

ADMINISTRATIVE PANEL DECISION

Stichting BDO v. Contact Privacy Inc. Customer 7151571251 /
Name Redacted
Case No. D2022-1379

1. The Parties

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

The Respondent is Contact Privacy Inc. Customer 7151571251, Canada / Name Redacted¹

2. The Domain Name and Registrar

The disputed domain name <receivable-bdo.com> is registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 19, 2022. On April 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 19, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on April 27, 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 30, 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”).

¹ An identity theft appears to have taken place in this case. In light of the identity theft, the Panel has redacted the Respondent’s name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST 12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 30, 2022. Furthermore, on May 6, 2022, a third party sent a communication to the Center stating, "This note is in response to the letter I received from your organization relative to a domain dispute over <receivable-bdo.com>. I have never filed to use or used said domain name. Please remove my name from said complaint as I have no connection to this domain name".

The Center appointed Fabrizio Bedarida as the sole panelist in this matter on June 20, 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 in this proceeding 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 and is the owner of the BDO trademark and company name, and trademarks fully incorporating the BDO trademark.

The BDO Network is an internationally renowned network of public accounting firms that dates back to 1963. The BDO Network currently has over 88,000 global employees in 1,617 offices in 167 countries around the world, including in the United States, Europe, Africa and the Middle East, North and South America, and Asia. The Complainant affirms that since its adoption, the term "BDO" has acquired and developed considerable goodwill and fame in connection with a wide range of services within the financial services industry including audit, tax, and advisory services across sectors such as banking, capital markets, insurance, and asset management. The Complainant and members of the BDO Network have been consistently ranked amongst the top accounting firms in the United States and in the world, with USD 2+ billion in revenue in the United States alone and over USD 11.8 billion in global revenue combined.

The Complainant owns the BDO trademarks, which enjoy thorough protection through many registrations worldwide.

The Complainant is, *inter alia*, the owner of:

- United States Trade Mark registration number 4,854,142 for the BDO trademark, registered on November 17, 2015.
- United States Trade Mark registration number 2,699,812 for the BDO (device) trademark, registered on March 25, 2003.

In addition, the term "BDO" is part of the registered company name of the Complainant.

The Complainant also owns and operates the following domain names: <bdo.com> (registered on February 28, 1995), <bdointernational.com>, <bdo.com.au> (Australia), <bdo.at> (Austria), <bdo.be> (Belgium), <bdo.ca> (Canada), <bdo.fr> (France), <bdo.de> (Germany), <bdo.com.hk> (Hong Kong), <bdo.co.il> (Israel), <bdo.it> (Italy), <bdo.ma> (Morocco), <bdo.ch> (Switzerland) and <bdo.co.uk> (United Kingdom).

The disputed domain name was registered on April 12, 2022.

The disputed domain name does not direct to any active website but it has been used to impersonate an employee of Complainant to perpetrate a financial fraud/phishing scam by soliciting invoice payments from Complainant's clients or contacts.

The Complainant's trademark registrations predate the registration of the disputed domain name.

5. Parties' Contentions

A. Complainant

The Complainant claims that the disputed domain name, which contains the Complainant's complete BDO trademark paired with the descriptive term "receivable" and a hyphen, is confusingly similar to the Complainant's renowned trademark. The Complainant thus affirms that the descriptive term "receivable" suggests that the disputed domain name, or any email addresses using the "@Receivable-BDO.com" extension, may relate to, or originate from, the Complainant's accounting or billing department.

The Complainant further states that the Respondent has no rights or legitimate interests whatsoever with respect to the disputed domain name. No license or authorization of any other kind has been given by the Complainant to the Respondent to use the BDO trademark.

Moreover, the Complainant asserts that BDO is a renowned trademark, and consequently the Respondent was aware of the rights the Complainant has in the BDO trademark at the time of the registration.

The Complainant also affirms that although the Respondent was not using the disputed domain name to host a legitimate website, according to information and belief, the Respondent has however used the disputed domain name in relation to a corresponding email address from "@Receivable-BDO.com" with the contact portion of the email address featuring the name of an employee of the Complainant, and the email has an address used to impersonate an employee of the Complainant in order to perpetrate a financial fraud/phishing scam by soliciting payments of invoices from the Complainant's clients or contacts. In support of this argument the Complainant has provided a copy of an invoice (which bears the official BDO logo and contact information) that was attached to an alleged fraudulent email.

