

Caso Banorte

WIPO Arbitration and Mediation Center
Administrative Panel Decision
Banco Mercantil del Norte, S.A., v. Servicios de Comunicación En Línea (sic)

1. The Parties

Complainant is Banco Mercantil del Norte, S.A., a corporation duly organized and existing under the Mexican laws, with its principal place of business located at Padre Mier Ote. 227, Col. Centro, Monterrey N.L, Mexico

Respondent is Servicios de Comunicación En Línea, with its principal place of business located at Av. Lázaro C.... México.

2. The Domain Name and Registrar

The domain name under dispute is banorte.com (the "Domain Name").

The registrar of the domain name under dispute is Network Solutions, Inc. ("NSI" or the Registrar), with business address in Herndon, Virginia, USA.

3. Procedural History

The Complaint was submitted by email on September 14, 2000, and by hard copy on September 18, 2000, with the required filing fee for a single-member Panel, to the World Intellectual Property Organization ("WIPO") Arbitration and Mediation Center (the "WIPO Center"), in accordance with the Uniform Domain Name Dispute Resolution Policy (the "Policy") adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and WIPO's Supplemental Rules for Uniform Domain Name Dispute Resolution Policy ("WIPO's Supplemental Rules").

An Acknowledgment of the Receipt of Complaint was sent to Complainant by the WIPO on September 18, 2000.

On September 19, 2000, WIPO sent a "Request for Registrar Verification" via email to NSI requesting, a confirmation that NSI had received a copy of the complaint; that the domain name under dispute is registered with NSI; that Respondent is the current registrant of such domain name; and full contacts details available under the WHOIS database. On September 24, 2000, WIPO received via e-mail from NSI the "Network Solutions' Verification Response".

On September 25, 2000, WIPO completed a "Formal Requirements Compliance Checklist". It is worth mentioning that the undersigned Panel has independently determined and agrees with WIPO's assessment that the Complaint is in formal compliance with the requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules, and WIPO's Supplemental Rules.

On September 29, 2000, WIPO properly sent via e-mail, via facsimile and a hardcopy through express mail to Respondent and to its registered administrative contact, technical contact, zone contact and billing contact, a "Notification of Complaint and Commencement of Administrative Proceedings" enclosing copy of Complainant's complaint. Furthermore, hardcopy of such Complaint as confirmed by Complainant was also previously sent by Complainant to Respondent via courier on September 13, 2000.

On October 12, 2000 via e-mail (received by WIPO on October 13, 2000), on October 16, 2000 via facsimile and on October 17, 2000 via hardcopy, Respondent through its administrative contact, Mr. H..., expressly confirmed the legal title to the banorte.com domain name, recognized his participation as defendant in this administrative proceeding and submitted a request for the translation of the Complaint from English into Spanish and an extension of the deadline for filing the response. On October 18, 2000, WIPO requested Complainant to comment on Respondent request on the possibility of changing the proceeding language. On October 18, 2000, Complainant, based on Paragraph 11 of the Rules, which establishes that a change of language can only be admitted if both parties agree on that matter, contested the Respondent requests, not agreeing to the change of language. On October 19, 2000, WIPO granted an extension of eight (8) additional days for the Response, establishing the new due date for the Response until October 27, 2000, and confirmed that the language of the administrative proceedings will continue to be in English. This was reconfirmed by the WIPO on October 20, 2000.

This Panel also considers that the language of the proceeding, absent party agreement to the contrary, is English, as being the language of the domain registration and Service Agreement, pursuant to paragraph 11 (a) of the Rules.

Nevertheless, this Panelist has decided, to ensure that the Parties be treated with equality and that each Party be given a fair opportunity to present its case, as provided for under paragraph 10 (b) of the Rules, and particularly for the clarification of the facts under dispute, to receive and consider all information or documentation received whether in the English or Spanish languages.

This Panel further considers that the complaint was properly notified to the registered domain-name holder, the administrative contact, technical contact, zone contact and billing contact as provided for in paragraph 2 (a) of the Rules.

The Respondent failed to comply with the deadline to submit its response, and therefore the single panelist was appointed as proposed by the Complainant and as may be evidenced from paragraph 44 of Complainant's complaint.

