

Decision for dispute CAC-UDRP-104458

Case number	CAC-UDRP-104458
Time of filing	2022-03-31 09:45:45
Domain names	bnpotc.com, bnp-otc.com, bnp-exchange.com, bnppcoins.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
--------------	---------------------------------

Complainant

Organization	BNP PARIBAS
--------------	-------------

Complainant representative

Organization	NAMESHIELD S.A.S.
--------------	-------------------

Respondent

Organization	Nasdaq, plum Bruce
--------------	--------------------

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

As a banking group, BNP Paribas was born on 23 May 2000 from the merger of “Banque Nationale de Paris” (BNP) and Paribas bank. BNP PARIBAS S.A., the Complainant, is an international banking group with a presence in 68 countries, and one of the largest banks in the world as it might be seen on the website <https://www.group.bnpparibas>. With more than 193,000 employees and €7.1 billion in net profit, the Complainant stands as a leading bank in the Eurozone and a prominent international banking institution.

The Complainant owns numerous trademarks BNP PARIBAS®, such as:

- International trademark BNP PARIBAS® n°728598 registered since 23 February 2000;
- International trademark BNP PARIBAS® n°745220 registered since 18 September 2000;
- International trademark BNP PARIBAS® n°876031 registered since 24 November 2005;
- European trademark BNP® n° 000089649 registered since 1 April 1996.

The Complainant is also the owner of a large portfolio of domain names “BNP PARIBAS”, such as:

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

- <bnpparibas.net>, registered since 29 December 1999;
- <bnpparibas.pro>, registered since 23 July 2008.

The disputed domain names <bnpotc.com>, <bnp-otc.com>, <bnp-exchange.com> and <bnpcoins.com> were registered on 12 November 2021.

FACTUAL BACKGROUND

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

A. The disputed domain names are confusingly similar to the trademark in which the Complainant has rights
The Complainant contends that the disputed domain names are confusingly similar to the trademark BNP PARIBAS® and BNP® while the trademark is included in its entirety.

The Complainant recalled:

- WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasilij Terkin.

The terms "OTC" (for "Over-the-counter"), "exchange" or "coins" refer to the trading, therefore is closely related to the Complainant and its business activities. The addition of the gTLD ".COM" does not change the overall impression of the designation as being connected to the trademarks of the Complainant. It does not prevent the likelihood of confusion between the disputed domain names and the Complainant, its trademarks and its domain names associated.

The Complainant recalled:

- WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A.

B. The Respondent does not have any rights or legitimate interest in the disputed domain names

A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is deemed to have satisfied the allegation that the respondents lacks any rights or legitimate interest in the domain names.

The Complainant recalled:

- WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.

The Respondent is not commonly known by a disputed domain name because the WHOIS information is not similar to the disputed domain name. The Respondent's denomination is "Nasdaq - plum Bruce" and it has not acquired trademarks mark rights on this term.

The Complainant recalled:

- Forum Claim No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com>.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain names and that he is not related in any way to the Complainant's business while the Respondent is not affiliated with him nor authorized by him in any way to use the trademark BNP PARIBAS® or BNP®. The Complainant does not carry out any activity for, nor has any business with the Respondent.

The disputed domain names <bnp-exchange.com> and <bnpcoins.com> are inactive. The Respondent did not make any use of disputed domain names since their registration, and the Respondent has no demonstrable plan to use the disputed domain names.

The disputed domain names <bnpotc.com> and <bnp-otc.com> redirect to what looks like a trading website by reproducing the BNP logo. Using a disputed domain name to compete with a complainant is not a bona fide offering of goods or services or a legitimate non-commercial or fair use. The Respondent uses the disputed domain names to divert Internet users to Respondent's website.

The Complainant recalled:

- Forum Claim No. FA 1741737 Ripple Labs Inc. v. NGYEN NGOC PHUONG THAO;
- Forum Claim No. FA 1659965 General Motors LLC v. MIKE LEE.

The Respondent uses the disputed domain names to pass off as Complainant and phish for users' personal information. The Respondent uses the site attached to the disputed domain names to promote unauthorized use of Complainant's systems. The usage of Complainant's NETFLIX mark without a significant reputation is not fair as the site.

The Complainant recalled:

- Forum Claim No. FA 1737766 in Airbnb, Inc. v. Nima Rahnemoon;
- Forum Claim No. FA 1741976 in Netflix, Inc. v. Irpan Panjul / 3corp.inc.

C. The disputed domain names have been registered and are being used in bad faith

The Complainant states that the disputed domain names are identical to its trademark BNP PARIBAS® which is well-known.

The Complainant recalled:

- WIPO Case No. D2017-2167, BNP Paribas v. Ronan Laster ("T").

Regarding <bnpotc.com> and <bnp-otc.com>

As demonstrated by the websites <bnpotc.com> and <bnp-otc.com>, the Respondent clearly knows the Complainant and its trademarks. The resolving websites display Complainant's mark and distinctive logo, and pictures of Complainant's products. The Complainant recalled:

- Forum Claim No. FA 1535826 in Orbitz Worldwide, LLC v. Domain Librarian;
- Forum Claim No. FA 1000079 in Univision Comm'cns Inc. v. Norte, FA;
- Forum Claim No. FA 1790949 in Ripple Labs Inc. v. Jessie McKoy / Ripple Reserve Fund.

Regarding <bnp-exchange.com> and <bnpcoins.com>

The disputed domain names are inactive. The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain names, and it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate.

The Complainant recalled:

- WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows;
- WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen.

The Complainant contended that the Respondent is known in such pattern of conduct.

