ARBITRATION
AND
MEDIATION CENTER

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

ADMINISTRATIVE PANEL DECISION
Stichting BDO v. chiemela uruakpachiemela
Case No. D2025-0029

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 chiemela uruakpachiemela, Germany.

2. The Domain Name and Registrar

The disputed domain name <bdoglobal.works> is registered with Hostinger Operations, UAB (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 4, 2025. On January 6, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 7, 2025, 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 (Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 14, 2025, 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 January 17, 2025.

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 January 17, 2025. In accordance with the Rules, paragraph 5, the due date for Response was February 6, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 7, 2025.

The Center appointed Dr. Hong Xue as the sole panelist in this matter on February 11, 2025. 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 network of public accounting firms dating back to 1963, offering financial services including audit, tax, and advisory services such as banking, capital markets, insurance, and asset management in more than 100 countries and territories.

According to the trademark registration information published by the European Union Intellectual Property Office (EUIPO), the Complainant registered the following European Union trademarks on December 9, 2002, i.e. BDO (Registration number 002419778) and BDO & device (Registration number 002419315). Both marks are registered on accounting services, fiscal assessments, and other goods or services. Both registrations are effective within the European Union until October 22, 2031.

The Complainant proves that it registered in the United States of America ("U.S.") the mark BDO (Registration number 4854142) on accounting services and other goods or services on November 17, 2015.

The Complainant states that it owns over 350 trademark registrations and applications in 173 territories for various BDO marks and provides three U.S. trademark registration certificates for the BDO Marks.

The Complainant registered <bdo.com> on February 27, 1995 and owns and operates <bdo.com>, <bdo.de> and other domain names containing BDO.

The disputed domain name <bdoglobal.works> was registered on December 12, 2024. The disputed domain name does not resolve to any website but is used in the email address of "[…]@bdoglobal.work" posing as the work email of the "Staff Opertional [typo from the original text] Controller at BDO Global".

The Respondent "chiemela uruakpachiemela" is based in Germany, which is a Member State of the European Union. The Respondent did not submit any response.

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, in the Complainant's contention, the disputed domain name is confusingly similar to its BDO trademarks that are substantially reputable in association with the Complainant's services over 60 years of use. The Respondent has no legitimate interest in respect of the disputed domain name for, inter alias, using the disputed domain name in relation to a corresponding email address to perpetuate a hiring/phishing scam. The BDO trademark is distinctive and well known throughout the world, and it is highly likely that the Respondent registered and used the disputed domain name in bad faith.

The Complainant requests the disputed domain name be transferred from the Respondent to the Complainant.

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 the marks of BDO for the purposes of the Policy. WIPO Overview 3.0, section 1.2.1.

The Panel finds the mark BDO is recognizable within the disputed domain name <bdoglobal.works>. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. WIPO Overview 3.0, section 1.7.

Although the addition of "global" to "bdo" may bear on assessment of the second and third elements, the Panel finds the addition of such a descriptive term does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's BDO marks for the purposes of the Policy. WIPO Overview 3.0, section 1.8.

The generic Top Level Domain ("gTLD") in disputed domain name, i.e. ".works", is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. WIPO Overview 3.0, section 1.11.

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.

Panels have held that the use of the disputed domain name for impersonation of the work email of the "Staff Operational Controller" of "BDO Global", which is discussed further in the third element, can never confer rights or legitimate interests on the Respondent. WIPO Overview 3.0, section 2.13.1.

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, long before the registration of the disputed domain name, the Complainant's marks BDO and BDO & device have been registered in European Union, where the Respondent resides in. The Complainant has been promoting and disseminating the information about BDO accounting and other professional services on the Internet through the websites of "www.bdo.com", "www.bdo.de", etc. In absence of any rights or legitimate interests in the disputed domain name, the Respondent's choice of registration of "bdoglobal" in the disputed domain name is highly likely an imitation to the Complainant's BDO marks. In addition, the ordinary meaning ascribed to the gTLD ".works" signals the Respondent's abusive intent to confuse Internet users that the disputed domain name refers to the "works/jobs at BDO Global". WIPO Overview 3.0, section 3.2.1.

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.

The Panel, particularly, notes that the disputed domain name is used to pose as the work email address of "Staff Opertional Controller at BDO Global", through which the fake employment documents with the Complainant's registered BDO & device mark used as the letterhead were sent to a scam victim. The impersonated emails pretending to be sent from the Complainant clearly know that "BDO is an international network of public accounting, tax and advisory firms which perform professional services under the name of BDO". While looking at the total circumstances of the registration and use of the disputed domain name, the Panel finds that it is the Respondent that is behind the email address "[…]@bdoglobal.works" and the recruitment scam.

Panels have held that the use of the disputed domain name to impersonate the work email of the Complainant's staff operational controller for a recruitment scam constitutes bad faith. WIPO Overview 3.0, section 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.

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 <bdoglobal.works> be transferred to the Complainant.

/Dr. Hong Xue/
Dr. Hong Xue
Sole Panelist
Date: February 21, 2025