

## **ADMINISTRATIVE PANEL DECISION**

Stichting BDO v. Domain Admin, Domain Privacy Service FBO Registrant /  
Dustin Hay, Live Health Center  
Case No. D2022-2985

### **1. The Parties**

The Complainant is Stichting BDO, Netherlands, represented by McDermott Will & Emery LLP, United States of America (“United States” or “USA”).

The Respondent is Domain Admin, Domain Privacy Service FBO Registrant, United States / Dustin Hay, Live Health Center, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <bdousa.org> (the “Domain Name”) is registered with FastDomain, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 12, 2022. On August 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On August 12, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on August 16, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on August 20, 2022.

The Center verified that the Complaint, together with the amended Complaint, satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 19, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 23, 2022.

The Center appointed Geert Glas as the sole panelist in this matter on September 28, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Complainant is Stichting BDO. In the fields of accounting, taxation, consulting, and advice and other professional services, the Complainant is a well-known international network of public accounting firms providing such services under the name BDO and dating back to 1963. Through the years, the BDO marks have acquired a substantial reputation within the financial services industry.

The Complainant owns over 350 trademark registrations and applications in 173 territories for various BDO marks. In the USA, the Complainant owns a number of trademarks including the following:

The word mark BDO, registration no. 4,854,142, registered on November 17, 2015, in class 9, 16, 35, 36, 41, 42, and 45;

The design mark BDO, registration no. 2,699,812, registered on March 25, 2003, in class 9, 16, 35, 36, 41, and 42.

The Domain Name was registered on August 4, 2022, and leads to an inactive website page. It appears from evidence provided by the Complainant that the Respondent has used the Domain Name to perpetuate a hiring/phishing scam using at least two email addresses featuring the Domain Name, *i.e.*, “[...]@bdousa.org”. The targeted candidates were receiving emails stating that they had been scheduled for an online job interview with the Tax Office Managing Partner of BDO USA and which were constructed to solicit information from the email contact. The emails also used the name of an actual employee of the Complainant.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The following is a summary of the Complainant’s contentions.

The Complainant request that the Domain Name be transferred on the following grounds:

(i) The Domain Name is confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant considers that the Domain Name is confusingly similar to its famous BDO trademark, regardless of the addition of “USA” as a geographic designation.

(ii) The Respondent has no legitimate interests in the Domain Name

The Complainant considers that its BDO mark is neither a generic nor descriptive term in which the Respondent might have an interest. According to the Complainant, the Respondent has not been affiliated with, licensed or permitted to use the Complainant’s BDO trademark.

Additionally, the Complainant argues that the Respondent is not making a legitimate noncommercial fair use of the Domain Name since the Domain Name leads to an inactive website page. Aside from the absence of a legitimate website, the Complainant claims that the Domain Name has been used in a hiring/phishing scam.

(iii) The Respondent has registered and is using the Domain Name in bad faith

The Complainant argues that the Domain Name was registered in bad faith since the latter could not have been unaware of the worldwide reputation of the BDO mark of the Complainant. Moreover, the Complainant considers that the Respondent is using the mark in bad faith, as it is not making a legitimate, noncommercial or fair use of the Domain Name. The Complainant further argues that the Respondent has chosen the Domain Name in view of creating confusion amongst Internet users and job seekers for the sake of its hiring/phishing scam.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

In order for the Complainant to prevail and have the Domain Name transferred to the Complainant, the Complainant must prove the following (paragraph 4(a) of the Policy):

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

The Panel will therefore deal with each of these requirements.

### **A. Identical or Confusingly Similar**

This element is divided into two parts: first, does the Complainant have rights in a relevant trademark and, second, is the Domain Name identical or confusingly similar to that trademark?

The Complainant has demonstrated that it owns numerous trademarks consisting of the letters "BDO".

The Panel observes that the Domain Name includes the Complainant's BDO mark in its entirety and adds the geographic term "USA" as well as the generic Top-Level Domain ("gTLD") ".org".

Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8). The nature of such additional terms may however bear on the assessment of the second and third elements.

The other difference between the Domain Name and the Complainant's trademark BDO is the addition of the gTLD ".org" to the said domain name, which should be disregarded in the comparison as it is of no legal significance (see *PepsiCo, Inc. v. Pepsi, SRL and EMS Computer Industry*, WIPO Case No. [D2003-0696](#); *Ahmanson Land Company v. Vince Curtis*, WIPO Case No. [D2000-0859](#) (citing in turn *Monty and Pat Roberts, Inc. v. J. Bartell*, WIPO Case No. [D2000-0300](#); *J.P. Morgan v. Resource Marketing*, WIPO Case No. [D2000-0035](#)).

Therefore, the Panel finds that the Domain Name is confusingly similar to the Complainant's BDO trademark under paragraph 4(a)(i) of the Policy.

