

ADMINISTRATIVE PANEL DECISION

Stichting BDO v. Contact Privacy Inc. Customer 7151571251 /
BDO GLOBAL, BDO GLOBAL COMPANY
Case No. D2022-1380

1. The Parties

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

The Respondent is Contact Privacy Inc. Customer 7151571251, Canada / BDO GLOBAL, BDO GLOBAL COMPANY, U.S.

2. The Domain Name and Registrar

The disputed domain name <bdousa.net> 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 the same day, 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 20, 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 the first amended Complaint on April 23, 2022. The Complainant filed the second amended Complaint on April 25, 2022.

The Center verified that the Complaint together with the first and second 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. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 16, 2022.

The Center appointed Christian Gassauer-Fleissner 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 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.

The Complainant owns over 350 trademark registrations and applications in many countries, including U.S trademark registrations:

- U.S. trademark registration No. for BDO, 4854142, registered on November 17, 2015
- U.S. trademark registration No. for BDO (and device), 2699812, registered on March 25, 2003
- U.S. trademark registration No. for PEOPLE WHO KNOW, KNOW BDO., 4748152, registered on June 2, 2015

The Complainant and some member firms of the BDO network have been ranked amongst the top accounting firms in the US and in the world. The BDO network has currently over 88,000 global employees in 167 countries.

The dispute concerns the disputed domain name <bdousa.net> registered on December 8, 2021, that resolves to an inactive website.

5. Parties' Contentions

A. Complainant

The arguments put forward by the Complainant can be summarized as follows:

On the Respondent's identity, the Complainant claims that the Respondent registered the disputed domain name using a false registrant name and organization fully incorporating Complainant's BDO name and trademark.

On the first element of the Policy, the Complainant claims that the disputed domain name incorporates the Complainant's BDO mark in its entirety with the addition of the term "USA" and the generic Top-Level Domain ("gTLD") ".com".

On the second element of the Policy, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not commonly known by the disputed domain name. The Respondent uses the disputed domain name to suggest sponsorship or endorsement by the Complainant. The Respondent has not been authorized, licensed, or permitted by the Complainant to do so.

On the third element of the Policy, the Complainant claims that the Respondent had prior knowledge of the Complainant and its BDO trademark, therefore, the Respondent registered the disputed domain name in bad faith. The Respondent tried to create a likelihood of confusion with the Complainant's trademark in order to benefit financially from it.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

It has been a consensus view in previous UDRP decisions that a respondent's default (*i.e.*, failure to submit a response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true (see section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the Complaint, namely 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, under the first requirement of paragraph 4(a)(i) of the Policy, needs to establish that the disputed domain name is identical or confusingly similar to a trademark or a service mark in which it has rights.

The Complainant has shown that it holds rights over the trademark BDO, namely also US trademark registrations.

The disputed domain name incorporates the BDO mark with the addition of the suffix "USA" and followed by the gTLD ".com".

[WIPO Overview 3.0](#), section 1.11.1 reads: "The applicable Top Level Domain ('TLD') in a domain name (*e.g.*, '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test."

In many UDRP decisions, panels have found that the addition of terms does not prevent a finding of confusing similarity where the relevant trademark is recognizable within the disputed domain name. The disputed domain name is a combination of the Complainant's mark BDO and the geographical term "USA". The Panel finds that the inclusion of the word "USA" does not prevent the Complainant's mark from being recognizable in the disputed domain name, (see section 1.8 of [WIPO Overview 3.0](#)) which states that "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. The nature of such additional term(s) may however bear on assessment of the second and third elements".

The Panel finds the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The second element that the Complainant has to satisfy in order to prevail is established within paragraph 4(a)(ii) of the Policy.

Regarding the second element of the Policy, section 2.1 of the [WIPO Overview 3.0](#), states, “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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element”.

The disputed domain name contains the Complainant’s trademark and the geographical term “USA”. This suggests a sponsorship or endorsement by the Complainant. (See [WIPO Overview 3.0](#), section 2.5.1).

In this case, the Panel finds that the Complainant has made out a *prima facie* case. The Respondent has not submitted any arguments or evidence to rebut the Complainant’s *prima facie* case. Further, the Complainant has not authorized, licensed, or otherwise permitted the Respondent to use its BDO trademark. Also, the Respondent did not use the disputed domain name in connection with a *bona fide* offering of goods or services.

Concerning all trademark rights of the Complainant, the composition of the disputed domain name, and the provision of a false registrant name and organization fully incorporating Complainant’s BDO name and trademark, it can be assumed that the Respondent did not have any rights or legitimate interests regarding the disputed domain name.

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

C. Registered and Used in Bad Faith

The Complainant has been using the BDO mark for many years and has rights in many trademarks. The trademark BDO is a well-known trademark at least in key markets all over the world. The Complainant has provided evidence to support this argument.

Considering the reputation and public presence of the Complainant, it does not seem likely that the Respondent had no knowledge of the trademark. The Respondent knew or should have known about the existence of the Complainant’s trademark. (See [WIPO Overview 3.0](#) section 3.2.2). Further, in light of the lack of any rights to or legitimate interests in the disputed domain name by the Respondent and in the absence of any conceivable good faith use, the Panel finds from the present circumstances that the Respondent has registered the disputed domain name to take advantage of its significance as a trademark owned by the Complainant, intentionally creating a likelihood of confusion with the Complainant’s trademark.

The disputed domain name does not currently resolve to an active website at the moment of the decision; however, the current non-use of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding. (See section 3.3 of the [WIPO Overview 3.0](#)).

Additionally, the Respondent hid its identity by using a privacy/proxy registration service. This is an additional indicator of bad faith in the circumstances of this case. (See section 3.6 of the [WIPO Overview 3.0](#))

Under these circumstances, the Panel therefore finds that the Respondent registered and is using the disputed domain name in bad faith.

Thus, the Panel finds that the Complainant has satisfied the requirements of 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 <bdousa.net> be transferred to the Complainant.

Christian Gassauer-Fleissner
Christian Gassauer-Fleissner
Sole Panelist
Date: June 1, 2022