Decision for dispute CAC-UDRP-102063

Case number	CAC-UDRP-102063
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Domain names	finance-pioneer.com

Case administrator

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

Complainant

Organization	AMUNDI S.A.

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Autorenwerft GmbH

Respondent representative

Name	Dr. Jörg Heyer

OTHER LEGAL PROCEEDINGS

The Panel is not aware any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of international trademark number 1398148, AMUNDI PIONEER, registered 11 January 2018.

The Complainant owns, through its American subsidiary Pioneer Investment Management USA Inc., several trade marks for PIONEER that predate the registration of the disputed domain name.

The Complainant owns, through its subsidiary Amundi Pioneer Asset Management USA Inc., the domain names <pioneerfunds.com>, registered 21 January 1997 and <pioneerinvestments.com>, registered 7 May 2004.

FACTUAL BACKGROUND

The Complainant, Amundi SA, is a subsidiary jointly created by Credit Agricole (80%) and Society Generale (20%) to regroup their activities of asset management. It ranks in the top ten worldwide for asset management.

The Complainant owns international trademark number 1398148 AMUNDI PIONEER registered on 11 January 2018. It also owns through its subsidiaries several trade marks for the mark PIONEER, and the domain names <pioneerfunds.com>, registered 21 January 1997 and <pioneerinvestments.com>, registered 7 May 2004.

The Respondent, Autonwerft GmbH, is a German limited liability company under registered number HRB 11105. Its corporate purpose is "the writing and publishing of journalistic texts and the exploitation of copyrights pertaining thereto". Its managing director and sole shareholder is Mr Gabor Steinhart, a German journalist, who was previously had been an editor of Handelsblatt, Germany's biggest daily newspaper.

The Respondent is the general partner of Media Pioneer GmbH & Co KG, a limited partnership organised under the laws of Germany with registered number HRA 5470B. Its corporate purpose is the writing and publishing of journalistic texts. The Respondent together with Media Pioneer GmbH & Co KG, publishes a daily political, economic and financial newsletter called the "Steingart Morning Briefing".

The disputed domain name was registered on 11 June 2018. It redirects to an inactive website.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant asserts that the disputed domain name is confusingly similar to the Complainant's trade mark AMUNDI PIONEER and its associated domain names and submits that:

(i) The disputed domain name contains the term PIONEER associated with the term “finance”. The term PIONEER is included in the disputed domain name in its entirety. The Complainant’s trade marks are all registered in class 36, which includes mainly services rendered in financial and monetary affairs and services rendered in relation to insurance contracts of all kinds.

(ii) The addition of the term “finance” refers to these services, and to the Complainant’s trade marks. The terms “finance" and “investment” are conceptually close. The addition of the term “finance” can create a likelihood of confusion in the Internet users’ mind, making them believe that there is a relation between the Complainant and the disputed domain name.

(iii) As the Complainant is widely known for its financial services, this association is not sufficient to distinguish the disputed domain name from the Complainant’s trade marks.

(iv) The addition of the generic top-level domain suffix “.com” does not change the overall impression that the disputed domain name is connected to the Complainant’s trade marks. Nor does it prevent the likelihood of confusion between the disputed domain name and the Complainant's trade marks.

The Complainant therefore claims that the disputed domain name is confusingly similar to its prior trade mark AMUNDI PIONEER.

The Complainant claims that the Respondent has no rights or legitimate interests in the disputed domain name and submits that:

(i) The Complainant must establish a prima facie case that the Respondent lacks rights or legitimate interests. Once a 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 Policy.

(ii) The Respondent 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.

(iii) No licence or authorisation has been granted to the Respondent to make any use of the Complainant's trade mark AMUNDI PIONEER, or apply for registration of the disputed domain name.

(iv) The disputed domain name redirects to the domain name <leere.seite>, which has been inactive.

(v) Therefore, the Respondent has not make any use of disputed domain name since its registration, which confirms that the Respondent has no demonstrable plan to use the disputed domain name and demonstrates a lack of legitimate interests in respect of the disputed domain name.

Thus, the Complainant contends that the Respondent has no right or interest in the disputed domain name.

The Complainant claims that the disputed domain name has been registered in bad faith. The Complainant:

(i) Repeats the assertion that the disputed domain name is confusingly similar to the Complainant's trade mark AMUNDI PIONEER and that the addition of addition of the term "finance" is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trade mark AMUNDI PIONEER and that the addition of the term "finance" renders the disputed domain name more confusing because it creates an immediate association with the Complainant's trade marks and activities.

