

Decision for dispute CAC-UDRP-104330

Case number	CAC-UDRP-104330
Time of filing	2022-02-04 09:20:26
Domain names	bnp-paribas.biz, bnp-paribas.info, bnp-paribas.live, bnp-paribas.xyz, bnpparibas.icu

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)
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Complainant

Organization	BNP PARIBAS
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Name	Lerhvcv Gyffhfygg
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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 Names.

IDENTIFICATION OF RIGHTS

BNP PARIBAS S.A. (the "Complainant") owns rights in the "BNP PARIBAS" sign and owns numerous trademarks (the "Registered Trademarks") such as:

- International trademark "BNP PARIBAS" n° 728598 filed and registered on February 23, 2000, duly renewed and covering services in classes 35, 36 and 38;
- International trademark "BNP PARIBAS" n° 745220 filed and registered on September 18, 2000, duly renewed and covering goods and services in classes 9, 35, 36 and 38;
- International trademark "BNP PARIBAS" n°876031 filed and registered on November 24, 2005, duly renewed and covering goods and services in classes 9, 35, 36 and 38.

Moreover, Complainant is also the owner of a large portfolio of domain names "BNP PARIBAS", such as:

- <bnpparibas.com>, registered since September 2, 1999;

- <bnpparibas.net>, registered since December 29, 1999;

- <bnpparibas.pro>, registered since July 23, 2008.

FACTUAL BACKGROUND

Complainant is an international banking group. As Complainant is present in 68 countries, has more than 193,000 employees and €7.1 billion in net profit, Complainant is one of the largest banks in the world and stands as a leading bank in the Eurozone and a prominent international banking institution.

The following disputed domain names (the "Disputed Domain Names") were registered by Respondent and resolve to inactive webpages:

- <bnp-paribas.biz>, registered on January 21, 2022;

- <bnp-paribas.info>, registered on January 21, 2022;

- <bnp-paribas.live>, registered on January 21, 2022;

- <bnp-paribas.xyz>, registered on January 21, 2022;

- <bnpparibas.icu>, registered on January 21, 2022.

Thus, Complainant's Registered Trademarks predate the registration of the Disputed Domain Names.

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").

Please see for instance:

- WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows;

- WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

I. The Disputed Domain Names are identical to Complainant's registered "BNP PARIBAS" trademarks.

Complainant establishes its rights in its "BNP PARIBAS" trademarks.

The latter contends that the Disputed Domain Names are identical to its Registered Trademarks as said domain names include Complainant's "BNP PARIBAS" sign in its entirety.

Finally, Complainant emphasizes that the addition of the new gTLDs does not change the overall impression of the designation as being connected its Registered Trademarks as it does not prevent the likelihood of confusion between said domain names and its Registered Trademarks.

Thus, Complainant contends that the Disputed Domain Names are identical its Registered Trademarks in which it has rights.

II. Respondent does not have any rights or legitimate interest in the Disputed Domain Names.

Complainant contends that Respondent is not known as the Disputed Domain Names in the Whois database, and has not acquired trademark rights on the "BNP PARIBAS" sign.

Further, Complainant states that Respondent has no rights or legitimate interests in respect of said domain names. According to Complainant, Respondent is not related in any way to Complainant's business and is not affiliated with Complainant nor authorized in any way to use Complainant's Registered Trademarks. Besides, Complainant does not carry out any activity for, nor has any business with Respondent.

In addition, Complainant contends that Respondent did not make any use of the Disputed Domain Names since their registration. According to the latter, this inactivity confirms that Respondent has no demonstrable plan to use said domain names which evidences a lack of legitimate interest.

Thus, according to Complainant, Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.

III. The Disputed Domain Names have been registered and are being used in bad faith.

Complainant states that the Disputed Domain Names are identical to its well-known Registered Trademarks.

Based on the distinctiveness and reputation of Complainant's Registered Trademarks, the latter contends that it is inconceivable that Respondent could have registered said domain names without actual knowledge of Complainant's Registered Trademarks, evidencing bad faith.

Further, Complainant contends that Respondent has not demonstrated any activity in respect of the Disputed Domain Names. According to Complainant, it is not possible to conceive of any plausible actual or contemplated active use of said domain names by Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of Complainant's trademark rights.

Based on prior Panel decisions, Complainant contends that the incorporation of its famous Registered Trademarks into the Disputed Domain Names, redirecting to inactive websites, evidences bad faith registration and use.

Thus, Complainant concludes that Respondent has registered and is using the Disputed Domain Names in bad faith.

RESPONDENT:

No administratively compliant response has been submitted.

The CAC shall proceed to appoint a Panel to decide on the Complaint. The Panel shall draw such inferences from

Respondent's default as it considers appropriate.

