Decision for dispute CAC-UDRP-101914

Case number	CAC-UDRP-101914
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Domain names	amundisgsssocgen.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	AMUNDI S.A.

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Organization	amundi

OTHER LEGAL PROCEEDINGS

None of which the Panel is aware.

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of International trademark No. 1024160 for AMUNDI, which was registered on September 24, 2009 (“the AMUNDI trademark”).

FACTUAL BACKGROUND

The Complainant is a French company engaged in the finance industry and in particular in asset management. It is in effect an amalgamation of Credit Agricole and Societe Generale. It is one of the largest asset management businesses in the world and is highly regarded.

The Complainant is the registered owner of International trademark No. 1024160 for AMUNDI, which was registered on September 24, 2009 (“the AMUNDI trademark”).

The Complainant is also the owner of several registered domain names that include the AMUNDI mark and which uses in its business.

The Complainant has been concerned about the registration and use of the disputed domain name by the Respondent. The

domain name was registered by the Respondent on February 2, 2018 and resolves to an internet parking page with commercial links to the Complainant and its competitors. Accordingly, the Complainant has filed this Complaint in which it seeks the transfer of the disputed domain name from the Respondent to itself.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT

Complainant made the following contentions.

IDENTITY OR CONFUSING SIMILARITY OF THE DOMAIN NAME WITH THE TRADEMARK

The disputed domain name <amundisgsssocgen.com> is confusingly similar to the Complainant's AMUNDI trademark. The AMUNDI trademark is included in the disputed domain name in its entirety.

The addition of letters "sg ss socgen" (in relation with the subsidiary SOCiété GENéral) and the generic Top-Level Domain ("gTLD") suffix ".com" does not change the overall impression of the designation as being connected to the Complainant 's AMUNDI trademark. It also does not prevent the likelihood of confusion between the disputed domain name and the AMUNDI trademark.

Prior UDRP decisions have confirmed the Complainant's trademark rights.

Thus, the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

RIGHTS AND LEGITIMATE INTERESTS

The Respondent does not have any rights or legitimate interests in the disputed domain name.

The Complainant must first make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP.

The Respondent has no rights or legitimate interests in respect of the disputed domain name and it is not related in any way to the Complainant's business.

The Respondent is not affiliated with the Complainant or authorized by him in any way to use the trademark AMUNDI. The Complainant does not carry out any activity for, nor have any business with the Respondent.

In support thereof, the Complainant submits that the Respondent is not commonly known by the domain name under Policy 4(c)(ii).

The disputed domain name points to a parking page with commercial links in relation to the Complainant and its competitors.

The Complainant submits several prior UDRP decisions that support the above contentions.

Accordingly, the Respondent has no rights or legitimate interests in the disputed domain name.

REGISTRATION AND USE IN BAD FAITH

The domain name has been registered and is being used in bad faith.

The disputed domain name is confusingly similar to the AMUNDI trademark. The Respondent was aware of Complainant and its well-known trademark at the time of registration of the disputed domain name.

The disputed domain name points to a parking page with commercial links ("PPC") in relation to the Complainant and its competitors. Thus, the Complainant contends that the Respondent registered the disputed domain name primarily for the purpose of disrupting the business of a competitor.

Under paragraph 4(b)(iv), bad faith may be shown by evidence that "By using the domain name Registrant has intentionally attempted to attract for commercial gain, Internet users to Registrant's web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of Registrant's web site or location or of a product or service on that web site or location."

Accordingly, the Respondent registered and used the disputed domain name in bad faith.

RESPONDENT

The Respondent failed to file a Response in this proceeding.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP") of the Internet Corporation for Assigned Names and Numbers ("ICANN"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the CAC Supplemental Rules.

A. Administrative deficiency

By notification dated March 13, 2018 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that the Complainant identified the wrong Respondent.

The notification invited the Complainant to have regard to the Registrar's Verification available in the online case file in the form of a Nonstandard Communication regarding the appropriate identification of the domain name holder. On March 13, 2018, the Complainant filed an Amended Complaint and the CAC determined that the Complaint should be admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiencies have been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In that regard, the Panel also notes that the onus is on the complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

(i) The 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 domain name; and

(iii) The domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

A. Identical or Confusingly Similar

The Complainant has adduced evidence that the Panel accepts that it is the registered owner of the AMUNDI trademark and as such has rights in that trademark.

The Panel next finds that the disputed domain name is confusingly similar to the AMUNDI trademark for the following reasons:

First, the disputed domain name includes the entirety of the AMUNDI trademark and that word is by far the dominant part of the disputed domain name. Accordingly, the attention of the internet user would naturally be drawn to that part of the disputed domain name and would inculcate in the mind of the user the idea that the disputed domain name was an official domain name of the Complainant.

Secondly, the disputed domain name includes some letters that have been added to the word AMUNDI, namely “sg ss socgen”. Several of those letters are “socgen” which are widely understood to signify the Societe Generale, one of the constituent parts of the Complainant. This must strengthen in the mind of the internet user the notion that the disputed domain name is an official domain name of the amalgamated body that includes the famous Societe Generale as one of its constituent members.