On October 28, 2000, this is after the October 27, 2000 deadline, Respondent's administrative contact, Mr. H..., untimely submitted response indicating that he is no longer the owner of the domain name "banorte.com", due to the fact that he sold the company, including the domain name to a person named Gabriel...since September 21, 2000 (in contradiction to his October 17, 2000 communication). Furthermore, on such communication Respondent confirms that he is not able to provide any related supporting documentation. On November 3, 2000, Complainant submitted additional comments to the Respondent's response. This was also complemented with a certain communication dated November 7, 2000 to WIPO from Mr. Gabriel....

On November 8, 2000, the undersigned signed and sent to WIPO, a Statement of Acceptance to participate as Single Member Panelist and a Declaration of Impartiality and Independence.

On November 10, 2000, WIPO sent to Complainant and Respondent a "Notification of Appointment of Administrative Panel and Projected Decision Date", appointing Pedro W. Buchanan as Sole Panelist and scheduling November 23, 2000, as the date for issuance for the Panel's decision, notifying the above pursuant to paragraphs 6 (f) and 15 (b) of the Rules. On the same date, WIPO transferred the case file to the Sole Panelist.

The Panel has not received any further requests from Complainant or Respondent regarding submissions or waivers, extensions of deadlines and the Panel has not found it necessary to request any further information, statements or documents from the parties, nor the need as an exceptional matter, to hold any in-person hearings as necessary for deciding the complaint, as provided for in paragraphs 12 and 13 of the Rules. Therefore, the Panel has decided to proceed under the customary expedited nature contemplated for this type of domain name dispute proceedings.

4. Factual Background

The Complainant, Banco Mercantil del Norte, S.A. (also known nation-wide by its acronym "Banorte"), is the primary subsidiary of "Grupo Financiero Banorte", one of Mexico's largest and oldest financial institutions, which has been present in Mexico since 1899. Banco Mercantil del Norte, S.A., launched a private equity offering what was the beginning of its privatization and expansion phase. It continued with the creation of its leasing services subsidiary (Arrendadora Banorte) in 1990, and of its factoring and warehousing subsidiaries (Almacenadora Banorte and Factor Banorte) in 1991. Since 1997, through an alliance with Generalli, one of the main European insurance companies, also offers insurance, pension funds and Afore's services, respectively known nation-wide as Afore Banorte-Generalli, Seguros Banorte-Generalli and Pensiones Banorte-Generalli. Currently, Complainant is present in all Mexico's 32 states and in Mexico City, with 1,350 ATM'S and branches in 167 cities across Mexico, more than 450 branches nationwide, as well as operations in New York and Grand Cayman.

The BANORTE trademark is a well-known mark in Mexico and is Complainant's famous trademark and service mark. Complainant obtained its first "BANORTE" trademark registration on April 19, 1991, prior to Respondent's registration of the domain name "BANORTE.COM" which was created on October 13, 1998 as indicated by Network Solutions' WHOIS database search. Although Complainant obtained its first trademark registration in 1991, the date of its use goes back to 1985 as it is evidenced in Complainant's trademark registrations. Complainant has made various types of advertising involving the mark BANORTE. Such trademark use has been promoted for over 15 years in all kind of media, including but not limited to radio, newspapers and television.

In support of its Complaint, Complainant submitted copies of the following Trademark Registrations:

5. Parties' Contentions

A. Complainant

The Complainant alleges that the domain name banorte.com, registered by Respondent, is identical to the BANORTE trademark, which is Complainant's famous trademark and service mark, as well as to the commercial name

used by Complainant for over 15 years in all kind of media. That BANORTE is a well-known trademark in Mexico and abroad and that Complainant has been using BANORTE in Mexico and abroad as its main trademark for more than fifteen years. That although it obtained its first BANORTE trademark registration in 1991, the date of its first use goes back to 1985. That it has registered and/or is in the process of registering the BANORTE trademark in Mexico, both as a nominative mark and with design, in all of the 42 classes of the International Classification of Products and Services for the Purposes of Registration of Marks, with a total of 48 registrations and/or applications within Mexico.

Furthermore, the Complainant alleges that the banorte.com domain name was registered and is being used in bad faith by Respondent. That the Respondent registered the domain names with the sole purpose of seeking an unjustifiable benefit from the Complainant, and without having any legitimate interest in either of these domains. That when the Complainant became aware of the Respondent's registrations, it approached Mr. G... in order to find out its intention in registering the Complainant's well-known trademark as domain names. That it became quickly apparent that the purpose was to obtain an unfair economical benefit from such registrations. That the contact information available for the Domain Name in Network Solutions' WHOIS database has changed repeatedly to include apparently false or at the very least misleading information.

