

## DISPUTE RESOLUTION SERVICE

D00009323

Decision of Independent Expert

Bank of America Corporation

and

Cong ty TNHH Mot Thanh Vien B.O.F.A.M.L

### 1. The Parties:

Lead Complainant: Bank of America Corporation  
101 South Tyron Street  
Charlotte  
North Carolina 28255  
United States

Respondent: Cong ty TNHH Mot Thanh Vien B.O.F.A.M.L  
Tang 1, SN 126 Ly Thuong Kiet  
Dong Tam  
Vinh Yen  
Vinh Phuc  
11000  
Viet Nam

### 2. The Domain Name:

bofaml.co.uk

### 3. Procedural History:

23 November 2010 17:12 Dispute received  
24 November 2010 12:08 Complaint validated  
02 December 2010 10:52 Notification of complaint sent to parties  
30 December 2010 10:08 Response received  
11 January 2011 11:25 Notification of response sent to parties

11 January 2011 11:28 Reply received  
11 January 2011 11:34 Notification of reply sent to parties  
11 January 2011 12:08 Mediator appointed  
28 January 2011 09:46 Mediation started  
03 May 2011 16:56 Mediation failed  
03 May 2011 17:21 Close of mediation documents sent  
12 May 2011 12:08 Expert decision payment received

#### **4. Factual Background**

The Complainant is one of the world's largest financial institutions.

On September 15, 2008, at a critical moment in what became known as the global financial crisis, the Complainant announced that it had agreed to acquire Merrill Lynch, one of the world's leading wealth management, capital markets and advisory companies.

The Domain Name was registered on September 17, 2008 in the name of Mr. Hoang Tran Van, said to be a UK individual, with an address in Dong Tam Ward, Vinh Yen city, Vinh Phuc province, Vietnam. On November 23, 2009, it was transferred to the Respondent, a Non-UK Corporation, with an address also in Dong Tam, Vinh Yen, Vinh Phuc, Vietnam.

The Domain Name did not resolve to a website until shortly before the filing of the Complaint. On November 10, 2010, the Domain Name resolved to a website headed with the word BOFAML with a stylised "O"; referring to the company name "Best Of Financial And Monetary Latitude One Member Co., Ltd."; and stating in a section headed "About Us": "The name of the company has originated since its Vice President had some chance to read upon the idea of "Financial Freedom" in a famous "Rich Dad Poor Dad" series by Robert Kiyosaki and Sharon Lechter".

#### **5. Parties' Contentions**

The Complainant claims trademark rights, *inter alia*, in BANK OF AMERICA, BofA, BOFA, MERRILL LYNCH, ML, BOFA MERRILL LYNCH and BOFAML and that the Domain Name is identical to the BOFAML mark and confusingly similar to the BOFA and ML marks. It says that, in the hands of the Respondent, the Domain Name is an abusive registration.

The Respondent denies the Complainant's contentions, saying, *inter alia*, that after reading "Rich Dad, Poor Dad" by Robert Kiyosaki and Sharon Lechter (in which the authors praised the financial freedom of people running a company as well as the benefits of owning a company) Mr. Hoang Tran Van registered the Domain Name as a preparatory step towards setting up a business with his business partner to do something that could lead to true financial freedom.

The Respondent says the period from September 2008 to September 2009 was used for studying the potential business fields that the company should focus on

to develop. Once business registration of the Respondent company was granted in October, 2009, Mr. Hoang Tran Van joined the Respondent and then transferred the Domain Name to the Respondent on November 23, 2009. The Respondent says: "This could be understood as a simple update for correct information of ownership from a staff of the company to the ownership of the company that staff works for".

The Respondent says it registered to use the Domain Name for its company email with the registered email address as: info@bofaml.co.uk; that both the company email and the Vietnamese company name also contain the word "BOFAML"; and that the Respondent registered its trading name in English as "Best Of Financial And Monetary Latitude One Member Company Limited".

The parties disagree on many issues, including the date of incorporation of the Respondent, particularly whether this took place before or after a "cease and desist" letter from the Complainant's solicitors dated November 13, 2009. It is unnecessary for the Panel to resolve this issue or to set out more fully the contentions of the parties, supported, as they are, with hundreds of pages of Annexes.

## **6. Discussions and Findings**

Under paragraph 2 of the Policy, a complainant is required to show, on the balance of probabilities, that:

- (1) it has rights in respect of a name or mark which is identical or similar to the Domain Name; and
- (2) the Domain Name in the hands of the Respondent is an Abusive Registration.

### Rights

"Rights" are defined in the Policy as "rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning".

The Complainant has shown that it has rights in the registered trademark BOFAML in the European Community, No. 8696544, dated June 15, 2010, based on a filing on November 18, 2009. Although that filing post-dated the registration of the Domain Name, it is sufficient under this heading for a complainant to establish that it has rights at the time of the filing of its Complaint.

The Panel finds that the Domain Name is identical to the Complainant's BOFAML mark.

The Complainant has established this element.

### Abusive Registration

Abusive Registration is defined in the Policy as:

“...a domain name which either;

- (i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of, or was unfairly detrimental to the Complainant’s rights; or
- (ii) has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.”

Although the Complainant acquired no rights in the trademark BOFAML until after the Respondent registered the Domain Name, the Complainant has provided evidence that it has been known by the financial and general media in the UK as “BofA” since October, 2002 and that Merrill Lynch has been known by the financial and general media in the UK as “ML” since July, 2006. The Independent (UK) reported on September 15, 2008 that, in acquiring Merrill Lynch, the Complainant would issue Merrill Lynch investors with “new BofA shares”.

The Respondent’s assertion that “The period from September 2008 to September 2009 was used for studying the potential business fields that the company should focus on to develop” is inconsistent with the name “Best Of Financial And Monetary Latitude One Member Company Limited” having been chosen for the intended business at the time the Domain Name was registered by Mr. Hoang Tran Van. In the absence of any explanation by the Respondent as to why the Domain Name was chosen, the Panel infers that Mr. Hoang Tran Van, having learned on or about September 15, 2008 of the forthcoming acquisition by the Complainant of Merrill Lynch, anticipated that the Complainant would use the name BOFAML to identify its business once the acquisition had been consummated, and moved swiftly to prevent the Complainant from acquiring the Domain Name. This registration took unfair advantage of and was unfairly detrimental to the Complainant’s rights.

That Mr. Hoang Tran Van subsequently joined the staff of the Respondent upon its incorporation a year later and dutifully transferred the Domain Name to the Respondent leads to the inevitable conclusion that the state of mind of Mr. Hoang Tran Van when he registered the Domain Name must be imputed to the Respondent.

Accordingly, the Panel finds that the Domain Name was registered by the Respondent in a manner which, at the time when the registration took place, took unfair advantage of or was unfairly detrimental to the Complainant’s rights and that the Domain Name, in the hands of the Respondent is an Abusive Registration.

The Complainant has established this element.

## **7. Decision**

I find that the Complainant has proved that it has Rights in a mark which is identical to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. I therefore direct that the Domain Name be transferred to the Complainant.

**Signed** Alan Limbury

**Dated** June 11, 2011