

Decision for dispute CAC-UDRP-104263

Case number CAC-UDRP-104263

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Domain names bnpparibas-fortis.com

Case administrator

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

Complainant

Organization BNP PARIBAS

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Name Greg Morgan

OTHER LEGAL PROCEEDINGS

The Panel is not conscious of any other pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns several trademarks for "BNP PARIBAS", such as:

- International trademark "BNP PARIBAS" n°728598 registered since February 23, 2000;
 - International trademark "BNP PARIBAS" n°745220 registered since September 18, 2000; and
 - International trademark "BNP PARIBAS" n°876031 registered since November 24, 2005.
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FACTUAL BACKGROUND

The following facts have been asserted by the Complainant and have not been contested by the Respondent:

BNP PARIBAS S.A. (the "Complainant") is an international banking group in 68 countries and one of the largest banks in the world. With over 193,000 employees and €44.3 billion in revenues, the Complainant stands as a leading bank in the Eurozone and a prominent international banking institution.

The Complainant is also the owner of several domain names containing "BNP PARIBAS", such as <bnpparibas.com>, registered since September 2, 1999.

The disputed domain name <bnpparibas-fortis.com> was registered on July 13, 2019, and resolves to an inactive page. Besides, MX servers are configured.

PARTIES CONTENTIONS

I. The Complainant states that the disputed domain name <bnpparibas-fortis.com> is confusingly similar to its previous trademark registration on the term "BNP PARIBAS" and its domain names associated.

Indeed, the disputed domain name <bnpparibas-fortis.com> contains the Complainant's registered trademark "BNP PARIBAS" in its entirety.

The Complainant contends that the disputed domain name only differs from the trademark "BNP PARIBAS" by the addition of the term "FORTIS" (which refers to the Complainant's subsidiary BNP PARIBAS FORTIS) and the addition of a hyphen.

It is well-established that "a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP".

Moreover, the Complainant contends that the addition of the gTLD ".COM" does not change the overall impression of the designation as being connected to the trademark "BNP PARIBAS". Therefore, it does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark, and its domain names associated.

II. A Complainant must make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such a 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 paragraph 4(a) (ii) of the UDRP.

The Complainant asserts that the Respondent is not known as the disputed domain name in the Whois database, but as "Greg Morgan", and has not acquired trademark rights on this term. Past Panels have held that a Respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name.

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 contends 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 disputed domain name is not used. The Complainant contends that Respondent did not use the disputed domain name since its registration, and it confirms that Respondent has no demonstrable plan to use the disputed domain name. It demonstrates a lack of legitimate interests regarding the disputed domain name.

Thus, the Complainant contends that the Respondent has no rights or legitimate interests regarding the disputed domain name <bnpparibas-fortis.com>.

III. The Complainant states that the disputed domain name <bnpparibas-fortis.com> is confusingly similar to its trademark "BNP PARIBAS".

Prior UDRP panels have established that the trademark "BNP PARIBAS" is well-known.

Besides, the Complainant asserts that the Respondent had the Complainant and its subsidiary in mind when it registered the disputed domain name and that this registration cannot be coincidental. Indeed, the association of the term "FORTIS" and the trademark "BNP PARIBAS" is only known in relation to the Complainant's subsidiary.

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

Furthermore, the disputed domain name is not used, resolving to an inactive page. Besides, the disputed domain name has been set up with MX records. The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name. It is impossible to conceive of any plausible actual or contemplated active use of the domain name 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.

Besides, although the disputed domain name appears to be unused, it has been set up with MX records which suggests that it may be actively used for e-mail purposes.

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

RESPONDENT

No administratively compliant Response has been filed.

RIGHTS

To the satisfaction of the Panel, the Complainant has shown that the disputed domain name is identical or confusingly similar to the trademark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

To the satisfaction of the Panel, the Complainant has 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

To the satisfaction of the Panel, the Complainant has 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 have been met, and there is no other reason why it would be unsuitable for providing the Decision.

PRINCIPAL REASONS FOR THE DECISION

I. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has shown it owns rights in the trademark "BNP PARIBAS" trademark, with the earliest registration dating back to 2000.

