years; its volume and geographic scope, with over 5,000 branches distributed throughout Spain; the prestige it has acquired on the Spanish market; as well as the general public's awareness of the mark, there is no doubt as to the nature of the well-known "LA CAIXA" mark.

"la Caixa" recently opened its first branch office in the People's Republic of China, in the city of Beijing.

Moreover, the Complainant is also the holder of many other marks in which the name "LA CAIXA" appears as a distinctive element. These marks are registered in Spain as well as in 49 other countries throughout the world, either in the countries themselves or as an international trademark.

The Complainant also holds a large number of similar registered trademarks. All of them have a common characteristic, which is that they include the term "la Caixa" as a distinctive element.

By virtue of ownership of the "LA CAIXA" trademark the holder, in this case the Complainant, is entitled to exclusive use of the aforementioned name to identify its products and services in commercial trade on the Internet, to prevent third parties from using it without authorization, and even to prevent them from using it to identify products or services which could cause confusion.

By virtue of the provisions of article 34 of Spanish Trademark Law, registration of a mark grants the holder the right to exclusive use in commerce. Therefore, use of the LACAIXA.CN and LA-CAIXA.CN names on the Internet by the Respondent constitutes intentional misappropriation of the rights which the mark grants to its holder since we are dealing with a sign which, because it is identical or confusingly similar to the trademarks previously registered by the Complainant, may cause confusion by the general public.

All of the marks named in this document were registered before the disputed domain name. Based on all that has been mentioned up to this point, the exclusive rights to the LACAIXA.CN and LA-CAIXA.CN domain names held by the Complainant CAIXA D'ESTALVIS I PENSIONS DE BARCELONA ("LA CAIXA") are unquestionable.

Although the word "caixa" with the article "la" means "the box" in Catalan, the term "la Caixa" has been used for a very long time. It has become disassociated from the literal meaning and has become a specific, distinct term used to identify the business that has a special connection to the Complainant. As proof of this, it is sufficient to cite the decision of HKIAC Case No. DCN-0300008, *Hugo Boss AG vs Wenzhou Lucheng District Shangshu Sunbird Department Store and Zhao Ke Jian* as reference.

As proof of this it is sufficient to cite the following World Intellectual Property Organization (WIPO) decisions in which the disputed names included generic names as reference:

In case D2000-0012, *Stella D'oro Biscuit Co., Inc vs. The Patron Group, Inc.* the panelist stated: “*the fact that Stella D'oro has a discrete and identifiable meaning in Spanish, as Stella D'oro's trademark registrations demonstrate, does not detract from the identity of the domain name in issue with the Stella D'oro trademark*”.

In case D2000-0143, *Raimat, S.A. vs. Antonio Casals*, the panelist states: “the Respondent's allegation that *Raimat is a geographic identifier or the name of a municipality is irrelevant in this proceeding*”.

In case D2000-0647, *Société Le Monde Interactif vs. Monsieur Elphège Frémy*, regarding the use of the generic term “Le Monde” to designate a common product of the company Société Le Monde Interactive, its well-known newspaper, the panelist states that a company may conduct a commercial activity which grants such distinctiveness to a generic expression that this leads to a material evocation of it. **Therefore, a generic element may have a distinctive character by virtue of its renown.**