That Respondent tried to register the word "Banorte" as a commercial name in class 42. That as expected, such application has been denied by the Mexican Industrial Property Institute, which cited Complainant's registries as previous registries, thus impediments for registration. That the Domain Name was used in connection with a web site for "Banquetes Nortenos Tec" (Tec Northern Banquets). Yet, the web site for Banquetes Nortenos Tec does not include an address or a telephone number to allow one to order the offered banquet services. The site does offer an electronic mail address, but no replies have been received when e-mail requests for information have been sent. That Banquetes Nortenos Tec does not exist as a company in Mexico, as evidenced from the confirmation from Nuevo Leon's Public Registry of Commerce and Property. That the Respondent's bad faith and illegitimate intentions are clearly revealed by its economic motives and the substantial increase in its demand for transferring the Domain Name. In general that the domain name banorte.com has no relationship to the actual or intended business of Respondent.

Lastly, Complainant has requested under paragraph 4 (i) of the Policy, that the Administrative Panel appointed in this proceeding issue a decision ordering that the contested domain name be transferred to the Complainant.

B. Respondent

Respondent alleges that he acquired the company on August 8th, 2000 and that he sold the company on September 21, 2000. That information related to the domain name contacts and access to the domain name have been affected by third parties. He indicated that all evidence of such transfer as well as trademark registrations were in the hands of Mr. Gabriel ... the new owner. A certain communication dated November 7, 2000 to the WIPO from Mr. Gabriel ... also makes reference to the transfer of the banorte domain name, to the existence of the company Banquetes Northeños Tec, to the existence of an "endorsement" of certain trademark registrations before the IMPI to communications regarding negotiations with the "bank", and also that that information related to the domain name contacts and access to the domain name have been affected by third parties.

6. Discussion and Findings

The Panel considers that the Respondent by registering the contested domain name with Network Solutions, Inc. (an ICANN accredited domain name registrar), it agreed to be bound by all terms and conditions of Network Solutions Service Agreement, and any pertinent rule or policy, and particularly agreed to be bound by the Policy (incorporated and made a part of the Service Agreement by reference), which policies request that proceedings be conducted according to the Rules and the selected administrative-dispute-resolution service provider's supplemental rules, in the present case being the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy. Therefore, the dispute subject matter of this proceeding is within the scope of the above mentioned agreements and policy, and this Panel has jurisdiction to decide this dispute.

Furthermore, the Panel considers that in the same manner by entering into the above mentioned Service Agreement, the Respondent agreed and warranted that neither the registration of its domain name nor the manner in which it may intend to use such domain name will directly or indirectly infringe the legal rights of a third party, and that in order to resolve a dispute under the Policy, Respondent's domain name registration services may be suspended, cancelled or transferred.

The Panel also particularly considers that it is essential to dispute resolution proceedings that fundamental due process requirements be met.

Such requirements include that the parties and particularly the Respondent in this case be given adequate notice of proceedings initiated against them; that the parties may have a fair and reasonable opportunity to respond, exercise their rights and to present their respective cases; that the composition of this Panel be properly made and the parties be notified of the appointment of this Panel; and, that both parties be treated with equality in these administrative proceedings.

In the case subject matter of this proceeding, the Panel is satisfied that these proceedings have been carried out by complying with such elemental due diligence requirements, and particularly contemplating the notification of the filing of the Complaint and the initiation of these proceedings giving the Respondent a right to respond.

There is sufficient and adequate evidence confirming the above.

Respondent alleges that he acquired the company on August 8th, 2000 and that he sold the company and assets including, the domain name under dispute on September 21, 2000. Complainant's complaint is dated September 13, 2000 (on the same date it was transmitted to the Respondent by courier, with return receipt requested), and was filed via e-mail before the WIPO Center on September 14, 2000 and with its hardcopy on September 18, 2000. All of this occurred prior to the alleged transfer of Respondent's company and assets including, the domain name under dispute.

Under paragraph 3 (a) of the Policy, cancellations, transfers, and changes to domain name registrations shall only be made upon receipt of written or appropriate electronic instructions from the domain name holder or its authorized agent to the Registrar, on the understanding that as provided for under paragraph 8 (a) (i) of the Policy, a holder of a domain name may not transfer the domain name registration to another holder during a pending administrative proceeding brought pursuant to paragraph 4 of the policy. In this respect there has been no written or appropriate electronic instructions from the domain name holder or its authorized agent to the Registrar confirming transfers or changes to domain name registrations since September 14, 2000, nor this feasible until the conclusion of this administrative proceeding as provided for under paragraph 8 (a) (i) of the Policy.

