

ADMINISTRATIVE PANEL DECISION

Stichting BDO v. Jessica Hernandez
Case No. D2024-0716

1. The Parties

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

The Respondent is Jessica Hernandez, United States of America.

2. The Domain Name and Registrar

The disputed domain name <bdjoo.com> is registered with Realtime Register B.V. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 16, 2024. On February 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 16, 2024, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 20, 2024, 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 February 23, 2024.

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 February 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 17, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 20, 2024.

The Center appointed Benoit Van Asbroeck as the sole panelist in this matter on April 4, 2024. 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 financial services firm established in the Netherlands in 1963. The Complainant is now part of an international network of independent firms under the BDO brand with offices in 164 countries, including the United States.

The Complainant owns trademarks in the mark BDO, amongst which:

- United States Trademark No. 4854142 for BDO, registered on November 17, 2015, in International Classes 9, 16, 35, 36, 41, 42, and 45;
- United States Trademark No. 2699812 for , **BDO** registered on March 25, 2003, in International Classes 9, 16, 35, 36, 41, and 42.

The above trademarks will hereafter be referred to as “BDO Trademarks”.

The Complainant also owns numerous domain names incorporating the BDO Trademarks, which include <bdo.com>, <bdointernational.com>, <bdo.com.au>, <bdo.at>, <bdo.be>, <bdo.ca>, <bdo.fr>, <bdo.de>, <bdo.com.hk>, <bdo.co.il>, <bdo.it>, <bdo.ma>, <bdo.ch>, and <bdo.co.uk>. The domain name <bdo.com> is used for the Complainant's main official website and it offers information about the services offered by the Complainant and its global network.

The Respondent appears to be an individual located in the United States. The disputed domain name was registered on February 13, 2024, well after the Complainant secured rights in the BDO Trademarks. Evidence submitted by the Complainant shows that the disputed domain name resolves to a parking page. The Complainant also demonstrates that the disputed domain name has been used to create e-mail addresses, one of which was used to pose as one of the Complainant's employees and commit a financial fraud/phishing scam by soliciting payment of a legitimate invoice from one of the Complainant's customers while providing banking/payment information for a financial institution that is not used by the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, regarding the first element of the Policy, the Complainant contends that they have rights in the BDO Trademarks and that the disputed domain name is confusingly similar to these marks. They point out that the disputed domain name contains a misspelling of the BDO Trademarks as “bdjoo”. The Complainant believes that this particular misspelling and “typosquatted” version of the Complainant's BDO Trademarks may be intended to create visual confusion with the Complainant's “@bdo.com” email addresses, because in certain CAPS or fonts, the added letter “j” can get lost in or blend in with the preceding letter “d,” and the additional letter “o” again might be visually disregarded, if upon first glance, a reader sees the BDO trademarks in this misspelled and visually confusing formation. Furthermore, the Complainant notes that the generic Top-Level Domain (“gTLD”) “.com” can be ignored for the purposes of comparison of the disputed domain name to the Complainant's mark.

Regarding the second element of the Policy, the Complainant contends that the Respondent lacks a right or legitimate interest in the disputed domain name. The Complainant claim that their BDO Trademarks are not a descriptive term in which the Respondent might have an interest. Furthermore, the Complainant confirms

that the Respondent is neither affiliated with, nor has it been licensed or permitted to use the Complainant's BDO Trademarks or any domain names incorporating the BDO Trademarks. Moreover, the Complainant points out that the Respondent's name, as confirmed by the Registrar, does not correspond with the disputed domain name.

