

ADMINISTRATIVE PANEL DECISION

Stichting BDO v. lisa hinrichs, Klinks Inc
Case No. D2023-2934

1. The Parties

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

The Respondent is lisa hinrichs, Klinks Inc, United States.

2. The Domain Name and Registrar

The disputed domain name <bdo-usallp.com> is registered with GMO Internet Group, Inc. d/b/a Onamae.com (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on July 9, 2023. On July 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 11, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (REDACTED FOR PRIVACY (DT) / Klinks Inc) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 14, 2023 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 in English on July 19, 2023.

On July 14, 2023, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On July 17, 2023, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Japanese of the Complaint, and the proceedings commenced on July 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 11, 2023.

The Center appointed Masato Dogauchi as the sole panelist in this matter on August 31, 2023. 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 a member of the international BDO network of independent member firms, including BDO USA, LLP. The international network of financial services firms provides accounting, taxation, consulting, advice and other professional services under the name BDO. The network has, in total, over 111,300 global employees in more than 1,800 offices in 164 countries around the world, including in Europe, Africa and the Middle East, North and South America, and Asia.

The Complainant owns registered BDO trademarks in many jurisdictions, including:

- United States Registration for BDO, No 4,854,142, registered on November 17, 2015; and
- United States Registration for BDO, No 2,699,812, registered on March 25, 2003.

The Complainant and the member firms belonging to the BDO network also own many domain names corresponding to or containing the term "BDO", including its official domain name, <bdo.com>, registered on February 28, 1995.

The disputed domain name was registered on June 21, 2023, and resolves to a page displaying an Internet browser error message stating "[t]his site can't be reached".

5. Parties' Contentions

A. Complainant

The Complainant's contentions are divided into three parts as follows:

First, the Complainant asserts that the disputed domain name is confusingly similar to its BDO trademark. According to the Complainant, the first part of the disputed domain name is composed of the term "bdo", paired with the geographically descriptive term "usa" and the entity designation "llp", and the term "bdo" is identical to the Complainant's trademark BDO, and the terms "usa" and "llp" are significant to the Complainant because they refer to the Complainant's United States-based business. Consumers would view the disputed domain name, or any email addresses using the "@bdo-usallp.com" extension, as relating to, or originating from, the Complainant's US services offerings. And, it should be considered that the addition of the generic Top-Level Domain ("gTLD"), ".com", to the disputed domain name is without legal significance in this confusing similarity test.

Second, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant contends that the Respondent is not commonly known by the disputed domain name, nor were the Respondent known as such prior to the date on which the disputed domain name was registered. The Complainant confirms that the Respondent is neither affiliated with, nor has it been licensed or permitted to use the Complainant's BDO marks or any domain names incorporating the term "BDO". Moreover, the Complainant contends that the passive holding of a disputed domain name is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use, which shows that the Respondent has no legitimate interests in respect of the disputed domain name.

Third, the Complainant asserts that the disputed domain name has been registered and is being used in bad faith. The Complainant contends that, given the Complainant's worldwide reputation and the ubiquitous presence of the BDO marks on the Internet, the Respondent should have been aware of the BDO trademarks prior to registering the disputed domain name. With regard to the bad faith use, the Complainant contends that the passive holding of the disputed domain name without a legitimate Internet purpose should be considered to indicate that the disputed domain name is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

6.1. Preliminary Issue: Language of the Proceeding

In respect of the language to be used in the administrative proceeding, in accordance with the Rules, paragraph 11(a), the language of the administrative proceeding shall be, in principle, the language of the registration agreement. However, the same provision allows the panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

In the present case, the Registrar has confirmed that the language of the Registration Agreement is Japanese. However, the Panel determines that the language of this proceeding shall be English rather than Japanese on the following grounds:

- the Complainant requested to that effect;
- the Respondent surely has become aware of this case filed by the Complainant and did not reply to the notification in both English and Japanese by the Center that the Respondent was invited to indicate its objection, if any, to the Complainant's request for the language of the proceeding being English by the specified due date;
- the disputed domain name is not in Japanese but in Latin script;
- the use of the Japanese language would produce undue burden on the Complainant in consideration of the absence of a Response from the Respondent.

6.2. Substantive Matters

In accordance with the Rules, paragraph 15(a), a panel shall decide a case on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable. Since the Respondent has not made any substantive arguments in this case, the following decision is rendered on the basis of the Complainant's contentions and other evidence submitted by the Complainant.

In accordance with the Policy, paragraph 4(a), in order to qualify for a remedy, the Complainant must prove each of the following:

- (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 is being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has rights in the BDO trademark.

The disputed domain name includes the Complainant's BDO trademark in its entirety, and the first part of the disputed domain name after the term "bdo" accompanied by a hyphen is to be divided into two terms, "usa" and "llp". 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 section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The last part of the disputed domain name ".com" represents one of the gTLDs, which is irrelevant in the determination of the confusing similarity between the disputed domain name and the BDO trademark.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the trademark in which the Complainant has rights.

The above requirement provided for in paragraph 4(a)(i) of the Policy is accordingly satisfied.

B. Rights or Legitimate Interests

The Panel finds that there is no evidence that shows the Respondent is commonly known by the name "BDO", "BDO USA" or "BDO USA LLP", and that the Respondent is not affiliated with the Complainant or authorized or licensed to use the Complainant's BDO trademark. And it is found that the disputed domain name resolves to an inactive page. Since the Respondent did not reply to the Complainant's contentions in this proceeding, the Panel finds on the available record that the Complainant has established an un rebutted *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. See section 2.1 of the [WIPO Overview 3.0](#).

Further, the Panel notes that the term "usa" is a geographical one and the term "llp" is a descriptive one meaning a type of business entity. In addition, the Panel notes that the name of one of the Complainant's group companies is BDO USA, LLP, the order of which is the same with that of the first part of the disputed domain name. Therefore, the nature of the disputed domain name is inherently misleading and carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

The above requirement provided for in paragraph 4(a)(ii) of the Policy is accordingly satisfied.

C. Registered and Used in Bad Faith

With regard to the requirement that the Respondent registered the disputed domain name in bad faith, since the Complainant's BDO trademark is well known, it is highly unlikely that the Respondent would not have known of the Complainant's right in the trademark at the time of registration of the disputed domain name, particularly considering the first part of the disputed domain name corresponds to the name of one of the Complainant's group companies BDO USA, LLP. Therefore, it is found that the Respondent registered the disputed domain name in bad faith.

On the other hand, with regard to the requirement that the Respondent is using the disputed domain name in bad faith, the Panel found that the disputed domain name resolves to an inactive page. Since the Respondent did not reply to the Complaint in this proceeding, the Complainant's BDO trademark is well known, and the implausibility of any good faith use to which the disputed domain name may be put by the Respondent, the Panel finds that the disputed domain name has been registered in bad faith and is being used in bad faith. See section 3.3 of the [WIPO Overview 3.0](#).

The above requirement provided for in paragraph 4(a)(iii) of the Policy is accordingly satisfied.

In conclusion, all three cumulative requirements as provided for in paragraph 4(a) of the Policy are determined to be satisfied.

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 disputed domain name <bdo-usallp.com> be transferred to the Complainant.

/Masato Dogauchi/

Masato Dogauchi

Sole Panelist

Date: September 14, 2023