Decision for dispute CAC-UDRP-106326

Case number	CAC-UDRP-106326
Time of filing	2024-03-05 17:29:48
Domain names	bnpparibas.ist

Case administrator

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

Complainant

Organization	BNP PARIBAS

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	1337 Services LLC

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 proved to be the owner of the following trademarks:

- International trademark reg. no. 728598 for BNP PARIBAS since 2000-02-23;
- International trademark reg. no. 745220 for BNP PARIBAS since 2000-09-18;
- International trademark reg. no. 876031 for BNP PARIBAS since 2005-11-24.

The Complainant also owns the following domain names:

- <bnpparibas.com>, registered since 1999-09-02;
- <bnpparibas.net>, registered since 1999-12-29;
- <bnpparibas.pro>, registered since 2008-07-23.

FACTUAL BACKGROUND

The Complainant

The Complainant "BNP PARIBAS" is an international banking group with a presence in numerous countries, and one of the largest

banks in the world. With nearly 183,000 employees and €11.2 billion in net profit, the Complainant stands as a leading bank in the Eurozone and a prominent international banking institution.

The Respondent

The Respondent is 1337 Services LLC. The disputed domain name was registered on 2023-02-09 and resolves to a page without any substantial content.

PARTIES CONTENTIONS

COMPLAINANT:

As regards the first element of the Policy, the Complainant supports that the disputed domain name is identical to the "BNP PARIBAS" trademarks. The addition of the gtld ".IST" does not impact on the confusing similarity assessment in view of its technical function.

As regards the second element of the Policy, the Complainant denies that the Respondent has been authorized to use the trademark "BNP PARIBAS" in the disputed domain name. Moreover, according to the Complainant, the disputed domain name is not used to offer bona fide goods and services or in a legitimate non-commercial or fair manner.

As regards the third element of the Policy, the Complainant supports that the disputed domain name is registered and used in bad faith.

RESPONDENT:

The Respondent did not file an administrative reply to the Complaint.

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

1. The disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

The Panel agrees that the disputed domain name is confusingly similar to the Complainant’s registered trademark as it is entirely composed by the trademark "BNP PARIBAS".

The gTLD ".IST" should be disregarded in view of its technical function.

As a consequence, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks, for the purposes of the First Element of the Policy.

2. The Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not submitted a response to the Complaint. Therefore, it has filed no information on possible rights or legitimate interests it might hold on <bnpparibas.ist >. On its part, the Complainant submitted information and arguments which, according to the Panel, are sufficient to conclude that the Respondent has no rights or legitimate interest in the disputed domain name.

According to the information provided by the Complainant, and not contested, the Respondent is not commonly known by the disputed domain name nor he has been authorized to use the Complainant's trademark. The Panel adds that the Whois information does not provide any element in support of a legitimate interest in registering the disputed domain name.

Currently the disputed domain name resolves to an inactive webpage. Thus, <bnpparibas.ist> is not used in a fair and legitimate manner for the purpose of the Second element of the Policy.

All above considered the Panel takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name.

3. The disputed domain name has been registered and is being used in bad faith.

The Panel finds the following circumstances as material in order to establish the Respondent's bad faith in the registration of the disputed domain name:

(i) the disputed domain name was registered well after the Complainant acquired rights on the trademarks BNP PARIBAS;

(ii) the Complainant's trademark is known in the banking/financial field at least in Europe. The reputation of the BNP PARIBAS trademarks makes it very improbable that the Respondent was not aware of the Complainant's exclusive rights at the time of the registration of the disputed domain name;

(iii) the disputed domain name is identical to the BNP PARIBAS trademarks. According to previous panels, identical domain names carry a higher risk of affiliation with the Complainant's trademark and this element is relevant in assessing bad faith.

As regards use in bad faith, the Panel notes that the disputed domain name is not actively used. According to a consistent case law non-use does not exclude a finding of use in bad faith (the Telstra Corporation Limited v. Nuclear Marshmallows Case No. D2000-0003 is the case decision in the field of domain name passive holding). In the Panel's view the reputation of the BNP PARIBAS excludes that the identical disputed domain name could be used in a way that would not infringe the Complainant's trademarks. For this reason, the Panel takes the view that <bnpparibas.ist> is used in bad faith.

All above considered the Panel considers that the disputed domain name was registered and is used in bad faith for the purpose of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **bnpparibas.ist**: Transferred

PANELLISTS

Name	**Andrea Mascetti**

DATE OF PANEL DECISION 2024-04-08

Publish the Decision