

## **ADMINISTRATIVE PANEL DECISION**

**BNP Paribas v. David Craig**  
**Case No. D2022-3494**

### **1. The Parties**

The Complainant is BNP Paribas, France, represented by Nameshield, France.

The Respondent is David Craig, United Kingdom.

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

The disputed domain names <bnp-paribasbonds.com>, <bnp-paribasclient.com>, and <bnp-paribasclients.com> are registered with Nicenic International Group Co., Limited (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 21, 2022. On September 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 21, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 September 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 17, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 18, 2022.

The Center appointed Federica Togo as the sole panelist in this matter on October 28, 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, an international banking group, is the registered owner of several trademarks worldwide for BNP PARIBAS e.g., International trademark registration No. 728598 for BNP PARIBAS, registered on February 23, 2000 for services in classes 35, 36, and 38 and designating several jurisdictions. This trademark has been duly renewed and is in force.

The disputed domain names <bnp-paribasbonds.com> and <bnp-paribasclient.com> were both registered on September 7, 2022, and the disputed domain name <bnp-paribasclients.com> was registered on August 4, 2022; all the disputed domain names resolve to an inactive webpage.

In addition, the undisputed evidence provided by the Complainant proves that one of the disputed domain names, i.e., <bnp-paribasclient.com>, has been used to send an email, while pretending to be a Complainant's employee, in order to phish for personal information and receive undue payment.

#### 5. Parties' Contentions

##### A. Complainant

It results from the Complainant's allegations that it is an international banking group with a presence in 65 countries, and one of the largest banks in the world. It stands as a leading bank in the Eurozone and a prominent international banking institution.

In addition, the Complainant owns the domain name <bnpparibas.com>, created on September 2, 1999 and operates the website at "www.group.bnpparibas" in order to promote its products and services.

The Complainant contends that its trademark BNP PARIBAS is well-known.

The Complainant further contends that the disputed domain names are confusingly similar to the Complainant's trademark BNP PARIBAS, since they contain the Complainant's registered trademark in its entirety. The disputed domain names only differ from the trademark BNP PARIBAS by the addition of the terms "bonds", "client", or "clients" and it is well-established that a domain name that wholly incorporates a complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain names. According to the Complainant, the Respondent is not known as the disputed domain names in the Whois database. In addition, the Respondent is not related in any way to the Complainant's business, nor is affiliated with the Complainant nor authorized by the Complainant in any way to use the trademark BNP PARIBAS. The Complainant does not carry out any activity for, nor has any business with the Respondent. Besides, the disputed domain names resolve to an inactive page and at least one of them, <bnp-paribasclient.com>, has been used in a phishing scheme. Indeed, the Complainant asserts that the Respondent has used the disputed domain name <bnp-paribasclient.com> to pass itself off as one of the Complainant's employees, in order to phish for personal information and receive undue payment. Using the disputed domain name in this manner is neither a *bona fide* offering of goods or services nor a noncommercial or fair use.

Finally, the Complainant contends that the disputed domain names were registered and are being used in bad faith. In fact, given the distinctiveness of the Complainant's trademarks and reputation, it is inconceivable that the Respondent could have registered the disputed domain names without actual knowledge of the Complainant's rights in the trademark, which evidences bad faith. Moreover, the disputed domain names resolve to an inactive page and mail exchange (MX) servers are configured. The Complainant contends it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain names by the Respondent that would not be illegitimate, such as by being a passing off, an

infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law. The incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use. Finally, the Respondent has used the disputed domain name <bnp-paribasclient.com> in a phishing scheme. Indeed, the Respondent attempted to pass off as one of the Complainant's employees. Therefore, the Complainant states that the Respondent used the disputed domain name <bnp-paribasclient.com> in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint 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". Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain names be transferred or cancelled:

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

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

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain names are identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided that the Complainant is the registered owner of several trademark registrations for BNP PARIBAS.

Prior UDRP panels have found that a domain name is confusingly similar to a complainant's trademark where the domain name incorporates the complainant's trademark in its entirety (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 1.7).

This Panel shares this view and notes that the Complainant's registered trademark BNP PARIBAS is fully included in the disputed domain names, followed by the terms "bonds", "client", or "clients" respectively. Furthermore, it is the view of this Panel that the addition in the disputed domain names of a hyphen and the terms "bonds", "client", or "clients" respectively do not prevent a finding of confusing similarity between the disputed domain names and the Complainant's trademark, being the Complainant's trademark recognizable in the disputed domain names (see [WIPO Overview 3.0](#) at section 1.8).

Finally, the generic Top-Level Domain ("gTLD") ".com" of the disputed domain names may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#) at section 1.11.1).

