Decision for dispute CAC-UDRP-102041

Case number	CAC-UDRP-102041
Time of filing	2018-06-01 13:59:47
Domain names	amundi.app

Case administrator

Name	Sandra Lanczová (Case admin)

Complainant

Organization	AMUNDI

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Wilfried GRILLO

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the Disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the international trademark registration No. 1024160, registered on September 24, 2009, for goods and services in class 36.

The Disputed domain name was registered by the Respondent on May 25, 2018.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is a French asset management company jointly created in 2010 by Crédit Agricole and Société Générale with assets under management worldwide.

The Complainant is one of the ten biggest asset management companies worldwide.

The Complainant is the owner of an international trademark registration for the word "AMUNDI", registered and used in several countries.

The Complainant adds that it is also the owner of number of domain names that contain word "AMUNDI", including the domain name <amundi.com>, registered on August 26, 2004.

The Disputed domain name was registered by the Respondent on May 25, 2018.

The Disputed domain name is inactive.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that:

- the Disputed domain name is confusingly similar to its "AMUNDI" trademark;

- the Respondent has no rights or legitimate interests in respect of the Disputed domain name; and

- the Disputed domain name has been registered and is being used in bad faith.

For all these reasons, the Complainant requests that the Disputed domain name be transferred to it.

RESPONDENT:

The Respondent contends that:

- the Disputed domain name has been registered after several sunrise periods.

- the trademark means the generic concept "a world" in Latin.

- the Disputed domain name will be used at the end of 2018 respecting internet rights and Google recommendations and there will be no confusion between the Complainant's website and his website/app for students.

- it is hard to choose a domain name with general words, because all the relevant words are registered by companies.

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

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the Disputed domain name, the Complainant has to demonstrate that:

(i) The Disputed 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 Disputed domain name; and

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

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the Disputed domain name is identical with, or confusingly similar to, the Complainant's trademark or service mark.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the Disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademark "AMUNDI", identified in section "Identification of rights" above.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the Disputed domain name itself to the Complainant's trademark.

The Disputed domain name differs from the Complainant's trademark only by the addition of the top-level domain ".APP".

It is well established that merely adding a top-level domain to a trademark is not sufficient to distinguish a domain name from a trademark. See, for example, CAC Case No. 100831.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the Disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the Disputed domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [Disputed] domain name or a name corresponding to the [Disputed] domain name in connection with a bona fide offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [Disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or

(iii) [the Respondent] [is] making a legitimate noncommercial or fair use of the [Disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”.

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the Disputed domain name.

In particular, the Complainant states that:

- the Respondent is not related in any way with the Complainant;

- the Respondent does not carry out any activity for the Complainant;

- the Respondent does not have any business with the Complainant;

- the Complainant has not authorized the Respondent to use the Complainant's trademark;

- the Complainant has not granted any license to the Respondent to use the Complainant's trademark;

- the Complainant has not authorized the Respondent to apply for the registration of the Disputed domain name;

- the Respondent did not make any use of the Disputed domain name.

The Respondent argues that he has a project to create an educational site/app for students. However, he has given no evidence of about that project.

UDRP panels held that where no website has been developed and where no supporting evidence of “demonstrable preparations” to use the relevant domain name have been submitted, the mere declaration of the intention to create a website is not considered sufficient to establish rights or legitimate interests in the domain name (see, for example, WIPO case No. D2013-0585).

The fact that the Disputed domain name was not registered by the Complainant after the relevant sunrise period, does not mean that anyone is free to register it. Indeed, sunrise registration periods, during which trademark owners can purchase domain names corresponding exactly to their trademark before the general public, is just an option for trademark owners and not an obligation.

The Panel does not agree with the Respondent's argument that he choose to register the word "AMUNDI", which would mean the generic concept "a world" in Latin, because it is hard to choose a domain name with general words, due to the fact that all the relevant words are registered by companies. Indeed, in no document submitted by the Respondent the entire word "AMUNDI" is included. Only the word "MUNDI" together with other words has been found by the Respondent. Moreover, other UDRP panels have observed that the word "AMUNDI" is a coined word (see WIPO case No. DCC2018-0001) and that it is a distinctive, invented word (see WIPO case No. DCO2018-0010). The Panel reminds that a significant number of generic words in Latin and other languages are still available for registration and, in any case, this argument would not serve as a justification for registering a distinctive and well-known trademark.

Furthermore, even supposing that the word "AMUNDI" was a dictionary word, UDRP Panels have recognized that merely

registering a domain name comprised of a dictionary word or phrase does not by itself automatically confer rights or legitimate interests on the respondent. UDRP panels have held that mere arguments that a domain name corresponds to a dictionary word or phrase will not necessarily suffice. In order to find rights or legitimate interests in a domain name based on its dictionary meaning, the domain name should be genuinely used, or at least demonstrably intended for such use, in connection with the relied-upon dictionary meaning.

The Panel accepts the Complainant's submissions that the Respondent has not been authorized by the Complainant in any way to use the trademark "AMUNDI", does not have any business with the Complainant, is not affiliated with the Complainant and does not carry out any activity for the Complainant.

For the abovementioned reasons, the Panel finds on the evidence submitted and on the balance of probabilities that the Respondent’s adoption of the name “AMUNDI” for his future website was an opportunistic move to take a free ride on the back of the goodwill associated with the Complainant’s distinctive trademark.

Therefore, the Respondent has failed to demonstrate any of the non-exclusive circumstances evidencing rights or legitimate interests under the Policy, paragraph 4(c) or other evidence of rights or legitimate interests in the Disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the Disputed domain name has been both registered and used in bad faith by the Respondent.

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, including:

(i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [Disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [Disputed] 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 [Disputed] domain name; or

(ii) [the Respondent] [has] registered the [Disputed] 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 [Disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [Disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent'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 [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the Disputed domain name was registered in bad faith and that it has been used in bad faith.

The Panel observes that it is well established that the scenarios described in UDRP paragraph 4(b) are non-exclusive and merely illustrative. Therefore, even where a complainant is not able to demonstrate the literal application of one of the above-mentioned scenarios, evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behavior detrimental to the complainant’s trademark would also satisfy the complainant’s burden.

Having this in mind, the Panel accepts the Complainant's argument that the Disputed domain name was registered in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name. Indeed, taking into account the distinctiveness and reputation of the trademark "AMUNDI", it is inconceivable that the Respondent was not aware of the Complainant's rights in the trademark "AMUNDI" when registering the Disputed domain name.

The fact that the Disputed domain name is currently inactive does not prevent a finding of bad faith. Previous panels have indeed confirmed that the prerequisites under paragraph 4(a)(iii) of the Policy can be met under the doctrine of passive holding, giving close attention to all circumstances of the Respondent's behavior (see, for example, WIPO Case No. D2000-0003).

Furthermore, the Respondent, who concealed his identity using a privacy service, is based in France, where also the Complainant is based and where the Complainant is the leader in the asset management sector. It also appears extremely unlikely that the Respondent decided to register the Disputed domain name as combination of the two Latin words "A" (prefix with ablative meaning) and the word "MUNDI" (genitive, masculine, second declension of the word "MUNDUM") for creating an educational website/app, justifying this choice by the lack of other available words available for registration as domain name. The Panel underlines that the Respondent did conceal its identity behind a privacy service; it has often been observed in cases under the Policy that this is not, in and of itself, indicative of bad faith though it may be one of several cumulative factors to be weighed in the balance (see, for example, WIPO case No. D2017-0453).

In conclusion, the Panel determines that, for all of the above reasons, the Disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **AMUNDI.APP**: Transferred

PANELLISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2018-07-11

Publish the Decision