(ii) Submits that through its subsidiary it owns a large portfolio of trade marks containing the word PIONEER. It is widely known as an asset manager claims that the association of the word "pioneer" with "finance" makes it obvious that the Respondent knew of the Complainant's rights before the registration of the disputed domain name.

Claims the Respondent has failed to use the disputed domain name and therefore the Respondent has registered it and is using it in bad faith.

RESPONDENT:

The Respondent claims that the disputed domain name is neither identical nor confusingly similar to the protected mark for the following reasons:

(i) "finance-pioneer" and "investment pioneer" are not confusingly similar. While it is true that the terms "finance" and "investment" both relate to "money" in its broadest sense, "finance" covers a much broader space than "investment". The latter describes the process of spending money for a specific purpose, but "finance" is not similarly limited and its meaning goes far beyond the notion of "investment". Thus, there is no reason to assume that both terms are confusingly similar by their meaning. They are also not confusingly similar by way of their orthography or pronunciation.

(ii) Beyond alleging a confusing similarity, Complainant did not produce anything indicating a relevant similarity between the trade marks and the disputed domain name.

The Respondent contends that it has rights and legitimate interests in the disputed domain name. Together with Mr Stiengart and Media Pioneer GMbH &Co.KG it intends to start further new related new services using trade marks related to the element "pioneer" in the company name Media Pioneer GMbH &Co.KG.

The Respondent asserts that:

(i) It has a legitimate interest to make use of the domain "finance pioneer" in the course of his future journalistic activities.

(ii) The disputed domain name is a derivative of Media Pioneer's company name. The Respondent is in the course of preparing such activities involving the use of the disputed domain name.

(iii) Both the terms "investment" and "pioneer" are obviously generic, in spite of their alleged registration in combination as a trade mark in favour of the Complainant. The word "finance" is also a generic term. The Complainant cannot hinder the use of two generic terms by a third party by combining one of these terms with another generic term and having it registered as a trade mark.

(iv) While the Complainant mentions that it uses the trade mark "investment pioneer" in class 36, the Respondent's intended use of the domain/trade mark "finance pioneer" is for journalistic services under class 41.

The Respondent asserts that the disputed domain name has not been registered and used in bad faith. It says:

(i) The fact that the disputed domain is not yet in use in the month following its registration does not indicate that it was not acquired bona fide. It is likely to some months until the Respondent will be in a position to produce consistent journalistic content under a variety of trade marks and domains including the disputed domain name.

(ii) Complainant had every possibility to register the dispute domain name on his behalf. Not having done so first and questioning Respondent's right to register the disputed domain name for himself represents an act of bad faith.

(iii) The Respondent was unaware of Complainants activities and use/alleged registration of the trade mark "Investment Pioneer".

(iv) The Complainant has produced no information indicating any intention of Respondent to interfere with Complainant's activities. Furthermore, the Complainant and the Respondent operate the respective trade marks in two different trade mark classes. There is no reason to assume, and no such reason was produced by the Complainant, Respondent's bad faith in registering the disputed domain name.

Finally, the Respondent asserts that the Complainant failed in every possible way to meet the necessary standard of proof. The terms "finance pioneer" and "investment pioneer" are not confusingly similar. The parties to the dispute operate the respective trade marks in different classes: while the Complainant had "investment pioneer" registered in class 36, the Respondent intends to use "finance pioneer" in class 41. Furthermore, the Respondent's articles of association would not even allow Respondent to use the domain in class 36. "Investment", "finance" and "pioneer" are all generic terms which cannot be granted protection against their use by third parties. Respondent is making reasonable efforts to use the disputed domain name in the future. Complainant is acting in bad faith by not registering the disputed domain name on his behalf but claiming it now from the Respondent.

RIGHTS

The Complainant has not shown to the satisfaction of the Panel, that 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 failed show to the satisfaction of the Panel, that 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 failed to show to the satisfaction of the Panel, that 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

Paragraph 4 (a) of the Policy requires the Complainant to prove each of the following three elements:

(i) The disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights.

(ii) The Respondent has no rights or legitimate interests in the disputed domain name.

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

A. Rights

The Panel finds that the Complainant has rights in the trade mark AMUNDI PIONEER and through its subsidiary also has rights in the trade marks for PIONEER that predate the registration of the disputed domain name.