To this extent the decisions in WIPO cases D2000-0604, *Editora Globo, S.A. vs. Mundo on line Net*; D2000-0166, *Plaza Operating Partners, Ltd. vs. Pop Data Technologies, Inc. and Joseph Pillus*; D2000-0162, *Cortefiel, S.A. vs. The Gallery Group*; D2000-0007, *Alcoholics Anonymous World Services, Inc. vs. Lauren Raymond*; D2000-0019, *Which? Limited vs. James Halliday*; D2000-0065, *Surfdog, Inc. vs. Dr. Charles Cooper*; D2000-0073, *The Hamlet Group, Inc. vs. James Lansford*; D2000-0141, *Cortefiel, S.A. vs. Javier García Quintas*; D2000-0140, *Cortefiel, S.A. vs. Miguel García Quintas*; D2000-0201, *Guillermo J. Fesser Pérez de Petinto y Juan L. Cano Ambros vs. R&T y Tino Hernández*; D2000-0238, *Gestelevision Telecinco, S.A. y Estudios Telecinco, S.A. vs. Silber Investments Group, S.L.*; D2000-0362, *Oxygen Media, LLC vs. Primary Source*; D2000-0384, *Easyjet Airline Company Limited vs. Mahmoud Panjehshahi*; D2000-0751, *Port Aventura, S.A. vs. Miguel García Quintas*; D2000-0823, *El Rincón del Vago, S.L. et. al. vs. Nettika, S.L.*; D2000-0839, *Gruner+Jahr Printing & Publishing Co. vs. Luis Tobena*; D2000-0969, *General Optica, S.A. vs. Alfredo Labadía Pardo*; D2000-0970, *General Optica, S.A. vs. RMC, S.L.*; and D2000-0910, *Port Aventura, S.A. vs. Próspero Morán* are also illustrative.

Based on the criteria repeatedly pointed out by the panelists in the aforementioned decisions, we may state that, due to its special renown, the “LA CAIXA” name has a distinctive character that separates it from any possible generic evocation that may be associated with it.

The Complainant holds the following generic domain names: LACAIXA.COM, LACAIXA.NET, LACAIXA.ORG, LACAIXA.BIZ and LACAIXA.INFO, as well as the territorial domain names: LACAIXA.ES (Spain), LA CAIXA.FR (France), LACAIXA.IT (Italian), LACAIXA.LU (Luxembourg), LACAIXA.CO.UK and

LACAIXA.ORG.UK (United Kingdom), LACAIXA.LI (Liechtenstein), LACAIXA.BE (Belgium), LACAIXA.DK (Denmark), LACAIXA.CH (Switzerland), LACAIXA.TO (Tonga), LACAIXA.CAT (Catalonia) and LACAIXA.EU (European Union). “la Caixa” has also registered LACAIXA.NET.CN in China.

THE HOLDER OF THE DISPUTED DOMAIN NAME HAS NO LEGITIMATE RIGHT TO OR INTEREST IN THE DOMAIN NAME

According to the information obtained in the CNNIC WHOIS database, the disputed domain name was registered by Catalanhost.com.

The current holder of the domain name disputed in this complaint does not hold the “LA CAIXA” registered trademark, nor any other trademark which is similar to the aforementioned, nor any license or other type of authorization for use granted by the legitimate holders of such trademarks. Therefore, the Respondent does not have any legitimate right to or interest in use of the term “LACAIXA” as a domain name nor, consequently, to identify itself by use of this term.

As the panel can observe, the Respondent has not used the domain name in connection with any bona fide offering of goods or services. At present, the LACAIXA.CN Web site does not have any contents. It only offers the home page with different links to searches using the Google search engine. Therefore, the Respondent is only using the domain name to operate a Web site featuring links to some commercial Web sites through Google.

The contents of the Google search engine already show that the Respondent does not seek to present a Web site with its own contents, but rather that it is only attempting to give the impression that it is using the domain name.

Furthermore, the Respondent has not yet acted this way. The next case can be seen in the National Arbitration Forum decision, Claim No. FA0602000637920 *The University of Houston System vs. Salvia Corporation*.

It is evident that the Respondent cannot argue that it is known by the domain name since there is no connection between the meaning of the domain name in Catalan and the kind of services offered on the site mentioned. There is no reason for the Respondent to choose this domain name, since “LA CAIXA” is not a common name, and even less so in China.

THE HOLDER OF THE DISPUTED DOMAIN NAME HAS REGISTERED OR IS USING THE DISPUTED DOMAIN NAME IN BAD FAITH

The Complainant is convinced that the domain names which are the subject of this complaint were registered in bad faith. The Respondent has not used the disputed domain name commercially at any time other than offering links to Web sites through the Google search engine. This fact and the evidence stated below demonstrate a lack of legitimate interest regarding this domain name, and suggest that it was registered due to evident bad faith.

