

## **ADMINISTRATIVE PANEL DECISION**

Stichting BDO v. Name Redacted

Case No. D2023-1965

### **1. The Parties**

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

The Respondent is Name Redacted.

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

The disputed domain name <bdousaglobal.com> is registered with Google LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 3, 2023. On May 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 3, 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 (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 4, 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 amended Complaint on May 8, 2023 and requested that the Respondent’s name be redacted from this proceeding since it appears that the Respondent registered the disputed domain name by using a false name.

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 May 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 12, 2023.

The Center appointed Peter Burgstaller as the sole panelist in this matter on June 15, 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.

The Respondent appears to have used the name of a third party when registering the disputed domain name. Hence, in light of the potential identity theft, the Panel has decided to redact the Respondent's name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case (see *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#)).

#### **4. Factual Background**

The Complainant is a member of the international BDO network of independent member firms providing services especially in the field of accounting, taxation and consulting. The Complainant has rights in the mark BDO through various trademark registrations, *inter alia*:

- U.S. Registration No. 4,854,142 BDO (word), for goods and services in classes 9, 16, 35, 26, 41, 42 and 45, registered since November 17, 2015; and
- U.S. Registration No. 2,699,812 BDO (fig.), for goods and services in classes 9, 16, 35, 36, 41 and 42, registered since March 25, 2003 (Annex C).

The Complainant moreover has rights *inter alia* in the domain name <bdo.com>, registered on February 28, 1995, which addresses the main website of the Complainant and the BDO-Group worldwide. Besides that, the Complainant uses various online services for its online presence, e.g. Twitter, Facebook or YouTube (Annex E and F to the Complaint).

The disputed domain name was registered on April 16, 2023 (Annex A to the Complaint). According to the evidence provided by the Complainant, the disputed domain name was used to send fraudulent emails, in which the Respondent was impersonating the Complainant's related entity offering job interviews.

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

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

The Complainant is a member of the BDO international network of financial services firms providing services in the fields of accounting, taxation, consulting and advice and other professional services under the name BDO. The BDO Network currently has over 111,300 global employees in more than 1,800 offices in 164 countries around the world, including in the United States, Europe, Africa and the Middle East, North and South America, and Asia.

The term BDO has acquired and developed considerable goodwill and fame in connection with a wide range of services within the financial services industry including audit, tax, and advisory services across sectors such as banking, capital markets, insurance, and asset management. The Complainant and members of the BDO Network have been consistently ranked amongst the top accounting firms in the United States and in the world. The BDO marks are continually recognized as a leading global brand.

The Complainant has rights in the mark BDO through more than 350 trademark registrations and applications in 173 territories in favor of the BDO Network members. Moreover, the BDO Network owns and operates numerous domain names containing the mark BDO, e.g.: <bdo.com>, <bdo.ca>, <bdo.fr>, <bdo.de>, <bdo.uk>, <bdo.com.au> or <bdointernational.com>.

The disputed domain name is confusingly similar to the BDO trademarks in which the Complainant has rights.

The disputed domain name contains the Complainant's complete BDO trademark, paired with the geographically descriptive terms "USA" and "global". Adding a geographic or descriptive term to a trademark in a domain name fails to negate confusing similarity, especially when a registered trademark is clearly recognizable in the disputed domain name; moreover, the addition of the ".com" generic Top-Level Domain ("gTLD") to the disputed domain name is "completely without legal significance". Finally, the Respondent's addition of the descriptive "USA" and "global" to the disputed domain name only increases the potential for confusion with the Complainant's BDO marks. As such, Internet users are very likely to be confused as to whether an association exists between the disputed domain name and the Complainant or the Complainant's accounting/billing department.

The Respondent has no legitimate interests or legitimate interests in respect of the disputed domain name.

The Respondent is neither affiliated with, nor has it been licensed or permitted to use the Complainant's BDO marks or any domain names incorporating the BDO marks. The Complainant's BDO mark is not a generic or descriptive term in which the Respondent might have an interest. The Complainant's BDO marks are globally recognized and have acquired secondary meaning through the Complainant's substantial, continuous, and exclusive use of the marks in connection with the Complainant's goods and services. The Respondent is not commonly known by the disputed domain name and is not making a legitimate noncommercial use or fair use of it. The disputed domain name was used to perpetuate a hiring scam by sending fraudulent emails, and such use does not establish rights or legitimate interests on the Respondent.

