

Decision for dispute CAC-UDRP-104613

Case number **CAC-UDRP-104613**

Time of filing **2022-06-02 09:12:35**

Domain names **bnp-coin.com, bnp-otccoin.com, bnponeex.com, excoin-bnp.com**

Case administrator

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

Complainant

Organization **BNP PARIBAS**

Complainant representative

Organization **NAMESHIELD S.A.S.**

Respondent

Organization **plum Bruce, Nasdaq**

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

The Complainant is the owner of several trademarks consisting of the term “BNP®”, such as i) the European trademark BNP® n° 000089649 registered since April 1, 1996, ii) the International trademark BNP Paribas® n° 728598 registered since February 23, 2000 in classes 35, 36 38, iii) the international trademark BNP Paribas and device® n° 745220 registered since September 9, 2000 in classes 09, 35, 36 & 38, iv) the International trademark BNP Paribas® n° 876031 registered since November 24, 2005 in classes 09, 35, 36 38.

In addition, the Complainant owns domain names with the term “BNP PARIBAS”, such as i) <bnpparibas.com> created since September 1, 1999 ii) <bnpparibas.net> created since December 28, 1999 and iii) <bnpparibas.pro> created since July 22, 2008.

FACTUAL BACKGROUND**FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:**

The Complainant is an international banking group with a presence in 65 countries, and one of the largest banks in the world

with more than 190,000 employees and EUR46.2 billion in revenues in 2021. The Complainant stands as a leading bank in the Eurozone and a prominent international banking institution.

The Complainant contends that its trademark "BNP" is widely used for banking services worldwide.

The Complainant is the owner of several trademarks and domain names, including the term "BNP®" as well as "BNP PARIBAS®" at least since 2000.

The Respondent registered the four Disputed Domain Names as follows:

<bnp-coin.com> on March 29, 2022
<bnp-otccoin.com> on April 1st, 2022
<bnponeex.com> on April 29, 2022
<excoin-bnp.com> on April 25, 2022

hereinafter, the "Disputed Domain Names").

The Complainant argues that the Disputed Domain Names were registered by person plum Bruce based in China and they resolve to pages displaying information about cryptocurrencies and BNP PARIBAS FORTIS' logo. Furthermore, the Complainant states that the Disputed Domain Names are used to resolve to a login page reproducing the Complainant's logo.

According to Complainant's non-contested allegations, the Respondent has no rights or legitimate interest in respect of the Disputed Domain Names and Complainant is not related in any way to the Complainant's business.

For the purpose of this case, the Registrar confirmed that the Respondent is the current registrant of the Disputed Domain Names and that the language of the registration agreement is English.

The facts asserted by the Complainant are not contested by the Respondent.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT:

First element: Similarity

The Complainant states that the Disputed Domain Names are confusingly similar to its trademark BNP® and BNP PARIBAS®.

The Complainant asserts that the trademark BNP® is included in its entirety within the Disputed Domain Names. The terms "COIN", "OTC COIN" (for "Over-the-counter Coin"), "ONEEX" or "EXCOIN" all refer to the trading of cryptocurrencies, and, therefore are closely related to the Complainant and its business activities.

Second element: Rights or legitimate interest

The Complainant contends that the Respondent is not known as the Disputed Domain Names in the Whois database, and has not acquired trademark rights on the terms.

Moreover, 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.

The Complainant asserts that the Respondent is not affiliated with him nor authorized by him in any way to use the trademarks "BNP PARIBAS®" or "BNP®". The Complainant does not carry out any activity for, nor has any business with the Respondent.

The Complainant also claims that the Disputed Domain Names redirect to a trading website reproducing the Complainant's logo and trademarks and past panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use.

Third element: Bad faith

The Complainant states that the Disputed Domain Names are confusingly similar to its trademark BNP PARIBAS® and BNP®.

The Complainant indicates that given the distinctiveness of Complainant's trademarks and reputation, 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.

The Complainant contends that the Disputed Domain Names were registered in order to create a likelihood of confusion with the Complainant's and its trademarks. By profiting of the notoriety of the Complainant's trademark in the Disputed Domain Name, the Respondent is using the Disputed Domain Names to offer services in direct competition with Complainant.

The Complainant indicates that the Respondent has a history of registering domain names which incorporate the third parties' trademarks. See for instance Forum Case no. 1984496 and CAC Case no. 104458.

RESPONDENT

Respondent did not reply to the Complaint.

