

ADMINISTRATIVE PANEL DECISION

**Stichting BDO v. Registration Private, Domains by Proxy, LLC / Pattee Colvin
Case No. D2022-2238**

1. The Parties

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

The Respondent is Registration Private, Domains by Proxy, LLC, United States / Pattee Colvin, United States.

2. The Domain Name and Registrar

The disputed domain name <accounts-bdo.com> is registered with Wild West Domains, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 21, 2022. On June 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 23, 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 June 24, 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 June 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 July 4, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 24, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 9, 2022.

The Center appointed Leon Trakman as the sole panelist in this matter on August 12, 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. The Complainant is the owner of the BDO trademark and company name, and marks incorporating the BDO trademark. The BDO Network was established in 1963. It has offices in over 160 countries in Africa and the Middle East, North and South America, and Asia.

The Complainant owns over 350 trademark registrations and applications in more than 170 states and territories for variations of its BDO trademarks, including the United States trademark registrations for the BDO Marks which include the registrations below.

Mark	Goods and Services	Registration No.	Registration Date
BDO	Various goods and services in Classes 9, 16, 35, 36, 41, 42 and 45	4,854,142	November 17, 2015
BDO & Design 	Various goods and services in Classes 9, 16, 35, 36, 41 and 42	2,699,812	March 25, 2003
PEOPLE WHO KNOW, KNOW BDO.	Various services in Classes 35, 42 and 45	4,748,152	June 2, 2015

The Complainant owns and operates a number of domain names including <bdointernational.com>, and country code Top-Level Domain (“ccTLD”) domain names not limited to <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).

In addition, the Complainant owns and operates the website at “www.bdo.com” which includes information about the accounting, taxation, consulting and other services offered by the Complainant in connection with the BDO trademark.

The disputed domain name was registered on May 25, 2022. The Registrant listed in the Whois record for the disputed domain name at the time of the filing of the Complaint was identified as Registration Private, Domains by Proxy, LLC.

5. Parties 'Contentions

A. Complainant

The Complainant submits, in accordance with paragraph 4(a) of the Policy, that:

1. The disputed domain name is identical or confusingly similar to the trademark in which the Complainant has rights;

2. The Respondent has no rights or legitimate interests in the disputed domain name; and
3. The disputed domain name was registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel determines that the disputed domain name is confusingly similar to the Complainant's trademark.

Firstly, the disputed domain name contains the Complainant's complete BDO trademark, with the addition of the term "accounts" and a hyphen.

Secondly, adding random characters or a term to a trademark in a domain name does not prevent a finding of confusing similarity. See *The Swatch Group AG, Swatch AG v. John Wison*, WIPO Case No. [D2019-3182](#).

Thirdly, the addition of ".com" generic Top-Level Domain ("gTLD") to the disputed domain name does not prevent a finding of confusing similarity to the Complainant's trademark. See *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS Computer Industry (a/k/a EMS)*, WIPO Case No. [D2003-0696](#).

Accordingly, the Panel determines that these facts demonstrate that the disputed domain name is confusingly similar to the Complainant's trademark.

B. Rights or Legitimate Interests

The Panel determines that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent does not satisfy the requirements of paragraph 4(c) of the Policy in being unable to demonstrate a right or legitimate interest in a domain name by satisfying one of the following criteria: (i) that before notice of the dispute, it had made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services; (ii) it is commonly known by the disputed domain name; or (iii) it is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain, to misleadingly divert consumers or to tarnish the trademarks of the Complainant. See paragraph 4(c) of the Policy.

Firstly, there is no evidence to support the proposition that the Respondent made demonstrable preparations prior to the notice of the dispute, to use the disputed domain name in connection with a *bona fide* offering of goods or services. Nor, as is evident under the Policy, paragraph 4(c)(iii), has the Respondent engaged in a legitimate noncommercial fair use of the disputed domain name since registration.

Secondly, the Respondent is not commonly known by the disputed domain name.

