

## **ADMINISTRATIVE PANEL DECISION**

BNP Paribas v. Domain Admin, Whois protection, this company does not own this domain name s.r.o. / Louis Dale

Case No. D2022-1856

### **1. The Parties**

Complainant is BNP Paribas, France, represented by Nameshield, France.

Respondent is Domain Admin, Whois protection, this company does not own this domain name s.r.o., Czech Republic / Louis Dale, United States of America.

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

The disputed domain name <bnp-paribasfortis.info> is registered with Gransy, s.r.o. d/b/a subreg.cz (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 23, 2022. On May 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 25, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on May 28, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on May 30, 2022.

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 Respondent of the Complaint, and the proceedings commenced on June 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 4, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on July 5, 2022.

The Center appointed Gabriel F. Leonardos as the sole panelist in this matter on July 18, 2022. 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

Complainant, BNP Paribas, is an international banking group which acts in 68 countries, with a total of EUR 46.2 billion in revenues with nearly 190,000 employees.

Complainant owns International trademark registrations for the sign BNP PARIBAS, as can be seen below:

Registration No.	Trademark	Jurisdictions	International Classes	Date of Registration
728598	BNP PARIBAS	International trademark	35, 36, 38	February 23, 2000
745220	BNP PARIBAS	International trademark	09, 35, 36, 38	September 18, 2000
876031	BNP PARIBAS	International trademark	09, 35, 36, 38	November 24, 2005

The disputed domain name was registered on May 11, 2022, and resolves to an inactive webpage.

#### 5. Parties' Contentions

##### A. Complainant

Complainant pleads that the disputed domain name is confusingly similar to its registered trademark BNP PARIBAS, since it fully incorporates Complainant's trademark.

Complainant also notes that the disputed domain name uses the trademark BNP PARIBAS in its entirety with the addition of the word "fortis".

Consequently, the disputed domain name is confusingly similar to Complainant's trademark BNP PARIBAS.

In addition, Complainant states that Respondent does not have any rights or legitimate interests in respect of the disputed domain name, nor is Respondent commonly known by the disputed domain name. Further, Respondent has not been authorized to use Complainant's trademark BNP PARIBAS as a domain name nor is Respondent associated with Complainant.

Complainant observes that the disputed domain name is inactive which, according to previous UDRP decisions (such as *Boeing Co. v. Bressi*, WIPO Case No. [D2000-1164](#)), indicates the lack of legitimate interests or *bona fide* use of the domain name.

Thus, Complainant contends that Respondent has no rights or legitimate interests in respect of the disputed domain name.

Moreover, Complainant states that (i) its trademark BNP PARIBAS is well-known, as recognized by prior UDRP panels; (ii) Respondent made an attempt to confuse Internet users by associating Complainant's

trademark BNP PARIBAS with the word “fortis”, which has a relation with Complainant’s business via a subsidiary in Belgium named “BNP Paribas Fortis”; (iii) the use of the disputed domain name to redirect to an inactive website, coupled with the unauthorized use of Complainant’s trademark BNP PARIBAS, would suggest a finding of bad faith; (iv) the fact that the disputed domain name has been set up with mail exchanger records (MX records) would indicate that it has been used actively for email purposes, which would also be an indicative of bad faith.

On these bases, Complainant concludes that Respondent has registered and is using the disputed domain name in bad faith.

## **B. Respondent**

Respondent did not reply to Complainant’s contentions.

## **6. Discussion and Findings**

To succeed in a UDRP complaint, Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, as following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The burden of proving these elements is upon Complainant.

Respondent had 20 days to submit a response in accordance with paragraph 5(a) of the Rules and failed to do so. Paragraph 5(f) of the Rules establishes that if a respondent does not respond to the complaint, in the absence of exceptional circumstances, the panel’s decision shall be based upon the complaint.

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

Complainant has duly proven that owns prior rights for BNP PARIBAS, and that the disputed domain name is constituted by the trademark BNP PARIBAS in its entirety with the addition of the word “fortis” and the generic Top-Level Domain (“gTLD”) “.info”.

The addition of the word “fortis” does not prevent a finding of confusing similarity with Complainant’s trademark BNP PARIBAS, since the trademark BNP PARIBAS is fully integrated in the disputed domain name.

Thus, the Panel finds that the disputed domain name is confusingly similar to Complainant’s trademark, and so the requirement of the first element of paragraph 4(a) of the Policy is satisfied.

