

## **ADMINISTRATIVE PANEL DECISION**

Stichting BDO v. Contact Privacy Inc. Customer 7151571251 / Will Dan, BDO USA LLP

Case No. D2022-1803

### **1. The Parties**

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

The Respondent is Contact Privacy Inc. Customer 7151571251, Canada / Will Dan, BDO USA LLP, United States.

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

The disputed domain name <bdousllp.com> (the “Domain Name”) is registered with Google LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 19, 2022. On May 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On the same date, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on May 25, 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 May 28, 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 June 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 11, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 25, 2022.

The Center appointed Eva Fiammenghi as the sole panelist in this matter on August 2, 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, as well as various marks fully incorporating the BDO trademark.

The Complainant provided evidence of several trademark registrations for the mark BDO in several countries that predate the date of the Domain Name registration including, among others:

- incontestable US Trademark Registration No. 2,699,812 for BDO (figurative trademark) registered on March 25, 2003 in classes 9, 16, 35, 36, 41, 42; and
- incontestable US Trademark Registration No. 4,748,152 for PEOPLE WHO KNOW, KNOW BDO. registered on June 2, 2015 in classes 35, 42, 45.

Hereinafter collectively referred to as the “Complainant’s Trademarks.”

The Complainant owns and operates the domain name <bdo.com> since 1995, and it is also the owner of numerous other domain names incorporating the BDO trademark, where Internet users can find detailed information about the accounting, taxation, consulting and other services offered by the Complainant and its global network in connection with the Complainant’s Trademarks.

To name a few, the Complainant owns: <bdointernational.com>, and the country-code Top-Level Domain names <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 date of the Domain Name’s registration is May 14, 2022.

The Domain Name currently resolves to an error page.

#### **5. Parties’ Contentions**

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

The Complainant is an internationally renowned network of public accounting firms that dates back to 1963 operating under the “BDO” name; it currently has over 88 000 global employees 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 often refers to its United States-based business as “BDO USA”, “BDO USA, LLP” or “BDO United States”.

The Complainant owns over 350 trademark registrations and applications for various BDO marks in 173 territories, including United States. The Complainant underlines the fact that “bdo” is a fancy term, with no apparent meaning other than to designate the Complainant’s name and trademarks.

The Complainant highlights how, over nearly 60 years of use, the Complainant’s Trademarks have 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 argues that the Domain Name completely contains the Complainant's BDO trademark, paired with the country designation "us" and the corporate designation "llp".

Given the fact that in official and public communications, the Complainant often refers to its United States-based business as "BDO USA", "BDO USA, LLP" or "BDO United States", according to the Complainant, in this case, the addition of the descriptive terms "us" and "llp" increases the Domain Name's confusing similarity with the Complainant's Trademarks: as such, there is a high risk that Internet users may believe that there is an association between the Domain Name and the Complainant.

The Respondent is not affiliated with the Complainant and there is no evidence to suggest that the Respondent has registered the Domain Name to advance any legitimate interests.

The Complainant has never licensed or otherwise permitted the Respondent to use its trademark nor any domain name including its trademark. The Respondent registered and is using the Domain Name in bad faith.

The Complainant requests that the Domain Name be transferred to it.

## **B. Respondent**

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

## **6. Discussion and Findings**

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

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

The BDO mark consists of a coined term, where the letters "bdo" have no apparent meaning other than to designate the Complainant and the Complainant's Trademarks.

The Domain Name contains the Complainant's BDO trademark in its entirety, with the addition of the country designation "us", and the corporate designation "llp".

In cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. Furthermore, according to section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms does not prevent a finding of confusing similarity.

The Domain Name contains the BDO trademark in its entirety. The addition in the Domain Name of the letters "us" and the corporate designation "llp" does not prevent a finding of confusing similarity, as the BDO trademark remains clearly recognizable in the Domain Name.

Further, the applicable Top-Level Domain “.com” can be disregarded under the first element confusing similarity test, see section 1.11.1 of the [WIPO Overview 3.0](#).

Under these circumstances, the Panel concludes that the disputed domain name is confusingly similar to the Complainant’s mark.

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

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that the Respondent has rights or legitimate interests in the disputed domain name:

- (i) before any notice to you 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 (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 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 has not authorized, licensed, or permitted the Respondent to register or use the disputed domain name or to use the Complainant’s Trademarks.

The Complainant submits that although the WHOIS information identifies the registrant organization of the Domain Name as “Will Dan / BDO USA LLP,” the Respondent is not using the Domain Name to provide any goods or services under the business, individual, or organization name “BDO USA LLP,” and the Complainant has not been able to locate any additional evidence to indicate that Respondent is “commonly known” by the name “BDO USA LLP.”

The Panel finds on the record that there is therefore a *prima facie* case that the Respondent has no rights or legitimate interests in the Domain Name, and the burden is thus on the Respondent to produce evidence to rebut this presumption.

The Respondent has failed to show that it has acquired any trademark rights in respect of the Domain Name or that the Domain Name has been used in connection with a *bona fide* offering of goods or services.

To the contrary, the Domain Name has not been used for an active website but resolves to an error page.

There has been no evidence adduced to show that the Respondent has been commonly known by the Domain Name; and there has been no evidence adduced to show that the Respondent is making a legitimate noncommercial or fair use of the Domain Name.

The Panel finds that the Respondent has failed to produce any evidence to rebut the Complainant’s *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name.

The Panel therefore finds that the Respondent lacks rights or legitimate interests in the Domain Name, and that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

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

A finding of bad faith may be made where the Respondent knew or should have known of the Complainant’s rights in the BDO trademark prior to registering the Domain Name.

Given the notoriety of the Complainant and of the Complainant's Trademarks in the financial field; the distinctiveness acquired by the BDO trademark through over 60 years of use; and given the fact the term "bdo" has no apparent meaning other than to designate the Complainant and the Complainant's Trademarks, the Panel considers it most unlikely that the Respondent did not know of the Complainant and the Complainant's Trademarks when registering the Domain Name. Moreover, in this case, the addition of the company designation "llp" and of the term "us" which will be perceived as a geographical term referring to the United States where the Complainant's subsidiary operates, as well as the fact that the Respondent indicated that subsidiary's company name ("BDO USA LLP") when registering the Domain Name reinforces the finding that the Respondent was aware of and intended to impersonate the Complainant. The non-use of the Domain Name, in the circumstances, does not prevent a finding of bad faith.

The Panel concludes that the disputed domain name has been registered and is being used in bad faith, and that 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 <bdo>llp.com</bdo> be transferred to the Complainant.

*/Eva Fiammenghi/*

**Eva Fiammenghi**

Sole Panelist

Date: August 16, 2022