

ADMINISTRATIVE PANEL DECISION

Stichting BDO v. Contact Privacy Inc. Customer 7151571251 / gregory Motto
Case No. D2022-2023

1. The Parties

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

The Respondent is Contact Privacy Inc. Customer 7151571251, Canada / gregory Motto, United States.

2. The Domain Name and Registrar

The disputed domain name <accounting-bdo.com> is registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 3, 2022. On June 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 7, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on June 9, 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 June 14, 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 June 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 4, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 12, 2022.

The Center appointed Alistair Payne as the sole panelist in this matter on July 15, 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 a Netherlands based foundation that operates an international network of financial services firms including BDO USA LLP. The BDO Network was founded in 1963 and currently has over 88,000 global employees in 1,617 offices in 167 countries around the world, including in the United States, Europe, Africa and the Middle East, North and South America, and Asia. The business of the Complainant and of the members of the BDO Network is very substantial with the United States member earning over USD 2 billion in revenue in the United States alone and the network as a whole over USD 11.8 billion in global revenue combined.

The Complainant's network provides services in the fields of accounting, taxation, consulting and advice, and other professional services under the name BDO, and is the owner of numerous trade mark registrations worldwide for or incorporating its BDO mark, including United States trade mark registration 4854142 for BDO registered on November 17, 2015, and owns a combined logo and word mark registration incorporating the BDO mark registered under United States trade mark registration number 2699812, registered on March 25, 2003. The Complainant also owns and operates numerous domain names incorporating the BDO mark, including <bdo.com> at which Internet users can find detailed information about the accounting, taxation, consulting and other services offered by the Complainant and its global network.

The disputed domain name was registered on April 22, 2022, and resolves to a page displaying an Internet browser error message stating "[t]his site can't be reached." The disputed domain name was used in connection with an employment/phishing scam.

5. Parties' Contentions

A. Complainant

The Complainant submits that it owns registered trade mark rights for its BDO mark which it says is very well reputed in the United States and internationally and is a coined term and highly distinctive.

It notes that the disputed domain name wholly incorporates the BDO mark which is clearly recognizable within it. It says that this is sufficient to support a finding of confusing similarity and the fact that the disputed domain name also contains the descriptive word "accounting" does not detract from the overall impression of the mark and in fact further establishes confusing similarity, rather than distinguishing the mark and preventing a finding of confusing similarity.

The Complainant submits that the Respondent is neither affiliated with it, nor has it been licensed or permitted to use the Complainant's BDO marks, or any domain names incorporating those marks. It also says that its BDO mark is not a generic or descriptive term in which the Respondent might have an interest. The Complainant also submits that the Respondent is not commonly known by the disputed domain name and that according to the information provided by the Registrar the Respondent's real name is "Gregory Motto" and therefore the Respondent is not commonly known by the disputed domain name. Further, says the Complainant in making an inactive holding of the disputed domain name the Respondent is neither making a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name.

The Complainant submits that the Respondent has used the disputed domain name to impersonate an employee of Complainant to perpetrate a financial fraud/phishing scam by soliciting invoice payments from the Complainant's clients or contacts and has submitted evidence of an email chain in which an email sent

from "xxxxx @accounting-bdo.com" requested payment of a fake invoice as if it was the Complainant requesting payment for accounting services rendered and in this case the Respondent appears to have fraudulently obtained payment to a bank account associated with it of an invoice for USD 163,000.

In terms of registration in bad faith the Complainant says that when the Respondent registered the disputed domain name in April 2022 it must have been aware of the Complainant's business and distinctive coined mark which the Complainant has used in many countries worldwide since commencing business under the BDO mark in 1963 and its first registration of the mark in 2003.

The Complainant submits that the Respondent's intention to register the disputed domain name in bad faith is apparent, not only from the use that the Respondent has made of it to support a phishing scheme and fraudulently obtaining payments as described under Part B above, but also because it appears that the Respondent has a past history of such activity in that it appears to be connected with the named Respondent in *Stichting BDO v. Domains By Proxy, LLC / Name Redacted*, WIPO Case No. [D2022-1327](#) in which the Respondent was conducting near identical fraudulent activities by passing itself off as the Complainant and submitting fake invoices to the Complainant's clients for payment. This says the Complainant amounts to a pattern of conduct by engaging in registering "BDO" formative domain names for the purposes of commercial fraud.

The Complainant asserts that the phishing scheme and use of an email address based on the disputed domain name to fraudulently obtain payment of invoices as if it is the Complainant and as described under Part B above, amounts to registration and use of the disputed domain name in bad faith in terms of paragraph 4(b)(iv) of the Policy in that it is an intentional attempt to use the disputed domain name in bad faith to intentionally mislead and confuse the public into believing that the Respondent is associated or affiliated with the Complainant for misleading or fraudulent purposes.

