

ADMINISTRATIVE PANEL DECISION

Stichting BDO v. Kenneth Machado
Case No. D2022-4750

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 Kenneth Machado, Philippines.

2. The Domain Name and Registrar

The disputed domain name <bdo-online.net> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on December 10, 2022. On December 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 13, 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 (Whois Privacy Protection Service by onamae.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 14, 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 in English on December 17, 2022.

On December 14, 2022, the Center notified the Parties in both English and Japanese that the language of the registration agreement for the disputed domain name is Japanese. On December 17, 2022, the Complainant requested for English to be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Japanese of the Complaint, and the proceedings commenced on December 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 11, 2023.

The Center appointed Douglas Clark as the sole panelist in this matter on January 19, 2023. 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 network of public accounting firms that dates back to 1963 and currently is situated in 167 countries around the world. The Complainant also owns and operates the domain name <bdo.com>, along with various other domain names featuring the BDO mark.

The Complainant owns over 350 trade mark registrations and applications for BDO, including the following United States trade mark registrations:

<u>Trade Mark</u>	<u>Registration Number</u>	<u>Registration Date</u>	<u>Class</u>
BDO	4,854,142	November 17, 2015	9, 16, 35, 36, 41, 42, 45
 BDO & Design	2,699,812	March 25, 2003	9, 16, 35, 36, 41, 42
PEOPLE WHO KNOW, KNOW BDO.	4,748,152	June 2, 2015	35, 42, 45

The Respondent is an individual based in the Philippines.

The disputed domain name was registered on November 15, 2022. At the date of this Complaint, the disputed domain name resolved to a security warning stating "Deceptive site ahead; Attackers on bdo-online.net may trick you into doing something dangerous like installing software or revealing your personal information (for example, passwords, phone numbers, or credit cards)".

5. Parties' Contentions

A. Complainant

The Complainant contends that:

- (a) The disputed domain name is confusingly similar to its trade mark. The disputed domain name wholly incorporates the Complainant's well-known BDO trade mark with the addition of the term "online". The generic Top-Level Domain ("gTLD") ".net" in the disputed domain name does not eliminate the overall notion that the designations are connected to the trade mark and the likelihood of confusion that the disputed domain name and the trade mark are associated;
- (b) The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not affiliated with the Complainant in any way and the Complainant has never granted any authorisation or license to use the Complainant's trade mark. The Respondent is not commonly

known by the disputed domain name, and has not made a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name; and

- (c) The disputed domain name was registered and is being used in bad faith. The mere fact that the Respondent has registered a domain name incorporating trade mark of a well-known company gives rise to an inference of bad faith. Based on the use of the disputed domain name, the Respondent registered and is using the disputed domain name to attract Internet users for commercial gain, creating a likelihood of confusion with the Complainant's trade mark.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Issues – Language of the Proceeding

According to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

In this case, the language of the Registration Agreement for the disputed domain name is in Japanese. Based on the given evidence, there is no agreement between the Complainant and the Respondent regarding the language of the proceeding. The Respondent did not respond as to the language of the proceeding. The Complainant has filed its Complaint in English and has requested that English be the language for the proceeding under the following grounds:

- a) even though the Registrar appears to be located in Japan, the Registrar provides an alternative website which appears entirely in English;
- b) the disputed domain name is in Latin script and not Japanese script; and
- c) in order to proceed in Japanese, the Complainant would have had to retain specialised translation services that would cause an unnecessary burden to the Complainant.

The Panel also notes that the Registrar has disclosed that the Respondent is an individual based in the Philippines, which has English as an official language.

In accordance with paragraph 11(a) of the Rules, the Panel hereby determines that the language of the proceeding shall be in English after considering the following circumstances:

- the Respondent very likely understands English as he or she is based in the Philippines.
- the Center has notified the Respondent of the proceeding in both English and Japanese.
- the Respondent has not commented on the language of the proceeding.
- an order for the translation of the Complaint and other supporting documents will result in significant expenses for the Complainant and a delay in the proceeding.

Further, this Panel decided in *Zappos.com, Inc. v. Zufu aka Huahaotrade*, WIPO Case No. [D2008-1191](#), that a respondent's failure to respond to a preliminary determination by the Center as to the language of the proceeding "should, in general, be a strong factor to allow the Panel to decide to proceed in favour of the language of the Complaint".

6.2 Substantive Issues

The Complainant must satisfy all three elements of paragraph 4(a) of the Policy in order to succeed in its action:

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

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name <bdo-online.net> is confusingly similar to the Complainant's trade mark. The disputed domain name incorporates the BDO trade mark in full accompanied by the word "online" and the gTLD ".net". The gTLD is generally disregarded when considering the first element (see section 1.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")).

The Panel notes that the Complainant stated in its complaint that it held registrations for BDO in many countries, it only relied on registered trademarks in the USA. It did not rely on any registered trademarks in Japan where the Registrar is located or in the Philippines where the Respondent is located. The ownership of a trademark is generally considered to be a threshold standing issue. The location of the trademark, its date of registration (or first use) and the goods and/or services for which it is registered, are all irrelevant for the purpose of finding rights in a trademark under the first element of the UDRP. These factors may however bear on a panel's further substantive determination under the second and third elements. (See section 1.1.2 of the [WIPO Overview 3.0](#))).

The Complainant has therefore satisfied the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The Respondent has not asserted any rights or legitimate interests in relation to the disputed domain name.

Section 2.1 of the [WIPO Overview 3.0](#) provides:

"While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name 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. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, 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."

The Panel finds that the Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests, which has not been rebutted by the Respondent. Accordingly, and considering the Panel's findings below, the Respondent has no rights or legitimate interests in regard to the disputed domain name.

The second element of paragraph 4(a) of the Policy is therefore satisfied.

C. Registered and Used in Bad Faith

Based on the given evidence, the Panel finds that the disputed domain name was registered and is being used in bad faith.

The disputed domain name was registered long after the Complainant has registered the BDO trade mark and the use of the Complainant's BDO trade mark in the disputed domain name cannot be a coincidence. The BDO trade mark is used by the Complainant to conduct its business and the Complainant has used the trade mark for over 20 years. The Panel is satisfied that the Respondent was aware of the Complainant and its BDO trade mark when he or she registered the disputed domain name.

At the time of this Complaint, the disputed domain name directed Internet users to a security warning for malware or other security risks. UDRP panels have held that the use of a domain name for purposes, such as malware, other than to host a website may constitute bad faith. (See section 3.4 of the [WIPO Overview 3.0](#).) Though the disputed domain name resolves to an inactive website at the date of this decision, it is well established that the lack of use of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding. (See section 3.3 of the [WIPO Overview 3.0](#).)

Moreover, UDRP panels have consistently found that the mere registration of a domain name that is confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. (See section 3.1.4 of the [WIPO Overview 3.0](#).)

For the above reasons, the Panel finds that the disputed domain name was registered and is being used in bad faith.

The Complainant has therefore satisfied the third element under paragraph 4(a) 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 <bdo-online.net> be transferred to the Complainant.

/Douglas Clark/

Douglas Clark

Sole Panelist

Date: February 3, 2023