

ADMINISTRATIVE PANEL DECISION

Bank of New York Mellon v. Shu Lin
Case No. D2023-1539

1. The Parties

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

Respondent is Shu Lin, China.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 7, 2023. On April 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 12 and April 14, 2023, the Registrar transmitted by email to the Center its verification responses disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Unknown) and contact information in the Complaint. The Center sent an email communication to Complainant on April 12, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on April 18, 2023.

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 Respondent of the Complaint, and the proceedings commenced on April 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 10, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 11, 2023.

The Center appointed Stephanie G. Hartung as the sole panelist in this matter on May 25, 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

Complainant is a company organized under the laws of the United States that is active in the financial industry.

Complainant has provided evidence that it is the registered owner of various trademarks relating to its company name and brand BNY MELLON, including, but not limited to the following:

- word mark BNY MELLON, United States Patent and Trademark Office (USPTO), registration number: 3,585,488, registration date: March 10, 2009, status: active;
- word mark BNY, USPTO, registration number: 3,117,825, registration date: July 18, 2006, status: active;
- word mark MELLON, USPTO, registration number: 1,111,471, registration date: January 16, 1979, status: active.

Moreover, Complainant has demonstrated to own since 2006 the domain name <bnymellon.com> which resolves to Complainant's main website at "www.bnymellon.com", advertising Complainant's banking and financial services worldwide.

The disputed domain name was registered on August 13, 2007. Respondent, according to the disclosed Whois information for the disputed domain name, is a resident of China. By the time of rendering this decision, the disputed domain name resolves to a website at "www.flirtrigue.com" offering adult content. However, Complainant has provided evidence that at some point before the filing of the Complaint, the disputed domain name resolved to a website at "www.bnymellon.com" which was a standardized pay-per-click ("PPC") website showing search results related to the financial industry and also offering the disputed domain name for sale.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, Complainant contends to be a well-known leading global financial services investment company which, through its Bank of New York predecessor, is one of the three oldest banking corporations in the United States and one of the oldest banks in the world, having continuously used since at least as early as 2007 its famous BNY and BNY MELLON trademarks in the United States and throughout the world in connection with the promotion and provision of a wide variety of financial services.

Complainant submits that the disputed domain name is confusingly similar to Complainant's BNY MELLON trademark and domain name, as it transposes the latter by changing only one letter, thus constituting an obvious misspelling/typo-squatting. Moreover, Complainant asserts that Respondent has no rights or legitimate interests in respect of the disputed domain name since (1) Respondent is not commonly known by the disputed domain name and there is no indication that Respondent registered the disputed domain name as a trademark, (2) Complainant has never assigned, sold or transferred any rights in its BNY MELLON trademark to Respondent, has not granted Respondent a license or permission to register or use its trademark as a domain name and Respondent has no legal relationship with Complainant whatsoever, (3) Respondent offered the disputed domain name for online sale, and (4) Respondent appears to be using the disputed domain name as part of a malware scheme designed to victimize Complainant's employees, clients and the larger financial systems. Finally, Complainant argues that Respondent has registered and is using the disputed domain name in bad faith since (1) the disputed domain name was registered well after Complainant acquired rights in its BNY and MELLON trademarks and after Complainant registered its

<bnymellon.com> domain name, (2) Respondent's decision to transpose one letter of Complainant's BNY and BNY MELLON trademarks and to register the disputed domain name is far from coincidental, (3) as evidenced by numerous UDRP decisions, Respondent has engaged in a pattern of bad faith conduct by registering numerous domain names involving variations of well-known third-party brands, and (4) Complainant has made multiple attempts to contact Respondent over several years demanding that Respondent cease and desist use of the disputed domain name, which Respondent constantly ignored.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, Complainant carries the burden of proving:

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

Respondent's default in the case at hand does not automatically result in a decision in favor of Complainant, however, paragraph 5(f) of the Rules provides that if Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute solely based upon the Complaint. Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from Respondent's failure to submit a Response as it considers appropriate.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned, but relatively straightforward comparison between Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds that Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1

Also, the Panel finds the trademark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

