Decision for dispute CAC-UDRP-106106

Case number	CAC-UDRP-106106
Time of filing	2023-12-27 09:41:43
Domain names	bnpparibas.fun

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	BNP PARIBAS

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	Esteban Gouilly

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 trademark registrations:

- International trademark registration under the Madrid system “BNP PARIBAS” (word) No. 728598, registration date is February 23, 2000, protected inter alia in Australia, Bulgaria, China, the Czech Republic, Norway, Poland, Turkey and Switzerland;
- International trademark registration under the Madrid system “BNP PARIBAS” (word and device) No. 745220, registration date is September 18, 2000, protected inter alia in Algeria, Bulgaria, China, the Czech Republic, Hungary, Japan, Poland, Russia, Turkey and Ukraine; and
- International trademark registration under the Madrid system “BNP PARIBAS” (word) No. 876031, registration date is November 24, 2005, protected inter alia in Algeria, Australia, China, Croatia, Cuba, Japan, Morocco, Republic of Korea, Switzerland and USA.

The Complainant also refers to various domain names that incorporate the “BNP PARIBAS” trademark, including <bnpparibas. com> registered since September 2, 1999.

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

The Complainant states that it is an international banking group with a presence in 65 countries, and one of the largest banks in the world. The Complainant claims to have 190,000 employees and €10.2 billion in net profit and that it is a leading bank in the Eurozone and a prominent international banking institution.

The disputed domain name was registered on December 10, 2023 and resolves to an inactive website.

The Complainant contends the disputed domain name is identical to its "BNP PARIBAS" trademark as the trademark is included in its entirety in the disputed domain name. The addition of the new gTLD <.fun> does not change the overall impression of the designation as being connected to the trademarks of the Complainant and does not prevent the likelihood of confusion.

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

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 in relation to this term.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that he is not related in any way to the Complainant's business.

The Complainant contends that the Respondent is not affiliated with 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 Complainant contends that the Respondent did not use the disputed domain name, and non-use confirms that the Respondent has no demonstrable plan to use the disputed domain name and does not have any legitimate interest in respect of the disputed domain name.

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

The Complainant's submissions on the bad faith element of the UDRP can be summarized as follows:

1. The disputed domain name includes a well-known and distinctive trademark "BNP PARIBAS" and is identical to Complainant's mark. The Complainant refers to previous UDRP decisions where its "BNP PARIBAS" trademark is recognized as well-known.
2. Given the distinctiveness of the Complainant's trademark and its reputation, it is inconceivable that the Respondent could have registered the disputed domain name without actual knowledge of Complainant's rights.
3. The Complainant relies on the passive holding doctrine and the "Telstra" decision (**WIPO Case No. D2000-0003, "Telstra Corporation Limited v. Nuclear Marshmallows**"). 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.

Therefore, the Complainant claims the disputed domain name was registered and being used in bad faith.

PARTIES CONTENTIONS

The Complainant's contentions are summarized in the Factual Background section above.

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

The Complainant provides evidence of the international trademark registrations “BNP PARIBAS”. As confirmed by the “WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition” (“WIPO Overview 3.0”): “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” (see sec. 1.2.1).

The disputed domain name fully incorporates the Complainant’s mark and the only difference between the marks of the Complainant (its word elements) and the disputed domain name is <.fun> gTLD.

As stated in WIPO Overview 3.0: “in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing” (see sec. 1.7).

The Complainant’s word trademark “BNP PARIBAS” (word elements “BNP PARIBAS”) is fully included in the disputed domain name without any changes or additions.

The gTLD “.fun” is to be disregarded under the confusing similarity test as it does nothing to eliminate confusion.

Therefore, the Panel finds that the disputed domain name is identical to the Complainant’s trademark.

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**.

The disputed domain name was registered on December 10, 2023. It does not resolve to any active page.

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 the Panel to draw such inferences as it considers appropriate, see paragraph 14(b) of the Rules and **CAC Case No. 101284**: “A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable inferences may be drawn from the information provided by the complainant”.

