Decision for dispute CAC-UDRP-102801

Case number	**CAC-UDRP-102801**
Time of filing	**2019-12-05 13:13:48**
Domain names	**bnp-paribasfortis.net**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**BNP PARIBAS**

Complainant representative

Organization	**Nameshield (Enora Millocheau)**

Respondent

Name	**jolink bowling**

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

In this proceeding, the Complainant relies on the following trademarks:
- International word trademark “BNP PARIBAS” No. 728598, registered on February 23, 2000;
- International device trademark “BNP PARIBAS” No. 745220, registered on September 18, 2000;
- International word trademark “BNP PARIBAS” No. 876031, registered on November 24, 2005.

FACTUAL BACKGROUND

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

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

BNP PARIBAS S.A. (the “Complainant”) is an international banking group with a presence in 72 countries, and one of the largest banks in the world. With more than 202 624 employees and €7.5 billion in net profit, the Complainant claims to be a leading bank in the Eurozone and a prominent international banking institution.

The Complaint owns a number of trademarks with the “BNP PARIBAS” elements and is also the owner of a large portfolio of domain names “BNP PARIBAS”, such as <bnpparibas.com>, registered since 1999-09-02. BNP PARIBAS FORTIS is the Complainant’s Belgium subsidiary.

The disputed domain name was registered on November 11th, 2019 and is inactive.
The Complainant states that the disputed domain name is confusingly similar to its BNP PARIBAS trademarks.
The Complainant stresses that the disputed domain name contains Complainant’s registered and widely known trademark in its entirety and the addition of the dash and the term “FORTIS” is not sufficient to escape the finding that the disputed domain name is confusingly similar to Complainant's trademarks.

On the contrary, the addition of the term “FORTIS” worsens the likelihood of confusion, as it refers to the Complainant’s Belgium subsidiary “BNP PARIBAS FORTIS” and the addition of the generic Top-Level Domain suffix “.net” does not change the overall impression of the designation as being connected to the Complainant’s trademark.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant contends that the Respondent is not known by the disputed domain name in the Whois database, and has not acquired trademarks mark rights.
The Complainant states that the Respondent is not related in any way to the Complainant’s business.
The Complainant contends that the Respondent is not affiliated with the Complainant nor authorized by the Complainant 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 inactive.
Therefore, the Complainant contends that Respondent did not make any use of 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 in respect of the disputed domain name.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND BEING USED IN BAD FAITH

The Complainant refers to previous panels that have established that the “BNP PARIBAS” trademark is well-known.

According to the Complainant the Respondent had the Complainant and its subsidiary in mind when it registered the disputed domain name, and that this registration cannot be coincidental.
The association of the term “FORTIS” and the trademark “BNP PARIBAS” is only known in relation with the Complainant’s subsidiary
Given the distinctiveness of the Complainant's trademarks and reputation, it is inconceivable that the Respondent could have registered the disputed domain name without actual knowledge of Complainant's rights in the trademark, which evidences bad faith. The disputed domain name is inactive.
The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the disputed 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.
The Complainant refers to earlier UDRP panels that have held the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use.

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

A. Identical or confusingly similar with Complainant's trademark

The Complainant owns various "BNP PARIBAS" international trademark registrations effective in various jurisdictions.

As confirmed by WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), see paragraph 1.2.1: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".
The disputed domain name entirely incorporates the Complainant's trademark with the addition of the "Fortis" element in the end.

As stated in WIPO Overview 3.0 "where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element" (see par. 1.8).

In the present case, the Complainant's trademark is clearly recognizable in the disputed domain name.
The addition of the "Fortis" element does not change an overall impression of the disputed domain name and actually increases confusion with the Complainant since it creates a direct association with the Complainant's subsidiary in Belgium ("BNP Paribas Fortis").

The .net domain zone shall be disregarded under the identity or the confusing similarity test as it does not add anything to the distinctiveness of the disputed domain name.
Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:
(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and
(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.
If the respondent fails to do so, the second element of the Policy is satisfied (see Julian Barnes v. Old Barn Studios, WIPO Case No. D2001-0121; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110; Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455 and CAC Case No. 101284).
The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it

allows all reasonable inferences of fact in the allegations of the complaint to be deemed true (see paragraph 14(b) of the Rules and FORUM Case No. FA0006000095095, Vertical Solutions Management, Inc. v. webnet-marketing, inc.).

The web site under the disputed domain name is inactive.

The Complainant has made a prima facie case in respect of Respondent's lack of rights or legitimate interests, in particular absence of any affiliation, business relations with the Complainant or any authorization from the Complainant to use its trademarks in the disputed domain name and the fact that the Respondent is not known by the disputed domain name.
The Respondent failed to respond and rebut Complainant's arguments.

In the present case there is no evidence of any possible legitimate rights or interests of the Respondent.

Therefore, the Panel finds that the Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.
These circumstances are non-exhaustive and other factors can also be considered in deciding whether the disputed domain name is registered and used in bad faith.
The disputed domain name is inactive.

There is a general agreement that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding (see par. 3.3 of the WIPO Overview 3.0).

One has to look at the circumstances of a case taking into account, in particular, the degree of distinctiveness or reputation of the Complainant's mark, the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use and the implausibility of any good faith use to which the domain name may be put (see e.g. Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; "Dr. Martens" International Trading GmbH and "Dr. Maertens" Marketing GmbH v. Godaddy.com, Inc., WIPO Case No. D2017-0246; CAC Case No. 101435, CAC Case No. 101691 and CAC Case No. 101640).

Notoriety and distinctiveness of Complainant's "BNP PARIBAS" trademarks were recognized by previous panels (see BNP Paribas v. Ronan Laster, WIPO Case No. D2017-2167 and BNP Paribas v. Stanciu Stefan-George, WIPO Case No. DRO2018-0013) and these trademarks have been targeted by cybersquatters before (see e.g. CAC Case No. 102719, BNP Paribas v. eSeats.com, WIPO Case No. D2010-0104 and BNP Paribas v. Ronan Laster, WIPO Case No. D2017-2167).

The Complainant's marks are widely-known and distinctive and have been registered long before registration of the disputed domain name.

It is also clear that the Respondent targeted the Complainant by combining Complainant's trademark with a name of its Belgium subsidiary ("Fortis") in the disputed domain name.
The Respondent failed to provide any explanations as to intended purpose of registration of the disputed domain name and in the absence of such explanations it is hard if not impossible to imagine any conceivable good faith use of the disputed domain name by the Respondent.

Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see par. 3.1.4. of WIPO Overview 3.0).

Based on the above, the Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BNP-PARIBASFORTIS.NET**: Transferred

PANELLISTS

Name	**Igor Motsnyi**

DATE OF PANEL DECISION 2020-01-22

Publish the Decision