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

The Respondent had constructive notice that the BDO mark was a registered trademark in the United States and many other jurisdictions worldwide. Given the Complainant's worldwide reputation and the ubiquitous presence of the BDO marks on the Internet, the Respondent was or should have been aware of the BDO marks long prior to registering the disputed domain name. Further, although the Respondent has not used the disputed domain name for any legitimate purpose, the passive or inactive holding of a domain name that incorporates a registered trademark, without a legitimate Internet purpose, may indicate that the domain name is being used in bad faith; especially given the well-known status of the Complainant's BDO marks and its registration and use of the domain name <bdo.com>, there is no reason for the Respondent to have registered the disputed domain name other than to trade off the reputation and goodwill of the Complainant's BDO marks. Finally, the Respondent's use of the disputed domain name for a corresponding email address to create a false association with the Complainant and to perpetuate a phishing scam under the guise of an offer of employment with Complainant constitutes bad faith pursuant to Policy paragraph 4(b)(iv).

## **B. Respondent**

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

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, the Complainant must prove that

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests with respect to 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**

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 the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Complainant submitted evidence, which incontestably and conclusively establishes rights in the mark BDO.

In the present case, the disputed domain name is confusingly similar to the BDO mark in which the Complainant has rights since the Complainant's BDO mark is clearly recognizable in the disputed domain name. It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain name, the mere addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity under the first element of the Policy (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

This is the case at present: the addition of the other terms "usa" and "global" in the disputed domain name does not prevent a finding of confusing similarity.

Finally, it has also long been held that gTLDs are generally disregarded when evaluating the confusing similarity under the first element.

Therefore, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

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

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 (see section 2.1 of the [WIPO Overview 3.0](#)). Here, the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent.

Furthermore, the nature of the disputed domain name, comprising the Complainant's mark in its entirety together with a geographic and descriptive term, cannot be considered fair use as it falsely suggests an affiliation with the Complainant that does not exist (see section 2.5 of the [WIPO Overview 3.0](#)).

Noting the above and the Panel's findings below, and in the absence of any Response or allegations from the Respondent, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

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

As stated in many decisions rendered under the Policy (e.g. *Robert Ellenbogen v. Mike Pearson*, WIPO Case No. [D2000-0001](#)) both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainant must show that:

- the disputed domain name was registered by the Respondent in bad faith, and
- the disputed domain name is being used by the Respondent in bad faith.

(i) The Complainant has rights in the registered trademark BDO long before the registration of the disputed domain name. Further, the Complainant has a strong Internet presence under its domain name <bdo.com> and on social media platforms for years.

Furthermore, there is strong evidence that the Respondent has used the name of a third party when registering the disputed domain name - this evidence was not rebutted by the Respondent. The registration of the disputed domain name by the Respondent by using another person's identity (identity theft) can never convey good faith.

It is therefore inconceivable for this Panel that the Respondent registered and used the disputed domain name without knowledge of the Complainant's rights, which leads to the necessary inference of bad faith. This finding is supported by the fact that the disputed domain name incorporates the Complainant's distinctive registered trademark entirely, together with the geographic identifier "usa" and the descriptive term "global", and was used to send fraudulent emails impersonating the Complainant's related entity, which strengthen the finding that the Respondent must have been aware of the Complainant and its rights in the BDO mark when registering the disputed domain name.

Therefore, the Panel is convinced that the disputed domain name was registered in bad faith by the Respondent.

(ii) The disputed domain name is also being used in bad faith:

The disputed domain name was used to send fraudulent emails in connection with a hiring scam. The Panel finds the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his online location, pursuant to paragraph 4(b)(iv). Such use clearly indicates the Respondent's bad faith ([WIPO Overview 3.0](#), section 3.4).

Taking all these facts and evidence into consideration this Panel finds that the disputed domain name has been registered and used in bad faith under 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 <bdousaglobal.com> be transferred to the Complainant.

*/Peter Burgstaller/*

**Peter Burgstaller**

Sole Panelist

Date: June 29, 2023