

ADMINISTRATIVE PANEL DECISION

KPMG International Cooperative v. lisajoanna235 Joanna, kpmg-oilandgas
Case No. D2022-3718

1. The Parties

The Complainant is KPMG International Cooperative, Netherlands, represented by Taylor Wessing LLP, United Kingdom.

The Respondent is lisajoanna235 Joanna, kpmg-oilandgas, India.

2. The Domain Name and Registrar

The disputed domain name <kpmg-oilandgas.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 5, 2022. On October 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 6, 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 October 7, 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 October 10, 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 October 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 6, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 7, 2022.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on November 11, 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 members of the KPMG network of independent firms are affiliated with the Complainant. The KPMG member firms operate in 147 countries, with more than 219,000 employees. The Complainant owns the trademark KPMG and licenses its use to the KPMG member firms worldwide.

The Complainant owns over 480 trademark registrations containing the name KPMG around the world, including United States of America trademark registration Number 2339547 and European Union Trade Mark (“EUTM”) registration Number 1011220 for the word mark KPMG, in relation to auditing, taxation services, and advisory services in classes 35 and 36 (among other goods and services), registered on (respectively) April 11, 2000 and April 25, 2000 (filed on December 3, 1998). The Complainant also owns EUTM registration Number 1179662 for the figurative mark KPMG, in relation to auditing, taxation services and advisory services in classes 35 and 36 (among other goods and services), filed on May 20, 1999.

The global and member firm KPMG websites operate mainly from the domain name <kpmg.com>, whereas the Complainant itself operates the global KPMG website at “home.kpmg/uk/en/home.html”.

The disputed domain name was registered on April 16, 2022.

The disputed domain name resolves to a hosting parking website but has been used to impersonate officers of KPMG by way of fraudulent emails.

5. Parties’ Contentions

A. Complainant

The Complainant and its member firms have been ranked consistently for many years as one of the “Big Four” professional services firms, together with Deloitte, Ernst & Young (EY), and PricewaterhouseCoopers (PwC). Its origins span three centuries. The network has therefore been using the trademark KPMG for over 30 years. The combined global revenues of the KPMG member firms in 2018 were USD 28.96 billion. The Complainant points out that the KPMG brand has been highly ranked in a number of global brand rankings. The Complainant also says that it has established very substantial international rights in the trademark KPMG, a mark said to be inherently distinctive and non-descriptive, and famous throughout the world.

The Complainant contends that the disputed domain name is confusingly similar to the KPMG trademark, as it contains the name KPMG in its entirety, combined with “-oilandgas.com”. The first and dominant part of the disputed domain name is said to be identical to the distinctive KPMG trademark. Further, the Complainant points out that the combination of “-oilandgas” with ‘KPMG’ conveys the meaning that the disputed domain name relates to the professional support KPMG offers to companies in the oil and gas industries.

The Complainant asserts that the Respondent has no rights or legitimate interests in the disputed domain name, and that the latter does not resolve to a valid website. Moreover, the Complainant says that the disputed domain name has on at least one occasion been used in a fraudulent scam, using the email address [...]@kpmg-oilandgas.com, to invite clients [...] of the Complainant via email to complete a job offer application form following the purported submission of a CV to a “Recruitment team”. A client of the Complainant was required to send scanned copies of an “Education Certificate” and a “valid Passport” within

“24 hours” in order to “enter an agreement” with the Respondent. The Respondent used the email address incorporating the disputed domain name, that being ‘[...]@kpmg-oilandgas.com’, to masquerade as a genuine member of KPMG’s Board of Directors in Canada. The Complainant does not in reality have any connection with the Respondent who thus used the email address incorporating the disputed domain name to perpetrate a fraud on an unsuspecting recipient by initially obtaining personal information. The Complainant says there is no possible *bona fide*, noncommercial or legitimate use of the disputed domain name, and that there is no evidence that the Respondent is commonly known by the latter.

In terms of bad faith, the Complainant says that the disputed domain name was registered primarily for the purpose of targeting a third party by way of a serious, unlawful and fraudulent email scam to elicit personal information. The Complainant contends that the Respondent is intentionally attempting to opportunistically attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s KPMG mark as to the source, sponsorship, affiliation, or endorsement of the disputed domain name.

In conclusion, the Complainant says that the Respondent’s registration, referenced fraudulent use, and any other use, of the disputed domain name will disrupt the business and image of the KPMG network by misleading members of the public into believing that the disputed domain name is connected with KPMG. It will also impede members of the public, who are searching for genuine KPMG websites.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The disputed domain name is not identical to the KPMG trademark of the Complainant. However, it includes the KPMG mark in its entirety. That mark is immediately recognizable in the disputed domain name. The addition of the terms “oilandgas” does not prevent a finding of confusing similarity under the first element.

Therefore the Panel holds that the disputed domain name is confusingly similar to the KPMG trademark of the Complainant.

B. Rights or Legitimate Interests

There is no evidence before the Panel that the Respondent has any rights or legitimate interests in the disputed domain name. The Complainant has not licensed or authorized the use of the distinctive KPMG trademark by the Respondent, nor its inclusion in the disputed domain name. The Respondent has not reacted to the contentions of the Complainant. The disputed domain name does not resolve to a website in a manner that could have found a contention that the Respondent has acquired rights or legitimate interests in it. The only evidence of use of the disputed domain name, relates to its inclusion in an email address with fraudulent intent, that being for the purpose of obtaining private information from email recipients. This is not a *bona fide*, legitimate or acceptable noncommercial activity. It is not activity of a kind that would vest rights or legitimate interests in a party that engages in it.

Therefore the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

At the time the disputed domain name was registered, the Complainant already had longstanding rights in the KPMG registered trademark. The mark was taken into use 30 or so years ago. It is unimaginable that the Respondent was not aware of the Complainant’s rights in the Complainant’s highly distinctive and widely

recognized mark, a fact further underscored by the composition of the disputed domain name itself. The latter suggests a deliberate attempt to suggest that the disputed domain name is connected with oil and gas industry-related services offered by the Complainant. Furthermore, the disputed domain name has demonstrably been used in a fraudulent attempt to impersonate one of the officers of a Complainant-affiliated firm, for the purpose of obtaining private information, including passport copies. This is clearly a bad faith activity carefully and deliberately crafted by the Respondent, with a fraudulent purpose.

Therefore the Panel holds that the disputed domain name was registered and 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, <kpmg-oilandgas.com>, be transferred to the Complainant.

William A. Van Caenegem

Sole Panelist

Date: November 25, 2022