The literal form of the LACAIXA.CN and LA-CAIXA.CN domain names has nothing to do with the data provided by the holder when registering this domain name. Therefore, the sole reason for carrying out such registration could only have been to later sell the domain name to the party that actually had legitimate interests in it, and to benefit from doing so.

As has already been clearly demonstrated, the Complainant is a well-known entity in Spain and is ranked third in the European savings bank sector. It has been shown that the aforementioned trademark was registered long before the Respondent registered the disputed domain name, and also that the Complainant is a prestigious, well-known company in Spain.

The Respondent does not have and does not presume to have any legitimate interest in maintaining this domain name other than to give the impression on its Web site that it is legitimate to use the LACAIXA.CN and LA-CAIXA.CN domain names, for the following reasons:

The Respondent has Web sites called “The Box of Sciences” and “La caixa de ciències” under the LACAIXA.CN and LA-CAIXA.CN domain names. However, the Respondent does not have any trademark or business name with these names.

The Respondent does not offer products or services. It does not have any contents on its Web sites except for some science-related hyperlinks and the Google search engine.

Also, the Respondent has not registered the names of the Web sites, for example “Theboxofsciences” or “lacaixadeciencies”, or “thebox”. The Respondent has only registered the “LA CAIXA” trademark.

On May 11, 2006 an e-mail was sent to the e-mail address provided to the registry by the registrant. In this communication an attempt was made to inform the Respondent that CAIXA D'ESTALVIS I PENSIONS DE BARCELONA ("LA CAIXA") is a bank that holds several national and international registered trademarks, and that it has not provided any authorization whatsoever to use the bank's distinctive signs as a domain name. It also requested collaboration to transfer this domain name without any charges. A copy of the document sent by e-mail with the attachment.

This statement could not be sent by post since, as suspected, the address of the WHOIS database was not accurate. This address in Vaduz refers to a hotel, not a company.

The aforementioned fact appears to suggest that the Respondent used incomplete data in the registration agreement to conceal his true identity or to make it difficult to be able to contact him. This implies bad faith and is an evident breach of the registration agreement which all registering agents are bound to. This agreement includes a clause in which the registrant is bound to guarantee that the information included in the registration form is true, current, complete, and accurate.

Furthermore, in the attachment there is an e-mail in which the registrant's representative requests that "la Caixa" provide the sum of 3 million euros for sale of the LACAIXA.CN domain name. This is evidence of the bad faith of the Respondent. In this e-mail the registrant's representative uses the English language. The representative is an American lawyer who resides in Indianapolis.

Subsequently, the Complainant received two more communications in which the Respondent's representative insists on negotiating a price for transferring the current domain name to "la Caixa".

It has been shown that the aforementioned trademarks were registered a long time before the Respondent registered the disputed domain name and also that the Complainant is a prestigious, well-known entity in Spain. Therefore, when the Respondent registered this domain name, he was aware of the fact that he was taking over a name which, from a commercial point of view, is a key point for the Complainant.

In his decision on WIPO Case No. D2002-0506, *Caja de Ahorros del Mediterráneo vs. Antonio Acuña Racero*, the panelist found the following: "Given the referred to renown, is it clear that the Respondent registered the domain name fully aware that he was infringing the rights of the Complainant, and also aware that use of the domain could cause confusion between Internet users as to the real identity of the holder of the domain [...] On the other hand, the fact that the

Complainant has not registered as a domain a name which coincides with that of his marks, in its full version (although, the Complainant has since applied to register the syncopated version “cam” as a first level domain) does not lead us to believe that it would permit or tolerate the infringement of its rights in general and particularly with regard to the registration and use of the disputed domain. Obviously, the mere acquisition of a domain name does not in itself accredit the Respondent’s legitimate interest (the findings of the panel were also similar in its decisions in WIPO Case No. D2000-0003 “Telstra Corporation Limited vs. Nuclear Marshmallows”; WIPO Case No. D2001-0001, “City of Hamina vs. Paragon International Projects Ltd.”). Furthermore, in keeping with some of the panel’s decisions, which need not be mentioned at this point, the previously existing renown of the distinctive signs cause the burden of proof to fall on the holder of the domain, who, given that it would be impossible for the complainant to do so, is in a better position to prove his good faith, which he must do, and in so doing, his legitimate interests.”

