



सत्यमेव जयते

# INDIA NON JUDICIAL Government of Uttar Pradesh

e-Stamp

Signature.....

ACC Name: RAHUL VERMA, ACC Code: UP14003004

ACC Add: Sub-Registrar, Noida, Mob. 9810434882

License No.: 115/10, Tehsil & Distt- Dadri, G. B. Nagar, UP

Certificate No.	: IN-UP17272741518069S
Certificate Issued Date	: 18-Dec-2020 03:09 PM
Account Reference	: NEWIMPACC (SV)/ up14003004/ NOIDA/ UP-GBN
Unique Doc. Reference	: SUBIN-UPUP1400300427975562088637S
Purchased by	: PUNITA BHARGAVA
Description of Document	: Article 12 Award
Property Description	: Not Applicable
Consideration Price (Rs.)	:
First Party	: PUNITA BHARGAVA
Second Party	: Not Applicable
Stamp Duty Paid By	: PUNITA BHARGAVA
Stamp Duty Amount(Rs.)	: 100 (One Hundred only)



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BEFORE THE NATIONAL INTERNET EXCHANGE OF INDIA  
.IN REGISTRY

Arbitral Award in Case No. 1280 dated October 28, 2020

Ms. Punita Bhargava, Sole Arbitrator

Disputed domain name: <BNPPARIBAS-AM.IN>

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**In the matter of**

**BNP PARIBAS**

16 boulevard des italiens  
F-75009 Paris  
France

... Complainant

v.

**Apex Consulting**

**Yitao**

No. 33, Tongji East Road, Chancheng  
District, FoShan City, Guangdong  
Province, FoShan, Hong Kong 528000 HK  
China

... Respondent

**1. The Parties**

The Complainant in this proceeding is BNP PARIBAS, a French corporation of the address 16 boulevard des italiens, F-75009 Paris, France and is represented by Nameshield SA, a French legal entity with registration n° 399 140 961 R.C.S. Paris.

The Respondent in this proceeding is Apex Consulting of the address No. 33, Tongji East Road, Chancheng District, FoShan City, Guangdong Province, FoShan, Hong Kong 528000 HK, China.

**2. Disputed Domain Name and Registrar**

This dispute concerns the domain name <BNPPARIBAS-AM.IN> (the 'disputed domain name') registered on August 13, 2018. The Registrar with which the disputed domain name is registered is Dynadot, LLC.

**3. Procedural History**

The arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy (Policy), adopted by the National Internet Exchange of India (NIXI).

NIXI vide its email dated October 22, 2020 requested availability of Ms. Punita Bhargava to act as the Sole Arbitrator in the matter. The Arbitrator indicated her availability and submitted the Statement of Acceptance and Declaration of Impartiality and Independence in compliance with the .INDRP Rules of Procedure (Rules) on the same date.

In accordance with Rules, NIXI vide its email of October 26, 2020 appointed the Arbitrator and also notified the Respondent of the Complaint. The Arbitrator sent an email to the Complainant on October 28, 2020 with regard to Annex 2 filed by it and asking for clarification on the documents filed under such Annex. However, no



response was received from the Complainant. Accordingly, the Arbitrator sent an email to the Respondent on October 28, 2020 informing it of the commencement of the proceeding and providing it time of two weeks to file its reply.

No reply was received from the Respondent within the time prescribed and so the Arbitrator sent an email to all concerned parties on November 19, 2020 that the Arbitrator would proceed to pass its award ex-parte taking into consideration all the material presented before it.

The language of this proceeding is English.

4. **Background of the Complainant and its rights in BNP PARIBAS as submitted by it**  
The Complainant is an international banking group with a presence in 72 countries, and one of the largest banks in the world. It has more than 202,624 employees and €7.5 billion in net profit and is a leading bank in the Eurozone and a prominent international banking institution. Information about it can be seen at [www.group.bnpparibas](http://www.group.bnpparibas).

The Complainant owns a large portfolio of trademarks including the word "BNP PARIBAS" in several countries including in India. It also owns and communicates on Internet through various domain names, such as <bnpparibas.com> registered since September 2, 1999 and <bnpparibas.in> registered since February 20, 2005.

5. **Respondent's default**

Despite notice of the present proceeding in terms of the Rules and an opportunity to respond, no response has been received from the Respondent in this matter by the Arbitrator.

6. **Grounds for Complaint**

The Complainant contends that the disputed domain name is confusingly similar to its trademark BNP PARIBAS as it incorporates the trademark in its entirety. It also contends that the addition of the generic term "AM" (for "Asset Management") and a hyphen is not sufficient to escape the finding that the domain name is confusingly similar to the trademark BNP PARIBAS and it does not change the overall impression of the designation as being connected to the Complainant's trademark BNP PARIBAS. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and domain names associated. The Complainant contends that the addition of the ccTLD ".IN" is not sufficient to escape the finding that the domain is confusingly similar to its trademark and does not change the overall impression of the designation as being connected to the trademark of the Complainant.

The Complainant contends that the Respondent has no rights or legitimate interest in respect of the disputed domain name as the Respondent is known as Apex Consulting and it is not commonly known by the disputed domain name. The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name and it is not related in any way



with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent. No license or authorization has been granted to the Respondent to make any use or apply for registration of the disputed domain name. The Complainant contends that disputed domain name resolves to a parking page with commercial links in relation with the Complainant.