B. Respondent

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

6. Discussion and Findings

The Complainant filed an additional submission dated June 24, 2022 prior to the due date for Response. This submission contained specific evidence that had just come to the Complainant's attention of the alleged fraudulent activities of the Respondent, including email chain evidence of the fraud. The Respondent had the opportunity to respond in relation to the Complainant's original allegation that the Respondent was using the disputed domain name for a phishing scheme in order to fraudulently obtain payment of fake invoices but failed to do so. The additional evidence submitted by the Complainant concerned a specific instance of the alleged conduct and did not go further than that in asserting other causes of action. Considering that the Complainant obviously did not have the evidence of this specific example of the Respondent's fraudulent activity at the time of filing and that this evidence is submitted in order to corroborate the Complainant's original allegations, then the Panel is prepared in this case to exercise its discretion to admit the additional submission to the record.

A. Identical or Confusingly Similar

The Complainant has demonstrated that it owns registered trade mark rights in various countries for its BDO word mark including in particular Registration No. 4854142 for BDO registered on November 17, 2015; and also a combined logo and word mark registration incorporating the BDO mark registered under United States trade mark registration number 2699812, which was registered on March 25, 2003. The disputed domain name wholly incorporates the BDO word mark and the Panel therefore finds that it is confusingly similar to the Complainant's registered trade mark rights for BDO. The addition of the word "accounting" does not detract from the overall impression of the recognizability of the mark in the disputed domain name and does not prevent a finding of confusing similarity. The Panel finds therefore finds that the disputed domain names

is confusingly similar to the Complainant's registered BDO mark and that the Complaint therefore succeeds under the first element of the Policy.

B. Rights or Legitimate Interests

The Complainant has submitted that the Respondent is neither affiliated with it nor has been licensed or permitted to use the Complainant's BDO marks or any domain names incorporating those marks. It has also asserted that its BDO mark is not a generic or descriptive term in which the Respondent might have an interest. The Complainant has further submitted that the Respondent is not commonly known by the disputed domain name and that according to the information provided by the Registrar the Respondent's name is "Gregory Motto" and therefore that the Respondent is not commonly known by the disputed domain name. The Complainant has also alleged that in making an inactive holding of the disputed domain name the Respondent is neither making a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name.

The Complainant has submitted evidence that the Respondent has used the disputed domain name to impersonate an employee of the Complainant to perpetrate a financial fraud/phishing scam by soliciting invoice payments from the Complainant's clients or contacts. Fraudulent conduct is not consistent with the Respondent having rights or *bona fide* or legitimate interest in the disputed domain name as further described under Part C below.

In these circumstances, the Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has failed to respond to or to rebut the Complainant's case and for these reasons and for the reasons set out under Part C below, the Panel finds that the Complaint also succeeds under this element of the Policy.

C. Registered and Used in Bad Faith

The Respondent registered the disputed domain name on April 22, 2022, many years after the date on which the Complainant first registered a trade mark containing or a word mark for BDO in the United States. The BDO mark is highly distinctive, has been used by the Complainant's group extensively in many countries, and enjoys a very substantial reputation as a result. In these circumstances the Respondent, who is also apparently based in the United States, is more likely than not to have been well aware of the Complainant's very well reputed mark and business at the date of registration of the disputed domain name. This is all the more so in circumstances, as discussed below, that the Respondent appears to have used the disputed domain name as a means of creating an email address in order to fraudulently masquerade as the Complainant for the purpose of soliciting the payment of fake invoices by the Complainant's clients.

The Complainant has presented evidence, including of correspondence between the Respondent and one of the Complainant's customers in a specific case, that the Respondent has used the disputed domain name to create an email address which it has used to act as if it is the Complainant to communicate with the Complainant's clients and to send them fraudulent invoices for payment. Based on the evidence submitted by the Complainant, this particular client was duped into paying a fraudulent invoice. Although the disputed domain name does not resolve to an active website, this is clear evidence that the Respondent has used it in relation to a fraudulent scheme to defraud the Complainant's clients of significant sums of money. This conduct is in bad faith and is exactly the conduct which the Policy aims to proscribe.

Accordingly, the Panel finds that the Respondent has both registered and used the disputed domain name in bad faith and the Complaint also succeeds under this element 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 disputed domain name, <accounting-bdo.com> be transferred to the Complainant.

/Alistair Payne/

Alistair Payne

Sole Panelist

Date: August 1, 2022