

Decision for dispute CAC-UDRP-104509

Case number	CAC-UDRP-104509
Time of filing	2022-04-20 09:22:32
Domain names	bnpparibasgroup-am.com

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	Peter Chandler
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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

The Complainant owns:

- international trademark BNP PARIBAS n° 728598 registered since February 23, 2000;
- international trademark BNP PARIBAS n° 745220 registered since September 18, 2000;
- international trademark BNP PARIBAS n° 876031 registered since November 24, 2005.

FACTUAL BACKGROUND

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

The disputed domain name <bnpparibasgroup-am.com>, which is confusingly similar to the Complainant's trademark BNP PARIBAS, was registered on October 26, 2021. It resolves to a suspended parking page, which contains commercial links.

The Respondent has no rights or legitimate interests in respect of the disputed domain name, which has been registered and is being used in bad faith.

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

In accordance with paragraph 4(a) of the Policy, to obtain transfer of a domain name, a complainant must prove the following three elements: (i) the respondent's domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; (ii) the respondent has no rights or legitimate interests in the domain name; and (iii) the respondent has registered the domain name and is using it in bad faith.

Under paragraph 15(a) of the Rules, "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, asserted facts may be taken as true and reasonable inferences may be drawn from the information provided by the complainant. See *Reuters Limited v. Global Net 2000, Inc*, WIPO Case No. D2000-0441.

The Complainant has shown that it has rights in the very well-known BNP PARIBAS trademark, registered since 2000. The Panel finds the disputed domain name <bnpparibasgroup-am.com> to be confusingly similar to the Complainant's BNP PARIBAS trademark, since it incorporates the mark in its entirety and adds the terms "group" and "am" (for "asset management", in reference to the Complainant's subsidiary BNP PARIBAS ASSET MANAGEMENT) and a hyphen. These additions do nothing to dispel the confusing similarity between the disputed domain name and the mark. The inconsequential gTLD ".com" may be ignored.

Paragraph 4(c) of the Policy sets out three illustrative circumstances as examples which, if established by a respondent, shall demonstrate rights to or legitimate interests in a domain name for purposes of paragraph 4(a)(ii) of the Policy, i.e.

(i) before any notice to the respondent of the dispute, the use by the respondent of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent (as an individual, business or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

The Complainant asserts that the Respondent is not known by the disputed domain name and is not affiliated with nor authorized by the Complainant in any way. The Complainant does not carry out any activity for, nor has any business with the Respondent and has not granted any licence or authorization to the Respondent to make any use of the Complainant's trademark BNP PARIBAS, nor to apply for registration of the disputed domain name. The disputed domain name currently points to a parking page displaying pay-per-click advertising links of a financial description.

The Complainant's assertions are sufficient to constitute prima facie showing of absence of rights or legitimate interests in respect of the disputed domain name on the part of the Respondent. The evidentiary burden therefore shifts to the Respondent to show that it does have rights or legitimate interests in the disputed domain name. See *Cassava Enterprises Limited, Cassava Enterprises (Gibraltar) Limited v. Victor Chandler International Limited*, WIPO Case No. D2004-0753. The Respondent has made no attempt to do so. Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which, though not exclusive, shall be evidence of the registration and use of the disputed domain name in bad faith for purposes of paragraph 4(a)(iii) of the Policy, including:

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 or service on its website or location.

The Panel accepts the Complainant's submission that the Respondent registered the disputed domain name many years after the Complainant had established a strong reputation and goodwill in its mark. It is very unlikely that the Respondent was unaware of the Complainant and its trademark, and the Panel finds that the Respondent likely targeted the Complainant and its trademark BNP PARIBAS when registering the disputed domain name, which the Respondent is using to divert Internet users searching for the Complainant's website or that of its subsidiary BNP PARIBAS ASSET MANAGEMENT to the Respondent's competing website, and to create a likelihood of confusion with the Complainant's mark for the Respondent's commercial gain.

Accordingly, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BNPPARIBASGROUP-AM.COM**: Transferred

PANELLISTS

Name	Mr. Alan Lawrence Limbury
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DATE OF PANEL DECISION 2022-05-14

Publish the Decision