

ADMINISTRATIVE PANEL DECISION

Banque Francaise Mutualiste (BFM) v. Kamlesh Kumar, Kamlesh Kumar
Case No. D2024-3096

1. The Parties

The Complainant is Banque Française Mutualiste (BFM), France, represented by Lexing Alain Bensoussan Avocats, France.

The Respondent is Kamlesh Kumar, Kamlesh Kumar, United Arab Emirates.

2. The Domain Name and Registrar

The disputed domain name <bfm-fr.com> is registered with DreamHost, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 29, 2024. On July 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 30, 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 (Proxy Protection LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 31, 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 August 2, 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 August 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 1, 2024. The Respondent sent email communications to the Center on July 31, 2024, and August 12, 2024. Accordingly, the Center informed the Parties about the Commencement of Panel Appointment Process by email on September 3, 2024.

The Center appointed Edoardo Fano as the sole panelist in this matter on September 10, 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.

Having reviewed the communication records in the case file provided by the Center, the Panel finds that the Center has discharged its responsibility under the Rules, paragraph 2(a), “to employ reasonably available means calculated to achieve actual notice to [the] Respondent”. Therefore, the Panel shall issue its Decision based upon the Complaint, the Policy, the Rules and the Supplemental Rules and without the benefit of a formal response from the Respondent.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

4. Factual Background

The Complainant is Banque Française Mutualiste (BFM), a French company operating in the banking field, and owning several trademark registrations containing its common abbreviation BFM as their distinctive element, among which the following ones:

- French Trademark Registration No. 3375212 for BFM ENERGIE, registered on August 11, 2005;
- French Trademark Registration No. 3927349 for BFM AVENIR, registered on June 14, 2012;
- French Trademark Registration No. 4026469 for BFM BANQUE FRANÇAISE MUTUALISTE and design, registered on August 12, 2013.

The Complainant also operates on the Internet, having registered the domain names <banquefrancaisemutualiste.fr> and <bfm.fr>, and being “www.banquefrancaisemutualiste.fr” its official website, to which the domain name <bfm.fr> is redirecting.

The Complainant provided evidence in support of the above.

According to the Whois records, the disputed domain name was registered on March 20, 2024, and it is currently inactive. However, when the Complaint was filed, the disputed domain name was redirecting to the “customer relations” page of the Complainant’s official website. Moreover, the Complainant provided evidence that the disputed domain name was used to conduct a fraudulent phishing activity in which the Respondent sent email communications to third parties by impersonating 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, the Complainant states that the disputed domain name is confusingly similar to its trademarks containing the abbreviation BFM, as the disputed domain name wholly incorporates the Complainant’s common abbreviation BFM, with the addition of the suffix “fr” as the abbreviation of the geographical location “France”, where the Complainant is located and is doing business.

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name since it has not been authorized by the Complainant to register the disputed domain

name or to use its trademark within the disputed domain name, it is not commonly known by the disputed domain name and it is not making either a bona fide offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name. The disputed domain name was used by the Respondent to redirect to the “customer relations” page of the Complainant’s official website and to conduct a fraudulent phishing activity as the Respondent sent email communications to third parties by impersonating the Complainant.

The Complainant submits that the Respondent has registered the disputed domain name in bad faith, since the abbreviation BFM contained in the Complainant’s trademarks is distinctive and well known in the banking field. Therefore, the Respondent targeted the Complainant’s trademark at the time of registration of the disputed domain name and the Complainant contends that the disputed domain name was registered with the aim to disrupt the Complainant’s business, to attract, for commercial gain, Internet users to the Respondent’s website, creating a likelihood of confusion with the Complainant’s trademark as to the affiliation of the Respondent’s website, and to conduct a fraudulent phishing activity, which qualifies as bad faith registration and use.

B. Respondent

The Respondent has made no formal reply to the Complainant’s contentions.

In the Respondent’s email communication of July 31, 2024, the Respondent stated:

“This is to inform you that this domain registrant information was not updated. This domain was registered for one of my clients. Here are the details for the client. Please communicate with him for all further communications and use his email address. Please update the registrant information as follows:

Name: [Redacted]
Address: [Redacted]
City: Dubai
Country: UAE
Email: [Redacted]
Contact Number: [Redacted]

Please update the registrant information mentioned below and communicate with him for further details.”

In the Respondent’s email communication of August 12, 2024, the Respondent addressed the communication to the alleged beneficial holder of the disputed domain name:

“Dear Mr. [Redacted],

I have received all these documents on your behalf and I’m sending these all documents including the settlement form to your other email address as well. Please do the needful.”