With respect to the third element of the Policy, the Complainant contends that the Respondent has registered and used the disputed domain name in bad faith for the following reasons. The Complainant claims that by using the disputed domain name to create a corresponding email address and to use such email address to pose as the Complainant, perpetrating a financial fraud/phishing scam, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location by creating a likelihood of confusion with the Complainant's BDO Trademarks as to the source, sponsorship, affiliation, or endorsement of its website as per paragraph 4(b)(iv) of the Policy. Furthermore, the Complainant points out that given the Complainant's worldwide reputation and the ubiquitous presence of the BDO Trademarks on the Internet, the Respondent was or should have been aware of the BDO Trademarks long before registering the disputed domain name. Moreover, the Complainant argues that the passive or inactive holding of a domain name that incorporates a registered trademark, without a legitimate Internet purpose, may indicate that the domain name is being used in bad faith under paragraph 4(a)(iii) of the Policy.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The Panel finds that the Complainant has clearly evidenced that it owns registered trademark rights to BDO. It should be noted that paragraph 4(a)(i) of the Policy does not set minimum requirements as to the jurisdictions of the trademarks a complainant relies on, nor as to the number, nature or scope of protection of such trademarks. Furthermore, one of the BDO trademarks that the Complainant relies on is figurative, however this can also be taken into account to show "rights in a mark" since the dominant portion of this trademark is the word "BDO". It is a consensus view of UDRP panels, with which the Panel agrees, that trademark registrations with design elements can prima facie satisfy the requirement that a complainant shows "rights in a mark" so long as the textual elements are not overtaken. [WIPO Overview 3.0](#), section 1.10.

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The Panel agrees with the Complainant that the disputed domain name is a clear case of "typosquatting" since the disputed domain name is a slight misspelling of the Complainant's registered trademark. [WIPO Overview 3.0](#), Section 1.9.

Finally, as for the applicable gTLD, i.e., the suffix ".com", the Panel holds that this can be disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, 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 domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel finds that the Respondent does not use the disputed domain name in connection with a bona fide offering of services and has not made a legitimate non-commercial or fair use of the disputed domain name. The evidence submitted by the Complainant shows that the disputed domain name has been used to create email addresses, one of which was used to pose as one of the Complainant’s employees and commit a financial fraud/phishing scam by soliciting payment of a legitimate invoice from one of the Complainant’s customers while providing banking/payment information for a financial institution that is not used by the Complainant. This kind of use of the disputed domain name does not represent a bona fide offering and does not support rights or legitimate interests in the disputed domain name. Moreover, Panels have held that the use of a domain name for illegal activity, here attempts to impersonate the Complainant, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

In addition, it is clear from the name of the Respondent, as confirmed by the Registrar, that they have not been commonly known as “bdjoo” prior to or after the registration of the disputed domain name. The Panel notes that the Respondent failed to respond to the Complaint and the evidence on record therefore does not contain any evidence of the same either. Furthermore, the Panel has taken note of the Complainant’s confirmation that they have not licensed, authorized, or permitted the Respondent to register domain names incorporating the Complainant’s BDO Trademarks and has not seen any evidence that would suggest the contrary. In the absence of any license or permission from the Complainant to use their trademarks, the composition of the disputed domain name, and the fact that the disputed domain name has been used to create email addresses used in an attempt to impersonate the Complainant, no actual or contemplated bona fide or legitimate use of the disputed domain name could reasonably be claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#); and *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. [D2010-0138](#)).

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent intentionally attempted to attract, for commercial

gain, Internet users by creating a likelihood of confusion with the Complainant's BDO Trademarks (paragraph 4(b)(iv) of the Policy). As the Panel found above under the first element, the disputed domain name is confusingly similar to the Complainant's BDO Trademarks. In addition, as discussed in detail under the second element above, the Respondent attempted to impersonate the Complainant by using the disputed domain name to create an email address purportedly belonging to one of the Complainant's employees. These circumstances, in combination with the Respondent's clear absence of rights or legitimate interests in the disputed domain name, are strong indicators of bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have held that the use of a domain name for illegal activity, here the impersonation of the Complainant (as detailed above) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Furthermore, the Panel believes that the Respondent knew or, at least, should have known at the time of registration that the disputed domain name included the BDO Trademarks. As demonstrated by the Complainant, such trademarks were registered many years before the registration of the disputed domain name where the Respondent is located, in the United States. Moreover, as detailed above, the disputed domain name was used to create email address used to impersonate the Complainant. This indicates that the Respondent had the Complainant's trademarks in mind when registering the disputed domain name. The Respondent's knowledge of the Complainant and the BDO Trademarks and therefore its registration in bad faith of the disputed domain name may accordingly also be inferred from these circumstances. [WIPO Overview 3.0](#), section 3.2.2.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy. The Panel finds that the Complainant has 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 <bdjoo.com> be transferred to the Complainant.

/Benoit Van Asbroeck/

Benoit Van Asbroeck

Sole Panelist

Date: April 18, 2024