

ADMINISTRATIVE PANEL DECISION

Stichting BDO v. Contact Privacy Inc. Customer 7151571251 /
Daniel Newton, BDO USA
Case No. D2022-2073

1. The Parties

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

The Respondent is Contact Privacy Inc. Customer 7151571251, Canada / Daniel Newton, BDO USA, US.

2. The Domain Name and Registrar

The disputed domain name <bdousajobs.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 8, 2022. On June 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 8, 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 George R. F. Souter as the sole panelist in this matter on July 18, 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 an international network of financial services firms providing services under its trademark BDO since 1963. It has over 88,000 employees, operating from 1,617 offices in 167 countries. Its revenue is over 11.8 billion US dollars, over 2 billion of which emanates from the US.

The Complainant is the proprietor of over 350 registrations of its BDO trademark, including US registration number 4854142, registered on November 17, 2015.

The disputed domain name was registered on January 24, 2022, and resolves to a page displaying an Internet error message stating: "this site can't be reached".

5. Parties' Contentions

A. Complainant

The Complainant alleges that the disputed domain name is confusingly similar to its BDO trademark, comprising its BDO trademark in its entirety, together with merely descriptive or non distinctive elements.

The Complainant alleges that the Respondent lacks rights or legitimate interests in the disputed domain name, in particular, to the best of the Complainant's knowledge, the Respondent is not generally known by the disputed domain name, and the Respondent has never received permission from the Complainant to use its trademark in connection with a domain name, or otherwise.

The Complainant alleges that the disputed domain name was registered in bad faith, and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds – noting its hundreds of trademark registrations – that the Complainant has sufficient rights to its BDO trademark for the purposes of these proceedings, and recognizes that the Complainant's extensive use of its BDO trademark will also have resulted in the Complainant having acquired significant common law rights to its BDO trademark.

It is well established in prior decisions under the UDRP, with which the Panel agrees, that a generic Top-Level Domain ("gTLD") may generally be disregarded when comparing a trademark with a disputed domain name. The Panel considers the gTLD ".com" to be irrelevant in the circumstances of the present case, and finds that it may be disregarded here.

The Complainant's BDO trademark is clearly recognizable in the disputed domain name, rendering the disputed domain name confusingly similar to the Complainant's trademark, and the mere addition of the

geographical term “usa” and the word “jobs” do not detract from this finding.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in connection with the disputed domain name at issue.

B. Rights or Legitimate Interests

It is the consensus view of UDRP panels, with which the Panel agrees, that a *prima facie* case advanced by the complainant will generally be sufficient for the complainant to be deemed to have satisfied the requirement of paragraph 4(a)(ii) of the Policy, provided the respondent does not come forward with evidence demonstrating rights or legitimate interests in the domain name and the complainant has presented a sufficient *prima facie* case to succeed under paragraph 4(a)(ii) of the Policy.

The Respondent did not advance any claim of rights or legitimate interests in the disputed domain name to rebut this *prima facie* case.

Furthermore, the nature of the disputed domain name, incorporating the Complainant’s well-known BDO trademark and adding in particular the term “jobs”, carries a risk of implied affiliation. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 2.5.1.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy, in connection with the disputed domain name.

C. Registered and Used in Bad Faith

The Panel is of the view that the finding that a respondent has no rights or legitimate interests in a disputed domain name can lead, in appropriate circumstances, to a finding of registration of a disputed domain name in bad faith. The circumstance of the present case, in which the Panel regards it as self-evident that the Complainant’s DBO trademark was deliberately appropriated in the disputed domain name are such that the Panel concludes that a finding of registration in bad faith is justified, in connection with the disputed domain name and so finds.

Although the disputed domain name is not currently being commercially used, it is well-established in prior decisions under the Policy, since the decision in *Telstra Corporation v Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), that the non-use of a disputed domain name does not preclude a finding of use in bad faith under the doctrine of passive holding. In the circumstances of the present case, where any commencement of use of the disputed domain name would logically imply affiliation to the Complainant, the Panel considers that a finding of use in bad faith is clearly justified, and so finds.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of 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 disputed domain name, <bdousajobs.com> be transferred to the Complainant.

/George R. F. Souter/
George R. F. Souter
Sole Panelist
Date: August 1, 2022