Decision for dispute CAC-UDRP-103699

Case number	CAC-UDRP-103699
Time of filing	2021-03-31 10:30:50
Domain names	bnp-paribas.online

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	BNP PARIBAS

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Pascal chevalier

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

In these proceedings, the Complainant relies on the following trademarks:

- BNP Paribas, International Registration No. 728598, based on a French trademark, registered as of February 23, 2000, in the name of BNP PARIBAS (the Complainant);
- BNP PARIBAS & device, International Registration No. 745220, based on a French trademark, registered as of September 18, 2000, in the name of BNP PARIBAS (the Complainant); and
- BNP Paribas, International Registration No. 876031, based on a French trademark, registered as of November 24, 2005, in the name of BNP PARIBAS (the Complainant),

among many others. The Complainant owns hundreds of similar well-known trademarks in various countries, all around the world, which have not been mentioned in the Complaint.

FACTUAL BACKGROUND

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

The Complainant is among the large international banking groups, based in France but commercially present all around the world, in as many as 71 countries. With nearly 200 thousand employees, its annual net revenue amounts to several billion Euros and its trademarks are well-known among consumers.

The Complainant owns a large-sized portfolio of trademarks including the wording "BNP Paribas", among which an EU registration dating back to 1999. It also owns a multitude of related domain names, like <bnpparibas.net> and <bnpparibas.pro>. It is notably the registrant of <bnpparibas.com> since September 2, 1999.

The disputed domain name <bnp-paribas.online> was registered on March 20, 2021 by the Respondent.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to its “BNP Paribas” trademark, as it is identical to and wholly incorporates this trademark (to which it merely adds a hyphen between the two words). This last element is sufficient to support the finding that the disputed domain name is confusingly similar to the Complainant's trademark. Indeed, the mere adding of a hyphen to the Complainant’s trademark does not change the overall impression of a most likely connection with the well-known trademark “BNP Paribas” of the Complainant. As to the gTLD “.online”, the Complainant suggests that it should be disregarded, as per the usual practice regarding TLDs.

The Complainant maintains that the Respondent lacks rights or legitimate interests in the disputed domain name because the Respondent is not known by the disputed domain name, the Complainant is neither affiliated with nor has it ever authorised the Respondent to register its trademark as a domain name and the Complainant has no business with the Respondent. Further, the disputed domain name resolves to a parking page.

According to the Complainant, given the distinctiveness and reputation of the BNP Paribas trademark (especially in France, where the Respondent is based), the Respondent registered the disputed domain name with full knowledge of the Complainant's trademark in an intentionally designed way with the aim to create a likelihood of confusion with the Complainant’s trademarks and domain names, and this is evidence of the fact that the disputed domain name was registered in bad faith.

With respect to use in bad faith, the Complainant points out that the Respondent has used the disputed domain name as a parking page in order to attract users to other relevant websites with the aim of commercial gain, a fact that by itself obviously proves use in bad faith.

For all these reasons, the Complainant concludes that the Respondent registered and used the disputed domain name in bad faith.

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).

The disputed domain name consists of the Complainant's whole trademark “BNP Paribas”, separated by a hyphen. The

addition of a simple hyphen is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark of the Complainant.

As far as the gTLD ".online" is concerned, it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity, according to paragraph 4(a)(i) of the Policy.

Hence, the Panel is satisfied that the first requirement under the Policy is met.

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).

Since proving a negative fact is almost impossible, panelists in UDRP proceedings have generally agreed that it is sufficient for the Complainant to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent.

In the case at issue, the Complainant argued that it had never authorised the Respondent to register the BNP Paribas trademark in a domain name, and that it had never licensed its trademark to the Respondent.

Furthermore, the Respondent has not demonstrated any use of the disputed domain name in connection with a bona fide offering of goods and services or a legitimate non-commercial or fair use of the disputed domain name. On the contrary, through a parking page, the Respondent has attempted to attract users to other relevant websites for commercial gain.

Finally, there is no other evidence in the case file that could demonstrate that the Respondent has been commonly known by the disputed domain name.

In view of the foregoing, the Panel is satisfied that the Complainant has established a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name. In order to rebut the Complainant's arguments, the Respondent had the possibility to make his own defense. However, the Respondent has chosen not to file a Response.

Therefore, the Panel is satisfied that also the second requirement under the Policy is met.

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).

As far as registration in bad faith is concerned, given the reputation of the Complainant's trademark and the fact that the disputed domain name fully incorporates this trademark, it is evident that, at the time of the registration of the disputed domain name, the Respondent –based in France, where the Complainant’s headquarters are situated – was well aware of the Complainant's trademark. The registration as domain name of a third party's well-known trademark with full knowledge of the fact that the rights over this trademark belong to a third party amounts to registration in bad faith.

With respect to use in bad faith, the disputed domain name has been used as a parking page, in order to attract users for commercial gain to relevant websites. This fact is to be combined with the full incorporation of the Complainant’s reputable trademark in the disputed domain name. For this Panel, such fraudulent behaviour clearly amounts to use in bad faith. Thus, it is impossible to conceive any plausible active use of the disputed domain name that would be legitimate. Therefore, the Panel finds it clear that the disputed domain name was used in bad faith.

For all circumstances mentioned above, the Panel is satisfied that also the third requirement under the Policy is satisfied.

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 disputed domain name wholly incorporates the Complainant's trademark “BNP Paribas”, separated by a hyphen. The disputed domain name is therefore confusingly similar to the Complainant's trademark.

The Respondent was not authorised to include the Complainant's trademark in the disputed domain name, and the Complainant never licensed its trademarks to the Respondent. The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services, or a legitimate non-commercial or fair use.

The Respondent registered the disputed domain name with full knowledge of the Complainant's reputable trademark. His use of the disputed domain name is in bad faith, as the Respondent has fraudulently attempted through a parking page to attract users for commercial gain to relevant websites and as there is no conceivable use of the disputed domain name that could amount to a legitimate use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Sozos-Christos Theodoulou**

DATE OF PANEL DECISION 2021-04-27

Publish the Decision