The Complainant recalled:

- Forum Claim No. FA2202001984496 in Cboe Exchange, Inc. v. plum Bruce / Nasdaq

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

The Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed allegations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules because of the Respondent's failure to submit a response.

Therefore, in the absence of a response, it is appropriate to accept as true all allegations of the Complainant.

RIGHTS

The 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 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 names (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 names have been registered and are

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

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs the Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (i) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
- (ii) respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

The Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations because of the Respondent's failure to submit a response. Therefore, it accepted as true all allegations of the Complainant as well of its legal assessments.

A. THE DISPUTED DOMAIN NAMES ARE CONFUSINGLY SIMILAR TO A TRADEMARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Panel finds that the disputed domain names are confusingly similar to the trademark BNP PARIBAS® and BNP® given that the trademark is included in its entirety in the disputed domain names. It is well-established that a domain name that wholly incorporates a Complainant's registered trademark are sufficient to establish confusing similarity.

The terms "OTC" (for "Over-the-counter"), "exchange" or "coins" refer to the trading, therefore are closely related to the Complainant and its business activities. The addition of the gTLD ".COM" does not change the overall impression of the designation as being connected to the trademarks of the Complainant and the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar. It is well accepted that it does not prevent the likelihood of confusion between the disputed domain names and the Complainant, its trademarks and its domain names associated.

The Panel therefore finds that the disputed domain names are 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).

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN THE DISPUTED DOMAIN NAMES

A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the panel concludes that the complainant is deemed to have satisfied the allegation that the respondent lacks any rights or legitimate interest in the domain name.

The Panel does not find that the Respondent is commonly known by the disputed domain names because the Whois information is not similar to any of the disputed domain names. The Respondent is not commonly known by disputed domain names because the WHOIS information is not similar to the disputed domain name. The Respondent's denomination is "Nasdaq - plum Bruce" and it is obvious that it does not acquire trademarks mark rights on this term. The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names and that he is not related in any way to the Complainant's business. In the opposite the Respondent is not affiliated with the Complainant or authorized by him in any way to use the trademark BNP PARIBAS® or BNP®. The Complainant does not carry out any activity for, nor has any business with the Respondent.

The Panel finds that disputed domain names <bnp-exchange.com> and <bnpcoins.com> are inactive. The Respondent did not make any use of disputed domain names since their registration, and the Respondent has no demonstrable plan to use

the disputed domain names. The Panel concludes that it demonstrates a lack of legitimate interests in respect of the disputed domain names except in order to create a likelihood of confusion with the Complainant and its trademark. The evidence shows that the disputed domain names <bnpotc.com> and <bnp-otc.com> redirect to a trading website by reproducing the BNP logo. The Panel finds that using a disputed domain names to compete with a Complainant is not a bona fide offering of goods or services or a legitimate non-commercial or fair use.

The Panel finds that the disputed domain names divert Internet users to Respondent's website by confusing them into believing that some sort of affiliation exists between it and Complainant which is neither a bona fide offering of goods or services nor a legitimate non-commercial or fair use. The use of a domain to sell products and/or services that compete directly with a complainant's business does not constitute a bona fide offering of goods or services or a legitimate non-commercial or fair use.

It is proven that the Respondent uses the disputed domain names to pass off as the Complainant and phish for users' personal information. The Panel concludes that such use of a domain name does not constitute a bona fide offering of goods or services or legitimate non-commercial or fair use. The Respondent uses the site attached to the disputed domain names to promote illegal unauthorized use of Complainant's systems so that it does not have rights or a legitimate interest in the disputed domain names.

The Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy).

C. THE DISPUTED DOMAIN NAMES WERE REGISTERED AND ARE USED IN BAD FAITH

The evidence shows that the disputed domain names are identical to the Complainant's trademark BNP PARIBAS® which is well-known. The Panel finds that the Respondent knows, 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 and it is inconceivable that the Respondent could have registered the disputed domain names without actual knowledge of Complainant's rights in the trademark, which evidences bad faith.

Regarding <bnpotc.com> and <bnp-otc.com>

As demonstrated by the websites <bnpotc.com> and <bnp-otc.com>, it is obvious that the Respondent clearly knows the Complainant and its trademarks. The evidence shows that the resolving websites of the Respondent display Complainant's mark and distinctive logo, and pictures of Complainant's products. The Panel finds that the Respondent registered and uses the disputed domain names in bad faith in order to offer similar services like the Complainant. Using a disputed domain name to offer online cryptocurrency services is in direct competition with the Complainant's business and under the Panel conclusion clear evidence of bad faith.

Regarding <bnp-exchange.com> and <bnpcoins.com>

The Panel finds that the disputed domain names are inactive. The Respondent has not demonstrated any activity in respect of the disputed domain names, so that it is not possible to conceive of any plausible actual or contemplated active use of the domain names by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law. The incorporation of a famous mark into a domain name, coupled with an inactive website, is the evidence of bad faith registration and use.

The Respondent is known in such pattern of conduct as it can be found under the Forum Claim No. FA2202001984496 in Cboe Exchange, Inc. v. plum Bruce / Nasdaq.

The Panel concludes therefore that the overall circumstances of this case suggest that the disputed domain names were registered and are being used in bad faith and the Complainant has satisfied 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. **BNPOTC.COM**: Transferred
2. **BNP-OTC.COM**: Transferred
3. **BNP-EXCHANGE.COM**: Transferred

4. BNPCOINS.COM: Transferred

PANELLISTS

Name JUDr. Vojtěch Trapl

DATE OF PANEL DECISION 2022-05-17

Publish the Decision
