

ADMINISTRATIVE PANEL DECISION

Stichting BDO v. Jayson Tamidles, Jayson Tamidles, and john weak, john weak

Case No. D2024-1832

1. The Parties

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

The Respondents are Jayson Tamidles, Jayson Tamidles, and john weak, john weak, Philippines.

2. The Domain Names and Registrar

The disputed domain names <bdoonlineadvisory.com> and <my-bdoonlineadvisory.com> are registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 1, 2024. On May 1, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On May 1, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (REDACTED FOR PRIVACY / REDACTED FOR PRIVACY) and contact information in the Complaint.

The Center sent an email communication to the Complainant on May 2, 2024, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant to either file separate complaints for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all domain names are under common control. The Complainant filed an amended Complaint on May 4, 2024.

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 Respondents of the Complaint, and the proceedings commenced on May 7, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 27, 2024. On May 7, 2024, the Center received email communications from a third party regarding the disputed domain names. On May 28, 2024, the Center informed the parties it will proceed to Panel Appointment.

The Center appointed Mihaela Maravela as the sole panelist in this matter on May 31, 2024. 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

According to information in the Complaint, the Complainant is an 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, dating back from 1963. The Complainant's group 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 Complainant is the registered owner of a number of trademarks consisting of or including "BDO", such as the United States trademark BDO registered under No. 4,854,142 on November 17, 2015, for the International classes of products and services 9, 16, 35, 36, 41, 42 and 45. Also, the Complainant's official website is operated at the domain name <bdo.com>, registered on February 27, 1995..

The disputed domain name <bdoonlineadvisory.com> was registered on April 10, 2023, and the disputed domain name <my-bdoonlineadvisory.com> was registered on April 16, 2023, and at the date of the Decision they both resolve toward parking pages containing sponsored pay-per-click ("PPC") links in the same area of activity as the Complainant. According to evidence with the Complaint, at the date thereof, the disputed domain name <bdoonlineadvisory.com> resolved to a PPC page, and the disputed domain name <my-bdoonlineadvisory.com> resolved to a page stating "[t]he content of the page cannot be displayed."

5. Parties' Contentions

A. Complainant

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

Notably, the Complainant contends that the disputed domain names contain the Complainant's BDO trademark, in addition to the descriptive terms "online" and "advisory" (or "my-" "online" and "advisory"), which suggest an online resource for the Complainant's public accounting advisory services. The Complainant argues that adding descriptive terms 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.

As regards the second element, the Complainant argues that the Respondent is neither affiliated with, nor has it been licensed or permitted to use the Complainant's BDO trademarks or any domain names incorporating the BDO trademark. The Respondent is not making legitimate noncommercial fair use of the disputed domain names. Instead, the Complainant argues that the website at the disputed domain name <bdoonlineadvisory.com> resolves to a page that displays sponsored PPC links, and the disputed domain name <my-bdoonlineadvisory.com> resolves to a page stating only "[t]he content of the page cannot be displayed."

With respect to the third element, the Complainant contends that its BDO trademark has acquired and developed a substantial reputation in association with the Complainant's services over nearly 60 years of

use. Given the Complainant's worldwide reputation and the ubiquitous presence of the BDO trademark on the Internet, the Respondent was or should have been aware of the BDO trademarks long prior to registering the disputed domain names. The Respondent's use of the disputed domain name <bdoonlineadvisory.com> to redirect Internet users to commercial website through various PPC links constitutes bad faith and indicates that the Respondent registered and is using the disputed domain name with the intent to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's BDO trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website. As regards the disputed domain name <my-bdoonlineadvisory.com>, its passive or inactive holding may indicate that the disputed domain name is being used in bad faith under paragraph 4(a)(iii) of the Policy. Given the well-known status of the BDO trademarks and the Complainant's registration and use of the disputed domain name <bdo.com>, there is no reason for the Respondent to have registered the disputed domain names other than to trade off the reputation and goodwill of the Complainant's trademarks.

