

Decision for dispute CAC-UDRP-104176

Case number CAC-UDRP-104176

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Domain names bnnparibas.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization BNP PARIBAS

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Organization Fundacion Comercio Electronico

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

The Complainant is the owner of several trademarks consisting of the term "BNP PARIBAS®", such as i) the international trademark BNP Paribas® n° 728598 registered since February 23, 2000 in classes 35, 36 38, ii) the international trademark BNP Paribas and device® n° 745220 registered since September 9, 2000 in classes 09, 35, 36 & 38, iii) the international trademark BNP Paribas® n° 876031 registered since November 24, 2005 in classes 09, 35, 36 38.

In addition, the Complainant owns domain names with the term "BNP PARIBAS", such as i) <bnnparibas.com> created since September 1, 1999 ii) <bnnparibas.net> created since December 28, 1999 and iii) <bnnparibas.pro> created since July 22, 2008.

FACTUAL BACKGROUND

The Complainant is an international banking group with a presence in 68 countries, and one of the largest banks in the world with more than 193,000 employees and EUR7.1 billion in net profit. The Complainant stands as a leading bank in the Eurozone and a prominent international banking institution.

The Complainant contends that its trademark "BNP Paribas" is widely used for banking services worldwide. The Complainant is the owner of several trademarks and domain names, including the term "BNP PARIBAS®" at least since 2000.

The disputed domain name <BNNPARIBAS.COM> was registered on April 1, 2021 by the organization Fundacion Comercio Electronico based in Panama and it resolves to a parking page with commercial links, including some using Complainant's trademark "BNP PARIBAS".

According to Complainant's non-contested allegations, the Respondent has no rights or legitimate interest in respect of the domain name and he is not related in any way to the Complainant's business.

For the purpose of this case, the Registrar confirmed that the Respondent is the current registrant of the disputed domain name and that the language of the registration agreement is English.

The facts asserted by the Complainant are not contested by the Respondent

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

First element: Similarity

The Complainant states that the disputed domain name <bnnparibas.com> is confusingly similar to its trademark BNP PARIBAS®

The Complainant asserts that the misspelling in the domain name (the substitution of the letter "P" by "N") is not sufficient to escape the finding that the domain name is confusingly similar to the trademark BNP PARIBAS®.

Second element: Rights or legitimate interest

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the domain names and that he is not related in any way to the Complainant's business.

The Complainant asserts 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.

The Complainant also claims that the disputed domain name is a typosquatted version of the trademark BNP PARIBAS®.

The Complainant indicates that the disputed domain name resolves to a parking page with commercial links and past panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use.

Third element: Bad faith

The Complainant states that the disputed domain name <bnnparibas.com> is confusingly similar to its trademark BNP PARIBAS®

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

The Complainant states the misspelling of the trademark BNP PARIBAS® was intentionally designed to be confusingly similar with the Complainant's trademark. Previous UDRP Panels have seen such actions as evidence of bad faith.

The Complainant contends the Respondent has attempted to attract Internet users for commercial gain to his own website thanks to the Complainant's trademarks for its own commercial gain, which is an evidence of bad faith.

The Complainant indicates that the Respondent has a history of registering domain names which incorporate the third parties' trademarks. See for instance CAC cases no. 102871 and no. 104014.

RESPONDENT

Respondent did not reply to the Complaint.

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

A) THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR TO THE TRADEMARK BNP PARIBAS OF THE COMPLAINANT.

The Uniform Domain Name Dispute Resolution Policy (the Policy) in its Paragraph 4(a)(i) indicates the obligation of Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights.

In accordance with the evidence provided, Complainant owns different trademarks and domain names with the term BNP PARIBAS with ownership for more than 20 years.

In the present case, the disputed domain name is composed of almost all letters of the term "BNP PARIBAS" with the only replacement of the first letter "P" by "N" to remain as "BNN PARIBAS". From the Panel's perspective, this an intentional misspelling of Complainant's trademark and a clear typosquatting case where internet users searching for "www.bnpparibas.com" might wrongly double type the letter N in the keyboard rather than typing the first letter P and by doing so, they would end up at Respondent's website "www.bnnparibas.com. (See, e.g., Sanofi. v. Domains By Proxy, LLC /domain admin, WIPO Case No. D2013-0368: "The Domain Name consists of the SANOFI Mark with the letter "o" replaced by the letter "i". The replacement of "o" with "i" does not operate to prevent a finding of confusing similarity between the SANOFI Mark and the Domain Name especially in circumstance where the letters "o" and "i" are right next to each other on a typical "qwerty" keyboard, meaning that a single slip of the fingers would result in an Internet user who intended to visit the Complainant's website at www.sanofi.com visiting the Respondent's Website instead").

Furthermore, the addition of the Top-Level Domain Name “.com” in a domain is considered as a standard registration requirement and, therefore, it should be disregarded under the first element confusing similarity test (see paragraph 1.11 WIPO Overview 3.0).

Therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the disputed domain name is confusingly similar to Complainant’s mark.

(B) RESPONDENT’S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME

The second element of the Policy requires that the Complainant establishes that the Respondent has no rights or legitimate interests in the disputed domain name. The generally adopted approach by UDRP panels, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it (see WIPO Jurisprudential Overview, version 3.0., paragraph 2.1).

The Complainant indicates that they have not granted authorization to Respondent to use their BNP Paribas trademarks. Furthermore, the Complainant asserts that the Respondent is not affiliated with him nor authorized in any way to use the trademark BNP PARIBAS.

From the information provided by Complainant, there is no evidence or reason to believe that the Respondent (as individual, business or other organization) has been commonly known by the disputed domain name.

The Complainant also made the valid point about the “rationale” behind the registration of the disputed domain name by which the Complainant indicates that the disputed domain name is a typosquatted version of the trademark BNP PARIBAS. In this regard, UDRP panels have confirmed in different decisions that when typosquatting is occurring then this can be considered as additional evidence that Respondent has no right or legitimate interest under the Policy” (See, e.g., Pentair Flow Services AG v. Scott Fisher, CAC Case No. 103931. “Since typosquatting is a practice of registering a domain name in an attempt to take advantage of internet user’s typographical errors, this circumstance is also evidence that the Respondent lacks rights and legitimate in the disputed domain name”).

Moreover, the website associated with the disputed domain name resolves to a parking page with commercial links (PPC), including the trademark BNP PARIBAS. In this sense, UDRP past decisions have found that the use of a disputed domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users (see paragraph 2.9 WIPO Overview 3.0).

The fact that Respondent did not reply to the Complaint gives an additional indication that Respondent lacks rights or legitimate interest since Respondent did not provide with evidence of the types specified in paragraph 4 (c) of the Policy, or of any circumstances, giving rise to rights or legitimate interests in the disputed domain name.

Therefore, the Panel concludes that neither the Respondent nor the evidence establishes that the Respondent has any right or legitimate interest to the disputed domain name. The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

(C) THE DISPUTED DOMAIN NAME HAS BEEN REGISTERED AND IS BEING USED IN BAD FAITH IN ACCORDANCE WITH THE POLICY.

Paragraph 4(a)(iii) of the Policy indicates that Complainant must assert that the Respondent registered and is using the disputed domain name in bad faith. In this sense, Paragraph 4(b) of the Policy sets out four circumstances which if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the

Respondent's documented out-of-pocket costs directly related to the domain name; or
(ii) The Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
(iii) The Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
(iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product.

The evidence submitted by Complainant confirms that its trademark BNP PARIBAS is distinctive and it has a strong reputation in the banking industry. In fact, Complainant referred to WIPO Case No. D2017-2176 BNP Paribas v. Ronan Laster by which the Panel mentioned the high notoriety of the BNP PARIBAS trademarks throughout the world. In this regard and absent of Respondent's reply, the Panel finds that Respondent, prior to the registration of the disputed domain name was aware of Complainant's trademark, in particular since the disputed domain name was registered on April 1st, 2021 and Complainant's trademarks were registered long before the registration of the disputed domain name.

Furthermore, the disputed domain name is a typosquatted version of the trademark BNP PARIBAS. Some Panels have found that domain names comprising typos or misspellings to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see paragraph 3.1.4 WIPO Overview 3.0).

As indicated by Complainant, the website associated with the disputed domain name resolves to a PPC website, including the trademark BNP PARIBAS. Prior panels have held that a Respondent cannot disclaim responsibility for content appearing on the website associated with its domain. In this regard, the fact that Respondent may not have directly profited from the PPC cannot prevent a finding of bad faith.

In light of the above-mentioned findings, the Panel finds that the evidence submitted by the Complainant supports the argument that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product.

Last but not least, Complainant mentioned that Respondent has a history of registering domain names which incorporate third parties' trademarks; in particular CAC UDRP Cases Nr. 102871 & 104104. The Panel verified the existence of both cases plus identified many other UDRP cases where Respondent has been involved. In this sense, paragraph 4(b) of the Policy describes the situation when Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct. Past panels have found that a pattern of conduct may include a scenario where the respondent, on separate occasions, has registered trademark-abusive domain names and to establish a pattern of bad faith conduct requires more than one, but as few as two instances of abusive domain name registrations and, therefore, the Panel finds that the evidence provided by Complainant confirms the engagement by Respondent in a pattern of bad faith conduct (see paragraph 3.1.2. WIPO Overview 3.0).

Therefore, the Panel concludes that Respondent registered and is using the disputed domain name in bad faith and thus has satisfied the requirement 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. **BNNPARIBAS.COM**: Transferred

PANELLISTS

Name Victor Hugo Garcia Padilla, LL.M.

DATE OF PANEL DECISION 2021-12-16

Publish the Decision
