

ADMINISTRATIVE PANEL DECISION

Stichting BDO v. Robert Iho, amex
Case No. D2022-4353

1. The Parties

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

The Respondent is Robert Iho, amex, United States.

2. The Domain Name and Registrar

The disputed domain name <bdousallp.com> (the “Domain Name”) is registered with Key-Systems GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 15, 2022. On November 16, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On November 17, 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 (On behalf of bdousallp.com OWNER / c/o whoisproxy.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 17, 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 November 21, 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 November 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 18, 2022. The Center received an email communication from a third party on December 3, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 20, 2022.

The Center appointed Vincent Denoyelle as the sole panelist in this matter on December 23, 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 public accounting, tax, consulting, and business advisory firms. One of the Complainant's business names in the United States of America is BDO USA, LLP.

The Complainant is the owner of several BDO trade mark registrations, including the following:

- United States trade mark BDO, registered on November 17, 2015, under registration No. 4,854,142 in classes 9, 16, 35, 36, 41, 42, and 45.

The Complainant owns several domain names reflecting its BDO trade marks including <bdo.com> which it registered in 1995.

The Domain Name was registered on November 9, 2022. The Domain Name resolves to the holding page of a hosting provider.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to the BDO trade mark in which the Complainant has rights, as the Domain Name incorporates the entire BDO trade mark of the Complainant with the mere addition of the geographic designation "USA", along with "lllp" which is a misspelling of the corporate entity descriptor "LLP". The Complainant considers that such additions do not prevent confusing similarity between the Domain Name and the Complainant's trade mark.

The Complainant asserts that the BDO trade mark is not a generic or descriptive term in which the Respondent might have a legitimate interest and adds that the Complainant's BDO trade marks are globally recognized and have acquired secondary meaning through the Complainant's substantial, continuous, and exclusive use of the trade marks in connection with the Complainant's goods and services. According to the Complainant, the Respondent is neither affiliated with, nor has it been licensed or permitted to use the Complainant's BDO trade marks or any domain names incorporating the BDO trade marks. The Complainant asserts that the Respondent is not commonly known by the Domain Name. The Complainant contends that under the present circumstances, the fact that the Domain Name points to a hosting provider holding page is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use. Finally, the Complainant alleges that the Domain Name has been used in order to create email addresses to facilitate a phishing scam.

The Complainant contends that the Respondent has registered the Domain Name with full knowledge of the Complainant's BDO trade mark and the Complainant refers to prior UDRP panels' findings that the Complainant's BDO trade mark is distinctive and that the Complainant has demonstrated a long standing and widespread use of its BDO trade mark. The Complainant considers that the reproduction of the BDO trade mark of the Complainant in the Domain Name creates a presumption of bad faith given the well-known nature of the BDO trade mark. In terms of use of the Domain Name in bad faith, the Complainant contends that the passive holding of the Domain Name amounts to use in bad faith given the overall circumstances of the case, including the renown of the BDO trade mark. The Complainant considers that it is impossible to imagine any plausible legitimate use of the Domain Name by the Respondent, especially in view of the global reach of the Complainant and the well-known and distinctive character of its BDO trade mark.

The Complainant also alleges that the Domain Name has been used in order to create email addresses to facilitate a phishing scam. The Complainant concludes that the Domain Name has been registered and is being used in bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions. However, an informal communication was received from a third party (whose name differs from the name of the Respondent) claiming that their postal address was misappropriated by the Respondent as part of the contact details provided for registration of the Domain Name.

6. Discussion and Findings

In order to prevail the Complainant must substantiate that the three elements of paragraph 4(a) of the Policy have been met for the Domain Name, namely:

- (i) the Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

In light of the evidence provided by the Complainant, the Panel is satisfied that the Complainant has substantiated that it holds valid trade mark rights in the BDO trade mark, which is reproduced in its entirety in the Domain Name.

The second point that has to be considered is whether the Domain Name is identical or confusingly similar to the BDO trade mark in which the Complainant has rights.

At the second level, the Domain Name incorporates the entire BDO trade mark with the mere addition of the terms "usa" and "llp". The Panel finds that the BDO trade mark of the Complainant is instantly recognizable in the Domain Name and that the terms added to the Complainant's BDO trade mark do not prevent a finding of confusing similarity arising from the incorporation of the Complainant's exact BDO trade mark in the Domain Name.

Then there is the addition of the generic Top-Level Domain ("gTLD") ".com". As is generally accepted, the addition of a gTLD (such as ".com") is merely a technical registration requirement and as such is typically disregarded under the first element confusing similarity test.

