

## **ADMINISTRATIVE PANEL DECISION**

KPMG International Cooperative v. Domain Administrator, See  
PrivacyGuardian.org / Machotech, luna Morgan  
Case No. D2022-1359

### **1. The Parties**

The Complainant is KPMG International Cooperative, Netherlands, represented by Taylor Wessing LLP, United Kingdom.

The Respondent is Domain Administrator, See PrivacyGuardian.org, United States of America ("US") / Machotech, luna Morgan, US.

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

The disputed domain names <interview-kpmg.com> and <job-kpmg.com> (the "Disputed Domain Names") are registered with NameSilo, LLC (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 14, 2022. On April 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On April 19, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on April 21, 2022, 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 April 22, 2022.

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 April 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 15, 2022. An email communication was received from the email address [...]@job-kpmg.com on April 27, 2022. The Respondent sent email communications to the Center

on April 28, 2022, but did not submit any formal response. On May 16, 2022, the Center informed the Parties that it will proceed to panel appointment.

On May 18, 2022, the Respondent sent another email communication to the Center, which still did not contain any formal response to the Complainant's contentions.

The Center appointed Christiane Féral-Schuhl as the sole panelist in this matter on May 18, 2022. 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 worldwide known provider of audit, tax and advisory services and operates in approximately 147 countries.

The Complainant is the owner of many trademarks and is in particular the owner of the following trademarks (the "KPMG Trademarks"):

- the US trademark KPMG, No. 2339547, registered on April 11, 2000, and regularly renewed for products and services in classes 9, 16, 35, 36, 41 and 42;
- the European Union trademark KPMG, No. 001011220, registered on April 25, 2000, and regularly renewed for products and services in classes 9, 16, 35, 36, 41 and 42;
- the European Union trademark KPMG, No. 001179662, registered on June 27, 2000, and regularly renewed for products and services in classes 9, 16, 35, 36, 41 and 42.

The Disputed Domain Name <interview-kpmg.com> (hereinafter the "First Disputed Domain Name") was registered by the Respondent on March 23, 2022, and reverts to a fraudulent website which purports to belong to the Complainant.

The Disputed Domain Name <job-kpmg.com> (hereinafter the "Second Disputed Domain Name") was registered by the Respondent on March 23, 2022, and was inactive at the time of the Complaint. At the time of the decision, the Second Disputed Domain Name reverts to the parking webpage of the Registrar.

#### **5. Parties' Contentions**

##### **A. Complainant**

First, the Complainant stands that it is one of the world's leading providers of audit, tax and advisory services that owns more than 480 trademark registrations in the world (including the KPMG Trademarks). The Complainant contends that it owns very substantial international rights in the KPMG Trademarks that have been recognized by previous panels in at least 24 previous UDRP cases.

The Complainant contends that the Disputed Domain Names encompass the KPMG Trademarks in their entirety and that they are combined in both cases with descriptive terms respectively "interview" for the First Disputed Domain Name and "job" for the Second Disputed Domain Name. The Complainant stands that the fact that the second element of both Disputed Domain Names is identical to the distinctive and famous KPMG Trademarks conveys the meaning the Disputed Domain Names relate to its recruitment process, which demonstrates that the Disputed Domain Names are confusingly similar to the KPMG Trademarks.

Second, the Complainant contends that the Respondent does not have any rights or legitimate interests in respect of both Disputed Domain Names. The Complainant states that both Disputed Domain Names were registered many years after the establishment of its well-known KPMG Trademarks.

Moreover, the Complainant states that it has come to its attention that the Disputed Domain Names were used on several occasions in unlawful, fraudulent email and website scams while usurping the identity of several of its employees. The Disputed Domain Names were used to send fraudulent emails and also conduct fraudulent interviews for a fake position at the Complainant. Several people have fallen victim to this scam, and some of them even transmitted to the Respondent their identity documents and their banking information.

The Complainant states that it has no connection with the Respondent, the Disputed Domain Names or the email addresses used by the Respondent and that there is no credible evidence that the Respondent is commonly known by the Disputed Domain Names. The Complainant also stands that there is no credible evidence that the Respondent is making any legitimate noncommercial or fair use of the Disputed Domain Names.

Finally, the Complainant contends that the Disputed Domain Names were registered and are being used in bad faith by the Respondent. The Complainant underlines the fact that both Disputed Domain Names were registered and acquired primarily for the purpose of using them to target multiple third parties as part of a general scam. The Complainant states that the Disputed Domain Names are being used to send fraudulent emails while purporting to be emanating from its employees and that this use will disrupt the business and image of the Complainant by misleading members of the public into believing that the Disputed Domain Names are connected with the Complainant.

## **B. Respondent**

An email communication was received from the email address [...]@job-kpmg.com on April 27, 2022, expressing the willingness to explore settlement. According to the Complainant's evidence, this same email address was used for sending fraudulent emails to third parties.

The Respondent sent a couple of email communications to the Center as described under section 4 above, mainly asking "the reason for the dispute" and what it can do. However, the Respondent did not formally reply to the Complainant's contentions.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that the Complainant shall prove the following three elements:

- (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.

### **A. Identical or Confusingly Similar**

According to the Policy, paragraph 4(a)(i), the Complainant shall prove that the Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

First of all, the Panel finds that the Complainant has provided evidence that it has rights in the KPMG Trademarks.

Then, the Panel wishes to remind that the first element of the UDRP serves essentially 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.

This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of the UDRP (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that the First Disputed Domain Name is composed of:

- the KPMG Trademark in its entirety, and
- the term "interview", and
- a hyphen, and
- the generic Top-Level Domain ("gTLD") ".com".