The lack of existence of legitimate interest, as well as awareness of the “la Caixa” entity with a solid presence on the market that cannot be ignored by those who seek to register a domain name that contains the name of the Complainant and the mark registered to the Complainant, lead to the conclusion that the only reason that the LACAIXA.CN and LA-CAIXA.CN domain names were registered was to obtain economic gain by selling them to “la Caixa”.

Therefore, in accordance with the statements made up to this point, the Respondent registered a domain name which is exactly the same as the trademarks registered by one of the most important banks in Spain and Europe, has not made commercial use of this domain, and has registered the domain with a contact address which appears to be false, probably in order to make it difficult to contact him.

For Respondent

Identity or confusing similarity to the trademark or service mark in which the Complainant has rights

“La Caixa” is a catalan term which translates to “the box.” “The Box” is a generic term like the house or the car. CAIXA D.ESTALVIS I PENSIONS DE BARCELONA has trademarked the term “lacaixa” in Mexico, Andorra and Spain and is known as CaixaBank or BancolaCaixa. The only country where the bank is commonly known as La Caixa is Spain. In fact on page 12 of the complaint, the Complainant itself states that the term La Caixa would be virtually unknown in China.

The trademarks held are limited to the area where they are given and the fact that the CAIXA D.ESTALVIS I PENSIONS DE BARCELONA goes by the name CaixaBank in Andorra and France and Bancolacaixa in Mexico shows the fact that La

Caixa is not an internationally business name. According to their complaint, no claim is made to any rights in China for the term “La Caixa”.

There have been multiple cases brought before WIPO that show that common terms cannot be completely controlled or owned. DeutschePost AG v NJDomains Case No D2006-0001; Wal-Mart Stores, Inc v Lynda’s Case No. D2003-0719; Gordon Sumner, p/k/a/ Sting v Michael Urvan Case No. D2000-0596; Sallie Mae Inc. v Michele Dinola Case No. D2004-0648 Goldline International v Gold Line Case No. D2000-1151 and AXA China Region Limited v Kannet Limited Case No D2000-1377.

Panelist found in Sallie Mae Inc. v Michele Dinola Case No. D2004-0648 agreed with the findings in Etam, plc v Alberta Hot Rods that a Complainant does not have exclusive rights to “to this fairly short, non fanciful name, [thus] Respondent may legitimately its own use of that name in an unrelated field.”

Furthermore the Respondent does not offer services that could be confused with those of CAIXA D.ESTALVIS I PENSIONS DE BARCELONA, nor is it attempting to trick the public in to mistaking it with the Claimant.

Finally, lacaixa.cn and la-caixa.cn were established before the CAIXA D.ESTALVIS I PENSIONS DE BARCELONA had an interest or presence in the Chinese market.

Rights or legitimate interests in respect of the domain name

In June of the 2005 lacaixa.cn and la-caixa.cn were envisioned to establish an open information portal to lead to the wider dissemination and cooperation of international scientist and interested lay people. Our strategy is based on activating generic controls in different languages connected and linked strategically to form networks that attract visitors with academic interests and scientists of different sub-areas.

The idea of naming this entity La Caixa De Ciencies was born of a combined imagery of both a tool box and a medicine chest, as well as the mythological story of Pandora’s Box (La caixa de Pandora in catalan). Using the term “The box of” (the literal translation of La caixa) is a common usage and turn of phrase not connected to any specific business entity. The fact that this web portal concept was developed by an American and a Catalan led to the decision to use the catalan word as www.thebox.cn was already registered. Furthermore it was decided that theboxofsciences or lacaixadeciencis would be too cumbersome and easy to misspell to be used. Please see the attachment for sample of other uses of “the box of”, or “la caixa.”