## B. Rights or Legitimate Interests

Although the Complainant bears the ultimate burden of proof regarding all three elements of paragraph 4(a) of the Policy, the consensus is that, once the Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests, the burden of production 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, the Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy (see *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#); *Dow Jones & Company, Inc., (First Complainant) and Dow Jones LP (Second Complainant) v. The Hephzibah Intro-Net Project Limited (Respondent)*, WIPO Case No. [D2000-0704](#), and the [WIPO Overview 3.0](#), section 2.1).

The Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. Based on the evidence submitted by the Complainant, the Panel makes the following observations:

- i. The Respondent has not used the Domain Name in relation with a *bona fide* offering of goods and services.
- ii. The Respondent is not commonly known by the Domain Name.
- iii. The Respondent has not been authorized or licensed by the Complainant to use the BDO mark.
- iv. The Respondent has not made a legitimate noncommercial fair use of the Domain Name. To the contrary, the Respondent has used the Domain Name for the purpose of perpetrating a fraudulent hiring/phishing scheme, which could also tarnish the Complainant's mark and reputation.

Given that the Respondent did not reply to the Complainant's contentions and did not present any explanation for its use of the Domain Name, the Panel considers that the Complainant has satisfied its burden of proof under this element of the Policy. Moreover, the illegal use of the Domain Name for a fraudulent email scheme can never confer rights or legitimate interests upon the Respondent. [WIPO Overview 3.0](#), section 2.13. It is evident that the Respondent sought to capitalize on the risk of implied affiliation caused by the construction of the Domain Name, particularly as the Complainant's USA-based businesses identify as "BDO USA".

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name under paragraph 4(a) (ii) of the Policy.

## C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances that will be considered as evidence of the registration and use of the domain name in bad faith. Among these circumstances is the use of a domain name to intentionally attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location (paragraph 4(b)(iv) of the Policy).

### (a) Registered in bad faith

Bad faith can be established when a complainant's trademark has been shown to be well known or in wide use at the time of registering a domain name (see *Caesars World, Inc. v. Forum LLC.*, WIPO Case No. [D2005-0517](#); *The Gap, Inc. v. Deng Youqian*, WIPO Case No. [D2009-0113](#); *Volvo Trademark Holding AB v. Unasi, Inc.*, WIPO Case No. D2005-0556). In line with previous decisions (see e.g., *Alpargatas S.A. v. Whois agent (869611973)*, *Whois Privacy Protection Service, Inc. / Alan Vitor, Leite Santos*, WIPO Case No. [D2020-1325](#); *Alpargatas S.A. v. LeylaLeyla Leyla*, WIPO Case No. [DNL2015-0030](#); and *Alpargatas S.A. v.*

*Domain Admin, Whoisprotection.cc / Rizky Fauzy, Busana/Pakaian -- PT Kanmo Retailindo Havaianas Indonesia, WIPO Case No. [D2020-1111](#)*).

The Panel considers that, at the time of the registration of the Domain Name, the Complainant, which offers its services under the BDO name, had already acquired an extensive and worldwide reputation and was already well-known in its field. Consequently, the Panel finds that the Respondent knew or should have known about the reputation of the BDO make of the Complainant at the time of the registration of the Domain Name.

Moreover, the registration of a domain name that reproduces a trademark in its entirety (being identical or confusingly similar to such trademark) by an individual or entity that has no relationship to that mark, without any reasonable explanation on the motives for the registration, may be suggestive of opportunistic bad faith. (See *Niantic, Inc. v. Privacy service provided by Withheld for Privacy ehf / Redde reddy*, WIPO Case No. [D2021-3801](#) (December 29, 2021)).

Seeing as the Domain Name was used to impersonate an employee from the Complainant for purposes of an employment-phishing scheme, it is evident that the Respondent was aware of and intended to target the Complainant when registering the Domain Name.

(b) Used in bad faith

The Respondent used the Domain Name to impersonate a Complainant's employee and perpetrate a hiring/phishing scam to send fraudulent emails claiming to come from the Complainant's recruitment team. Such deceiving conduct demonstrates the Respondent's bad faith in the use of the Domain Name ((see *Niantic, Inc. v. Privacy service provided by Withheld for Privacy ehf / Redde reddy*, WIPO Case No. [D2021-3801](#)).

Other panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers (see [WIPO Overview 3.0](#), section 3.4).

Moreover, UDRP panels have also found that email-based phishing schemes using a complainant's trademark in a domain name are evidence of bad faith (See *DeLaval Holding AB v. Registration Private, Domains By Proxy LLL / Craig Kennedy*, WIPO Case No. [D2015-2135](#)).

In light of these circumstances, the only plausible explanation for the Respondent's registration and use of the Domain Name appears to be the intention to trade upon the reputation of the Complainant's name and mark for commercial gain.

Therefore, the Panel finds that the Respondent has registered and used the Domain Name in bad faith under paragraph 4(a)(iii) of the Policy.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <bdousa.org> be transferred to the Complainant.

/Geert Glas/

**Geert Glas**

Sole Panelist

Date: October 12, 2022