Moreover, the Panel finds that the Second Disputed Domain Name is composed of:

- the KPMG Trademark in its entirety, and
- the term "job", and
- a hyphen, and
- the gTLD ".com".

According to prior UDRP panel decisions, it is sufficient that the domain name incorporates the entirety of a trademark, in order to consider the domain name as confusingly similar to that mark for purposes of UDRP standing. The mere addition of a word to a mark does not prevent a finding of confusing similarity (see *Hoffmann-La Roche Inc., Roche Products Limited v. Vladimir Ulyanov*, WIPO Case No. [D2011-1474](#); *Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. [D2000-1525](#); *Bayerische Motoren Werke AG v. bmwcar.com*, WIPO Case No. [D2002-0615](#); *Swarovski Aktiengesellschaft v. mei xudong*, WIPO Case No. [D2013-0150](#); *RapidShare AG, Christian Schmid v. InvisibleRegistration.com, Domain Admin*, WIPO Case No. [D2010-1059](#)).

The Panel considers that, in this case, the addition of the terms "interview" and "job" to the distinctive sign KPMG included in both Disputed Domain Names does not prevent a finding of confusing similarity between the latter and the KPMG Trademarks.

Moreover, the gTLD in a domain name is viewed as a standard registration requirement and as such is disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

Therefore, the Panel holds that the First Disputed Domain Name <interview-kpmg.com> and the Second Disputed Domain Name <job-kpmg.com> are confusingly similar to the KPMG Trademarks and that the Complainant has established the first element of paragraph 4(a) of the Policy.

## **B. Rights or Legitimate Interests**

According to the Policy, paragraph 4(a)(ii), the Complainant shall demonstrate that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.

The Policy, paragraph 4(c), outlines circumstances that if found by the Panel to be proved shall demonstrate the Respondent's rights or legitimate interests in the Disputed Domain Names.

These circumstances are:

- before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

According to prior UDRP panel decisions, it is sufficient that the complainant shows *prima facie* that the respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of production to the respondent (see *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

Indeed, while the overall burden of proof in UDRP proceedings is on the complainant, UDRP 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 *prima facie* 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](#)).

According to the Panel, the Complainant has shown *prima facie* that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.

Indeed, it appears that the Complainant has not given any license or authorization of any other kind to the Respondent to use the KPMG Trademarks. Moreover, the Panel finds that there is no evidence that the Respondent is commonly known by the Disputed Domain Names or that the Respondent has the intent to use the Disputed Domain Names in connection with a *bona fide* offering of goods or services. On the contrary, the Complainant has evidenced that both Disputed Domain Names are used to scam potential job applicants of the Complainant by setting with them for fraudulent interviews, while usurping the identity the employees of the Complainant, and then requesting them for their personal information including their identification documents and bank details.

In any case, the Respondent did not formally reply to the Complainant's contentions.

Moreover, considering the nature of the Disputed Domain Names, Internet users may think that the Disputed Domains are dedicated to the Complainant's recruiting process and thus automatically associating the Complainant with the Disputed Domain Names.

Therefore, according to the Policy, paragraphs 4(a)(ii) and 4(c), the Panel considers that the Respondent does not have rights to or legitimate interests in the First Disputed Domain Name <interview-kpmg.com> and the Second Disputed Domain Name <job-kpmg.com>.

### **C. Registered and Used in Bad Faith**

According to the Policy, paragraph 4(a)(iii), the Complainant shall prove that the Disputed Domain Names have been registered and are being used in bad faith.

Thus, paragraph 4(b) provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent's bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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.

First, the Panel considers that it is established that the Complainant's KPMG Trademarks were registered before the registration of the Disputed Domain Names and that the Complainant is worldwide known by its KPMG Trademarks. Therefore, there is a presumption of bad faith registration of the Disputed Domain Names, given the fact that the Disputed Domain Names wholly reproduce the KPMG Trademarks.

Moreover, the Panel points out that the First Disputed Domain Name revolves to a page purporting to provide interview information about the Complainant. This page is also used to scam users into thinking they are dealing with the Complainant by including a link where applicants can purportedly proceed to an interview. The Respondent has used the First Disputed Domain Name to invite third parties via text message by usurping the identity of some of the Complainant's employees. The Complainant has evidenced that it has received several complaints from users thinking they had gotten a position at the Complainant and thus sending their personal information to email addresses derived from both Disputed Domain Names.

The Second Disputed Domain Name was previously inactive and is currently linked to the parking webpage of the Registrar, which constitutes a passive holding use of the Second Disputed Domain Name. Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Moreover, the Second Disputed Domain Name was also used to derive email addresses as part of the recruiting scam originated from the First Disputed Domain Name.

Accordingly, the Panel finds that the Complainant has provided evidence that the two Disputed Domain Names were registered and used by the Respondent to implement a scam consisting of impersonating the Complainant and its employees to obtain identity information and bank documents.

Finally, the Respondent has not provided any formal response to the Complainant's contentions.

Considering all of the above, it is not possible to conceive any plausible actual or contemplated good faith registration and use of the Disputed Domain Names by the Respondent.

Therefore, in view of all the circumstances of this case, the Panel holds that the Respondent has registered and is using the Disputed Domain Names in bad faith according to the Policy, paragraphs 4(a)(iii) and 4(b).

## **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 <interview-kpmg.com> and <job-kpmg.com> be transferred to the Complainant.

*/Christiane Féral-Schuhl/*

**Christiane Féral-Schuhl**

Date: June 1, 2022