The Complainant's contention that the Respondent do not offer bone fide services through lacaixa.cn and la-caixa.cn is a misunderstanding of the concept behind open web portals. The fact that they dismissively characterize Respondent's legitimate efforts at creating an effective web portal is unfortunate. Web Portals have a legitimate place on the World Wide Web and a long history. Many of the portals started initially web directories. The Respondent is modeling themselves on portals such as those in India ([Rediff](#)), ([MswPower.Com](#)) China ([Sina.com](#)) Italy ([Webplace.it](#)) and so on. Such portals reach out to the widespread diaspora spread across the world.

Respondent has been working on the content of lacaixa.cn for a year, and it is a site under construction. Respondent intends to improve day by day the information made available and expect that their presence will continue growing until they can establish the necessary infrastructures to create more interactive content.

The immediate project offers part of those contents translated in Chinese tongue to facilitate the accesses to the visitors that arrive through <http://lacaixa.cn>.

Chinese network and the first connection of links are published then that relates the searches in <http://Google.com> and <http://Google.cn> under the concept "The Box of Sciences".

The endeavors of lacaixa.cn are genuine. The website exists to help Respondent's attempt to position ourselves in the Chinese market. The website lacaixa.cn existed prior to the knowledge that CAIXA D.ESTALVIS I PENSIONS DE BARCELONA intended to open a branch in China, as this bank has presence in European countries but would have been unknown to the Chinese market at the inception of Lacaixa.cn and la-caixa.cn.

Bad Faith

Respondent made no attempt to contact CAIXA D.ESTALVIS I PENSIONS DE BARCELONA during the period that Respondent owned the domain. No attempts were made to sell the domains to Complainant.

Respondent feel that the characterization of their good faith efforts at a non-profit oriented, public edification web portal have been dismissed and denigrated by CAIXA D.ESTALVIS I PENSIONS DE BARCELONA, who assumes to have control over all instances of the term "la caixa" worldwide. The trademarks they hold are clearly limited to those areas and CAIXA D.ESTALVIS I PENSIONS DE BARCELONA did not have a known interest in the Chinese market when we began our site.

Complainant has asserted that Respondent did an offer to sell the domain name and that this is evidence of bad faith. It is evident that Respondent never contacted the Complainant and it is not true that we did an offer to sell the domain. Moreover, as noted in *Deutsche Welle v. DiamondWare Limited* Case No. D 2000-1202, "The Panel does not interpret the Policy to mean that a mere offer for sale of a domain name for a large sum of money is, of itself, proof of cybersquatting. ... Indeed, some of the largest sums of money paid for domain names have been for generic names"

Respondent's responses to CAIXA D.ESTALVIS I PENSIONS DE BARCELONA have been in line with the threatening and dismissive tone of their communications with Respondent. CAIXA D.ESTALVIS I PENSIONS DE BARCELONA feels it has the power to force Respondent to bend to their will. This is an instance of attempted reverse domain hijacking. Reverse Domain Name Hijacking is defined in paragraph 1 of the Rules as meaning "using the Policy in bad faith to attempt to deprive a registered domain name holder of a domain name."

Complainant has established bad faith by asserting that Respondent do not offer bone fide services although Respondent's site has been active for over 1 year, just because the Complainant does not see the value of our offerings, does not prove that they are not valid and useful to others. Complainant also tried to establish bad faith of the Respondent by attempting to force Respondent to transfer the domain name to them through threatening letters. Furthermore the Complainant has a vested financial interest in acquiring lacaixa.cn that it has not disclosed. Before the establishment of a presence of CAIXA D.ESTALVIS I PENSIONS DE BARCELONA in China, CAIXA D.ESTALVIS I PENSIONS DE BARCELONA took no issue with our use of the domain name. Transfer of the Domain Name to Complainant would effectively provide Complainant with all of Respondent's web traffic, which is due to Respondent's goodwill in the Domain Name lacaixa.cn and la-caixa.cn. At present we receive around 50,000 monthly visitors.