Finally, the Complainant contends that that the disputed domain name is confusingly similar to its trademark BNP PARIBAS which has been held to be well-known. It contends that given the distinctiveness of the Complainant's trademark and reputation, it is inconceivable that the Respondent could have registered the disputed domain name without actual knowledge of Complainant's rights in the trademark, which evidences bad faith. The Complainant contends the disputed domain name resolves to a parking page with commercial links and that the Respondent has attempt to attract Internet users for commercial gain by creating confusion and also takes unfair advantage of Complainant's goodwill and reputation. The Complainant also places reliance on Para 6 of the Policy as evidence of registration and use of a domain name in bad faith.

#### 7. Discussion and Findings

The Arbitrator has reviewed the Complaint and the Annexures filed by the Complainant as well as the case law cited by the Complainant. The Arbitral Tribunal has been properly constituted.

The Policy requires that the Complainant must establish three elements *viz.* (i) the Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights; (ii) the Registrant has no rights or legitimate interests in respect of the domain name; and (iii) the Registrant's domain name has been registered or is being used in bad faith. These are discussed hereunder:

##### (i) Identical or Confusingly Similar

As regards this the first element, the Complainant has established that it has rights in the trademark BNP PARIBAS. It has a registration for the mark BNP PARIBAS in India under no. 1261126 in classes 35, 36 and 38 and owns several domain names including <bnpparibas.in>. There is no dispute as to the Complainant's ownership of its registered trademark. The Arbitrator notes that the dominant part of the disputed domain name is BNPPARIBAS i.e., the disputed domain name wholly incorporates the Complainant's BNP PARIBAS trade mark and this is also the distinctive part of the same. It has been held in several decisions that when a domain name wholly incorporates a complainant's registered mark, this is sufficient to establish identity or confusing similarity. See *Hoffmann-La Roche Inc., Roche Products Limited v. Vladimir Ulyanov, WIPO Case No. D2011-1474* and *Swarovski Aktiengesellschaft v. mei xudong, WIPO Case No. D2013-0150*. The phrase '-AM', short for asset management, added to the disputed domain name does not negate the confusing similarity between the disputed domain name and the Complainant's BNP PARIBAS trademark. Rather, '-AM' is indicative of the



Complainant's business area and adds to the element of confusion. It does not serve to distinguish the Respondent in any way and its addition cannot prevent a finding of confusing similarity under the first element. See The Arsenal Football Club Public Limited Liability Company v. Official Tickets Ltd, WIPO Case No. D2008-0842 and Wal-Mart Stores, Inc. v. Domains by Proxy, LLC / UFCW International Union, WIPO Case No. D2013-1304.

It is a well settled legal position that for the purpose of comparing a trademark with a disputed domain name, the country code top-level domain (ccTLD) can be excluded.

The Arbitrator accordingly finds that the first element is satisfied and that the disputed domain name is confusingly similar to the Complainant's registered trademark.

(ii) Rights or Legitimate Interests

As regards the second element, there are several contentions made by Complainant which show that the Respondent does not have rights or legitimate interests in the disputed domain name. The Respondent is not commonly known by the disputed domain name, nor authorized by or connected with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent. Respondent has not been granted any license or authorization to apply for registration of the disputed domain name. The disputed domain name also resolves to a parking page with commercial links in relation to the Complainant.

It has been held that where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of proof regarding 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. See OSRAM GmbH. v. Mohammed Rafi/Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org WIPO Case No. D2015-1149 and Document Technologies, Inc. v. International Electronic Communications Inc. WIPO Case No. D2000-0270.

The Respondent has not countered or objected to the Complainant's claim. Accordingly, the Arbitrator finds that the Complainant has prima facie established that the Respondent does not have rights or legitimate interests in the disputed domain name.

(iii) Registered or Used in Bad Faith

As regards the third element of bad faith, the Complainant had well established its rights in BNP PARIBAS for its business prior to Respondent's registration of the disputed domain name on August 13, 2018. As a matter of fact, the trademark BNP PARIBAS has been held to be well-known in BNP Paribas v. Ronan Laster, WIPO Case No. D2017-2167. Thus, by the time the



Respondent registered the disputed domain name, the Complainant had already garnered a high level of reputation in trademark BNP PARIBAS plus statutory rights in the same.

The Arbitrator accepts the Complainant's contention that in view of the distinctiveness and reputation of the Complainant's trademark, the Respondent would have had actual knowledge of the same when it registered the disputed domain name. The Arbitrator further accepts the Complainant's contention that the Respondent has used the disputed domain name to intentionally attract Internet users for commercial gain by creating a likelihood of confusion with its BNP PARIBAS trademark and in an attempt to take unfair advantage of Complainant's goodwill and reputation. This cannot confer any legitimacy to the Respondent and is indicative of bad faith on part of the Respondent. See StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC, WIPO Case No. D2018-0497.

In light of the above, the Arbitrator considers that the Respondent's conduct in this case constitutes bad faith registration and use of the disputed domain name within the meaning of .INDRP.

Accordingly, the Arbitrator finds that the Complainant has established all three elements as required by the Policy.

#### 8. Decision

For all the foregoing reasons, the Complaint is allowed and it is hereby ordered in accordance with paragraph 10 of the Policy that the disputed domain name be transferred to the Complainant. There is no order as to costs.

This award has been passed within the statutory deadline of 60 days from the date of commencement of arbitration proceeding.



Punita Bhargava

Sole Arbitrator

Date: December 19, 2020