

## **ADMINISTRATIVE PANEL DECISION**

The Bank of New York Mellon v. Martin Ponce  
Case No. D2023-1329

### **1. The Parties**

The Complainant is The Bank of New York Mellon, United States of America (“U.S.”), represented by Dinsmore & Shohl LLP, U.S..

The Respondent is Martin Ponce, Mexico.

### **2. The Domain Name and Registrar**

The disputed domain name <bnewyorkmellon.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 28, 2023. On March 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 28, 2023, 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 (Privacy Service Provided By Withheld For Privacy Ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 29, 2023, 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 amendment to the Complaint on March 29, 2023.

The Center verified that the Complaint together with the amendment to the 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 March 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 20, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 21, 2023.

The Center appointed Daniel Peña as the sole panelist in this matter on May 9, 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 global financial services and investments company.

The Complainant has used the names BNY MELLON and THE BANK OF NEW YORK MELLON continuously since 2007, when The Bank of New York Company, Inc. merged with Mellon Financial Corporation.

The Complainant is the owner of over 20 existing U.S. federal registrations for trademarks comprising or containing names BNY MELLON and THE BANK OF NEW YORK MELLON, and many others around the globe. These registrations include a registration of the mark BNY MELLON, U.S. Registration No. 3,585,488 (registration date: March 10, 2009), and a registration of the mark THE BANK OF NEW YORK MELLON, U.S. Registration No. 3,553,005 (registration date: December 30, 2008), both covering financial services.

The disputed domain name was registered on January 17, 2023.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant helps its clients manage and service their financial assets through the investment lifecycle.

The Complainant, as of December 31, 2022, had approximately USD 44.3 trillion in assets under custody and/or administration, and USD 1.8 trillion in assets under management on behalf of clients around the world.

The Complainant is one of the three oldest banking corporations in the U.S. and one of the oldest banks in the world, having been established in 1784 as the Bank of New York by a group including Alexander Hamilton. The estimated number of employees worldwide in 2022 for the Complainant was 51,700.

The Complainant trademarks have been widely promoted among members of the general consuming public and to persons in the financial industry.

The disputed domain name is confusingly similar to the Complainant's BNY MELLON trademarks.

The disputed domain name is virtually identical to the Complainant's BNY MELLON mark, with the exception that the letters NY in the Complainant's mark have been replaced with the antecedent wording "New York".

Given that the letters NY in the Complainant's mark are a shorthand reference to the phrase New York, it is clear that the disputed domain name is confusingly similar to the Complainant's BNY MELLON mark.

The domain name is also virtually identical to the Complainant's THE BANK OF NEW YORK MELLON mark, with the exception that the term "The" has been dropped, and the term "Bank" replaced with the initial "B".

The Respondent has no legitimate rights in the disputed domain name.

The Respondent is not commonly known by the disputed domain name.

The Complainant has not granted the Respondent permission to use or register its trademark as a domain name.

The Respondent is not making a legitimate noncommercial or fair use of the domain name, nor is the Respondent using the domain name in connection with a *bona fide* offering of goods or services.

The Respondent has registered and used the disputed domain name in bad faith.

The Respondent almost certainly had actual knowledge of the Complainant's rights in the BNY MELLON marks at the time it registered the disputed domain name.

The disputed domain name currently redirects to the Complainant's site, which creates a clear likelihood of confusion with the Complainant's mark

The Respondent's use of a privacy protection service in the registration of the disputed domain name in order to conceal his/her identity.

## **B. Respondent**

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

## **6. Discussion and Findings**

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (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. Considering these requirements, the Panel rules as follows:

### **A. Identical or Confusingly Similar**

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The Complainant has provided evidence of its rights in the trademarks BNY MELLON and THE BANK OF NEW YORK MELLON on the basis of its multiple trademark registrations including those in the U.S..