In the light of the above, the Panel finds that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights.

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

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain names. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain names.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and did, in particular, not authorize the Respondent's use of the trademark BNP PARIBAS, e.g., by registering the disputed domain names comprising the said trademark entirely.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain names in the sense of paragraph 4(c)(ii) of the Policy.

In addition, no content is displayed on the websites to which the disputed domain names resolve. Furthermore, the Respondent has not demonstrated any *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue in the sense of paragraphs 4(c)(i) and (iii) of the Policy (see, e.g., *Banca Monte dei Paschi di Siena S.p.A. v. Privacy service provided by Withheld for Privacy ehf / Julius Boyler*, WIPO Case No. [D2021-2296](#)). Moreover, the Panel notes that the disputed domain names are clearly constituted by the Complainant's registered trademark BNP PARIBAS and the term "bonds", "client", or "clients" respectively, which clearly refer to the Complainant's activity, tending to suggest sponsorship or endorsement by the Complainant. The Panel finds it most likely that the Respondent selected the disputed domain names with the intent to attract Internet users for commercial gain.

In addition, it results from the undisputed evidence before the Panel that the disputed domain name <bnp-paribasclient.com> has been used for sending fraudulent emails. UDRP panels have categorically held that the use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent (see [WIPO Overview 3.0](#) at section 2.13.1 with further references). In the case at hand, the Complainant submitted substantial evidence of such illegal activities by providing email correspondence sent from an email account under the disputed domain name <bnp-paribasclient.com>. This email correspondence has been signed in the name of a person, pretending to be a Complainant's employee. The Panel considers this evidence as sufficient to support the Complainant's credible claim of the Respondent's illegal activity.

It is acknowledged that once the Panel finds a *prima facie* case is made by a complainant, the burden of production under the second element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name (see [WIPO Overview 3.0](#) at section 2.1). Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds, in the circumstances of this case, that the Respondent has no rights or legitimate interests in the disputed domain names.

The Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

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

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain names have been registered and are being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain names' registration and use in bad faith.

Based on the evidence submitted by the Complainant, the Panel shares the view of other UDRP panels and finds that the Complainant's trademark BNP PARIBAS is well-known (e.g., *BNP Paribas v. Domain Admin, Whois protection, this company does not own this domain name s.r.o. / Louis Dale*, WIPO Case No. [D2022-1856](#)). Therefore, this Panel has no doubt that the Respondent positively knew that the disputed domain names consisted of the Complainant's trademark when registering the disputed domain names. Registration of the disputed domain names in awareness of the reputed BNP PARIBAS mark and in the absence of rights or legitimate interests in this case amounts to registration in bad faith (see e.g., *Bayer AG v. Privacy service provided by Withheld for Privacy ehf / farm construction, BAYERCROP POLAND*, WIPO Case No. [D2022-1043](#)).

The disputed domain names do not resolve to an active website, however the disputed domain name <bnp-paribasclient.com> has been used for sending fraudulent email pretending to be the Complainant's employee. In this regard, the Panel notes that the passive holding of the other two disputed domain names does not preclude a finding of bad faith (see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)). In fact, the further circumstances surrounding the disputed domain names registration confirm the findings that the Respondent has registered and is using the disputed domain names in bad faith: (1) the Complainant's trademark BNP PARIBAS is well-known; (2) the Respondent failed to submit a response or to provide any evidence of actual or contemplated good-faith use; and (3) the nature of the disputed domain names (e.g., incorporating the Complainant's trademark BNP PARIBAS plus the term "bonds", "client", or "clients", respectively, that corresponds to the complainant's area of activity, which creates a risk of implied affiliation). See [WIPO Overview 3.0](#) at sections 3.2.1 and 3.3).

Finally, this Panel agrees with the approach taken by previous UDRP panels stating that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending fraudulent email, phishing, identity theft, or malware distribution. Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers (see [WIPO Overview 3.0](#) at section 3.4). As explained above, it results from the undisputed evidence submitted by the Complainant that the disputed domain name <bnp-paribasclient.com> has been used for sending fraudulent email pretending to be the Complainant's employee, in order to phish for personal information and receive undue payment. The use of the disputed domain name <bnp-paribasclient.com> in such an illegal scheme additionally demonstrates that the Respondent not only knew of the Complainant, its business and marks, but also attempted to pass itself off as the Complainant.

In the light of the above, the Panel finds that the disputed domain names have been registered and are being used in bad faith pursuant to 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 names <bnp-paribasbonds.com>, <bnp-paribasclient.com>, and <bnp-paribasclients.com> be transferred to the Complainant.

*/Federica Togo/*

**Federica Togo**

Sole Panelist

Date: November 11, 2022