In particular, the disputed domain name incorporates all of Complainant's BNY, BNY MELLON, and MELLON trademarks in their entirety, the only difference being a misspelling caused by changing the letters "n" and "y" in the element "bny". Numerous UDRP panels have recognized that where a domain name incorporates a trademark in its entirety, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that trademark (see [WIPO Overview 3.0](#), section 1.7). Moreover, the fact that the disputed domain name obviously includes an intentional misspelling of Complainant's BNY and BNY MELLON trademarks is consistent with such finding of confusing similarity. Typo-squatted domain names are intended to be confusing so that Internet users, who unwittingly make common type errors, will enter the typo-squatted domain name instead of the correct spelled trademark (see *e.g.*, *National Association of Professional Baseball Leagues, Inc, d/b/a Minor League Baseball v. John Zuccarini*, WIPO Case No. [D2002-1011](#)). Accordingly, UDRP panels agree that domain names which consist of an intentional misspelling of a trademark are considered to be confusingly similar under the UDRP (see [WIPO Overview 3.0](#), section 1.9).

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

The Panel considers that the record of this case reflects that:

- before any notice to Respondent of the dispute, Respondent did not use, nor has it made demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services. Paragraph 4(c)(i) of the Policy, and [WIPO Overview 3.0](#), section 2.2.
- Respondent (as an individual, business, or other organization) has not been commonly known by the disputed domain name. Paragraph 4(c)(ii) of the Policy, and [WIPO Overview 3.0](#), section 2.3.
- Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Paragraph 4(c)(iii) of the Policy, and [WIPO Overview 3.0](#), section 2.4.
- the record contains no other factors demonstrating rights or legitimate interests of Respondent in the disputed domain name.

In particular, the Panel recognizes that holding a domain name for resale can be *bona fide* and is not *per se* illegitimate under the UDRP (see [WIPO Overview 3.0](#), section 2.1), but that the mere registration of such a domain name does not by itself automatically confer rights or legitimate interests (see [WIPO Overview 3.0](#), section 2.10.1). Moreover, given that the disputed domain name consists entirely of Complainant’s undisputedly famous BNY, BNY MELLON, and MELLON trademarks together with a deliberate misspelling constituting typo-squatting, the disputed domain name carries, as such, the high risk of implied affiliation with those trademarks which is why offering it *e.g.*, for online sale cannot constitute fair use either (see [WIPO Overview 3.0](#), section 2.5.1).

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Panel considers that the record of this case reflects that Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

In particular, the Panel recognizes that the disputed domain name is an obvious and intentional typo-squatted version of Complainant's undisputedly famous BNY and BNY MELLON trademarks by switching the letters "n" and "y" in the element "bny" which, in turn, is a clear indication that Respondent registered the disputed domain name in full knowledge of said trademarks. This is even more true when also taking into account that, at some point before the filing of the Complaint, the disputed domain name redirected to a typical PPC website which showed search results related to the financial industry, thus to Complainant's core business. Such demonstration of Respondent's knowledge of Complainant's trademarks when registering the disputed domain is relevant to the Panel in order to overcome any doubts in Respondent's bad faith acting that could arise when noticing that the disputed domain name was registered back in 2007. Still, by that time, Complainant already possessed of registered rights at least with respect to its BNY and MELLON trademarks, and there is no indication whatsoever in the available record that Respondent made use of the disputed domain name ever since that would not have been to somehow unfairly ride on the reputation connected to Complainant's well-known BNY, BNY MELLON, and MELLON trademarks, thus constituting registration and use of the disputed domain name in bad faith within the meaning of paragraph 4(b) of the Policy.

Finally, the Panel has also taken into account that Respondent (1) engages in a pattern of conduct of registering variations of well-known-trademarks as evidenced by numerous parallel UDRP decisions held in the past against Respondent, and (2) has rejected to accept the Written Notice on the Notification of Complaint. These facts throw a light on Respondent's behavior which supports the Panel's bad faith finding on the part of Respondent.

Based on the available record, the Panel finds the third element of the Policy has been established.

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, <bynmellon.com>, be transferred to Complainant.

/Stephanie G. Hartung/

Stephanie G. Hartung

Sole Panelist

Date: June 8, 2023