Decision for dispute CAC-UDRP-103409

Case number	CAC-UDRP-103409
Time of filing	2020-11-19 09:49:55
Domain names	bnp-paribasfortis.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	BNP PARIBAS

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	luikio Anelisa

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

BNP PARIBAS S.A. (the “Complainant”) is an international banking group with a presence in 71 countries, and one of the largest banks in the world. With more than 198,816 employees and €8.2 billion in net profit, the Complainant stands as a leading bank in the Eurozone and a prominent international banking institution.

BNP PARIBAS FORTIS is the Complainant’s Belgium subsidiary.

The Complainant owns numerous trademarks BNP PARIBAS®, such as:
- the international trademark BNP PARIBAS® n°728598 registered since 2000-02-23;
- the international trademark BNP PARIBAS® n°745220 registered since 2000-09-18;
- the international trademark BNP PARIBAS® n°876031 registered since 2005-11-24.

FACTUAL BACKGROUND

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

The disputed domain name <bnp-paribasfortis.com> was registered on November 1, 2019, and resolves to a parking page with commercial links related to the Complainant and its banking activities.

The Complainant states that the disputed domain name <bnp-paribasfortis.com> is confusingly similar to its previous trademark registrations on the term BNP PARIBAS®.

PARTIES CONTENTIONS

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).

Indeed, the disputed domain name <bnp-paribasfortis.com> contains the Complainant's registered trademark BNP PARIBAS® in its entirety.

The disputed domain name only differs from the trademark BNP PARIBAS® by the addition of the term "FORTIS" (which refers to the Complainant's subsidiary BNP PARIBAS FORTIS) and the addition of a hyphen.

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 addition of the gTLD ".COM" 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 trademark.

So the disputed domain name <bnp-paribasfortis.com> is confusingly similar to Complainant's trademark BNP PARIBAS®.

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).

The Respondent is not known as the disputed domain name in the Whois database. 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 paragraph 4(c)(ii) that the Respondent is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii).").

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.

Furthermore, the disputed domain name resolves to a parking page with commercial links related to the Complainant and its activities. Many past panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use.

Thus, the Complainant has no rights or legitimate interests in respect of the disputed domain name <bnp-

paribasfortis.com>.

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).

Prior UDRP panels have established that the trademark BNP PARIBAS® is well-known. 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.").

Also, the Respondent must have had the Complainant and its subsidiary in mind when it registered the disputed domain name, and this registration cannot be coincidental. Complainant has provided evidence the association of the term "FORTIS" and the trademark BNP PARIBAS® is mainly known in relation with the Complainant's subsidiary.

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

Finally, the disputed domain name resolves to a parking page with commercial links related to the Complainant and its activities. The Respondent has attempted to attract Internet users to his own website thanks to the Complainant's trademarks for its own commercial gain, which is evidence of bad faith.

Therefore, the Respondent has registered and is using the disputed domain name in bad faith.

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

Prior UDRP panels have established that the trademark BNP PARIBAS® is well-known. 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").

Furthermore, the disputed domain name resolves to a parking page with commercial links related to the Complainant and its activities. Many past panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BNP-PARIBASFORTIS.COM**: Transferred

PANELLISTS

Name	**Mike Rodenbaugh**

DATE OF PANEL DECISION 2020-12-18

Publish the Decision