A widely regarded case of reverse domain hijacking occurred in 2000, when the Deutsche Welle attempted to acquire the domain dw.com from software company Diamond Ware. This attempt was reprimanded as reverse domain hijacking in 2001 by the WIPO in Case No. D 2000-1202 <http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1202.html>

Respondent is not willing to comply with the bullying of CAIXA D.ESTALVIS I PENSIONS DE BARCELONA, but gladly accepted the offer to go through the mediation process with the Hong Kong International Arbitration Center.

5. DISCUSSION AND FINDINGS

Pursuant to article 6 of the Policy, the language of the domain name dispute resolution proceeding shall be Chinese, unless otherwise agreed by the parties or determined by the Panel.

In this circumstance, Chinese is not the first language for the Complainant and the Respondent and their submissions were also made in the English language. The Panel accepts that the Complainant and the Respondent may use English for the domain name dispute. The Panel also determines that the decision will be rendered in English.

Pursuant to Article 8 of the Policy, the Complainant has the burden of proving that:-

- (i) the Respondent's domain name is identical with or confusingly similar to the Complainant's name or mark in which the Complainant has civil rights or interest;
- (ii) the disputed domain name holder has no right or legitimate interest in respect of the domain name or major part of the domain name;
- (iii) the disputed domain name holder has registered or is being used the domain name in bad faith.

Whether Identical or Confusingly Similar to a Trademark or Service Mark in which the Complainant has Rights

The Complainant is the owner of the "LA CAIXA" trademark in Mexico and Andorra, as demonstrated by the certificate issued by the Mexican Institute of Industrial Property, and the certificate issued by the Trademark Office of the Principality of Andorra.

The Complainant holds the "LA CAIXA" trademark in Andorra, number 3.008 for classes 16, 35, 36 and 38, (registered on January 24, 1997) to the date of registration of the domain name. The Complainant also holds the trademark in Mexico, number 364.159 for classes 35 and 36, (registered on May 24, 1988).

The Complainant also holds the composite "LA CAIXA" trademark registered with the Spanish Patent and Trademark Office on November 14, 1986.

The name "La Caixa" has been used in the banking sector for over 25 years; with over 5,000 branches distributed throughout Spain; the prestige it has acquired on the Spanish market; as well as the general public's awareness of the mark, there is no doubt as to the nature of the well-known "LA CAIXA" mark.

Moreover, the Complainant is also the holder of many other marks in which the name "LA CAIXA" appears as a distinctive element. These marks are registered in Spain as well as in 49 other countries throughout the world, either in the countries themselves or as an international trademark.

"la Caixa" recently opened its first branch office in the People's Republic of China, in the city of Beijing.

The Panel was referred to D2000-0012, Stella D'oro Biscuit Co., Inc vs. The Patron Group, D2000-0143, Raimat, S.A. vs. Antonio Casals, D2000-0647 Societe Le Monde Interactif vs. Monsieur Elphege Fremy and accepts that "La Caixa", although may be a generic term, has a distinctive character by virtue of the renown of the Complainant

The Panel accepts that the Complainant has acquired rights in the Trademark or Service Mark "La Caixa" (the Catalan bank CAIXA D'ESTALVIS I PENSIONS DE BARCELONA) and that the domain names in dispute are identical or confusingly similar with "La Caixa".

Therefore, the Panel finds that the Complainant has proved article 8(i) of the Policy.

Whether the Respondent has no Rights or Legitimate Interests in respect of the Domain Name

The Respondent has not provided any evidence that it has rights to the "LA CAIXA" registered trademark, nor any other trademark which is similar to the aforementioned, nor any license or other type of authorization for use granted by the legitimate holders of such trademarks.

Taking into consideration the overall evidence, the Panel finds that the Complainant has proved article 8(ii) of the Policy.

Whether the Respondent's Domain Name has been registered or is being used in Bad Faith.