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

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that a disputed domain name should be transferred or cancelled:

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

The Panel has reviewed in detail the evidence available to it and has come to the following conclusions concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

(A) THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAMES TO THE COMPLAINANT'S RIGHTS.

Paragraph 4(a)(i) of the Policy establishes the obligation of Complainant to demonstrate that the Disputed Domain Names is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant submitted copies of different trademarks registrations pertaining the term "BNP®" as well as "BNP PARIBAS®" for banking services, among others.

The Complainant's trademarks were registered prior to 2022, the year of the creation date of the Disputed Domain Names.

In the current case, the Disputed Domain Names are composed as follows:

1. <bnp-coin.com >: the trademark BNP plus the generic word "Coin";
2. <bnp-otccoin.com>: the trademark BNP plus the abbreviation "OTC" which means "Over-the-counter" and the generic word Coin – all related to the trading of cryptocurrencies;
3. <bnponeex.com>: the trademark BNP plus the term "ONEEX" which might refer to the trading of cryptocurrencies; and
4. <excoin-bnp.com>; the trademark BNP plus the term "EXCOIN" which apparently is a professional global cryptocurrency exchange that supports BTC/ETH/DOGE/LTE/XRP trading.

In assessing confusing similarity, the Panel finds the Disputed Domain Names are confusingly similar to the Complainant's trademark, as it incorporates the entirety of the "BNP®" as well as "BNP PARIBAS®" trademarks plus different generic terms or abbreviations mainly used to the trading of cryptocurrencies such as "Coin", "OTC" and "EXCOIN". In this regard, UDRP panels agree that 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 paragraph 1.8. of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition 3.0 ("WIPO Jurisprudential Overview 3.0.).

UDRP panels agree that the TLD may usually be ignored for the purpose of determination of identity or confusing similarity between a domain name and the Complainant's trademark as it is technical requirement of registration. See paragraph 1.11.1 of WIPO Jurisprudential Overview 3.0.

Therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the Disputed Domain Names are confusingly similar to Complainant's "BNP®" and "BNP PARIBAS®" trademarks.

(B) RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAMES.

The second element of the Policy requires that the Complainant establishes that the Respondent has no rights or legitimate interests in the Disputed Domain Names. The generally adopted approach, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it with relevant evidence demonstrating rights or legitimate interests in the domain name; see, for example, CAC Case No. 102333, Amedei S.r.l. v sun xin. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

In this vein, Paragraph 4 (c) provides with circumstances which could prove rights or legitimate interest in the disputed domain name on behalf of the Respondent such as:

- (i) before any notice to Respondent of the dispute, Respondent is using or provides with 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 consumers or to tarnish the trademark or service mark at issue.

The Respondent did not reply to the Complaint despite the efforts made by this Center to notify the Complaint. In this regard, the Complainant has confirmed in the Complaint that the Disputed Domain Names are not connected with or authorized by the Complainant in any way.

From the information provided by the Complainant, there is no evidence or reason to believe that the Respondent (as individual, business or other organization) has been commonly known by the Disputed Domain Names.

The Respondent's name "plum Bruce" is all what it links the Disputed Domain Names with the Respondent. Absent of any other evidence such as a personal name, nickname or corporate identifier, the Panel is of the opinion that the Respondent is not commonly known by the Disputed Domain Names.

The Complainant indicates that they have not granted authorization to Respondent to use their "BNP®" and "BNP PARIBAS®" trademarks. Furthermore, the Complainant asserts that the Respondent is not affiliated with him nor authorized in any way to use the trademark "BNP®" and "BNP PARIBAS®".

In terms of the evidence provided by the Complainant, the websites linked to the Disputed Domain Names redirect to a potential trading website. At the top of the websites, Complainant's trademark "BNP®" and "BNP PARIBAS®" is used together with a logo and the term FORTIS.

From the evidence at hand, Respondent registered the Disputed Domain Names with the intention to divert internet users to his websites by confusing them into believe that there is an association or an affiliation between the Respondent and Complainant. This conduct cannot be considered as good faith or a legitimate use.

See paragraph 2.5.1 of WIPO Jurisprudential Overview 3.0. which establishes the following:

"Generally speaking, UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation. Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner".

Finally, Complainant indicated that the Respondent uses the Disputed Domain Names to pass off as the Complainant and phish for users' personal information and to this end, the Complainant provided with the relevant evidence showing screenshots of the websites with options to provide with email address and phone number.