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (i) the disputed domain name is 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 name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Preliminary Issue – Respondent Identity

The Respondent's informal communications suggest that the Respondent is not the beneficial holder of the disputed domain name.

The Panel notes that paragraph 1 of the Rules defines “Respondent” as “the holder of a domain-name registration against which a complaint is initiated” and that the appointed panel retains discretion to determine the respondent against which the case should proceed. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.4.5.

In this regard, the Panel also notes the panel's findings in *Hon Hai Precision Industry Co., Ltd. v. Mauricio Ruiz Diaz, Nineteen Solutions*, WIPO Case No. [D2023-3208](#):

“The Panel further notes as stated in a previous UDRP decision *Bryan Cave Leighton Paisner LLP v. Job*, WIPO Case No. [D2020-0592](#), ‘[...] in certain circumstances, especially when (i) the identity of the beneficial holder is disclosed, (ii) the beneficial holder submits arguments explaining its position, or (iii) the relationship between the registrant of the domain name and the beneficial holder is clear, panels would normally consider any submission by the beneficial holder (and, obviously, the submissions by the registrant) in reaching their decisions (including for the purposes of the determination of the respondent's identity) [...]’

Considering the circumstances of this proceeding, in particular, the silence of the beneficial holder, the Panel finds in the present case there is no evidence on the existence and nature of any relationship between the listed registrant and the beneficial holder which would allow the Panel to consider that the beneficial holder should be treated as a further Respondent.

Further, the Panel also agrees that ‘[t]he existence of a beneficial holder should not serve generally to renege on the obligations and responsibilities that a registrant of a domain name has by virtue of its registration. The Panel considers that if the disputed domain name is not being used by the registrant itself, the registrant should adopt such measures that are necessary to tend to ensure the proper and bona fide use of its registered domain name (for example via contractual obligations in a license to use the disputed domain name) and should not turn a blind eye or expect a disclaimer of its responsibility merely because of the use is being carried out by a beneficial holder and not the registrant itself.’ See *Bryan Cave Leighton Paisner LLP v. Job*, supra.”

In the circumstances of this case, the Panel finds that “Kamlesh Kumar, Kamlesh Kumar” is the Respondent in this proceeding.

B. 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 3.0](#), section 1.7.

Based on the available record, the Panel finds 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 entirety of the dominant element “BFM” of the Complainant's trademarks is reproduced 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.

While the addition of other terms, here “fr”, may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

It is also well accepted that a generic Top-Level Domain, in this case “.com”, is typically ignored when assessing the similarity between a trademark and a domain name. [WIPO Overview 3.0](#), section 1.11.1.

The Panel also finds that the overall facts and circumstances of this case (use of the disputed domain name to conduct a fraudulent phishing activity in which the Respondent sent email communications to third parties by impersonating the Complainant) supports a finding of confusing similarity, as it is clear that the Respondent registered the disputed domain name precisely because it believed that the domain name was confusingly similar to the Complainant’s trademarks. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established.

C. 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.

While 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 often impossible 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. 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 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.

Panels have held that the use of a domain name for illegal activity, here phishing and impersonation/passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

D. 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, regarding the registration in bad faith of the disputed domain name, the reputation in the banking field of the abbreviation BFM contained in the Complainant’s trademarks is clearly established, and the Panel finds that the Respondent must have known of the Complainant, and deliberately registered the disputed domain name in bad faith, especially because the latter was used to redirect to the “customer relations” page of the Complainant’s official website as well as to conduct a fraudulent phishing activity in which the Respondent sent email communications to third parties by impersonating the Complainant.

The Panel further notes that the disputed domain name was also used in bad faith since the Respondent was trying to impersonate the Complainant, in connection to a phishing scheme, with the purpose of intentionally attempting to create a likelihood of confusion with the Complainant’s trademark as to the disputed domain name’s source, sponsorship, affiliation or endorsement. Panels have held that the use of a domain name for illegal activity, here phishing and impersonation/passing off, constitutes bad faith.

[WIPO Overview 3.0](#), sections 3.1.4 and 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

As regards the current use of the disputed domain name, being inactive, panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the record, the Panel notes the distinctiveness and reputation of the Complainant's trademark in the banking field, the composition of the disputed domain name, the previous use of the disputed domain name and the failure of the Respondent to submit a formal response, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Based on the available record, the Panel finds the third element of the Policy has been established.

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, <bfm-fr.com>, be transferred to the Complainant.

/Edoardo Fano/

Edoardo Fano

Sole Panelist

Date: September 20, 2024