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

The consensus view of UDRP panels on the burden of proof under paragraph 4(a)(ii) of the Policy is summarized in section 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) as follows: “[w]hile the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of ‘proving a negative’, requiring information that is often primarily within the knowledge or control of the respondent. As such, 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.”

In this case, noting the facts and contentions listed above, the Panel finds that Complainant has made out a *prima facie* case showing that Respondent lacks rights or legitimate interests in the disputed domain name, so the burden of production shifts to Respondent. As Respondent has not replied to Complainant’s contentions, the Panel has considered Complainant’s un rebutted *prima facie* case to be sufficient to demonstrate that Respondent has no rights or legitimate interests in the disputed domain name.

Furthermore, there is no evidence that Respondent has used the disputed domain name in the context of a *bona fide* offering of goods or services or a legitimate noncommercial or fair use, since the evidence shows that the disputed domain name resolves to a blank webpage.

Also, the Panel notes that the nature of the disputed domain name, incorporating the Complainant’s well-known trademark and an additional term related to a subsidiary of the Complainant, carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the requirement of the second element of paragraph 4(a) of the Policy is also satisfied.

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

Paragraph 4(b) of the Policy lists a number of circumstances that, without limitation, are deemed evidence of registration and use of a domain name in bad faith.

Respondent has registered the disputed domain name that fully incorporates Complainant’s trademark BNP PARIBAS, plus the addition of the word “fortis”. The Panel finds that it is duly demonstrated that Respondent was aware of Complainant’s rights to the trademark BNP PARIBAS at the time of the registration – as Complainant enjoys a worldwide reputation with the use of the referred trademark, and the word “fortis” has a relation to Complainant’s business.

With that in sight, Panel finds that Respondent registered the disputed domain name with the intention of attracting Internet users and consumers in search of authentic BNP PARIBAS services.

Moreover, Panel finds that the word “fortis” that accompanies the trademark BNP PARIBAS in the disputed domain name consists of a reference that is linked with Complainant’s business – which indicates that the use of the trademark BNP PARIBAS, paired with a word that is linked with Complainant’s services, in a domain name that is unauthorized by Complainant, will most likely be in bad faith.

In addition, the fact that the disputed domain name resolves to a blank webpage does not prevent a finding of bad faith registration and use under the passive holding doctrine. Further to the decision in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), the consensus view of UDRP panels, found in section 3.3 of the [WIPO Overview 3.0](#), lists four circumstances that should be taken in consideration, in the totality of the circumstances, to indicate if the passive holding of a domain name could be regarded as bad faith:

“(i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.”

Considering all of the items listed above, this Panel finds that all these circumstances are present in this case, since (i) Complainant enjoys a well-known reputation under the trademark BNP PARIBAS; (ii) Respondent has not responded to Complainant’s contentions, failing to provide evidence of the use in good

faith of the disputed domain name; (iii) a privacy service has been used to conceal the identity of Respondent; and (iv) there is no plausible use of the disputed domain name that would not represent bad faith, especially considering that it is composed by Complainant's trademark BNP PARIBAS with the addition of the word "fortis", which is linked to Complainant's business. Thus, the circumstances of the present case strongly indicate that the disputed domain name is being passively held as an act of bad faith.

Further, as discussed in *PrideStaff, Inc. v. Pearl Njinjoh, Trearl*, WIPO Case No. [D2021-2033](#), it should be noted that the setup of the disputed domain name with MX records by the Respondent, depending on the circumstances of the case, may also indicate bad faith:

"To support a finding of use of the disputed domain name in bad faith in this situation, it is not necessary for the Complainant to prove that such a communication has actually been sent; it is sufficient that such a communication could be sent, for a Panel to assess the Respondent's bad faith on the balance of probabilities. The establishment of MX records for a domain name points towards a potential active use of it, which, in the circumstances of this case, and particularly noting the composition of the disputed domain name, affirms the Respondent's bad faith."

In this regard, the Panel finds that the setup of the disputed domain name with MX records together with other circumstances of the case, such as the passive holding and choice of additional term, creates a risk the disputed domain name could be used to send fraudulent and/or impersonating communications and supports a finding of bad faith.

In light of the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith. Therefore, the requirement of the third element of paragraph 4(a) of the Policy is satisfied.

## **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 name <bnp-paribasfortis.info> be transferred to Complainant.

*/Gabriel F. Leonardos/*

**Gabriel F. Leonardos**

Sole Panelist

Date: August 1, 2022