Past panels have found that the use of a domain name for illegal activity, including phishing can never confer rights or legitimate interest on a Respondent. Absent of Respondent's answer to rebut the phishing arguments, the Panel is of the opinion that such use of the Disputed Domain Names does not constitute a bona fide offering of goods or services or legitimate non-commercial or fair use.

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) BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAMES.

Paragraph 4(a)(iii) of the Policy indicates that the Complainant must assert that the Respondent registered and is using the Disputed Domain Names in bad faith. In this sense, Paragraph 4(b) of the Policy sets out four circumstances which if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the Respondent has registered or acquired the domain name primarily for the purpose of

selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) The Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
(iii) The Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
(iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's 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.

The evidence submitted by the Complainant confirms that its trademarks "BNP®" and "BNP PARIBAS®" is distinctive and it has a strong reputation in the banking industry. In fact, Complainant referred to WIPO Case No. D2017-2176 BNP Paribas v. Ronan Laster by which the Panel mentioned the high notoriety of the BNP PARIBAS trademarks throughout the world. In this regard and absent of Respondent's reply, the Panel finds that Respondent, prior to the registration of the Disputed Domain Names was aware of Complainant's trademark, in particular since the Disputed Domain Names were registered in 2022 and Complainant's trademarks were registered long before the registration of the Disputed Domain Names.

Panels have found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See paragraph 3.1.4 of WIPO Jurisprudential Overview 3.0.

Furthermore, the Complainant provided with evidence showing that the four websites linked to the Disputed Domain Names redirect to a potential trading website. At the top of the websites, the Complainant's trademark "BNP®" and "BNP PARIBAS®" is used together with a logo and the term FORTIS. The websites were created with the intention to divert internet users to his websites by confusing them into believe that there is an association or an affiliation between the Respondent and Complainant. In this sense, the Complainant has confirmed that no authorization was granted to the Respondent to register them and no counterargument has been submitted by Respondent.

The Complainant included as evidence a screenshot with the website www.bnpparibasfortis.be where the same the "BNP®" and "BNP PARIBAS®" is used together with a logo and the term FORTIS. This is a clear indication that Disputed Domain Names were set up with the only intention to attract, for commercial gain, Internet users to the Respondent's 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.

The Complainant indicated that the Respondent has been involved in different UDRP proceedings such as CAC Case No. 104458 BNP PARIBAS v. Nasdaq, plum Bruce & Forum Case No. 1984496 Cboe Exchange Inc v. plum Bruce / Nasdaq. UDRP panels have held that establishing a pattern of bad faith conduct requires more than one, but as few as two instances of abusive domain name registration.

This may include a scenario where a respondent, on separate occasions, has registered trademark-abusive domain names, even where directed at the same brand owner.

A pattern of abuse has also been found where the respondent registers, simultaneously or otherwise, multiple trademark-abusive domain names corresponding to the distinct marks of individual brand owners.

Panels have however been reluctant to find a pattern of abuse where a single UDRP case merely contains two domain names registered simultaneously by the same respondent directed at a single complainant mark.

See paragraph 3.1.2. of WIPO Jurisprudential Overview 3.0.

Since the Complainant was able to mention as evidence at least 2 UDRP cases where the Respondent was also involved, the Panel concludes that the Complainant has established a pattern of bad faith conduct on Respondent's side.

In light of the evidence presented to the Panel, including: a) the likelihood of confusion between the Disputed Domain Names and the Complainant's "BNP®" and "BNP PARIBAS®" trademarks, b) the lack of reply to this Complaint by Respondent, c) the fact that the Disputed Domain Names are being used to redirect to a potential trading website with Complainant's trademark "BNP®" and "BNP PARIBAS®" with the intention to divert internet users to his websites by confusing them into believe that there is an association or an affiliation between the Respondent and Complainant, d) The Respondent has been involved in at least two additional UDRP cases, the Panel draws the inference that the Disputed Domain Names were registered and are being used in bad faith.

Therefore, the Panel concludes that Respondent registered and is using the Disputed Domain Names in bad faith and thus has satisfied the requirement under 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. **BNP-COIN.COM**: Transferred
- 2. **BNP-OTCCOIN.COM**: Transferred
- 3. **BNPONEEX.COM**: Transferred
- 4. **EXCOIN-BNP.COM**: Transferred

PANELLISTS

Name	Victor Hugo Garcia Padilla, LL.M.
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DATE OF PANEL DECISION 2022-09-02

Publish the Decision