

## Decision for dispute CAC-UDRP-105225

Case number CAC-UDRP-105225

Time of filing 2023-02-24 10:09:31

Domain names bnp-paribas.cloud

### Case administrator

Name Olga Dvořáková (Case admin)

### Complainant

Organization BNP PARIBAS

### Complainant representative

Organization NAMESHIELD S.A.S.

### Respondent

Name Meg Niccson

#### 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 bases its Complaint on the following trademark registrations:

- the international trademark BNP PARIBAS, no. 728598 registered since 23.02.2000, for services in classes 35, 36, 38;
- the international trademark BNP PARIBAS, no. 745220 registered since 18.09.2000, for goods and services in classes 09, 35, 36, 38;
- the international trademark BNP PARIBAS, no. 876031 registered since 24.11.2005, for goods and services in classes 09, 35, 36, 38.

In addition, the Complainant holds the following domain names:

- <bnpparibas.com>, registered since 02.09.1999;
- <bnpparibas.net>, registered since 29.12.1999;
- <bnpparibas.pro>, registered since 23.07.2008.

#### FACTUAL BACKGROUND

The Complainant is an international banking group with a presence in 65 countries, and one of the largest banks in the world. With nearly 190,000 employees and €10.2 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 as well as a large portfolio of domain names "BNP PARIBAS".

The disputed domain name was registered on 18.02.2023 and resolves to an error page.

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#### PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

#### COMPLAINANT'S CONTENTIONS:

The Complainant's contentions are the following:

The disputed domain name < **bnp-paribas.cloud** > (registered on 18.02.2023) is identical to its BNP PARIBAS trademark, as the trademark is included in its entirety.

The Complainant contends that the addition of the new gTLD ".cloud" 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 name and the Complainant, its trademarks and its domain names associated.

Further, the Complainant considers that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

In this sense, the Complainant underlines that according to the WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd., 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 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, and has not acquired trademarks mark rights on this term. The Complainant further contends that 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 (Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy ¶ 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy ¶ 4(c)(ii).")

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the domain name 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 trademark BNP PARIBAS. The Complainant underlines that it does not carry out any activity for, nor has any business with the Respondent.

Finally, the Complainant contends that the disputed domain name points to an error page and that the Respondent did not make any use of disputed domain name since their registration, which in his view 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, in Complainant's view.

For these reasons, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Lastly, the Complainant asserts that the disputed domain name was registered and is being used in bad faith.

To this end, the Complainant states that the disputed domain name is identical to its well-known and distinctive trademark BNP PARIBAS. With nearly 190,000 employees and €10.2 billion in net profit, the Complainant states that it stands as a leading bank in the Eurozone and a prominent international banking institution.

Complainant underlines that prior UDRP panels have established that the trademark BNP PARIBAS is well-known (see for instance WIPO Case No. D2017-2167, BNP Paribas v. Ronan Laster ("Then, according to the Panel, the Complainant has shown that the Respondent knew, 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").

The Complainant further underlines that all the results of a Google searches are related to the Complainant.

Thus, given the distinctiveness of the 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, in the Complainant's view.

Furthermore, the disputed domain name points to an error page. 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 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.

As prior WIPO UDRP panels 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, as asserted by the Complainant (see for instance WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows; WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen).

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

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#### 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).

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#### 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).

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#### 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).

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#### 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.

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#### PRINCIPAL REASONS FOR THE DECISION

##### 1. Identity

The Panel agrees that the disputed domain name incorporates in its entirety the Complainant's earlier BNP PARIBAS trademark.

The addition of the extension ".cloud" is not to be taken into consideration when examining the identity between the Complainant's trademarks and the disputed domain name (WIPO Case No. D2005-0016, Accor v. Noldc Inc.). The mere adjunction of a gTLD such as ".com" is irrelevant as it is well established that the generic Top Level Domain is insufficient to avoid a finding of identity / confusing similarity (WIPO Case No. 2013-0820, L'Oréal v Tina Smith, WIPO Case No. D2008-0820 Titoni AG v Runxin Wang and WIPO Case No. D2009-0877, Alstom v. Itete Peru S.A.).

Therefore, the Panel is satisfied that the first condition under the Policy is met.

##### 2. Lack of Respondent's rights or legitimate interests

The 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, the burden of proof shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

Based on the available evidence, the Respondent does not appear to be known by the disputed domain name. The Respondent is not a licensee of, nor has any kind of relationship with, the Complainant. The Complainant has never authorised the Respondent to make use of its trademark, nor of an identical trademark in the disputed domain name.

Also, based on the available evidence, the disputed domain name points to an inactive website and the Respondent did not demonstrate use of, or demonstrable preparation to use, the disputed domain name in connection with a bona fide offering of goods or services.

The above does not amount to a bona fide offering of goods or services, or to a legitimate noncommercial or fair use of the disputed domain name.

The Panel notes that the Respondent had an opportunity to comment on the Complainant's allegations by filing a Response, which the Respondent failed to do.

Thus, the Panel is satisfied that the Complainant has at least established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. Accordingly, the Panel takes the view that also the second requirement under the Policy is met.

### 3. Bad Faith

The Complainant's BNP PARIBAS trademark is a well-known one as recognized also by past panels and the disputed domain name is incorporating the BNP PARIBAS trademark in its entirety. Therefore, the Panel concludes that at the time of registration of the disputed domain name, the Respondent was well aware of the Complainant's trademark and has intentionally registered the disputed domain name in order to benefit from the reputation of the Complainant's trademark.

In the present case, the following factors should be considered:

(i) the Complainant's trademark is a well-known one, being also highly distinctive;

(ii) the Respondent failed to submit any response and has not provided any evidence of actual or contemplated good faith use of the disputed domain name;

(iv) the Respondent registered the disputed domain name containing in its entirety a well-known trademark;

(v) any good faith use of the disputed domain name would be implausible, as the trademark BNP PARIBAS is univocally linked to the Complainant and the Respondent has no business relationship with the Complainant, nor was ever authorised to use/register a domain name identical to the Complainant's trademark;

(vii) the disputed domain name appears to resolve to an inactive website.

In light of the foregoing, the Panel concludes that the Respondent has registered and has been using the disputed domain name in bad faith. Thus, also the third and last condition under the Policy is satisfied.

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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

**Accepted**

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

1. **bnp-paribas.cloud**: Transferred

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## **PANELLISTS**

Name	<b>Delia-Mihaela Belciu</b>
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DATE OF PANEL DECISION **2023-03-31**

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**Publish the Decision**

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