Decision for dispute CAC-UDRP-102719

Case number	CAC-UDRP-102719
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Domain names	ukbnpparibas.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	BNP PARIBAS

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	CSD UK

OTHER LEGAL PROCEEDINGS

The Panel is not cognizant of any other pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns several trademarks for “BNP PARIBAS” ®, such as:

- International trademark “BNP PARIBAS” ® n°728598 registered since 2000-02-23;

- International trademark “BNP PARIBAS” ® n°745220 registered since 2000-09-18; and

- International trademark “BNP PARIBAS” ® n°876031 registered since 2005-11-24.

FACTUAL BACKGROUND

The following facts have been asserted by the Complainant and have not been contested by the Respondent:

BNP PARIBAS S.A. (the “Complainant”) is an international banking group with a presence in 72 countries, and one of the largest banks in the world. With more than 202,624 employees and €7.5 billion in net profit, the Complainant stands as a leading bank in the Eurozone and a prominent international banking institution.

The Complainant is also the owner of a large portfolio of domain names containing the trademark “BNP PARIBAS”, such as:

- <bnpparibas.com>, registered since 1999-09-02;

- <bnpparibas.net>, registered since 1999-12-29; and

- <bnpparibas.co.uk>, registered since 2001-05-16.

The disputed domain name <ukbnpparibas.com> was registered on August 14th, 2019 and is inactive.

PARTIES CONTENTIONS

COMPLAINANT

A. The Complainant states that the disputed domain name <ukbnpparibas.com> is confusingly similar to its trademark “BNP PARIBAS” ®, as it incorporates the trademark in its entirety.

The addition of the geographic term “UK” is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark “BNP PARIBAS” ®. It does not change the overall impression of the designation as being connected to the Complainant’s trademark “BNP PARIBAS” ®. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and domain names associated.

It is well-established that “a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP”.

Moreover, the Complainant contends that the addition of the generic Top-Level Domain suffix “.COM” does not change the overall impression of the designation as being connected to the trademark “BNP PARIBAS” ® of the Complainant. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and its domain names associated.

Thus, the disputed domain name <ukbnpparibas.com> is confusingly similar to the Complainant's trademark “BNP PARIBAS” ®.

B. A Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, a respondent carries the burden of demonstrating rights or legitimate interests in a domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy.

The Respondent is not known as the disputed domain name in the Whois database, and has not acquired trademarks mark rights on this term. Past Panels have held that a Respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that he is not related in any way to the Complainant’s business.

The Complainant contends that the Respondent is not affiliated with him nor authorized by him in any way to use the trademark “BNP PARIBAS” ®. The Complainant does not carry out any activity for, nor has any business with the Respondent.

Besides, the Complainant asserts that Respondent used the disputed domain name to pass itself off as a Complainant’s Client Support in the UK to conduct a phishing scheme, by using an e-mail address closely similar to the Complainant’s official one: “******@ukbnpparibas.com” instead of “******@uk.bnpparibas.com”. Using the disputed domain name in this

manner is neither a bona fide offering of goods or services under Policy 4 (c)(i), nor a non-commercial or fair use pursuant to Policy 4(c)(iii).

Besides, the disputed domain name is currently inactive. Therefore, the Complainant contends that Respondent did not make any use of disputed domain name since its registration, and it confirms that Respondent has no demonstrable plan to use the disputed domain name, except for the phishing scheme. It demonstrates a lack of legitimate interests in respect of the disputed domain name.

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

C. Prior UDRP panels have established that the trademark “BNP PARIBAS” ® is well-known.

Besides, the Respondent has used the disputed domain name in a phishing scheme in order to pass off as the Complainant’s Client Support in the UK.

Thus, given the distinctiveness of the Complainant's trademarks and reputation, it is inconceivable that the Respondent could have registered the disputed domain name <ukbnpparibas.com> without actual knowledge of Complainant's rights in the trademark, which evidences bad faith.

Furthermore, the Complainant states that the Respondent used the disputed domain name in bad faith. It is well-established that using a domain name for purposes of phishing or other fraudulent activity constitutes solid evidence of bad faith use.

Finally, the disputed domain name is inactive. The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name, except for the phishing scheme, and it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant’s rights under trademark law.

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

RESPONDENT

No administratively compliant Response has been filed.

RIGHTS

To the satisfaction of the Panel, the Complainant has shown that the disputed domain name is identical or confusingly similar to the trademark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

To the satisfaction of the Panel, the Complainant has shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

To the satisfaction of the Panel, the Complainant has shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP have been met and there is no other reason why it would be unsuitable to provide the Decision.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has shown it owns rights in the trademark “BNP PARIBAS” ® trademark, with the earliest registration dating back to 1999.

We must now turn to analyse if there is confusing similarity between the disputed domain name and the trademark. As contained in the available record, the disputed domain name reproduces the trademark in its totality, with two exceptions. The first difference is that there is no space between the word components of the trademark. The second difference is the addition of the two characters “uk” that precede the trademark. These characters seem to refer to the United Kingdom and/or the ccTLD assigned to the United Kingdom. A further analysis of this difference may be relevant to the second and third element under the UDRP Policy set out below. Nevertheless, for the purposes of this element, these small differences are insignificant, since they are not substantive enough to dispel the confusing similarity between the disputed domain name and the Complainant’s trademarks.

Consequently, the Panel determines that the Complaint has satisfied the first element set under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

For the Complainant to succeed under the second element of the Policy, it has to show a prima facie case, which consequently shifts the burden of proof to the Respondent. In this case, the Respondent failed to produce allegations or evidence necessary to demonstrate its rights or legitimate interests in the disputed domain name.

In this matter, the uncontested facts indicate that a) the Respondent is not known as the disputed domain name in the Whois database; b) the Respondent has not acquired trademark rights on this term; c) the Complainant contends that the Respondent is not affiliated with it nor authorized by it in any way to use the trademark “BNP PARIBAS” ®; and d) the Complainant does not carry out any activity for, nor has any business with the Respondent.

These facts lead the Panel to conclude that the Respondent did not have rights or legitimate interests in the disputed domain name. Furthermore, the Complainant provides evidence of a phishing attempt using an e-mail associated to the disputed domain name. This last fact will be further analysed under the third element below. Nevertheless, assessing these facts in conjunction provide sufficient inputs for the purposes of the second element.

Consequently, the Panel determines that the Respondent has no rights or legitimate interests in the disputed domain name and subsequently the Complainant has fulfilled the second requirement set under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Complainant provided evidence on record that shows a fraudulent use of the disputed domain name through an e-mail meant to appear as having originated from the Complainant, with a clear intention of deriving in unjust enrichment to the benefit of the Respondent. The Panel believes that this conduct embodies the thrust of circumstances exemplified as evidence of bad faith under Paragraph 4(b) of the Policy (see Lockheed Martin Corp. v. Reid Harward, WIPO Case No. D2000-0799).

In light of the circumstances of the case, based on the available records, the Panel finds that the Complainant has proven that the disputed domain name was registered and is used in bad faith according to paragraph 4(a)(iii) of the Policy.

D. Decision

For the foregoing reasons and in concurrence with the provisions specified under Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders the transfer of the disputed domain name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **UKBNPPARIBAS.COM**: Transferred

PANELLISTS

Name	**Rodolfo Carlos Rivas Rea**

DATE OF PANEL DECISION 2019-11-07

Publish the Decision