Thus, the Panel finds that the Domain Name is confusingly similar to a trade mark or service mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out relevant circumstances that could demonstrate that a respondent has rights or legitimate interests in a domain name, namely:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate [the respondent's] rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to [the respondent] of the dispute, [the respondent's] use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a

bona fide offering of goods or services; or

(ii) [the respondent] (as an individual, business, or other organization) ha[s] been commonly known by the domain name, even if [the respondent] ha[s] acquired no trade mark or service mark rights; or

(iii) [the respondent] is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.”

Numerous previous UDRP panels have found under the UDRP that once the Complainant makes a *prima facie* showing that the respondent does not have rights or legitimate interests in the domain name, the burden of production shifts to the respondent to rebut the showing by providing evidence of its rights or legitimate interests in the domain name.

Having reviewed the Complainant's assertions and evidence, the Panel is satisfied that the Complainant has made a *prima facie* case showing that the Respondent does not have rights or legitimate interests in the Domain Name.

There is no indication that the Respondent is commonly known by the Domain Name. The Complainant has stated that the Respondent has no rights in the Domain Name and has not been authorized by the Complainant to make any use of its BDO trade mark.

The fact that the Domain Name does not seem to direct to an active website suggests that the Domain Name is held passively by the Respondent. Given the overall circumstances of the present case including the renown of the BDO trade mark of the Complainant, the passive holding of the Domain Name cannot be considered *bona fide*, legitimate, or fair.

While the Complainant has claimed use of the Domain Name for a fraudulent email scheme, the evidence is limited to an alert by the Complainant's "Security Operations" as to the active MX records associated with the Domain Name. In the Complaint itself, the Complainant has provided an email address connected to the Domain Name (e.g., "[...]@bdousallp.com") that allegedly impersonated the Complainant's Chief Executive Officer, but no email has been provided into evidence. Accordingly, the Panel is reluctant to make a finding regarding the alleged use of the Domain Name for a fraudulent email scheme based on the limited evidence. However, further to the Panel's finding below on the risk of affiliation to the Complainant, the intent of the Respondent to impersonate or cause confusion with the Complainant via the Domain Name seems apparent and as such no rights or legitimate interests could vest in the Respondent.

Furthermore, the nature of the Domain Name, incorporating the Complainant's trade mark and additional terms related to a particular business entity that is part of the Complainant's group of companies, carries a risk of implied affiliation and cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 2.5.1.

Thus, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a number of relevant non-exhaustive circumstances, which can be deemed to constitute evidence of registration and use of a domain name in bad faith, namely:

“(i) circumstances indicating that [the respondent has] registered or acquired [a disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trade mark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the respondent's] documented out-of-pocket costs directly related to the domain name; or

(ii) [the respondent has] registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or

(iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location."

Given the circumstances described in the Complaint and the documentary evidence provided by the Complainant, the Panel finds that the Domain Name was registered in bad faith.

The Domain Name reproduces the exact BDO trade mark of the Complainant and this cannot be a coincidence. The Complainant has provided evidence of the goodwill and renown of the BDO trade mark and this has been recognized by previous UDRP panels under the Policy. Therefore, the fact that the Respondent decided to register the Domain Name reproducing the exact BDO trade mark of the Complainant strongly suggests that the Respondent had the Complainant's BDO trade mark in mind and targeted it specifically at the time of registering the Domain Name.

This is even more likely given (i) the fact that the Domain Name was registered relatively recently and many years after the registration of the Complainant's BDO trade mark, and (ii) the choice of additional terms appended to the BDO trade mark which essentially refer to a particular business entity that is part of the Complainant's group of companies.

Thus, the Panel finds that the Domain Name was registered in bad faith.

As for use of the Domain Name in bad faith, given the circumstances described in the Complaint and the documentary evidence provided by the Complainant, the Panel is satisfied that the Domain Name is being used in bad faith.

The Domain Name is being held passively as it directs to a hosting provider holding page and this type of use can be seen as passive holding of the Domain Name. Whilst there might be an underlying malevolent use of the Domain Name to impersonate the Chief Executive Officer of the Complainant, there is no conclusive evidence in this respect provided by the Complainant. In any event, passive use itself would not prevent a finding of the Respondent's bad faith given the overall circumstances here, noting in particular the renown of the Complainant's BDO trade mark, the Respondent's failure to rebut the Complainant's contentions, the Respondent's use of a privacy service to mask its details, and the Respondent's fraudulent registration of the Domain Name using contact details associated with a third party. Indeed, given the substantial goodwill and reputation of the Complainant's BDO trade mark, it is difficult to conceive that there could be any actual or contemplated good faith use of the Domain Name (see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

Thus, the Panel finds that the Domain Name is being used in bad faith.

Accordingly, the Complainant has met its burden of showing that the Domain Name was 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 Domain Name, <bdousallp.com>, be transferred to the Complainant.

/Vincent Denoyelle/

Vincent Denoyelle

Sole Panelist

Date: January 6, 2023