

ADMINISTRATIVE PANEL DECISION

Stichting BDO v. Jackieke fawcett

Case No. D2023-2317

1. The Parties

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

The Respondent is Jackieke fawcett, United States.

2. The Domain Name and Registrar

The disputed domain name <bdo-subs.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 May 30, 2023. On May 30, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 30, 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 / Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 2, 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 June 7, 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 the Respondent of the Complaint, and the proceedings commenced on June 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 9, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 10, 2023.

The Center appointed Marilena Comanescu as the sole panelist in this matter on July 13, 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 an international network (the “BDO Network”) of financial services firms providing services in the fields of accounting, taxation, consulting and advise and other professional services under the name BDO, and is the owner of the BDO trademark and company name, with a history dating back in 1963. 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, Middle East, North and South America, and Asia.

The BDO Network received numerous accolades and recognitions in its field, has been consistently ranked amongst the top accounting firms in the United States and in the world, with more than USD 2.4 billion in revenues in the United States alone, and over USD 12.8 billion in global revenue combined.

The Complainant owns over 350 trademark registrations and applications in 173 territories for various BDO marks, such as the following:

- the United States Trademark registration number 2699812 for the mark BDO (word with device), filed on December 31, 2001 and registered on March 25, 2003, covering goods and services in the International classes 9, 16, 35, 36, 41 and 42; and
- the United States Trademark registration number 4854142 for the mark BDO (word), filed on December 9, 2014 and registered on November 17, 2015, covering goods and services in the International classes 9, 16, 35, 36, 41, 42 and 45.

The Complainant owns numerous domain names comprising the mark BDO, such as <bdo.com> (its main domain name registered on February 27, 1995), <bdointernational.com>, <bdo.de>, <bdo.com.hk>, <bdo.co.il> or <bdo.co.uk>.

The disputed domain name <bdo-sub.com> was registered on May 4, 2023 and, at the time of filing the Complaint, depending on the user’s browser, it resolved to a website either blocked by a security warning, or to a page that appears to be parked/hosted by the Registrar, with pay-per-click (“PPC”) pages with sponsored links.

According to Annex P to the Complaint, the Respondent has used the disputed domain name to perpetrate a financial fraud/phishing scam by soliciting invoice payments from the Complainant’s clients, using the email address “[...]@bdo-sub.com” and sending to the Complainant’s clients falsified invoices bearing the Complainant’s logo and contact information.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name is virtually identical or at least confusingly similar to its well-known and distinctive trademark and domain name; the Respondent has no rights or legitimate interests in the disputed domain name; and the Respondent registered and is using the disputed domain name in bad faith. The Complainant requests the transfer of the disputed domain name to it.

B. Respondent

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

6. Discussion and Findings

In view of the absence of a Response, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent. Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (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 the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will further analyze the potential concurrence of the above circumstances.

A. Identical or Confusingly Similar

The Panel finds that the Complainant holds rights in the BDO trademark.

The disputed domain name incorporates the BDO trademark in its entirety with a hyphen and an additional term. However, such additions do not prevent a finding of confusing similarity as the Complainant's trademark is clearly recognizable within the disputed domain name. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

It is well established in decisions under the UDRP that the generic Top-Level Domain ("gTLD") (e.g., ".com", ".net", ".info", ".shop") may typically be disregarded for the purposes of consideration of confusing similarity between a trademark and a domain name. See section 1.11.1 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the disputed domain name is confusingly similar to the BDO trademark, pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Complainant asserts that the Respondent does not hold any trademark rights, license, or authorization whatsoever to use the BDO mark, that the Respondent is not commonly known by the disputed domain name, and that the Respondent has not used the disputed domain name in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods or services.

In line with the case law, "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](#).

The Complainant has put forward a *prima facie* case that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Respondent has not replied to the Complainant's contentions and has not come forward with relevant evidence to rebut the Complainant's *prima facie* case. There is nothing in the record suggesting that the Respondent has ever been commonly known by the disputed domain name or that the Respondent made a *bona fide* offering of goods or services or a legitimate noncommercial use under the disputed domain name.

The Respondent is using the disputed domain name in connection with PPC pages and, according to the evidence in the Complaint, the email address associated with the disputed domain name was also used for scamming purposes. UDRP panels have categorically held that the use of a domain name for illegal activity (such as phishing, distributing malware, other types of fraud) can never confer rights or legitimate interests on a respondent. See section 2.13 of the [WIPO Overview 3.0](#).

For these reasons, the Panel finds that the second element of the Policy is established, and the Respondent has no rights or legitimate interests in respect of the disputed domain name, pursuant to the Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The Complainant has trademark rights in BDO since at least 2001, and corresponding domain name <bdo.com> since 1995. This Panel accepts the Complainant's evidence that the BDO trademark is well-known worldwide in its field.

The disputed domain name was created in May 2023 and incorporates the Complainant's mark in its entirety together with the term, "subs", that may refer to "subsidiary", a term related to the Complainant's business.

From the above, the Panel finds that the disputed domain name was registered in bad faith, knowing the Complainant and targeting its trademark.

At the time of filing the Complaint, the disputed domain name resolved to a page providing PPC links.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "to attract, for commercial gain, Internet users to [the respondent's] 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 [the respondent's] website or location" is evidence of registration and use in bad faith.

The Respondent was using without permission the Complainant's well-known trademark in order to get traffic on its web portal and to misleadingly divert Internet users to third parties website, and thus to obtain commercial gain from the false impression created with regard to a potential affiliation or connection with the Complainant.

According to the evidence provided in the Complaint and unrefuted by the Respondent, prior to the present proceeding, the Respondent was using the disputed domain name to send email communications for phishing and other fraudulent purposes in an attempt to obtain financial gain from third parties, impersonating the Complainant. This is a classic phishing scheme and establishes bad faith use and registration.

UDRP panels have consistently held that the use of a domain name other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. Many of such cases, as well as the present case, involve the respondent's use of the disputed domain name to send deceptive emails to obtain sensitive or confidential personal information from prospective clients or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers. See section 3.4 of the [WIPO Overview 3.0](#).

The Respondent did not participate in the present proceedings in order to put forward any arguments in its favor.

Previous UDRP panels have found that the mere registration of a domain name that is identical or confusingly similar to a third party's well-known trademark can, by itself, constitute a presumption of bad faith for the purpose of Policy. See section 3.1.4 of the [WIPO Overview 3.0](#).

For all the above reasons, the Panel finds that the Respondent registered and is using the disputed domain name in bad faith, pursuant to the Policy, paragraph 4(a)(iii).

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-subs.com> be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: July 24, 2023