

ADMINISTRATIVE PANEL DECISION

Stichting BDO v. Privacy Service Provided by Withheld for Privacy ehf / lindy Georg

Case No. D2022-1531

1. The Parties

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

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / lindy Georg, United States of America.

2. The Domain Name and Registrar

The disputed domain name <bdousallp.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 28, 2022. On April 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 28, 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 29, 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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 12, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 1, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 2, 2022.

The Center appointed Torsten Bettinger as the sole panelist in this matter on June 30, 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 field of accounting, taxation, consulting and advice, and other professional services. It operates in 167 countries, employs around 88,000 partners and staff and operates through 1,617 offices worldwide.

The Complainant provided evidence of the following trademark registrations in the United States of America:

- BDO, Registration Number 4,854,142, registered on November 17, 2015,
- BDO & Design, Registration Number 2,699,812, registered on March 25, 2003.

The Complainant owns and operates the domain names <bdo.com> and <bdointernational.com>, as well as various domain names under country code Top-Level Domains (“ccTLDs”) such as <bdo.com.au> (Australia), <bdo.at> (Austria), <bdo.be> (Belgium), <bdo.ca> (Canada), <bdo.fr> (France), <bdo.de> (Germany), <bdo.com.hk> (Hong Kong, China), <bdo.co.il> (Israel), <bdo.it> (Italy), <bdo.ma> (Morocco), <bdo.ch> (Switzerland) and <bdo.co.uk> (United Kingdom).

The Respondent registered the disputed domain name on January 20, 2022.

The disputed domain name resolved to a website that appears to be hosted by the Registrar and does not display any content other than the following:

“2022 Copyright. All Rights Reserved. The Sponsored Listings displayed above are served automatically by a third party. Neither Parkingcrew nor the domain owner maintain any relationship with the advertisers. Privacy Policy”.

5. Parties’ Contentions

A. Complainant

The Complainant claims that its BDO Marks have acquired and developed a substantial reputation in connection with its financial and accounting services and have become distinctive and famous globally prior to the date on which the Respondent registered the disputed domain name.

With regard to the requirement of identity or confusing similarity between the trademark and the disputed domain name pursuant to paragraph 4(a)(i) of the Policy, the Complainant asserts that the disputed domain name is confusingly similar to its registered trademark BDO as

- the disputed domain name contains the Complainant’s complete BDO trademark and
- the addition of the country designation “USA,” and the corporate designation “LLP” are not sufficient to distinguish the disputed domain name from the Complainant’s mark BDO.

With regard to the Respondent having no rights or legitimate interests in the disputed domain name, the Complainant submitted that:

- 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, nor was it known as such prior

to the date on which the Respondent registered the disputed domain name;

- the Respondent trades on the value of the Complainant's famous trademark and is not making a legitimate noncommercial fair use of the disputed domain name; as the disputed domain name resolves to a page that appears to be parked or hosted by the Registrar but which does not display any content;
- the inactive holding of a disputed domain name is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use;
- the Respondent's failure to use the disputed domain name to provide a *bona fide* offering of goods and services confirms that it does not have a right or legitimate interest in the disputed domain name.

Finally, with regard to the disputed domain name having been registered and being used in bad faith, the Complainant argues that:

- the Respondent had constructive notice that the BDO mark was a registered trademark in the United States of America and many other jurisdictions worldwide;
- 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 passive or inactive holding of a domain name shall be considered bad faith registration and use of the disputed domain name as the BDO trademark is distinctive and well known throughout the world and as there is no reason for the Respondent to have registered the disputed domain name other than to trade off the reputation and goodwill of the Complainant's marks.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy states that the Complainant must prove each of the three following elements:

- (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 demonstrated that it owns multiple trademark registrations for the mark BDO prior to the registration of the disputed domain name on January 20, 2022.

It is well-established that the test of identity or confusing similarity under the Policy is confined to a comparison of the disputed domain name and the trademark alone, independent of the products for which the trademark is used or other marketing and use factors usually considered in trademark infringement cases (see sections 1.1.2 and 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

In this case, the disputed domain name contains the disputed domain name in its entirety and only differs from the Complainant's trademark BDO by the addition of the country designation "usa", and the corporate designation "LLP".

