

Decision for dispute CAC-UDRP-103502

Case number	CAC-UDRP-103502
Time of filing	2021-01-12 09:57:45
Domain names	bnp-paribasmabanque.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	BNP PARIBAS
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Complainant representative

Organization	Nameshield (Enora Millocheau)
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Respondent

Name	emilio emilio
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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

As mentioned in the Complaint, the Complainant is an international well-known banking group of French origin, owner of numerous BNP PARIBAS® trademarks, registered in several countries (thereafter the "BNP PARIBAS trademarks") worldwide. The Panel notices European trademark EUTM No. 001845684 (providing trade mark protection in all 28 member states of the European Union, incl. Netherlands), as well as a multiple of valid international trademark registrations (as set above in the factual background by the Complainant), registered long before the registration of the disputed domain name in December 2020. The Complainant is also the owner of a vast portfolio of domain names including the term "BNP PARIBAS", e.g. <bnpparibas.com>, registered since 1999, among many others.

The Panel finds that the Complainant has provided sufficient evidence that it has rights on the BNP PARIBAS trademarks.

FACTUAL BACKGROUND

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

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.

The Complainant owns numerous international 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.

The Complainant is also the owner of a large portfolio of domain names “BNP PARIBAS”, (e.g. <bnpparibas.com>, registered since 1999-09-02; <bnpparibas.net>, registered since 1999-12-29; <bnpparibas.pro>, registered since 2008-07-23).

The disputed domain name <bnp-paribasmbanque.com> was registered on December 25th, 2020 and resolves to an inactive page.

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).

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

i. The Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

The Complainant has demonstrated sufficient evidence that it has rights on the BNP PARIBAS trademarks, rights that were registered and known long before the Respondent registered the disputed domain name in December 2020.

The disputed domain name <bnp-paribasmbanque.com> incorporates the BNP PARIBAS trademark in its entirety, with the sole difference of adding a "-" between "bnp" and "paribas", followed by the combination of the expression in French "mbanque", which in English means ("mybank"), and that said term is descriptive of the Complainant's business and bank services.

ii. In the Panel's view, the Complainant has shown prima facie that the Respondent lacks rights or legitimate interests in the disputed domain name. The Complainant has stated that the Respondent is not affiliated with BNP Paribas and that the Respondent has not been permitted, licensed or otherwise authorised by the Complainant to use its BNP PARIBAS trademarks. There is also no evidence suggesting that the Respondent is currently and/or has been known by the domain name or under the name BNP Paribas.

The burden of production shifts to the Respondent to rebut the Complainant’s statements, and the Respondent has not provided any response to the Complainant’s contentions in the current administrative proceedings. It is to be noted that the disputed domain name is not currently being used, being redirected to an inactive website (passive holding).

iii. The Complainant mentions prior UDRP panels decisions, in which it was held, that the incorporation of a famous mark into a domain name, well-known long before registration of the disputed domain name, combined with the fact that it redirects to an inactive website, may be evidence of bad faith registration and use.

In this line, the Panel would like to mention the passive holding doctrine in this occasion, explained as follows: “While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.” (Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

In the present circumstances, there is no doubt of the notoriety of the Complainant and its BNP PARIBAS Trademarks worldwide. It seems highly unlikely that the Respondent did not know about the reputation and well-known trademarks of the Complainant when registering the disputed domain name in December 2020. Additionally, there is no use of the disputed domain name (passive holding), and the Respondent has failed to rebut the Complainant’s allegations, choosing not to be participate in the present proceedings. Finally, the Panel notes the initial use by the Respondent of a privacy shield as well questions the veracity of its contact details (NB: no "emilio emilio" nor its address in "sloterland, Netherlands" could be found).

In view of all the above stated circumstances of this case, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

In accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel accepts the Complaint and the disputed domain name is to be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	Laura Martin-Gamero Schmidt
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DATE OF PANEL DECISION	2021-02-18
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Publish the Decision