Pursuant to paragraph Article 9 of the Policy, any of the following circumstances may be the evidence of the registration and use of a domain name in bad faith:

- (i) The purpose for registering or acquiring the domain name is to sell rent or otherwise transfer the domain name registration to the Complainant who is the owner of the name or mark or to a competitor of that Complainant, and to obtain unjustified benefits;
- (ii) the disputed domain name holder registered the domain name in order to prevent the owners of the name or mark from reflecting the domain name holder has been engaged in a pattern of such conduct;
- (iii) the disputed domain name holder has registered or acquired the domain name for the purpose of damaging the Complainant's reputation, disrupting the Complainant's normal business or creating confusion with the Complainant's name or mark so as to mislead the public;
- (iv) other circumstances which may prove the bad faith.

The Respondent has not used the domain name in connection with any bone fide offering of goods or services. The Panel has searched the sites of both disputed domain names which confirms the Complainant's allegations that the "lacaixa.cn" and "la-caixa.cn", web sites do not have much content other than a "home page" with different links to searches using the Google search engine. The Respondent has not created a Web site with its own contents, but rather that it is only attempting to give the impression that it is using the domain name. This demonstrates a lack of legitimate interest regarding this domain name.

The literal form of the LACAIXA.CN and LA-CAIXA.CN domain names has nothing to do with the data provided by the holder when registering this domain name. Therefore, the sole reason for carrying out such registration could only have been to later sell the domain name to the party that actually had legitimate interests in it, and to benefit from doing so.

The Complainant is a well-known entity in Spain and is ranked third in the European savings bank sector. The aforementioned trademark was registered long before the Respondent registered the disputed domain names.

The Complainant has also registered 5 top level domain names lacaixa.com, lacaixa.net, lacaixa.org, lacaixa.es, lacaixa.biz and lacaixa.info. The Respondent would surely have known of the existence of these names prior to registering the disputed domain names. If the Respondent has simply checked the web-sites of these top level domain names, Respondent could have been directed to the Complainant's sites.

The aforementioned trademarks were registered a long time before the Respondent registered the disputed domain name, and the Complainant is a prestigious, well-known entity in Spain. Therefore, when the Respondent registered this domain name, it must have been aware of the fact that it would be registering a name similar or identical to an existing trade mark or trade name.

The Respondent has Web sites called "The Box of Sciences" and "La caixa de cienies" under the LACAIXA.CN and LA-CAIXA.CN domain names, for the following reasons: The Respondent does not offer products or services. It does not have any contents on its Web sites except for some science-related hyperlinks and the Google search engine.

The Respondent has not registered the names of the Web sites, for example "Theboxofsciences" or "lacaixadeciencies", or "thebox". The Respondent has only registered the "LA CAIXA" trademark.

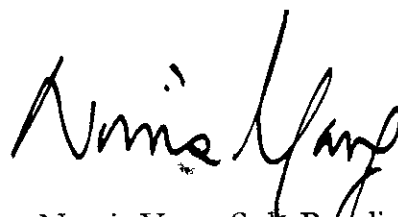
The Complainant has produced evidence that:

- (1) the Respondent is prepared to sell the disputed domain names for a very large sum of money to the Complainant; and
- (2) The address of the Respondent in the WHOIS database was not accurate. This address in Vaduz refers to a hotel, not a company.

Taking into consideration of the overall evidence presented, the Panel finds as the Respondent's actions can create confusion with the Complainant's name or mark and can mislead the public. The Complainant has proved article 8(iii) of the policy and that the Respondent has registered and used the Disputed Domain Name in bad faith (article 9(iii) of the Policy).

6. DECISION

The Panel determines that the Complainant has proved its case pursuant to Articles 8 and 9 of the Policy, and that the Dispute Domain Names “lacaixa.cn” and “lacaixa.cn” transferred to be the Complainant.

A handwritten signature in black ink, appearing to read "Norris Yang". The signature is fluid and cursive, with the first name "Norris" and the last name "Yang" clearly distinguishable.

Norris Yang, Sole Panelist
Date: 28 January 2007