

ADMINISTRATIVE PANEL DECISION

Stichting BDO v. Registration Private / Domains by Proxy, LLC /
Williams Jayden
Case No. D2022-2087

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 / Williams Jayden, United States.

2. The Domain Name and Registrar

The disputed domain name <bdoglobalcompany.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 9, 2022. On June 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 10, 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 16, 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 18, 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 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 13, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 18, 2022.

The Center appointed Adam Samuel as the sole panelist in this matter on July 29, 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 a member of the international BDO network of accountancy and financial services firms. It owns a number of trademarks for the name BDO including US trademark registration number 4854142, registered on November 17, 2015. The BDO group promotes its business using a number of domain names, notably <bdo.com>, registered by the Complainant on February 27, 1995.

The disputed domain name was registered on May 22, 2021. It resolves to a website displaying an Internet browser error message.

5. Parties' Contentions

A. Complainant

The disputed domain name contains the Complainant's BDO trademark and the descriptive words "Global" and Company. These terms describe the Complainant which is a global company. The BDO trademark consists of a coined term. The addition of the generic Top-Level Domain ("gTLD") ".com" to the disputed domain name is without significance.

The Complainant's BDO mark is not a generic or descriptive term in which the Respondent might have an interest. The Respondent is not affiliated with the Complainant. The Complainant has not licensed or permitted it to use the Complainant's BDO mark or any domain name incorporating it. The Respondent is not commonly known by the disputed domain name.

The inactive holding of a disputed domain name is neither a good faith offering of goods or services nor a legitimate non-commercial or fair use.

The Respondent has used the disputed domain name in relation to a corresponding email address, which has been used in a hiring and phishing scam. The Respondent used his own email address as well as the disputed domain name to create an email address which was used to email a potential job candidate to tell her that her resume had been approved for a further interview with the Complainant. The Respondent also supplied a job applicant with a fake cheque made to here for purported "start-up" costs.

Given the Complainant's worldwide reputation, the Respondent should have been or was aware of the Complainant's BDO marks prior to registering the disputed domain name. There is no reason for the Respondent to have registered the disputed domain name 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

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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 disputed domain name consists of the Complainant's trademark, the words "global" and "company" and the gTLD ".com". That trademark has no independent or ordinary meaning.

The gTLD is irrelevant here as it is a standard registration requirement. See section 1.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)).

The words "global" and "company" describe the Complainant's corporate group. As, Section 1.8 of the [WIPO Overview 3.0](#) says:

"Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive ... or otherwise) would not prevent a finding of confusing similarity under the first element."

For these reasons, the Panel concludes the disputed domain name is confusingly similar to the Complainant's trademark.

B. Rights or Legitimate Interests

The Respondent is not called "BDO Global Company" or anything similar. There is no evidence that the Complainant has ever authorized the Respondent to use its trademark. The Respondent does not appear to have used the disputed domain name for any legitimate purpose.

Based on the available record, where the Complainant has made out a preliminary case that the Respondent lacks rights or legitimate interests, and in the absence of any response on this point, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name. See section 2.1 of the [WIPO Overview 3.0](#).

C. Registered and Used in Bad Faith

The disputed domain name consists of the Complainant's trademark, a made-up word, and two generic words that describe the Complainant's group.

On January 3, 2022, just over six months after registering the disputed domain name, the Respondent emailed a job candidate under the name of "HUMAN RESOURCES BDO Global" trying to persuade the candidate to use a "TELGRAM account" through which the candidate was going to communicate with him. One minute later, he was also emailing a job candidate from an email address which used the disputed domain name.

Both the act of registering a domain name using a well-known trademark and by using that mark in correspondence just over six months later, the Respondent showed that he registered the dispute domain name knowing of the Complainant's group and its trademark.

The Respondent appears to have registered the disputed domain name primarily to attract for commercial gain Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the disputed domain name. The Respondent's subsequent emails dated January 3, 2022 also suggest that he registered the disputed domain name to

engage in fraudulent activities. All this is evidence of registration and use in bad faith in accordance with paragraph 4(b)(iv) of the Policy.

For all these reasons, the Panel concludes that the Respondent registered and is using the disputed domain name in bad faith.

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, <bdoglobalcompany.com> be transferred to the Complainant.

/Adam Samuel/

Adam Samuel

Sole Panelist

Date: August 9, 2022