RIGHTS

Complainant has, to the satisfaction of the Panel, shown the Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

As under section 1.2.1 of the WIPO Overview 3.0, ownership of a registered trademark serves as prima facie evidence trademark rights for the purposes of standing to file a complaint, Complainant has submitted sufficient evidence proving its prior rights in its "BNP PARIBAS trademarks.

First, the Disputed Domain Names reproduce Complainant's Registered Trademarks in their entirety. In this regard, several previous Panels have considered that the incorporation of a trademark in its entirety may be sufficient to establish that the domain name is identical or confusingly similar to Complainant's trademark (WIPO Case No. D2011-1627, L'Oréal, Lancôme Parfums et Beauté & Cie v. Jack Yang, WIPO Case No. D2010-1059, Rapidshare AG, Christian Schmid v. InvisibleRegistration.com, Domain Admin, WIPO Case No. D2007 1629, F. Hoffmann-La Roche AG v. Relish Entreprises, and WIPO Case No. D2000-0113, The Stanley Works and Stanley Logistics, Inc. v. Camp Creek Co., Inc. and WIPO Overview 3.0 , section 1.7). This happens to be the case here.

Moreover, the inserted Registered Trademarks are well-known and constitute the dominant part of the Disputed Domain Names (WIPO Case No. D2017-2167, BNP Paribas v. Ronan Laster). The amount of national and EU trademarks in which Complainant has rights and the longstanding and worldwide presence of Complainant, sufficiently evidence the international renown of Complainant and its Registered trademarks and could not have reasonably be ignored by Respondent at the time of registration of the Disputed Domain Names.

Further, the extensions ".xyz", ".biz", ".info", ".live", and ".icu" are not to be taken into consideration when examining the identity or similarity between Complainant's Registered Trademarks and the Disputed Domain Names, as it is viewed as a standard registration requirement (See section 1.11 of the WIPO Jurisprudential Overview 3.0). The relevant part of the Disputed Domain Names is "BNP PARIBAS", whereas said added generic Top-Level Domains ("gTLDs") – being a required element of every domain name – are irrelevant when assessing whether or not a trademark is identical or confusingly similar. Hence, under Section 1.8 of the WIPO Jurisprudential Overview 3.0, the addition of terms "whether descriptive, geographic, pejorative, meaningless, or otherwise" do not prevent a finding of confusing similarity where the relevant trademark is recognizable within the Disputed Domain Names.

Accordingly, by registering the Disputed Domain Names, Respondent has created a likelihood of confusion with Complainant's trademark. It is likely that said domain names could mislead Internet users into thinking that Respondent is, in some way, associated with Complainant.

For all of the above-mentioned reasons, the Disputed Domain Names are identical to the Registered Trademarks in which Complainant has rights, and therefore the condition of Paragraph 4(a)(i) is fulfilled.

NO RIGHTS OR LEGITIMATE INTERESTS

Under Policy paragraph 4(a)(ii), Complainant must first make out a prima facie case showing that Respondent lacks rights and legitimate interests in respect of the disputed domain name and then the burden, in effect, shifts to Respondent to come forward with evidence of its rights or legitimate interests. If Respondent fails to do so, Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (See WIPO Overview 3.0, section 2.1; WIPO Case No. D2000-0624, Do The Hustle, LLC v. Tropic Web, WIPO Case No. D2020-2200 Association des Centres Distributeurs E. Leclerc - A.C.D. Lec v. Domain Administrator, See PrivacyGuardian.org / Ghulo Dhulio).

Respondent is neither affiliated with Complainant in any way nor has it been authorized by Complainant to use and register its Registered Trademarks, or to seek registration of any domain name incorporating them. Furthermore, Respondent cannot claim prior rights or legitimate interest in the Disputed Domain Names as the Registered Trademarks precede the

registration of said domain names for years.

First, there is no evidence that Respondent is commonly known by the Disputed Domain Names or the “BNP PARIBAS” sign, in accordance with paragraph 4(c)(ii) of the Policy. As said domain names are confusingly similar to Complainant’s well-known Registered Trademarks (see WIPO Case No. D2017-2167, BNP Paribas v. Ronan Laster) Respondent cannot reasonably pretend it was intending to develop a legitimate activity through the Disputed Domain Names.