A trademark registration provides a clear indication that the rights in the trademark belong to the Complainant (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.2.1). It has also been established by prior UDRP panels that incorporating a trademark in its entirety into a domain name can be sufficient to establish that the domain name is confusingly similar to a trademark. Such findings were confirmed, for example, within section 1.7 of the [WIPO Overview 3.0](#). The Respondent's incorporation of the Complainant's BNY MELLON and THE BANK OF NEW YORK MELLON trademarks in the disputed domain name is evidence that the disputed domain name is confusingly similar to the Complainant's marks. The only difference between the disputed domain name and the Complainant's BNY MELLON trademarks is that the Respondent has replaced the abbreviation "ny" with the word "new york" and added the generic Top-Level-Domain ("gTLD") suffix ".com". The Panel finds that the abbreviation "ny" is equivalent to the word "new york" and holds that the mere replacement of a word incorporated into a registered trademark with an equivalent abbreviation does not overcome a proper claim of confusing similarity.

With respect to the trademark THE BANK OF NEW YORK MELLON, the mere suppression of the expression "the" and the use of the initial letter "B" instead of the word "bank" does not prevent a finding of confusing similarity between the disputed domain name and the aforementioned trademark.

As noted in [WIPO Overview 3.0](#), section 1.8: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element." Furthermore, the addition of the gTLD ".com" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademark in which the Complainant has rights, meaning that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

In accordance with paragraph 4(a)(ii) of the Policy, the Complainant must prove that the Respondent has no rights or legitimate interests in the disputed domain name. The Panel observes that there is no relationship, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant.

The Panel also finds that there is no indication that the Respondent is commonly known by the disputed domain name because the Respondent's name is "Martín Ponce" which has no apparent connection with the BNY MELLON and THE BANK OF NEW YORK MELLON trademarks.

The Complainant claims that the Respondent has no connection or affiliation with the Complainant and has not received any license or consent, express or implied, to use the Complainant's trademarks in a domain name or in any other manner. Furthermore, the unauthorized redirection of the disputed domain name to the Complainant's website does not serve as evidence of rights or legitimate interests, indicating even more there is very likely no connection with a *bona fide* offering of goods and services.

The Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain name, and the Panel draws adverse inferences from this failure, where appropriate, in accordance with the Rules, paragraph 14(b). The Panel finds the Respondent has no rights or legitimate interests in respect of the disputed domain name and that paragraph 4(a)(ii) of the Policy is satisfied. The Panel concludes that the Respondent deliberately chose to include the Complainant's BNY MELLON and THE BANK OF NEW YORK MELLON trademarks in the disputed domain name, in order to achieve commercial gain by misleading third parties, and that such use cannot be considered as a legitimate noncommercial or fair use.

The Panel further finds that the disputed domain name carries a risk of implied affiliation with the Complainant. The replacement of some letters by an abbreviation and the suppression of an accessory expression can lead to confusion regarding the affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Complainant has satisfied the requirement under paragraph 4(a)(ii) of the Policy.

## **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a disputed domain name in bad faith: (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; (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 its 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 its website or location. In the Panel's view, a finding of bad faith may be made where the Respondent "knew or should have known" of the registration and/or use of the trademark prior to registering the disputed domain name. In this case, the Complainant

submits that at the date of registration of the disputed domain name the Respondent knew or should have known of the Complainant's marks BNY MELLON and THE BANK OF NEW YORK MELLON considering the global renown of the Complainant's prior mark.

The Panel takes note of the construction of the disputed domain name, which reproduces the BNY MELLON and THE BANK OF NEW YORK MELLON trademarks, as well as the fact that the disputed domain name directs to the Complainant's website creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or of the products on its website (see section 3.1.3 of the [WIPO Overview 3.0](#)). Under paragraph 4(b)(iv) of the Policy, this circumstance shall be evidence of the registration and use of a domain name in bad faith.

The Complainant points out that the Respondent is hiding its identity behind a Whois privacy wall. It is well established that this, too, can be a further indicator of bad faith in certain circumstances. Having considered the Complainant's submissions and in the absence of a Response, the Panel accepts the Complainant's submission that on the evidence there is no plausible circumstance under which the Respondent could legitimately register or use the inherently misleading disputed domain name.

Consequently, the Panel finds that the disputed domain name was registered and used by the Respondent in bad faith within 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, <bnewyorkmellon.com> be transferred to the Complainant.

*/Daniel Peña/*

**Daniel Peña**

Sole Panelist

Date: May 23, 2023