The Complainant has made a prima facie case of Respondent’s lack of rights or legitimate interests.

The Respondent is not known by the disputed domain name and is identified as an individual from France with no connection to the Complainant’s business, the disputed domain name or any name corresponding to the disputed domain name.

The Complainant has not granted any license or authorization to use its trademark to the Respondent and the Complainant is not doing any business with the Respondent.

Passive holding of the disputed domain name in the circumstances of this case does not create any rights or legitimate 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 about the bad faith element.

It is well established that bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark (see sec. 3.1 of WIPO Overview 3.0). Targeting is important in establishing bad faith under the UDRP.

The Panel finds that the Complainant provided sufficient evidence that the disputed domain name was registered and is being used in bad faith based on the following:

- The nature of the disputed domain name – identical to Complainant's trademark and the timing of the registration of the disputed domain name – December 10, 2023, many years after the Complainant obtained protection for its trademarks. The nature of the disputed domain name indicates that the Respondent was most likely aware of the Complainant and its trademark when he registered the disputed domain name. The fact that the Respondent is based in France, the same country as Complainant's place of business also indicates likely knowledge of the Respondent.

- The strength of the "BNP PARIBAS" trademarks. The Panel notes that the Complainant provided only limited evidence of well-known character of its trademarks (screenshots of Complainant's own website that contain company's profile and reference to previous UDRP decisions involving the Complainant and its "BNP PARIBAS" trademark). Normally, more evidence is required to establish that a trademark is well-known/ has a strong reputation (e.g. evidence of awards, publications by independent sources, media reports, etc.). However, this is not fatal to the Complainant's case taking into account other evidence available as well as facts of the dispute. Previous UDRP decisions relating to the Complainant's trademarks in Complainant's favor, some of which are referred to in the complaint, could be an additional indication of popularity of the Complainant's trademarks. While each UDRP case is unique and has its own set of facts, previous decisions in Complainant's favor in similar circumstances can demonstrate that the Complainant's mark was already targeted by cybersquatters and enjoys reputation (see e.g. **CAC Case No. 104755**: "Given the distinctiveness of the Complainant's prior mark, confirmed by several UDRP decisions, the Respondent's choice to add non distinctive letters to the BNP PARIBAS Trademark could not have been for a mere chance without actual knowledge of the Complainant's rights in such mark and the intention to exploit its reputation…" and **CAC Case No. 104330**: "Considering the worldwide reputation of Complainant's Company and Registered Trademarks, the Panel finds it very unlikely that Respondent was unaware of the existence of Complainant and its trademark…").

- Passive holding of the disputed domain name in the circumstances of this case indicates Respondent's bad faith. The WIPO Overview 3.0 states that "from the inception of the UDRP, panelists have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding" and the panelists "will look at the totality of the circumstances in each case" (sec. 3.3). The Panel notes that passive holding per se does not demonstrate bad faith. However, the totality of the circumstances of this dispute proves bad faith of the Respondent, in particular: i) strength of the Complainant's mark (even taking into account certain shortcomings in Complainant's evidence) and timing of registration of the disputed domain name, ii) the nature of the disputed domain name, iii) failure of the Respondent to respond and take part in this proceeding and iv) the implausibility of any good faith use to which the domain name may be put – the Panel does not find any circumstances under which the Respondent could legitimately use the disputed domain name that is so closely associated with the Complainant and is identical to Complainant's trademarks and its business name. Any possible explanation of a potential legitimate use is solely within the Respondent's knowledge and the Respondent failed to respond and provide any explanations.

Based on the above, the Panel finds that Respondent's behavior falls within, at least, par. 4 b (iv) of UDRP and the Respondent by using the disputed domain name has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement and that the Respondent takes unfair advantage of the Complainant's mark.

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. **bnpparibas.fun**: Transferred

PANELLISTS

Name	**Igor Motsnyi**

DATE OF PANEL DECISION 2024-01-19

Publish the Decision