Thirdly, the Respondent is neither affiliated with, nor has it been licensed or authorized to use the Complainant's BDO Marks or any domain names incorporating the Complainant's trademark. See the Policy, paragraph 4(a)(ii). These facts constitute *prima facie* evidence that the Respondent does not have any rights or legitimate interests in the disputed domain name. See *CareerBuilder, LLC v. Stephen Baker*, WIPO Case No. [D2005-0251](#).

Given these findings, the Panel holds that the Complainant has discharged the burden of proving that the Respondent lacks rights or legitimate interests in the disputed domain name. The Panel determines further that the Respondent has not discharged the burden of production to demonstrate any rights or legitimate interests in the disputed domain name. See *Kate Spade, LLC v. Darmstadter Designs*, WIPO Case No. [D2001-1384](#).

C. Registered and Used in Bad Faith

The Panel determines that the Respondent registered and is using the disputed domain name in bad faith, as stipulated in the Policy, paragraph 4(a)(iii).

Firstly, the Respondent has registered the dispute domain name in bad faith. There is also no reasonable basis for the Respondent to have registered the disputed domain name other than to mislead Internet users into believing that it is owned by or being used on behalf of the Complainant. The Respondent's bad faith registration is evident in view of the composition of the disputed domain name, and the Respondent having no personal or business connection to the disputed domain name nor to the Complainant. Bad faith registration is also evident in the Respondent reasonably knowing of the Complainant's widely known trademark; registering the disputed domain name that is confusingly similar to that trademark; and not having any rights or legitimate interests in the disputed domain name.

The bad faith registration of a disputed domain name that is "so obviously connected with the Complainant and its products that its very use by someone with no connection with the Complainant suggests opportunistic bad faith." See *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#).

Secondly, the Respondent has not engaged in any legitimate, noncommercial, or fair use of the disputed domain name. See *Accenture Global Services Limited v. Contact Privacy Inc. Customer 1243443199 / Name Redacted*, WIPO Case No. [D2018-2677](#).

The disputed domain name that incorporates the Complainant's registered trademark was registered and is being used in bad faith, at variance with the requirements of the Policy, Paragraph 4(a)(iii). See *Telstra Corporation Limited v. Nuclear Marshmallows* (WIPO Case No. [D2000-0003](#)); *Jupiters Limited v. Aaron Hall* (WIPO Case No. [D2000-0574](#)).

The Respondent has registered and is using the disputed domain name in order to take advantage of the reputation and goodwill of the Complainant by creating confusion amongst Internet users. In particular, the Respondent is using the disputed domain name in a phishing scam, to solicit invoice payments from the Complainant's client by posing to be the Complainant by impersonating three of the Complainant's executives. Such a scheme is detrimental, not only to the Complainant in abusing its reputation and goodwill, but it is also harmful to third parties, such as customers who are deceived by the Respondent into buying non-existent goods and services, or to disclose sensitive information such as credit card details. See *Nelson Mullins Riley & Scarborough LLP v. Contact Privacy Inc. Customer 1246819098 / Debbi Scott*, WIPO Case No. [D2020-1404](#).

Both the Policy and prior decisions have maintained that such phishing practices constitute clear evidence of a respondent engaging in misleading and deceptive conduct constituting fraud. See the Policy, paragraph 4(b)(iv). See also *Carrefour v. WhoisGuard, Inc., WhoisGuard Protected / Robert Jurek, Katrin Kafut, Purchasing clerk, Starship Tapes & Records*, WIPO Case No. [D2017-2533](#); *Nelson Mullins Riley & Scarborough LLP v. Contact Privacy Inc. Customer 1246819098 / Debbi Scott*, WIPO Case No. [D2020-1404](#).

Accordingly, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith. Based on the evidence, the Respondent's intention is to mislead Internet users into believing that it is associated or affiliated with the Complainant, for the purpose of deceiving and defrauding them.

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 <accounts-bdo.com> be transferred to the Complainant.

/Leon Trakman/

Leon Trakman

Sole Panelist

Date: August 26, 2022