Thirdly, taken as a whole, the disputed domain name would convey to the objective bystander that it related to the activities of the Complainant and in particular to the activities of the former Societe Generale, giving rise to inevitable confusion.

It is also now well established that the addition of a generic top level domain, such as “.com” in the present case, cannot negate confusing similarity that is otherwise present, as it is in the present case.

Accordingly, the disputed domain name is confusingly similar to the Complainant’s trademark and the Complainant has thus

shown the first of the three elements that it must establish.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to the Respondent to establish its rights or legitimate interests in a 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.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests and that when such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Panel, after considering all of the evidence in the Complaint, finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name.

That prima facie case is made out from the following considerations.

The evidence of the Complainant is to the effect that the Respondent is not related in any way to the Complainant's business, is not affiliated with the Complainant or authorized by it in any way to use the trademark AMUNDI and does not carry out any activity for, nor has any business with, the Complainant.

It is also clear from the evidence that the Respondent is not commonly known by the disputed domain name under Policy 4(c)(ii).

The disputed domain name points to a parking page with commercial links in relation to the Complainant and its competitors. It is now well established that such conduct cannot give rise to a right or legitimate interest in the disputed domain name and the Panel so holds in the present proceeding.

These facts give rise to the prima facie case made out by the Complainant.

The Respondent has not filed a Response or made any other answer to the claims of the Complainant and is in default. Accordingly, the prima facie case has not been rebutted and the Complainant has made out the second of the three elements that it must establish.

C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith

and that it is being used in bad faith: Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the 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 the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith both in general and in particular because the Respondent's conduct puts the case squarely within paragraph 4(b)(iv) of the Policy and probably within other provisions of paragraph 4(b).

That is so for the following reasons:

First, the Complainant submits that Respondent was aware of Complainant and its well-known trademark at the time of registration of the disputed domain name. The Panel agrees. Because of the fame and strong reputation of the AMUNDI trademark, the Respondent must have been aware of the existence of the Complainant and its reputation when it registered the disputed domain name. In particular, the Respondent could not have made randomly the association of the AMUNDI trademark and the popular initials of one of the constituent parts, namely "socgen", signifying Societe Generale. The Panel accepts the Complainant's submission that it is highly likely that the Respondent chose such combination of words to invoke the concept of the Complainant and its activities. By that means the Respondent, in registering the domain name deceptively and without any authority to do so, must be taken to have created a likelihood of confusion, with the intention of attracting current and potential customers of the Complainant looking for its services and doing so in this misleading manner. Accordingly, the disputed domain name was registered in bad faith.

Secondly, the Complainant submits that the disputed domain name points to a parking page with commercial links in relation to the Complainant and its competitors. The Panel accepts the Complainant's evidence to that effect. Thus, the Complainant contends that the Respondent registered the disputed domain name primarily for the purpose of disrupting the business of a competitor. The Panel accepts that submission and notes that there are many UDRP decisions to that effect.

Thirdly, that evidence leads to the conclusion that the Respondent registered the disputed domain name to attract, for commercial gain, internet users to its website. By clicking on these links, internet users are redirected to a webpage in which sponsored links to the websites of competitors of the Complainant are offered. These facts bring the case squarely within paragraph 4(b)(iv) of the UDRP, i.e. "by using the domain name, (the Respondent) ... intentionally attempted to attract, for commercial gain, Internet users to (its) web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of (its) web site or location or of a product or service on (its) web site or location".

Fourthly, in addition and having regard to the totality of the evidence, the Panel finds that, in view of Respondent's registration of the disputed domain name using the AMUNDI trademark and in view of the conduct that Respondent has engaged in when using the disputed domain name, Respondent registered and used it in bad faith within the generally accepted meaning of that expression.

As the Complainant submits, such conduct has been held by previous UDRP panels to constitute bad faith.

Accordingly, the Complainant has shown the third of the three elements that it must establish.

The Complainant, Amundi SA is a well-known French company engaged in the business of asset management.

The Complainant is the registered owner of an international trademark No. 1024160 for AMUNDI, which was registered on September 24, 2009 ("the AMUNDI trademark"). It also owns a number of domain names that include the AMUNDI trademark.

The Respondent registered the disputed domain name on February 2, 2018. It resolves to a parking webpage, containing links to businesses in competition with the Complainant.

The Complainant contended that it has rights in the trade mark AMUNDI, that the disputed domain name is confusingly similar to that trademark, that the Respondent has no rights or legitimate interests in the disputed domain name and that it is being used in bad faith.

The Respondent did not reply to the Complainant's claims.

The Panel found that the disputed domain name was confusingly similar to the Complainant's AMUNDI tradmark and that on the evidence submitted, the Respondent had no rights or legitimate interests in the disputed domain name. Considering the use of the disputed domain name for a website resolving to pay per click sites promoting services competing with those of the Complainant, the Panel found that the disputed domain name was registered and is being used in bad faith.

For the reasons set out in the Decision, the Complaint was accepted and the disputed domain name was ordered to be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **AMUNDISGSSSOCGEN.COM**: Transferred

PANELLISTS

Name	**The Hon. Neil Brown, QC**

DATE OF PANEL DECISION 2018-04-15

Publish the Decision