

ADMINISTRATIVE PANEL DECISION

Stichting BDO v. Jayson Tamidles

Case No. D2023-2437

1. The Parties

The Complainant is Stichting BDO, Netherlands (Kingdom of the), represented by McDermott Will & Emery LLP, United States of America (“U.S.”).

The Respondent is Jayson Tamidles, Philippines.

2. The Domain Name and Registrar

The disputed domain name <bdoclientadvisory.com> (“Disputed Domain Name”) is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 6, 2023. On June 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On June 6, 2023, 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 the Complainant on June 7, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on June 10, 2023.

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 the Respondent of the Complaint, and the proceedings commenced on June 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 5, 2023. The Technical Contact of the Disputed Domain Name sent an informal communication to the Center on June 22, 2023. The Center notified about the Commencement of Panel Appointment Process on July 12, 2023.

The Center appointed Gabriela Kennedy as the sole panelist in this matter on July 21, 2023. 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

The Complainant is a global network of public accounting firms founded in 1963, offering a wide range of services within the financial services industry, such as audit, tax, and advisory services. The Complainant owns various word and figurative trademarks for or containing “BDO” (the “Complainant’s Trademark”) around the globe.

The relevant trademark registrations include, *inter alia*, the U.S. Trademark Registration No. 2699812 for the mark “ ” registered on March 25, 2003 in classes 9, 16, 35, 36, 41, and 42; and U.S. Trademark Registration No. 4854142 for the mark “BDO” registered on November 17, 2015 in classes 9, 16, 35, 36, 41, 42, and 45.

The Complainant’s Trademark is also fully incorporated in the Complainant’s domain names <bdo.com> which the Complainant registered on February 27, 1995 (the “Complainant’s Domain Name”) and resolves to the Complainant’s website. Apart from this, the Complainant also owns the following domain names featuring the Complainant’s Trademark, including *inter alia*, <bdointernational.com>, <bdo.com.au>, <bdo.it>, <bdo.ch>, and <bdo.co.uk>.

The Disputed Domain Name was registered by the Respondent on May 31, 2023. At the date of filing the Complaint and at the date of this decision, the Panel notes that the Disputed Domain Name resolves to a warning page stating “Deceptive Site Ahead” (“the Respondent’s Website”). Following a manual override to continue to the Respondent’s Website, the Disputed Domain Name then resolves to a page that could not be reached due to the DNS address not being found.

5. Parties’ Contentions

A. Complainant

(a) The Disputed Domain Name is identical or confusingly similar to the Complainant’s Trademark. The Complainant’s Trademark is reproduced in its entirety. Apart from the Complainant’s Trademark, the remaining elements in the Disputed Domain Name are the terms “client” and “advisory”, which do not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant’s Trademark. The generic Top-Level Domain (“gTLD”) extension, “.com” in the Disputed Domain Name also does not distinguish it from the Complainant’s Trademark.

(b) The Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent has not obtained any authorization from the Complainant to use the Complainant’s Trademark as part of a domain name or otherwise. The Respondent is not known by the Disputed Domain Name. Moreover, the Disputed Domain Name is not being used in relation to a *bona fide* offering of goods or services and the Respondent is not making legitimate or fair use of the Disputed Domain Name.

(c) Both the Respondent’s registration and use of the Disputed Domain Name establish the Respondent’s bad faith. Given the history of the BDO brand and reputation that the Complainant has acquired in the Complainant’s Trademark, the Respondent must have been fully aware of the existence of the Complainant’s rights in the Complainant’s Trademark when the Respondent registered and used the Disputed Domain Name. The Respondent used a privacy shield to mask his identity. The security warning on the Respondent’s Website also suggests that it might be used for malicious purposes. Therefore, the Respondent has registered and used the Disputed Domain Name in bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements:

- (i) The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) The 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 by the Respondent in bad faith.

A. Identical or Confusingly Similar

The Panel accepts that the Complainant has rights in the Complainant's Trademark, based on its various trademark registrations such as those listed in Section 4.

