Decision for dispute CAC-UDRP-102797

Case number	CAC-UDRP-102797
Time of filing	2019-12-17 11:31:37
Domain names	bnp-paribas.pro

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	BNP PARIBAS

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Julio Jaime

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant has submitted evidence, which the Panel accepts, showing that it is the registered owner of the following:

- the IR trademark BNP PARIBAS (Registration n°728598) dated February 23, 2000
- the IR trademark BNP PARIBAS (registration n°745220) dated September 18, 2000
- the IR trademark BNP PARIBAS (registration n°876031) dated November 24, 2005

Moreover, the Complainant is also the owner of the domain names bearing the sign “BNP PARIBAS” such as the following:

- bnpparibas.com registration dated September 02, 1999,
- bnpparibas.net registration dated December 29, 1999 and
- bnpparibas.pro registration dated July 23, 2008.

FACTUAL BACKGROUND

The Complainant is a leading international banking group with a presence in 72 countries and one of the largest banks in the

world. The Complainant owns 202 624 employees and has € 7.5 billion profit in net.

The Complainant holds several trademark registrations for “BNP PARIBAS” and the Complainant also holds the domain names bearing “BNP PARIBAS”.

On October 01, 2019, the Respondent registered the disputed domain name <bnp-paribas.pro>. The domain name is currently inactive. (http://bnp-paribas.pro/)

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant is a company specialized in banking and is a well-known company in its sector. The Complainant holds international trademark registrations for the trademark “BNP PARIBAS” and also is the owner of the domain names bearing the sign “BNP PARIBAS” including bnpparibas.pro.

1. THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR TO THE COMPLAINANT’S TRADEMARK „BNP PARIBAS“ and THE COMPLAINANT’S DOMAIN NAMES bearing „BNP PARIBAS“

The Complainant states that BNP PARIBAS is a globally known trademark.

The disputed domain name is confusingly similar to the Complainant’s trademarks “BNP PARIBAS” and to the Complainant’s domain names bearing “BNP PARIBAS” as it bears the Complainant’s “BNP PARIBAS” trademark as a whole.

The Complainant alleges that the addition of the dash “-” and “.pro” does not eliminate the confusingly similarity between the disputed domain name and the “BNP PARIBAS” trademark.

The Complainant states that prior Panel decisions have accepted the fact that the domain name which wholly incorporates a Complainant’s registered trademark is sufficient to establish the confusingly similarity despite the addition of the dash “-“. The Complainant refers to earlier Panel decision NAF Case No. FA 1764120, Morgan Stanley v. Bruce Pu.

2. THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant states that the Respondent has no rights on the disputed domain name as the Respondent is not known as the disputed domain name and the Respondent does not hold such trademark as the disputed domain name.

The Complainant also alleges that the Respondent is not affiliated with the Complainant and the Respondent has not been authorized by the Complainant to use the trademark “BNP PARIBAS”. The Complainant argues that the Respondent does not carry out any activity or business with the Complainant.

The Complainant argues that the disputed domain name is inactive. Thus, the Complainant argues that the Respondent has no demonstrable plan to use the disputed domain name.

3. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The Complainant states that the “BNP PARIBAS” is a well-known trademark and its notoriety has been accepted within the earlier decisions such as WIPO Case No. D2017-2167, BNP Paribas v. Ronan Laster.

The Complainant asserts that considering the well-known status of the Complainant’s trademark, the Respondent knew about the Complainant and its rights before the registration of the disputed domain name. Accordingly, the disputed domain name was registered and is being used in bad faith.

The Complainant alleges that the bad faith of the Respondent is supported within the fact that the disputed domain name is inactive.

The Complainant refers to earlier Panel decisions e.g. WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows and WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, 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

The Complainant has, to the satisfaction of the Panel, 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 were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15 of the Rules provides that the Panel is to 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.

In this context, the Panel also notes that the burden of proof is on the Complainant to make out its prima facie case and past UDRP panels have consistently said that a Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

A. The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

B. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and

C. The Disputed Domain Name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

A. IDENTICAL OR CONFUSINGLY SIMILAR

The Policy simply requires the Complainant to demonstrate that the Disputed Domain Name is identical or confusingly similar to a trademark in which the Complainant has rights. The Panel is satisfied that the Complainant is the owner of registration of the BNP PARIBAS trademarks.

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s BNP PARIBAS trademarks since it contains the Complainant’s trademark as a whole.

Further, the addition of the dash „-“ and „.pro“ is not enough to abolish the similarity.

The Panel is of the opinion that the internet users will easily fall into false impression that the disputed domain name is an official domain name of the Complainant. The Panel recognizes the Complainant's rights and concludes that the Disputed Domain Name is confusingly similar with the Complainant's trademarks. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy is provided.

B. NO RIGHTS OR LEGITIMATE INTERESTS

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is open to a Respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to the respondent of the dispute, the use or making demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bone fide offering of goods or services; or

(ii) the respondent of the dispute (as an individual, business, or other organization) has been commonly known by the domain name, even if it has had acquired no trademark or service mark rights; or

(iii) the respondent of the dispute is making a legitimate non-commercial or fair use of the domain name, without an intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if the Respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the disputed domain name, the Complainant will have failed to discharge its burden of proof and the Complaint will fail. The burden is on the Complainant to demonstrate a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name. Once the Complainant has made out a prima facie case, then the Respondent may, inter alia, by showing one of the above circumstances, demonstrate rights or legitimate interests in the disputed domain name.

The Complainant contends that the Respondent has nothing to do with the Complaint and any use of the trademark BNP PARIBAS has to be authorized by the Complainant and there is no such authorization. Moreover, the disputed domain name has no relation with the Respondent and the Respondent is not commonly known as the disputed domain name.

In the absence of a response, the Panel accepts the Complainant's allegations as true that the Respondent has no authorization to use the Complainant’s trademarks in the disputed domain name. Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain dame, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. BAD FAITH

The Panel concludes that the Complainant's BNP PARIBAS trademark has a significant reputation and is of distinctive character. Therefore, the Panel is of the opinion that due to the earlier rights of the Complainant in the BNP PARIBAS trademarks and the associated domain names, the Respondent, was aware of the Complainant and its trademarks at the time of registration of the disputed domain name (see e.g., Ebay Inc. v. Wangming, WIPO Case No. D2006-1107). Referring

to Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net, WIPO Case No. D2000-0226, the Panel believes that the awareness of the Complainant's trademark at the time of the registration of the disputed domain name is to be considered an inference of bad faith registration.

Moreover the http://bnp-paribas.pro/ link is currently inactive.

Therefore, in light of the above-mentioned circumstances in the present case, the Panel finds that the disputed domain dame has been registered and is being used in bad faith and that the Complainant has established the third element under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BNP-PARIBAS.PRO**: Transferred

PANELLISTS

Name	**Mrs Selma Ünlü**

DATE OF PANEL DECISION 2020-01-29

Publish the Decision