Now, turning to analyze if there is a confusing similarity between the disputed domain name and the trademark. As contained in the record before the Panel, the disputed domain name reproduces the trademark in its totality, with a couple of exceptions. The first difference is that there is no space between the two-word components of the trademark. The second difference is the addition of a hyphen after the trademark. The third difference is adding the generic term "fortis" after the trademark and the hyphen. The word "fortis" appears to refer to a subsidiary of the Complainant. The consequences of a further analysis under the second and third elements of these differences may be relevant to the second and third elements under the UDRP Policy set out below.

However, for the purposes of the first element, these minor differences prove insubstantial enough to dispel the confusing similarity between the disputed domain name and the Complainant's trademarks.

Consequently, the Panel determines that the Complaint has satisfied the first element set under paragraph 4(a)(i) of the Policy.

II. Rights or Legitimate Interests

Based on the evidence on record and acknowledging that the Respondent failed to produce any allegations or evidence necessary to demonstrate its rights or legitimate interests in the disputed domain name, the Panel must turn to the uncontested facts. These indicate that a) the Respondent is not commonly known by the disputed domain name; b) the Respondent has no license or authorization to use the trademarks; c) the Respondent is not affiliated with the Complainant; d) the Respondent is not authorized to carry out any activity for the Complainant and has no business dealings with the Complainant and e) the Respondent is not using the disputed domain name and has not demonstrable plans to use the disputed domain name legitimately.

In failing to respond to the Complainant's contentions, the Respondent has not rebutted the prima facie case, as described in paragraph 2.1 of WIPO 3.0 Overview.

In addition to this, the Respondent's use of the trademark plus the use of a generic term, that seems to refer to a subsidiary of the Complainant, namely "fortis", seems to indicate that the Respondent not only was aware of the Complainant but deliberately targeted the Complainant to benefit from the association to the Complainant and confuse Internet users as to the source of sponsorship. A practice like this can never be considered a bona fide offering under the Policy.

These facts lead the Panel to conclude that the Respondent did not have rights or legitimate interests in the disputed domain name. Furthermore, the Complainant provides evidence of the setting up of mail exchanger record (MX record), a resource record in the Domain Name System (DNS), which could be used to use e-mailing capabilities associated with the disputed domain name. This last fact will be further analyzed under the third element below. Nevertheless, assessing these facts in conjunction provides sufficient inputs for the purposes of the second element.

Consequently, the Panel determines that the Respondent has no rights or legitimate interests in the disputed domain name. Subsequently, the Complainant has fulfilled the second requirement set under paragraph 4(a)(ii) of the Policy.

III. Registered and Used in Bad Faith

As per the record and evidence at hand, the Panel finds that the Respondent was likely aware of the Complainant and had the Complainant's trademark in mind when registering the disputed domain name. This conclusion is reinforced by the fact that the Respondent seems to evoke a connection to the Complainant's trademark by including the trademark in its entirety, with the addition of a generic term, namely "fortis". There seems to evoke one of the Complainant's subsidiaries.

Additionally, although the website associated with the disputed domain name doesn't appear to be used, the MX record seems to have been configured in such a manner to likely offer e-mailing capabilities associated with the disputed domain name. Although no proof of any e-mails, which would likely be fraudulent, was provided, the Respondent's actions, the evidence on record, and the balance of probabilities seem to reinforce this potential line of thought.

All the preceding analysis leaves the Panel no other option than to conclude that the most likely intention of the Respondent was to intentionally attempt to attract, for commercial gain, Internet users to its website/disputed domain name, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and/or disputed domain name, as per illustrated under paragraph 3.1 of WIPO 3.0

Overview.

In light of the case's circumstances, based on the available records, the Panel finds that the Complainant has proven that the disputed domain name was registered and is used in bad faith according to paragraph 4(a)(iii) of the Policy.

IV. Decision

For the preceding reasons and in concurrence with the provisions specified under Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders the transfer of the disputed domain name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. BNPPARIBAS-FORTIS.COM: Transferred

PANELLISTS

| | |
|------|--------------------------|
| Name | Rodolfo Carlos Rivas Rea |
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DATE OF PANEL DECISION 2022-02-02

Publish the Decision