The Panel notes that it has long been established under the UDRP case law that the addition of a merely descriptive wording to a trademark in a domain name does not prevent a finding of confusing similarity under the first element of the UDRP (see section 1.8 of [WIPO Overview 3.0](#)). The Panel therefore agrees with the Complainant's assertion that the addition of the country designation "usa" and the corporate designation

“LLP” does not prevent a finding of confusing similarity the disputed domain name from the Complainant’s trademark.

Furthermore, it is well accepted under the UDRP case law that the specific generic Top-Level Domain (“gTLD”) designation such as “.com”, “.net”, “.org” is not to be taken into account when assessing the issue of identity and confusing similarity, except in certain cases where the applicable top-level suffix may itself form part of the relevant trademark (see [WIPO Overview 3.0](#) section 1.11).

For the foregoing reasons the Panel concludes that the disputed domain name is confusingly similar to the Complainant’s BDO trademarks in which the Complainant has exclusive rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy a respondent may establish its rights or legitimate interests in the domain name, among other circumstances, by showing any of the following elements:

“(i) before any notice to you [the Respondent] of the dispute, your 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
(ii) you [the Respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
(iii) you [the Respondent] are 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.”

The Complainant provided evidence of its extensive use and promotion of its BDO trademark and stated that the Respondent is not a licensee, authorized agent of the Complainant or in any other way authorized by the Complainant to register the disputed domain name.

These assertions and evidence are sufficient to establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

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 disputed 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](#).

The Respondent chose not to contest the Complainant’s allegations and has failed to come forward with any evidence to refute the Complainant’s *prima facie* showing that the Respondent lacks rights or legitimate interests. The Panel therefore accepts these allegations as undisputed facts.

From the record in this case, the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use.

On this basis and in light of the fact that the disputed domain name except for the addition of the country designation “USA” and the corporate designation “LLP” contains the Complainant’s trademark in its entirety the Panel concludes that the Respondent lacks rights and legitimate interests in the disputed domain name and that, accordingly, the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- i. circumstances indicating that the Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name; or
- ii. the Respondent has registered the disputed 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 disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. by using the disputed 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.

The Complainant holds multiple trademark registrations for the BDO trademark in various countries that predate the registration of the disputed domain name.

Given that as a result of extensive use and promotion the Complainant's BDO mark is widely known in many countries and that the Complainant's website and social media profiles prominently identify the Complainant as "BDO USA" and "BDO USA, LLP", it is inconceivable that the Respondent who appears to be located in the United States of America coincidentally registered the disputed domain name without any knowledge of the Complainant's rights in the BDO mark.

The fact that there is no evidence that the disputed domain name resolves to a webpage that merely shows an information about the Registrar's parking service but has not yet been actively used to show any substantive content does not prevent a finding of bad faith use.

Based on the record in this proceeding, the Panel is satisfied that the Complainant's BDO mark is distinctive and widely-known, including in the United States of America, where the Respondent is located.

Given that the disputed domain name consists of the Complainant's BDO mark in combination with the country designation "USA" and its corporate designation "LLP", the disputed domain name is also not susceptible to be used in a good faith manner. In addition, noting the composition of the disputed domain name, and its use to resolve to a Registrar's parking service, the Panel finds that the Respondent has registered and used the disputed domain name in bad faith.

Furthermore, the Respondent has not replied to the Complaint nor provided any evidence of actual or contemplated good faith use of the disputed domain name.

Finally, the details of the underlying registrant have been protected from the public Whois record by a privacy service.

The Panel therefore finds that the circumstances, as described above, show that the Respondent's registration and passive holding of the disputed domain name equals a bad faith registration and use of the disputed domain name and therefore the Complainant also 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, <bdousallp.com>, be transferred to the Complainant.

/Torsten Bettinger/

Torsten Bettinger

Sole Panelist

Date: July 13, 2022