

## **ADMINISTRATIVE PANEL DECISION**

Stichting BDO v. Carolina Rodrigues, Fundacion Comercio Electronico  
Case No. D2024-0274

### **1. The Parties**

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

The Respondent is Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

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

The disputed domain name <insightsbdo.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 January 23, 2024. On January 23, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 23, 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 (Registration Private / Domains by Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 24, 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 amended Complaint on January 27, 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 Respondent of the Complaint, and the proceedings commenced on January 29, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 18, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 23, 2024.

The Center appointed Roger Staub as the sole panelist in this matter on March 7, 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 runs an international network of financial services firms providing services in the fields of accounting, taxation, consulting and advice and other professional services. The Complainant submits that the BDO network dates back to 1963 and has currently over 111,300 global employees in more than 1,800 offices in 164 countries, including in the United States, Europe, Africa, the Middle East, North and South America and Asia. The Panel takes it from the Complainant's website <bdo.global> that these countries include Panama, where the Respondent is located. The network has achieved more than USD 2.4 billion revenue in the United States and over USD 12.8 billion in global revenue.

The Complainant owns various trademark registrations consisting of, or containing, the term "BDO" in many jurisdictions worldwide. The Complainant's portfolio of BDO trademark registrations includes, inter alia, the following trademark registrations:

- United States of America trade and service mark No. 4854142 BDO, registered on November 17, 2015, in Classes 9, 16, 35, 36, 41, 42 and 45.
- International trademark No. 770374 BDO, registered on October 30, 2001, in Classes 9, 16, 35, 36, 41 and 42, and with protection granted currently in 54 jurisdictions, including (but not limited to) the following: Australia, China, Colombia, Israel, Japan, Mexico, Russian Federation, Switzerland and Türkiye.

The disputed domain name was registered on January 16, 2024.

Further, the Complainant has submitted evidence that it owns various domain names containing its trademark BDO, e.g., <bdo.com> (registered on February 27, 1995) and <bdointernational.com>. The domain name <bdo.com> redirects to the Complainant's main website. At this website, Internet users can find detailed information about the accounting, taxation, consulting and other services offered by the Complainant and its global BDO network.

The disputed domain name resolves to a Pay-Per-Click ("PPC") website displaying links to third-party websites, divided into "Business Accounts", "Business Tax" and "Customer Insights".

#### **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.

First, the disputed domain name contains, and is confusingly similar to, the Complainant's BDO trademark. The disputed domain name contains the Complainant's complete BDO trademark, paired with the descriptive word "insights." The BDO mark is well-known and distinctive. The addition of the ".com" generic Top-Level Domain is completely without legal significance. Adding a descriptive term to the trademark fails to negate confusing similarity, especially when a registered trademark is clearly recognizable in the disputed domain name. The Respondent's addition of the word "insights" to the disputed domain name - which suggests thought leadership or news emanating from the Complainant - only increases the potential for confusion with the Complainant's marks.

Second, the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant's BDO mark is not a generic or descriptive term, in which the Respondent might have an interest. The BDO marks are globally recognized and have acquired secondary meaning. 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 Respondent is not commonly known by the disputed domain name. It appears that the Respondent has chosen to use the Complainant's famous BDO mark in the disputed domain name to create a direct affiliation with, or to pass itself off as, the Complainant and its business. The website at the disputed domain name resolves to a page that displays sponsored PPC links. The Respondent is not making a legitimate, noncommercial, or fair use of the disputed domain name, and it appears that the Respondent has chosen the disputed domain name to trade off the reputation and goodwill associated with the BDO marks and to cause confusion amongst Internet users and third parties in order to generate traffic to the resulting website.

Third, the disputed domain name was registered and is being used in bad faith. 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. The Respondent's use of the disputed domain name to redirect Internet users to commercial websites 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. Finally, the Respondent is a known cybersquatter, which has been named as a respondent in more than 400 WIPO UDRP proceedings.

## **B. Respondent**

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

## **6. Discussion and Findings**

According to the Policy, to qualify for a cancellation or transfer, the Complainant must prove each of the following:

First, the disputed domain name is identical or confusingly similar to a trademark or service mark to which the Complainant has rights.

Second, the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Third, the disputed domain name has been registered and is being used in bad faith.

Since the Respondent did not submit a reply, the Panel may choose to accept the reasonable contentions of the Complainant as true. This Panel will determine whether those facts constitute a violation of the Policy that is sufficient to order the transfer of the disputed domain name (see *Joseph Phelps Vineyards LLC v. NOLDC, Inc., Alternative Identity, Inc., and Kentech*, WIPO Case No. [D2006-0292](#)).

### **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 “insights” 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 notes the disputed domain name resolves to a parking page featuring PPC links connecting to other websites relating to the Complainant’s business. In this regard, previous panels have held 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. [WIPO Overview 3.0](#), section 2.9.

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.

In the present case, the Panel notes that the Complainant submits as evidence screenshots of the website accessible under the disputed domain name showing a website with PPC links related to third parties’ websites relating to the Complainant’s business area. The use of such PPC links suggests that the Respondent is using this disputed domain name as a tool to attract, for commercial gain, Internet users to its website. Hence, and to this extent, circumstance 4(b)(iv) is given and suggests bad faith intentions of the Respondent. [WIPO Overview 3.0](#), section 3.5.

This finding is supported by the other circumstances of the present case, which lead the Panel to the conclusion that the disputed domain name has been registered and is used in bad faith: the disputed domain name incorporates the Complainant’s trademark, which is both distinctive and reputed (also in the Respondent’s reported country). This distinctive and reputed trademark has been combined with a

descriptive term that suggests to the user that it will find insight information from the owner of that trademark (i.e., the Complainant). There are no plausible indications at all for a possible good faith use of the disputed domain name by the Respondent. The Respondent failed to submit a response and, thus, any evidence of an actual or contemplated good faith use. A further relevant element supporting this finding is the use of a proxy service, which in the present case, due to the lack of any explanation from the Respondent, seems to serve the mere purpose of avoiding being notified of a UDRP proceeding. [WIPO Overview 3.0](#), section 3.6.

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 name <insightsbdo.com> be transferred to the Complainant.

*/Roger Staub/*

**Roger Staub**

Sole Panelist

Date: March 21, 2024