

ADMINISTRATIVE PANEL DECISION

The Bank of New York Mellon v. Kilman Kim
Case No. D2024-2604

1. The Parties

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

The Respondent is Kilman Kim, Republic of Korea.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 26, 2024. On June 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 27, 2024, 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 (Privacy Service Provided by Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 27, 2024, 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 June 28, 2024.

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 July 4, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 24, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 25, 2024.

The Center appointed Knud Wallberg as the sole panelist in this matter on August 6, 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

The Complainant is a well-known global financial services and investments company. The Complainant is one of the oldest banking corporations both in the United States and globally.

The Complainant has used the trademark BNY (the “Mark”) continuously since at least 2006, and the Complainant holds several registrations or marks that incorporate the Mark, including United States Patent and Trademark Office Registration No. 3,117,825, registered on July 18, 2006, for a variety of financial services in international class 36.

The Complainant is also the owner of the domain names <bny.com> and <bnymellon.com> which are used to promote the company’s banking and financial services, and otherwise being continuously used in the conduct of its business.

The disputed domain name was registered on January 5, 2019, and has been offered for sale on various third-party websites.

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 name.

Notably, the Complainant contends that the disputed domain name is virtually identical to and wholly encompasses the Complainant’s BNY mark, with the addition of the term “bank” after “BNY”.

It is well known that the term “bank” is a generic term for a “financial institution” and that the addition of a generic wording along with the generic Top-Level Domain (“gTLD”) “.com.” does nothing to distinguish the disputed domain name from the Mark.

The Complainant further contends that none of the circumstances, which set out how a respondent can prove rights or legitimate interests in the disputed domain name, are present in this case. The Respondent is not commonly known by the disputed domain name or any portion thereof, and the Complainant has not granted the Respondent permission to use or register any of its BNY marks as a domain name. Further, the disputed domain name is listed for sale inter alia on dan.com for USD 55,000, so the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, nor is the Respondent using the disputed domain name in connection with a bona fide offering of goods or services.

The Complainant finally contends that the Respondent has registered and is using the disputed domain name in bad faith. The Respondent knew or should have known about the Complainant and its BNY mark when the disputed domain name was registered, and the fact that the disputed domain name is offered for sale is a clear proof of bad faith use.

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.

The 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. The entirety of the Mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "bank", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the Mark 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 name. 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 name such as those enumerated in the Policy or otherwise.

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 disputed domain name contains the Complainant's widely used and distinctive trademark and it is inconceivable to the Panel that the Respondent registered the disputed domain name without prior knowledge of the Complainants and the Complainant's marks.

Furthermore, the disputed domain name is offered for sale at a price in excess of the Respondent's out-of-pocket costs directly related to the disputed domain name (absent any evidence from the Respondent to the contrary), which is a clear indication of bad faith cf. paragraph 4(b)(i) of the Policy.

The Panel therefore 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 name <bnybank.com> be transferred to the Complainant.

/Knud Wallberg/

Knud Wallberg

Sole Panelist

Date: August 21, 2024