B. Confusingly similar

It is well established that the top-level domain suffix ".com" can be ignore when assessing confusing similarity under paragraph 4(a)(i) of the Policy.

The Complainant's assertion of confusing similarity focusses on its trade make AMUNDI PIONEER. The Panel does not find that the disputed domain name is confusingly similar to the Complainant’s trade mark AMUNDI PIONEER.

The disputed domain name is comprised of the combination of two dictionary words "finance" and "pioneer". In contrast, the trade mark AMUNDI PIONEER, which the Complainant alleges is confusingly similar, is made up of the words "amundi" and "pioneer". In a side-by-side comparison, both visually and orally, the Complainant's trade mark AMUNDI PIONEER is not confusingly similar to the disputed domain name.

The Complainant asserts that the term PIONEER is included in the disputed domain name in its entirety and that the mark is registered in class 36, which includes mainly financial and monetary affairs. It further asserts that the addition of the word "finance" can create a likelihood of confusion in the Internet user's mind.

The Respondent rejects this argument and claims that the disputed domain name is not confusing similar because the terms "investment" and "pioneer" as well as the term "finance" are all generic terms. It asserts that the Complainant cannot hinder the use of two generic terms by a third party by combining one of these terms with another generic term and having it registered as a trade mark.

It says that while the Complainant uses the trade mark "investment pioneer" in class 36, the Respondent's intended use of the domain/trade mark "finance pioneer" is for journalistic services under class 41. The Panel wishes to make clear that it makes no finding in respect of the trade mark rights of the parties, other than determined for the limited issues in these proceedings.

Because the of the Panel's findings in this decision regarding legitimate interests and bad faith it is not necessary for the Panel to make a finding regarding confusing similarity between the disputed domain name and the trade mark PIONEER.

C. Rights or legitimate interests

The Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Complainant does not carry out any business with the Respondent and has not licensed or authorised the Respondent to use its trade mark AMUNDI PIONEER, or to apply to register the disputed domain name.

Paragraph 4 (c) of the Policy sets out a non-exclusive list of circumstance in which the Respondent can demonstrate rights of legitimate interests. The Respondent says the it has a legitimate to use the disputed domain name for its future journalistic activities and has chosen the name "finance pioneer" because it is a derivative of Media Pioneer's company name. The explanation is plausible. The fact that the website associate with the disputed domain name is inactive one month after it was registered is not conclusive that the Respondent does not intend to use it connection a legitimate purpose, or that it lacks a legitimate interest. It is understandable that business plans can take time to develop.

The corporate purpose of the Respondent "is the writing and publishing of journalistic texts". There is no evidence to suggest that the Respondent has registered the disputed domain name (which is not identical to the Complainant's trade marks) to suggest an association with the Complainant, or to falsely suggest and affiliation with the Complainant or to trade off the Complainant's trade marks or its goodwill.

Considering all the evidence the Panel finds that the Respondent has demonstrated that it has rights to, or legitimate interests in, the disputed domain name for the purpose of paragraph 4 (c) of the Policy and that the Complainant has failed to prove the second element that the Respondent has no rights or legitimate interests in the disputed domain name for the purposes of paragraph 4 (a) (ii) of the Policy.

D. Registered and used in bad faith.

The disputed domain name is comprised of two words "finance" and "pioneer". There is no evidence to suggest that the Respondent knew, or ought to have known of the Complainant's rights in the trade mark AMUNDI PIONEER for or its subsidiary's trade marks incorporating the word PIONEER when it registered the disputed domain name.

The disputed domain name was registered using a privacy service. There can be legitimate reasons for doing so. There is no evidence to suggest that the Respondent's use of a privacy service was for an improper purpose.

The Respondent asserts that it was not aware of the Complainant's marks and has indicated that it wishes to use the disputed domain name to provide journalistic services. Even if the Respondent was aware of the Complainant's trade mark rights when it acquired the disputed domain name that does not mean that it was acquiring it for a bath faith purpose or to ride on the back of the Complainant's goodwill. Further, there is no evidence that the Respondent intended to interfere with Complainant's activities.

Considering all the evidence and the parties submissions the Panel finds that the Complainant has failed to prove on the balance of probabilities that the disputed domain name was registered and used in bad faith and thus that the requirements of paragraph 4(a)(iii) of the Policy have not been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **FINANCE-PIONEER.COM**: Remaining with the Respondent

PANELLISTS

Name	**Mrs Veronica Bailey**

DATE OF PANEL DECISION 2018-10-01

Publish the Decision