

## **ADMINISTRATIVE PANEL DECISION**

The Bank of New York Mellon v. Browning Mank, Vidapop  
Case No. DAI2024-0056

### **1. The Parties**

Complainant is The Bank of New York Mellon, United States of America ("United States"), represented by Dinsmore & Shohl LLP, United States.

Respondent is Browning Mank, Vidapop, United States.

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

The disputed domain name <bny.ai> (the "Domain Name") is registered with 1API GmbH (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 23, 2024. On July 24, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On July 29, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Privacy Service Provided by Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email to Complainant on August 7, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on August 12, 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 Respondent of the Complaint, and the proceedings commenced on August 15, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 4, 2024. Respondent sent two email communications to the Center and Complainant on August 7, 2024, then an additional two communications on August 13, 2024, and one further communication on September 13, 2024.

The Center appointed Robert A. Badgley as the sole panelist in this matter on September 17, 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**

According to the Complaint:

“Complainant, The Bank of New York Mellon, (‘Complainant’ or ‘BNY’) is a well-known leading global financial services and investments company that helps its clients manage and service their financial assets through the investment lifecycle. Complainant, as of June 30, 2024, had approximately USD 49.5 trillion in assets under custody and/or administration, and USD 2.0 trillion in assets under management on behalf of clients around the world. Complainant is one of the three oldest banking corporations in the United States and one of the oldest banks in the world, having been established in 1784 as the Bank of New York by a group including Alexander Hamilton. The estimated number of employees worldwide as of May, 2024 for Complainant was approximately 54,000 across 6 continents.”

“Complainant has used the name BNY continuously since 2006, and the names BNY MELLON and THE BANK OF NEW YORK MELLON continuously since 2007, when The Bank of New York Company, Inc. merged with Mellon Financial Corporation. Complainant is the owner of over 20 existing U.S. federal registrations for trademarks comprising or containing these names, and many others around the globe (collectively, the ‘BNY Marks’).”

One of Complainant’s registered trademarks is United States Patent and Trademark Office Reg. No. 3,117,825 for the word mark BNY, registered on July 18, 2006 in connection with, among other things, banking and financial services, with an April 10, 2006 date of first use in commerce.

Complainant asserts that, “due to widespread, continuous, and highly publicized use throughout the United States and the world, the BNY Marks have become famous and were famous long before Respondent registered the Disputed Domain Name.” According to Complainant, “BNY is consistently named as one of the top 100 most valuable banking brands in the world by Brand Finance.” Additionally, Complainant states, “an [I]nternet search for just the term ‘BNY’, brings up Complainant’s website as the first hit.”

Complainant’s website is located via the domain name <bny.com>, a domain name Complainant has owned since March 10, 1995.

The Domain Name was registered on May 9, 2023. The Domain Name resolves to a parking page which states, among other things, “The domain is registered, but may still be available,” with a link that states “Get this domain.”

#### **5. Parties’ Contentions**

##### **A. Complainant**

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

##### **B. Respondent**

Respondent did not formally reply to Complainant’s contentions. Respondent’s essential position in this case is largely captured in the following three emails, the first two of which were sent on August 7, 2024 and the last on September 13, 2024:

"Why don't you just give me a reasonable offer for the domain address? Willing to work with you, so we both can be happy."

"Again, you are requested to speak to your client (if they are your client) about purchasing the URL at a reasonable price and resolving your dispute services."

"I responded last time that this domain is my property and you are welcome to offer a reasonable bid for purchase. That was my formal response. This is a frivolous complaint and there is no infringement. There is no public or private website that would cause any confusion about IP. Feel free to submit an offer please if you actually represent BNY."

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

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

The Panel finds that Complainant has rights in the mark BNY through registration and use demonstrated in the record. The Panel also finds that the Domain Name is identical to that mark.

Complainant has established Policy paragraph 4(a)(i).

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

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a bona fide offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in connection with the Domain Name. Respondent has not come forward to deny that it was aware of Complainant's BNY mark when he registered the Domain Name. Nor has Respondent attempted to articulate, much less support with evidence, some type of legitimate reason for having registered the Domain Name. Based on the record presented here, including Respondent's brief emails to the Center (quoted above), the only discernible motivation Respondent seems to have had vis-à-vis the Domain Name was to capitalize on the renown of Complainant's BNY mark by selling the Domain Name to the Complainant for a profit. Such conduct does not invest Respondent with rights or legitimate interests in respect of the Domain Name.

Complainant has established Policy paragraph 4(a)(ii).

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

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation,” are evidence of the registration and use of the Domain Name in “bad faith”:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the Domain Name; or
- (ii) that Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes that Respondent registered and used the Domain Name (which is identical to Complainant’s trademark) in bad faith under the Policy. The Panel incorporates its discussion above in the “Rights or Legitimate Interests” section. On this record, including Respondent’s own statements, the Panel finds, on a balance of probabilities, that Respondent targeted Complainant’s BNY mark when registering the Domain Name, and did so in order to sell the Domain Name for a sum exceeding his registration costs in violation of the above-quoted Policy paragraph 4(b)(i). Respondent has not even suggested let alone provided evidence of any other motivation.

Complainant has established Policy paragraph 4(a)(iii).

### **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 Domain Name <bny.ai> be transferred to Complainant.

*/Robert A. Badgley/*

**Robert A. Badgley**

Sole Panelist

Date: October 1, 2024