The above should be taken into consideration regarding the alleged transfers of the domain name under dispute to Mr. Gabriel ... since September 21, 2000 or to any other company or person referred to in the documentation that has been submitted. Therefore, this Panel finds that Servicios de Comunicación En Línea shall be considered as the Respondent under these proceedings and has received and given proper consideration to all information, communications or documentations that was submitted by its holder, agents, officers, administrative contact, technical contact, zone contact and billing contact.

This proceeding is related to a domain name under dispute which must be resolved based on the above mentioned Rules and Policy. Furthermore, it is within the spirit and applicable Rules or Policy, to procure an effective and uninterrupted use of the Internet and of its domains without the same being affected from domain name transfers which have not been registered in the system.

In consideration to the particularities of this case, this Panel as directed by paragraphs 14 (a) and (b) and 15 (a) of the Rules shall decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable, and may draw such inferences there from as it may consider appropriate on the basis of Complainant's undisputed representations.

Paragraph 4 (a) of the Policy directs that the Complainant must prove the presence of each of the following elements: (i) that the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and, (ii) that the Respondent has no rights or legitimate interests in respect of the domain name; and, (iii) that the Domain Name has been registered and is being used in bad faith.

This Panel finds that Respondent's Domain Name is identical to Complainant's BANORTE trademark and commercial name. That although the Respondent has filed for the registration an identical trademark on November 18, 1999, under a different class (class 42), such filing was subject to requirements and prior existing registrations were noted. Furthermore, Complainant's registration, first and general use has been made significantly before such date and with respect to a very well known trademark and commercial name. Furthermore, this Panel finds that, the registration application and use of such trademark by Respondent, from the information and facts that were analyzed, and from the lack of evidence to the contrary, is questionable and in bad faith.

Furthermore, this Panel finds in general from the information and facts that were analyzed and from the lack of evidence to the contrary that, there is no indication that the Respondent has any rights or legitimate interests in respect of the domain name as it has not used or prepared to use the banorte.com domain name in connection with any bona

vide offering of goods or services as contemplated under Paragraph 4 (c) (i) of the Policy; nor that the Respondent is commonly known by the domain name as contemplated under Paragraph 4 (c) (ii) of the Policy; nor that the Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue as contemplated under Paragraph 4 (c) (iii) of the Policy.

The Panel also finds that Respondent has used the Domain Name in bad faith, in particular but without limitation, pursuant to Paragraph 4 (b) of the Policy, in view that the Respondent registered the domain name with the purpose of seeking an unjustifiable economic benefit from the Complainant in exchange for the transfer of the domain name; has made a bad faith use of the domain name; and, has changed repeatedly the contact information available for the Domain Name in Network Solutions' WHOIS database, to include false and misleading information, with bad faith intentions. Finally, from the information and facts that were analyzed, and from the lack of evidence to the contrary, the constant change of parties having rights under the domain name, and including those changes that have occurred during these proceedings are questionable and in bad faith.

Respondent did not address Complainant's contentions.

Lastly, it is hereby noted that no settlement has been reached by the Parties and made known to this Panel prior to the rendering of this Panel's decision, which may eventually affect or give ground for termination of this administrative proceedings as provided for under paragraph 17(a) of the Rules, nor is this Panel aware of the existence or initiation of any other type of legal proceedings before a court of competent jurisdiction for independent resolution, regarding the domain name dispute as contemplated under paragraph 4 (k) of the Policy.

7. Decision

Therefore, and in consideration to the Complaint's compliance with the formal requirements for this domain name dispute proceeding, to the factual evidence and legal contentions that were submitted, to the conclusive confirmation of the presence of each of the elements contemplated in Paragraph 4 (a) (i), (ii), and (iii) of the Policy, and on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and other applicable rules and principles of law, as directed by paragraphs 14 (a) and (b) and 15 (a) of the Rules, this Panel decides:

- (1) that the Domain Name registered by Respondent is identical to Complainant's trademark "Banorte";
- (2) that Respondent has no rights or legitimate interests in respect of the banorte.com Domain Name; and
- (3) that the banorte.com Domain Name has been registered and is being used in bad faith by the Respondent.

Therefore, the Panel requires, pursuant to what is provided for under Paragraphs 3 (c) and 4 (i) of the Policy, that the domain name banorte.com be transferred to Banco Mercantil del Norte, S.A., Complainant.

Dated: November 23, 2000