The Disputed Domain Name incorporates the Complainant's Trademark in its entirety with the addition of the terms "client" and "advisory". UDRP panels have consistently found that the addition of other terms to a mark (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity under the first element. See Section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The Panel, therefore, agrees with the Complainant that these additional terms do not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant's Trademark.

Furthermore, it is well established that the gTLD ".com" in this case, may be disregarded. See section 1.11.1 of the [WIPO Overview 3.0](#).

As such, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's Trademark, and accordingly, paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

The Panel accepts that the Complainant has not authorized the Respondent to use the Complainant's Trademark. There is no relationship between the Complainant and the Respondent, which would otherwise entitle the Respondent to use the Complainant's Trademark. Accordingly, the Panel is of the view that a *prima facie* case has been established by the Complainant and it is for the Respondent to show rights or legitimate interests in the Disputed Domain Name.

Once a complainant establishes a *prima facie* case in respect of the lack of rights or legitimate interests of a respondent in a disputed domain name, the respondent then carries the burden of demonstrating that it has rights or legitimate interests in the disputed domain name. Where the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent did not submit a formal Response. The fact that the Respondent did not submit a formal Response does not automatically result in a decision in favor of the Complainant. However, the Respondent's failure to file a formal Response may result in the Panel drawing appropriate inferences from such default. The Panel may also accept all reasonable and supported allegations and inferences flowing

from the Complainant as true (see *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. [D2009-1437](#); and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#)).

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the Disputed Domain Names by demonstrating any of the following:

- (i) before any notice to the Respondent of the dispute, the Respondent's use of, or demonstrable preparations to use the Disputed Domain Name or name corresponding to the Disputed Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent has been commonly known by the Disputed Domain Name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel agrees with the Complainant that there is no evidence to show that the Respondent has trademark rights corresponding to the Disputed Domain Name, or that the Respondent has become known by the Disputed Domain Name.

There is no evidence to suggest that the Respondent's use of, or demonstrable preparations to use the Disputed Domain Name or name corresponding to the Disputed Domain Name, is in connection with a *bona fide* offering of goods or services or be regarded as legitimate noncommercial or fair use. The security warning on the Respondent's Website suggests that it might be used for malicious purposes, such as tricking Internet users into installing software or revealing their personal information.

No evidence has been provided to show that the Respondent has trademarks rights corresponding to the Disputed Domain Name or that the Respondent has become known by the Disputed Domain Name.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name and the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Disputed Domain Name incorporates the Complainant's Trademark followed by the words "client" and "advisory". A quick Internet search conducted by the Panel shows that the top search results returned for the keyword "BDO" relate to the Complainant's services and/or third party websites providing information relating to the Complainant's services. Therefore, the Panel agrees with the Complainant that the Respondent must have been aware of the Complainant and its rights in the Complainant's Trademark when registering and using the Disputed Domain Name.

In addition, the Panel finds that the following factors support a finding that the Disputed Domain Name was registered and has been used by the Respondent in bad faith:

- (i) It is difficult to conceive of any plausible use of the Disputed Domain Name that would amount to good faith use, given that the Disputed Domain Name is confusingly similar to the Complainant's Trademark. Also, as discussed above, the Respondent lacks rights or legitimate interests in the Disputed Domain Name (see *Washington Mutual, Inc. v. Ashley Khong*, WIPO Case No. [D2005-0740](#)).
- (ii) The security warning on the Respondent's Website suggests that the Respondent might trick Internet users into installing software or revealing their personal information. The Respondent is therefore capitalizing on the Complainant's reputation and goodwill for some malicious intent (see *Accenture*

Global Services Limited v. Domain Privacy, Above.com Domain Privacy, WIPO Case No. [D2021-0481](#)).

- (iii) The Respondent failed to respond to the Complainant's contentions and has provided no evidence of his actual or contemplated good faith use of the Disputed Domain Name.
- (iv) The Respondent registered the Disputed Domain Name using a privacy shield to conceal his identity (see *Primonial v. Domain Administrator, PrivacyGuardian.org / Parla Turkmenoglu*, WIPO Case No. [D2019-0193](#)).

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 <bdoclientadvisory.com> be transferred to the Complainant.

/Gabriela Kennedy/

Gabriela Kennedy

Sole Panelist

Date: August 4, 2023