Second, Respondent was not authorized or licensed in any way by Complainant to use its Registered Trademarks, or to seek registration of any domain name incorporating them. In previous decisions, Panels have found that in the absence of any license or permission from Complainant to use such widely-known trademark, no actual or contemplated bona fide or legitimate use of the domain name could reasonably be claimed (WIPO Case No. D2021-2689, Virgin Enterprises Limited v. Guman Sulaen, Sulaen Company / Ivan Petrenkos / Leonid Duhar / Josh White, Build LMTD / Name Redacted ;WIPO Case No. D2019-0941, Linklaters LLP v. WhoisGuard Protected / Cindy Smith, WIPO Case No. D2010-0138, LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master). In addition, the fact that Respondent did not reply supports the evidence that the latter is not commonly known under the Disputed Domain Names and did not obtain an authorisation or license to use Complainant’s Registered Trademarks (CAC Case No. 102279, January 31, 2019, FILEHIPPO S.R.O. v. whois agent).

Third, there is no evidence that Respondent, before any notice of this dispute, was using or had made demonstrable preparations to use said domain names in connection with a bona fide offering of goods or services, in accordance with paragraph 4(c)(i) of the Policy. The Disputed Domain Names incorporating Complainant’s Registered Trademarks point to inactive webpages. Such passive holding of the Disputed Domain Names cannot constitute a bona fide offering of goods and services under the Policy (See WIPO Case No. D2015-1779 Philip Morris USA Inc. v. Gabriel Hall). As Respondent is not actively using said domain names, there is no legitimate use that would give rise to a legitimate right or interest in the name (see WIPO Case No. D2009-1529 Société Nationale des télécommunications: Tunisie Telecom v. Isamel Leviste,). Hence, Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Names.

Given Complainant’s goodwill and its international renown, as well as the nature of the Disputed Domain Names which are identical to the latter’s Registered Trademarks (WIPO Case No. D2017-2167, BNP Paribas v. Ronan Laster), the Panel finds that there is no plausible circumstance in which Respondent could legitimately use the Disputed Domain Names, as it would invariably result in misleading diversion and taking unfair advantage of Complainant’s rights. Hence, Respondent fails to show any intention of non-commercial or fair use of Disputed Domain Names.

Therefore, the Panel considers that Complainant has made a prima facie case showing Respondent’s lack of rights to or legitimate interest in the Disputed Domain Names. As Respondent has not responded, the latter fails to rebut the prima facie case established by Complainant.

Considering the above circumstances, the Panel finds, on the balance of probabilities, that Respondent has no rights or legitimate interests in respect of the Disputed Domain Names and the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

BAD FAITH

Complainant has shown that the Disputed Domain Names have been registered and are being used in bad faith (within the meaning of paragraph 4 (a) (iii) of the Policy).

First, bad faith can be found where Respondent “knew or should have known” of Complainant’s trademark rights and, nevertheless registered a domain name in which they had no rights or legitimate interest (WIPO Case No. D2009-0320, Research In Motion Limited v. Privacy Locked LLC/Nat Collicot and WIPO Case No. D2009-0113, The Gap, Inc. v. Deng Youqian).

The Panel considers Complainant’s Registered Trademarks to be well-known throughout the world. Given Complainant’s worldwide presence and its trademark registrations all around the world (WIPO Case No. D2017-2167, BNP Paribas v. Ronan

Laster), the Panel finds it strongly unlikely that Respondent was not aware of Complainant's rights in said trademark. Besides, the mere registration of an identical domain name to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (See section 3.1.4 of the WIPO Jurisprudential Overview 3.0). This appears to be the case here.

Secondly, the entire reproduction of Complainant's Registered Trademarks in the Disputed Domain Names confirms Respondent's awareness. In this respect, prior panels have stated that where a domain name is so obviously connected with a well-known trademark that its very use by someone with no connection to the trademark suggests opportunistic bad faith (WIPO Case No. D2013-0091, LEGO Juris A/S v. store24hour; WIPO Case No. D2008-0226, Lancôme Parfums et Beauté & Cie, L'Oréal v. 10 Selling; WIPO Case No. D2006-0464, Caixa D'Estalvis I Pensions de Barcelona ("La Caixa") v. Eric Adam). Therefore, bad faith registration of the Disputed Domain Names can be inferred.

Thirdly, Complainant's Registered Trademark registrations significantly predate the registration date of the Disputed Domain Names. In this regard, previous panels have established that knowledge of Complainant's intellectual property rights, including trademarks, at the time of registration of the disputed domain name proves bad faith registration (WIPO Case No. D2008-0287, Alstom v. Domain Investments LLC; WIPO Case No. D2007-0077, NBC Universal Inc. v. Szk.com). Besides, Respondent is reasonably expected to verify whether said domain names are likely to infringe the rights of any third party before registering them (WIPO Case No. D2009-0901, Compagnie Gervais Danone contre Gueorgui Dimitrov / NETART; WIPO Case No. D2002 0806, Carolina Herrera, Ltd. v. Alberto Rincon Garcia; WIPO Case No. D2000 1397, Nike, Inc. v. B.B. de Boer).

