

## **ADMINISTRATIVE PANEL DECISION**

BDO Unibank, Inc. v. Yangwen Chao  
Case No. D2023-1989

### **1. The Parties**

The Complainant is BDO Unibank, Inc., the Philippines, represented by Villaraza & Angangco, the Philippines.

The Respondent is Yangwen Chao, China.

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

The disputed domain name <bdounibank.com> is registered with Dynadot, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 4, 2023. On May 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 9, 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 (Redacted for Privacy, Dynadot Privacy Service) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 11, 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 May 15, 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 May 24, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was June 13, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 3, 2023.

The Center appointed Assen Alexiev, Francine Tan, and Linda Chang as panelists in this matter on August 2, 2023. The Panel finds that it was properly constituted. Each member of 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 bank based in the Philippines. It has a distribution network of over 1,500 operating branches and more than 4,400 ATMs in the country. In 2011, the Complainant adopted its current corporate name, "BDO Unibank, Inc."

The Complainant is the owner of a number of trademark registrations for BDO UNIBANK in various jurisdictions (the "BDO UNIBANK trademark"), including the following registrations in China, where the Respondent is located:

- the Chinese trademark BDO UNIBANK with registration No. 9110932, registered on July 21, 2015, for services in International Class 36; and
- the Chinese trademark BDO UNIBANK with registration No. 15780734, registered on September 7, 2016, for services in International Class 36.

The disputed domain name was registered on May 14, 2022. It is currently inactive. At the time of filing of the Complaint, the disputed domain name resolved to a betting website "ManBet X".

#### 5. Parties' Contentions

##### A. Complainant

The Complainant submits that the disputed domain name is confusingly similar to its BDO UNIBANK trademark, because it consists of the entirety of this trademark, and the only difference is the absence of an interval between the elements "bdo" and "unibank". The Complainant notes that this interval cannot be reproduced in a domain name.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it has no relationship with the Complainant and has not received an authorization by the Complainant to use the BDO UNIBANK trademark and the Complainant's trade name. The Complainant adds that the Respondent is not commonly known as "BDO Unibank" and does not use the disputed domain name for a *bona fide* offering of goods or services or in accordance with fair use because the disputed domain name leads to a betting website that has no connection with the Complainant and the Complainant's legitimate banking, monetary and financial business. According to the Complainant, there is no legitimate reason for the Respondent's registration of the disputed domain name.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. It notes that since 2011, it has been doing business under the name "BDO UNIBANK, INC." and has been using the BDO UNIBANK trademark. The Complainant notes that there is no *bona fide* business reason for the registration of the disputed domain name for use in connection with a betting website. The Complainant adds that the word "unibank", which implies a bank, has no relation to the betting business of the website at the disputed domain name. The Complainant adds that the identity of the disputed domain name with the Complainant's BDO UNIBANK trademark creates a high likelihood of confusion and deception, which would lead the unsuspecting public to believe that the website at the disputed domain name is a legitimate website of the Complainant, or to infer some relationship or affiliation between the Complainant and the Respondent where there is none. The Complainant adds that there was nothing in the website at the disputed domain name to prevent visitors from inferring a connection between the website and the Complainant, and the identity and contact details of the website's operator are not available at the website.

The Complainant notes that the Respondent's betting website is Chinese, and the BDO UNIBANK trademark is registered in various jurisdictions, including in China, for financial, monetary and banking services. The Complainant contends that the Respondent knew the Complainant's BDO UNIBANK trademark when it registered the disputed domain name, and registered it to capitalize on the goodwill of this trademark by attracting visitors to the Respondent's unrelated betting website, which the unsuspecting public could believe to be a legitimate website of the Complainant. The Complainant concludes that the Respondent had no legitimate reason to register the disputed domain name apart from capitalizing on the goodwill of the Complainant's BDO UNIBANK trademark.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **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. 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 the Complainant has shown rights in respect of the BDO UNIBANK trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The BDO UNIBANK trademark is fully reproduced in the disputed domain name without the addition of any other elements, and the only difference between them is the omission of the interval between the "bdo" and "unibank" elements of the trademark. As noted by the Complainant, a domain name cannot contain an interval for technical reasons. Taking the above into account, the Panel finds that the disputed domain name is identical to the Complainant's BDO UNIBANK trademark for the purposes of the Policy.

Based on the available record, the Panel therefore finds that 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 the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* case 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 the Respondent of the dispute, the 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.

The 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.

The 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 the Respondent in the disputed domain name.

As discussed above, the disputed domain name is identical to the Complainant's BDO UNIBANK trademark, which the Complainant has extensively used for the last 12 years both as trademark and trade name. The Respondent has not denied the contentions of the Complainant and has not brought forward any evidence or arguments why it should be regarded as having rights or legitimate interests in the disputed domain name. The evidence shows that the Respondent has used the disputed domain name to redirect to a commercial betting website. Therefore, and in the absence of any contrary allegations or evidence, the Panel accepts as more likely than not that the Respondent has registered and used the disputed domain name targeting the BDO UNIBANK trademark in an attempt to confuse and attract Internet users to a betting website for commercial gain. The Panel does not regard such conduct as giving rise to rights or legitimate interests of the Respondent in the disputed domain name.

Based on the available record, the Panel therefore finds that 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:

The Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant's BDO UNIBANK trademark 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. Paragraph 4(b)(iv) of the Policy, and [WIPO Overview 3.0](#), section 3.1.4.

As already mentioned, the Respondent has not provided any plausible explanation why it registered the disputed domain name. The BDO UNIBANK trademark predates the date of registration of the disputed domain name by seven years, and is also registered in China where the Respondent is located. The disputed domain name is identical to the BDO UNIBANK trademark and thus carries a high risk of implied affiliation with the Complainant ([WIPO Overview 3.0](#), section 2.5.1), so it appears that there is no plausible good faith use to which it may be put without the consent of the Complainant. At the time of filing of the Complaint, the disputed domain name resolved to a commercial betting website. Considering the above, it seems more likely than not that the Respondent has registered the disputed domain name with knowledge of the Complainant in an attempt to attract Internet users and direct them to a betting website for financial gain, by creating a likelihood of confusion with the Complainant's BDO UNIBANK trademark as to the affiliation or endorsement of the betting services offered on the website to which the disputed domain name resolved.

The disputed domain name is currently inactive, but its inactivation took place after the submission of the Complaint and does not affect the Panel's conclusions about the bad faith conduct of the Respondent.

Based on the available record, the Panel therefore 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 <bdounibank.com> be transferred to the Complainant.

*/Assen Alexiev/*  
**Assen Alexiev**  
Presiding Panelist

*/Francine Tan/*  
**Francine Tan**  
Panelist

*/Linda Chang/*  
**Linda Chang**  
Panelist  
Date: August 16, 2023