Decision for dispute CAC-UDRP-103111

Case number	CAC-UDRP-103111
Time of filing	2020-06-15 10:05:51
Domain names	bnp-paribas-fortis.info

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	BNP PARIBAS

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	domeinbeheer domeinbeheer

OTHER LEGAL PROCEEDINGS

There are no other proceedings the Panel is aware of.

IDENTIFICATION OF RIGHTS

The Complainant's name and mark is a well-known mark. It owns numerous national and regional registered trade marks with the word elements BNP PARIBAS including the following international trade marks:

- BNP PARIBAS n°728598 registered 23 February 2000;
- BNP PARIBAS n°745220 registered since 18 September 2000;
- BNP PARIBAS n°876031 registered since 24 November 2005.

The Complainant is also the owner of a large portfolio of domain names "BNP PARIBAS", such as <bnpparibas.com>, registered 02/09/1999.

In addition to its registered rights, the Complainant relies on its rights arising from its extensive use in those jurisdictions that recognize common law or unregistered marks.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is a well-known international banking group and one of the largest banks in the world. Its website is at www.group.bnpparibas. It has more than 202 624 employees and recently reported €7.5 billion in net profit.

The Respondent's details were provided by the Registrar. No individual's name is provided just the handle "domeinbeheer" and a phone number and e-mail address.

The Disputed Domain Name was registered on 6 January 2020 and is inactive. There is no evidence to suggest it has ever been used.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

1. Identical/Confusingly similar to mark

The Complainant states that the Disputed Domain Name <bnp-paribas-fortis.info> is confusingly similar to its earlier registered trade marks for the term BNP PARIBAS and its domain name.

Indeed, the Disputed Domain Name contains the Complainant's registered trademark BNP PARIBAS in its entirety.
The Complainant contends that the Disputed Domain Name only differs from the trade mark BNP PARIBAS by the addition of the term "FORTIS" (which refers to the Complainant's subsidiary BNP PARIBAS FORTIS) and the addition of hyphens.

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". Please see WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin.
Moreover, the Complainant contends that the addition of the gTLD ".INFO" does not change the overall impression of the designation as being connected to the trademark BNP PARIBAS. It does not prevent the likelihood of confusion between the Disputed Domain Name and the Complainant's name and marks.

2. The Respondent does not have any rights or legitimate interest in the Disputed Domain Name

According to the WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd., 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, Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy.

The Complainant asserts that the Respondent is not known by the Disputed Domain Name in the Whois database and has not acquired trade mark rights in 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.

Please see for instance FORUM Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy 4(c)(ii) that Respondent is not commonly known by 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 Disputed Domain Name has been inactive since registration. Therefore, the Complainant contends that the Respondent did not make any use of the Disputed Domain Name since its registration and confirms that Respondent has no demonstrable plan to use the Disputed Domain Name. 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.

3.Bad Faith

The Complainant states that the Disputed Domain Name is confusingly similar to its trade mark. Prior UDRP panels have established that the trademark BNP PARIBAS is well-known.

Please see for instance WIPO Case No. D2017-2167, BNP Paribas v. Ronan Laster ("Then, according to the Panel, the Complainant has shown that the Respondent knew, or should have known, that its registration would be identical or confusingly similar to the Complainant's mark specifically because of the high notoriety of the BNP PARIBAS trademarks throughout the world").

Besides, the Complainant asserts that the Respondent had the Complainant and its subsidiary in mind when it registered the Disputed Domain Name and that this registration cannot be coincidental. Indeed, the association of the term "FORTIS" with the trademark BNP PARIBAS can only have referred to the Complainant's subsidiary.
Thus, given the distinctiveness of the Complainant's trade marks and its fame and reputation, it is inconceivable that the Respondent could have registered the Disputed Domain Name without actual knowledge of Complainant's rights in the trade mark, which evidences bad faith.

Finally, the Disputed Domain Name is inactive. The Complainant submits that the Respondent has not demonstrated any activity related to the Disputed Domain Name, and it is not possible to conceive of any plausible actual or contemplated active use of the 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 trade mark law.

Please see FORUM Case No. 1800980, Fitness International, LLC v. Furqan Hameed ("Complainant provided screenshots of the <healthlafitness.com> website, which indicate that the site is inactive. The Panel finds that Respondent failed to actively use the domain name, evidence that Respondent registered and uses the domain name in bad faith under Policy 4(a)(iii).").

Consequently, the Complainant asserts that the Respondent has registered the Disputed Domain Name in bad faith and has used it to create a likelihood of confusion with the Complainant's trademark as to source, affiliation or endorsement, in the meaning of paragraph 4(b)(iv) of the Policy, and thus acted in bad faith.
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". Please see WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin.

Please see for instance FORUM Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> (above).

Please see for instance WIPO Case No. D2017-2167, BNP Paribas v. Ronan Laster (above).

Please see FORUM Case No. 1800980, Fitness International, LLC v. Furqan Hameed (“Complainant provided screenshots of the <healthlafitness.com> website, which indicate that the site is inactive. The Panel finds that Respondent failed to actively use the domain name, evidence that Respondent registered and uses the domain name in bad faith under Policy 4(a)(iii).”).

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

The Complainant’s name and mark are famous and well-known. The suffix is ignored for similarity. The Disputed Domain Name adds one word, FORTIS, which also refers to the Complainant’s subsidiary. The hyphens add nothing. There is no question that the Disputed Domain Name is confusingly similar to the Complainant’s name and mark.

The selection of .info may have been relevant to the second limb, legitimate right or fair use, if the Disputed Domain Name was used in connection with a website that discussed/ was about the Complainant or its business, that would be protected Fair Use. That is not the position. We have passive holding.

While inactivity is not objectionable in itself, in all of the circumstances, the registration of the Disputed Domain Name falls within the rule in Tesla Corp. Ltd v Nuclear Marshmallows, WIPO Case No. 2000-0003 in that the name and mark is famous, the Respondent has concealed his identity and has not come forward with an explanation for the selection and there is no fair or legitimate reason for it on the face of the matter, then it is reasonable to find bad faith. That case extends to reach passive holding and is applicable here.

The Complainant has discharged its burden and made out its case.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BNP-PARIBAS-FORTIS.INFO**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2020-07-22

Publish the Decision