In this regard, a quick "BNP PARIBAS" trademark search would have revealed to Respondent the existence of Complainant and its trademark. Respondent's failure to do so is a contributory factor to its bad faith (WIPO Case No. D2008-0226, Lancôme Parfums et Beauté & Cie, L'Oréal v. 10 Selling). Even supposing that Respondent was not aware of the possibility of searching trademarks online before registering the Disputed Domain Names, a simple search via Google or any other search engine using the keyword "BNP PARIBAS" demonstrates that all first results relate to Complainant's products and services.

In this day and age of the Internet and advancement in information technology, the reputation of brands and trademarks transcends national borders. Considering the worldwide reputation of Complainant's Company and Registered Trademarks, the Panel finds it very unlikely that Respondent was unaware of the existence of Complainant and its trademark at the time of registration of the Disputed Domain Names. It is most likely to be believed that Respondent registered said domain names based on the notoriety and attractiveness of Complainant's trademark to divert internet traffic to its website. Hence, Respondent has not demonstrated that the registration of the Disputed Domain Names was done in good faith.

Therefore, the Panel concludes that Respondent registered the Disputed Domain Names in bad faith.

Furthermore, as regards use in bad faith, the absence of any license or permission from Complainant to use such widely known trademarks, leads to the consideration that no actual or contemplated bona fide or legitimate use of the domain name could reasonably be claimed (WIPO Case No D2008-0281, Alstom, Bouygues v. Webmaster; WIPO Case No. D2000-0055, Guerlain S.A. v. Peikang).

Respondent uses the Disputed Domain Names to direct Internet users to its inactive webpages.

Hence, the state of inactivity does not mean that said domain names are used in good faith. On the contrary, passive holding does not preclude a finding of bad faith. The bad faith evidencing criteria provided for in section 4 (b) of the Policy are non-exclusive, and Panels have historically found that there can be a finding of registration and use in bad faith where there is passive use of a well-known trademark in a domain name (WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows, and WIPO Case No. D2002-0131 Ladbroke Group Plc v. Sonoma International LDC). Under the passive holding doctrine, bad faith use is more likely when Respondent passively holds the disputed domain, especially when the disputed domain name incorporates a famous trademark (WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen, WIPO Case No. D2015-0666, Hugo Boss Trade Mark Management GmbH & Co. KG, et al. v. Private Registration/George Kara).

It seems that Respondent is attempting to benefit from the fame of Complainant's Registered Trademarks and it appears more likely than unlikely that Respondent's primary motive in registering and using the Disputed Domain Names was to capitalize on or otherwise take advantage of Complainants' trademark rights, through the creation of initial interest of confusion.

Moreover, Respondent has not made any reasonable and demonstrable preparations to use the Disputed Domain Names and fails to show any intention of non-commercial or fair use. The fact for Respondent to choose domain names virtually identical to Complainant's trademarks and official domain names to direct Internet users to an inactive page cannot amount to a good faith use of the domain name (WIPO Case No. D2007-0085, Courtney Kellogg v. Vance Larson and WIPO Case No. D2005-0760, RuggedCom, Inc. v. LANstore, Inc).

Therefore, as passive holding evidences bad faith registration and use (WIPO Case No. D2020-1188, Union InVivo v. Name Redacted) the Panel finds that the Disputed Domain Names are used and registered in bad faith as Respondent lacks to demonstrate any activity in respect of the Disputed Domain Names and takes unfair advantage of Complainant's rights through incorporating the latter's Registered Trademarks into its said domain names (WIPO Case No. D2017-1997 Linxens Holding v. Benoit Bevis, WIPO Case No. D2019-1401, Bouygues S.A. v. Rafael Vivier, WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows and WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen).

Thus, in light of the above, the Panel finds that the Disputed Domain Names are both registered and used in in bad faith under 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

Complainant holds trademark rights for the "BNP PARIBAS" sign. The Disputed Domain Names are identical to Complainant's Registered Trademarks. Respondent failed to establish legitimate rights or legitimate interests in the Disputed Domain Names. Complainant has established that Respondent registered and uses the Disputed Domain Names in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BNP-PARIBAS.BIZ**: Transferred
2. **BNP-PARIBAS.INFO**: Transferred
3. **BNP-PARIBAS.LIVE**: Transferred
4. **BNP-PARIBAS.XYZ**: Transferred
5. **BNPPARIBAS.ICU**: Transferred

PANELLISTS

Name	Nathalie Dreyfus
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DATE OF PANEL DECISION 2022-03-11

Publish the Decision