The Complainant then asserts that the Respondent's passive holding of the disputed domain name as well as the use of the disputed domain name to perpetrate a financial fraud/phishing scam constitutes bad faith pursuant to Policy paragraph 4(b)(iv).

The Complainant thus concludes that the Respondent tried to benefit from the Complainant's renowned trademark, and that the disputed domain name has been registered and is being used in bad faith.

B. Respondent

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

On May 6, 2022, in response to the communication informing the parties of the present proceeding sent by the Center via courier, a third party sent an email to the Center stating, "This note is in response to the letter I received from your organization relative to a domain dispute over <receivable-bdo.com>. I have never filed to use or used said domain name. Please remove my name from said complaint as I have no connection to this domain name".

6. Discussion and Findings

In order for the Complainant to obtain a transfer of the disputed domain name, paragraphs 4(a)(i) – (iii) of the Policy require that the Complainant must demonstrate to the Panel that:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

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

A. Identical or Confusingly Similar

The Complainant has established rights in the BDO trademark.

The disputed domain name consists of the BDO trademark combined with the term “receivable”. This Panel agrees with the Complainant’s assertion that the addition of the above term in the disputed domain name does not prevent a finding of confusing similarity between the Complainant’s trademarks and the disputed domain name.

See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.8: “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element”. Furthermore, the applicable generic Top-Level Domain (“gTLD”) “.com” is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Therefore, the Panel finds the disputed domain name to be confusingly similar to the BDO trademark in which the Complainant has rights.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

This Panel finds that the Complainant has made a *prima facie* case that the Respondent does not have rights or legitimate interests in the disputed domain name. The Respondent has no connection or affiliation with the Complainant, and the Complainant has not licensed or otherwise authorized the Respondent to use or register any domain name incorporating the Complainant’s trademark. The Respondent does not appear to engage in any legitimate noncommercial or fair use of the disputed domain name, nor any use in connection with a *bona fide* offering of goods or services. In addition, the Respondent does not appear to be commonly known by the disputed domain name or by a similar name. Moreover, the Respondent has not replied to the Complainant’s contentions, claiming any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Based on the evidence put forward by the Complainant, the Panel is of the opinion that the Respondent was aware of the Complainant’s trademark registrations and rights to the BDO mark when it registered the disputed domain name.

The disputed domain name has been registered and used for many decades and is a renowned trademark worldwide, especially in the financial sector. Hence, the registration of the disputed domain name does not seem to be a coincidence, and thus indicates that the Respondent knew of the Complainant’s mark and intentionally intended to create an association with the Complainant and its business at the time of the registration of the disputed domain name.

Inference of bad faith can also be found in the failure to respond to the Complainant’s contentions, and the Respondent’s lack of any rights or legitimate interests in the disputed domain name.

Another factor supporting the conclusion of bad faith registration and use of the disputed domain name is the fact that the Respondent deliberately chose to conceal its identity. In fact, it appears that the Respondent has misused the identity of a third party to register the disputed domain name.

Further inference of bad faith can be found in the use of the disputed domain name for an apparent phishing scam.

In fact, as clearly expressed in *Nelson Mullins Riley & Scarborough LLP v. Contact Privacy Inc. Customer 1246819098 / Debbi Scott*, WIPO Case No. [D2020-1404](#), the Respondent's impersonation of the Complainant using an email address originating from a disputed domain name "...for an apparent phishing scam... is very far from giving rise to any right or legitimate interest in the Disputed Domain Name on the part of the Respondent. Indeed, on the contrary, it signals that whatever interest the Respondent might have had in the Disputed Domain Name could not be legitimate".

Lastly, in these circumstances, the passive holding of the disputed domain name would not prevent a finding of bad faith. See section 3.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Accordingly, the Panel finds, on the basis of the evidence presented, that the Respondent registered and is using the disputed domain names in bad faith.

Therefore, the Complainant has satisfied paragraph 4(a)(iii) 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 <receivable-bdo.com> be transferred to the Complainant.

/Fabrizio Bedarida/

Fabrizio Bedarida

Sole Panelist

Date: July 1, 2022