B. Respondents

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

Third-party email communications were received by the Center from the email address of the technical contact associated with the Respondents. The first communication was received by the Center on April 24, 2024, and stated:

"Hi there, Thanks for contacting us! Please allow me to forward this to the concerned person for further steps. We appreciate your patience."

On May 7, 2024, the Center received another communication from the same entity in which it stated that such was solely the domain reseller of the disputed domain names.

Lastly, on June 6, 2024, another communication was received reiterating that such would be a "branded link management platform and reseller of domains" and not the registrant of the disputed domain names, being merely the technical content of the Respondents.

6. Discussion and Findings

No response has been received from the Respondents in this case. Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules. The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", and the Panel can draw certain inferences in light of the particular facts and circumstances of the case. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.2.

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 names are 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 names, and (iii) the disputed domain names have been registered and are being used in bad faith.

Consolidation: Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See [WIPO Overview 3.0](#), section 4.11.2.

As regards common control, the Panel notes that the disputed domain names registrants share the same address and phone number per the information disclosed by the Registrar, they are registered through the same Registrar, and were registered within days of each other. Also, both disputed domain names have a similar composition, with the addition of the words "online" and "advisory" or "my-" "online" and "advisory" to the BDO trademark of the Complainant.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "the Respondent") in a single proceeding.

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 3.0](#), section 1.7.

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

The Panel finds the BDO trademark is incorporated in its entirety in the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the BDO trademark of the Complainant for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, "online", "advisory", "my" or a hyphen) may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the BDO trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). 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 available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

There is no evidence that the Respondent is using the disputed domain names in connection with a bona fide offering of goods or services, nor does the Respondent appear to engage in any legitimate noncommercial or fair use of the disputed domain names within the meaning of paragraphs 4(c)(i) and (iii) of the Policy. Rather, the disputed domain names are used to host parked pages comprising PPC links to competing services. According to section 2.9 of the [WIPO Overview 3.0](#), "Applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users". In this case, the PPC links are related to the Complainant's trademark BDO and generate search results with competing services to those offered by the Complainant. The disputed domain name <my-bdoonlineadvisory.com> resolved previously to a page stating "[t]he content of the page cannot be displayed." In this Panel's view, neither of the above use confer rights or legitimate interests on the Respondent.

Also, there is no evidence that the Respondent is commonly known by the disputed domain names in the meaning of the second circumstance of paragraph 4(c) of the Policy.

Furthermore, the nature of the disputed domain name carries a risk of implied affiliation and cannot constitute a fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The disputed domain names were registered long after the Complainant had obtained registration of its BDO trademark and used it in commerce. The disputed domain names incorporate the Complainant's trademark BDO. The websites associated with the disputed domain names contain PPC links related to the services offered by the Complainant. Under these circumstances, the Panel considers that the Respondent has registered the disputed domain names with knowledge of the Complainant and its trademark and that it targeted that trademark.

As regards the use of the disputed domain names, they redirect Internet traffic to websites displaying PPC advertisements for the Complainant-related services. Given the confusing similarity between the Complainant's BDO trademark and the disputed domain names, and that the PPC links operate for the commercial gain of the Respondent or of the operators of those linked websites, or both, the Panel considers that the disputed domain names are intended to attract Internet users by creating a likelihood of confusion with the Complainant's BDO trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites or other online location or of a service offered on such other online location within the terms of paragraph 4(b)(iv) of the Policy.

The Respondent has not participated in these proceedings and has failed to rebut the Complainant's contentions and to provide any evidence of actual or contemplated good-faith use. In the Panel's view, the circumstances of the case represent evidence of registration and use in bad faith of the disputed domain names. The passive holding of the disputed domain name <my-bdoonlineadvisory.com> before the date of the Decision does not in the circumstances of this case prevent a finding of bad faith.

The Panel finds that the Complainant has established the third element 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 names <bdoonlineadvisory.com> and <my-bdoonlineadvisory.com> be transferred to the Complainant.

/Mihaela Maravela/

Mihaela Maravela

Sole Panelist

Date: June 5, 2024