

ADMINISTRATIVE PANEL DECISION

BNP PARIBAS v. Contact Privacy Inc. Customer 7151571251 / Martin
Case No. D2022-2795

1. The Parties

The Complainant is BNP PARIBAS, France, represented by Nameshield, France.

The Respondent is Contact Privacy Inc. Customer 7151571251, Canada / Martin, Poland.

2. The Domain Name and Registrar

The disputed domain name <bnp-paribas.group> (the “Domain Name”) is registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 29, 2022. On July 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On July 29, 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 1, 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 1, 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 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 25, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 26, 2022.

The Center appointed Wolter Wefers Bettink as the sole panelist in this matter on August 31, 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 banking group with a presence in 68 countries, with nearly 190,000 employees and EUR 46.2 billion in revenues in 2020.

The Complainant holds *inter alia* the following trademarks (the "Trade Marks"):

- the International word mark BNP PARIBAS, registered under No. 728598 since February 23, 2000;
- the International device mark BNP PARIBAS, registered under No. 745220 since September 18, 2000;
- the International word mark BNP PARIBAS, registered under No. 876031 since November 24, 2005.

The Domain Name was registered on July 25, 2022 and redirects to the Complainant's English language website under the domain name <group.bnpparibas>.

5. Parties' Contentions

A. Complainant

The Complainant states that the Domain Name is identical to the Trade Marks, as it contains the Trade Marks in their entirety. The Complainant contends that the addition of the generic Top-Level Domain ("gTLD") ".group" does not change the overall impression of the Domain Name as being connected to the Trade Marks. Therefore, the Complainant concludes, the Domain name is confusingly similar to the Trade Marks.

The Complainant asserts that the Respondent is not known in relation to the Domain Name in the Whois database, and has not acquired trademark rights in the Domain Name. The Complainant submits that the Respondent has no rights or legitimate interest in respect of the Domain Name and that he is not related in any way to the Complainant's business. The Complainant states that the Respondent is not affiliated with it nor authorized by it in any way to use the Trade Marks and that it does not carry out any activity for, nor has any business with the Respondent. Furthermore, the Complainant points out that the Domain Name redirects to the Complainant's official website under the domain name <group.bnpparibas> and contends that thereby, the Respondent is not making a *bona fide* offering of goods or services by means of the Domain Name, or a legitimate noncommercial or fair use of it.

According to the Complainant, the Respondent registered the Domain Name in bad faith. The Complainant submits that the Respondent had knowledge of the Trade Marks prior to the registration of the Domain Name since the Trade Marks are well-known and the Domain Name is confusingly similar to the Trade Marks. The Complainant submits that the Respondent also uses the Domain Name in bad faith since it only registered the Domain Name in an effort to take advantage of the good reputation of the Trade Marks, with the sole aim to create a likelihood of confusion with the Trade Marks.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has shown that it has registered rights in the Trade Marks. The Domain Name is confusingly similar to the Trade Marks as it incorporates BNP PARIBAS, of which the word marks consist and which is the dominant element of the device mark, in its entirety. The addition of a hyphen between BNP and PARIBAS does not avoid a finding of confusing similarity between the Domain Name and the Trade Marks (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.8; see also, *inter alia*, *TPI Holdings, Inc. v. Carmen Armengol*, WIPO Case No. [D2009-0361](#), and *F. Hoffmann-La Roche AG v. John Mercier*, WIPO Case No. [D2018-0980](#)). The gTLD “.group” – may be disregarded under the confusing similarity test, since it is a technical registration requirement (see [WIPO Overview 3.0](#), section 1.11). Therefore, the Panel finds that the Domain Name is confusingly similar to the Trade Marks in which the Complainant has rights.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, the second element a complainant has to prove is that a respondent lacks rights or legitimate interests in a domain name. This may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. In order to satisfy the second element, the Complainant has to make out a *prima facie* case that the Respondent does not have rights or legitimate interests in the Domain Name. If the Complainant succeeds in doing so, the burden of production on this element shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the Domain Name. If the Respondent fails to come forward with such relevant evidence, the Complainant is deemed to have satisfied the second element (See [WIPO Overview 3.0](#), section 2.1).

Based on the evidence and the undisputed submissions of the Complainant, the Panel concludes that the Respondent has not received the Complainant’s consent to use the Trade Marks as part of the Domain Name, is not commonly known by the Domain Name, and has not acquired trade mark rights in the Domain Name. In addition, the use of the Domain Name to redirect Internet users to the Complainant’s website under the domain name <group-paribas.com>, without consent from the Complainant, does not constitute a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use.

In view of the above, the Panel concludes that the Complainant has established that the Respondent has no rights or legitimate interests in the Domain Name.

C. Registered and Used in Bad Faith

Based on the information and the evidence provided by the Complainant, the Panel finds that at the time of registration of the Domain Name the Respondent was or should have been aware of the Trade Marks, since:

- the Respondent’s registration of the Domain Name occurred twenty-two years after the registration of the earliest of the Trade Marks;
- the Domain Name is not a name that the Respondent is likely to have thought of spontaneously upon registration thereof;
- a simple trade mark register search, or even an Internet search, prior to registration of the Domain Name in its name would have informed the Respondent of the existence of the Trade Marks; and,
- the nearly identical nature of the Domain Name to the Trade Marks and the choice of the gTLD “.group”, which in this case suggests that the Domain Name concerns the group of companies of the Complainant.

Moreover, panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark, such as the Complainant's Trade Marks, by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

With regard to bad faith use, the Panel finds that the following circumstances taken together are indicative of bad faith use of the Domain Name:

- the probability that the Respondent was aware or should have been aware of the Complainant's rights in the Trade Marks;
- the use of a privacy shield upon the initial registration of the Domain Name;
- the lack of a formal Response of the Respondent.

Finally, the Respondent's redirection of the Domain Name to the Complainant's website constitutes bad faith insofar as the Respondent retains control over the redirection, thus creating a real or implied ongoing threat to the Complainant (see [WIPO Overview 3.0](#), section 3.1.4).

Therefore, the Panel concludes that the Domain Name has been registered and is being used in bad faith.

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 <bnp-paribas.group> be transferred to the Complainant.

/Wolter Wefers Bettink/

Wolter Wefers Bettink

Sole Panelist

Date: September 12, 2022