# Decision for dispute CAC-UDRP-102202

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| Case number | CAC-UDRP-102202 |
| Time of filing | 2018-10-22 09:40:39 |
| Domain names | usamundipioneer.com |

## Case administrator

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

## Complainant

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| Organization | AMUNDI ASSET MANAGEMENT |

## Complainant representative

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| Organization | Nameshield (Enora Millocheau) |

## Respondent

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| Organization | Fundacion Comercio Electronico |

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

AMUNDI PIONEER (word), International Registration No.1398148, registered on January 11, 2018.

FACTUAL BACKGROUND

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

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant states that it is a subsidiary jointly created in 2010 by Crédit Agricole and Société Générale to regroup their activities of asset management and is in the top 10 in Assets under Management worldwide.

The Complainant manages over 1.4 trillion euros of assets across six investment hubs.

It is the owner of international trademark No. 1398148 AMUNDI PIONEER, registration date – January 11, 2018 and is also the owner of several domain names that include the AMUNDI PIONEER trademark, such as <amundi-pioneer.com> and

<amundipioneer.com>.

The disputed domain name was registered on October 15, 2018 and points to a parking page with commercial links.

The Complainant states that the disputed domain name is confusingly similar to its trademark since it includes the Complainant's trademark in its entirety.

The Complainant contends that the addition of the term “US” (which is the abbreviation for the “United States”) and the gTLD extension “.com” are not sufficient to escape the finding that the disputed domain name is confusingly similar to the Complainant’s trademark.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Respondent has no rights or legitimate interests in respect of the disputed domain name, and is not related in any way to its business. The Complainant does not carry out any activity for, nor has any business with the Respondent.

The disputed domain name points to a parking page with commercial links (“PPC”) and this cannot be considered a bona fide offering of goods or services or legitimate non-commercial or fair use.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND BEING USED IN BAD FAITH

According to the Complainant, the Respondent could not have ignored the Complainant’s trademark at the moment of the registration of the disputed domain name, which cannot be a coincidence.

A Google search on the term AMUNDI PIONEER provides several results, all of them being linked with the Complainant and the takeover of the company Pioneer Investments.

The similarity between the disputed domain name and the Complainant's trademark makes it highly implausible that Respondent's registration of a confusingly similar domain name was not an intentional effort to capitalize on or otherwise take advantage of the likely confusion with Complainant's trademark rights.

The Respondent deliberately decided to cause confusion and to deceive as to the affiliation, connection or association of the Respondent with the Complainant. In doing so, the Respondent has shown bad faith registration.

Previous panels have found a bad faith attempt to confuse and attract Internet users for commercial gain where a respondent displayed advertisements on its website.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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

A. Identity or confusing similarity

The Complainant owns the international registration for the “AMUNDI PIONEER” word mark.

As confirmed by WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition
(“WIPO Overview 3.0”), see paragraph 1.2.1: “Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case”.

The disputed domain name entirely incorporates the Complainant’s trademark with the addition of the “us” element in the beginning.

As stated in WIPO Overview 3.0 “In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing” (see par. 1.7).

In the present case the Complainant’s “AMUNDI PIONEER” trademark is clearly recognizable in the disputed domain name. The addition of the “us” element in the beginning does not change an overall impression of the disputed domain name and may indicate connection with the US where the Complainant has business activity.

The .com domain zone shall be disregarded under the identity or the confusing similarity test as it does not add anything to the distinctiveness of the disputed domain name.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and

(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied (see Julian Barnes v. Old Barn Studios, WIPO Case No. D2001-0121; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110;

Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455 and CAC Case No. 101284).

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows all reasonable inferences of fact in the allegations of the complaint to be deemed true (see paragraph 14(b) of the Rules and FORUM Case No. 0006000095095, Vertical Solutions Management, Inc. v. webnet-marketing, inc.).

The disputed domain name is used for a parking page with third party pay-per-click links.

It is recognized that use of a domain name for parking can be consistent with respondent rights or legitimate interests under the UDRP – where the domain name consists of an actual dictionary word(s) or phrase and is used to host PPC links genuinely related to the dictionary meaning of the word(s) or phrase comprising the domain name, and not to trade off the complainant's (or its competitor's) trademark.

At the same time, panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users (see par. 2.9 of WIPO Overview 3.0).

In the present case the disputed domain name incorporates the Complainant's trademark in its entirety and such mark is not a dictionary word or phrase. There is no any indication of Respondent's rights or legitimate interests in this case.

Therefore, the Panel finds that the Complainant has shown a prima facie case that has not been rebutted by the Respondent and satisfied the second requirement of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

These circumstances are non-exhaustive and other factors can also be considered in deciding whether the disputed domain name is registered and used in bad faith.

The disputed domain name is used for a parking page with third party pay- per-click links.

It is unclear to what extent the Respondent controls the content of the page under the disputed domain name.

It is well accepted by the UDRP jurisprudence that with respect to "automatically" generated pay-per-click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests). Neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith (see par. 3.5 of WIPO Overview 3.0).

As was explained above, the use of a domain name to host a parked page comprising PPC links can be acceptable in certain cases and negate the bad faith element as illustrated by the UDRP case law, primarily in cases where a mark used in a domain name is a dictionary word and respondent's use is consistent with the meaning of a domain name (see CAC Case No. 101988) or where a domain name is descriptive and there is no indication that when the respondent registered the domain name, it was aware or should have been aware of the trademark of the complainant or targeted the complainant (see e.g. CAC Case No. 100101 and Gold Medal Travel Group plc v. Damir Kruzicevic, WIPO Case No. D2007-1902).

This is clearly not the case here.

The Panel finds that the present case falls within the provisions set forth in 4 (b) (iv) of the UDRP, namely the Respondent intentionally attempted to attract, for commercial gain, Internet users to the website or other on-line location, by creating a likelihood of confusion with the Complainant's mark.

The following factors, in the opinion of the Panel, indicate bad faith of the Respondent in the present dispute:

1) The disputed domain name is registered after the registration of the Complainant's word trademark and by the time of the registration of the disputed domain name the Complainant's business under the trademark was already well developed;

2) The disputed domain name has a high degree of similarity with the Complainant's trademark;

3) The Panel has discovered that the Respondent had already been a party to numerous UDRP disputes, including one case where the same Complainant was involved (see e.g. CAC Case No. 102090; CAC Case No. 101999; CAC Case No.102175; SAP SE v. Domains by Proxy LLC / Carolina Rodrigues, Fundacion Comercio Electronico, WIPO Case No. D2018-1090 and FORUM Case No. FA1806001792378, Webster Financial Corporation and Webster Bank, National Association v. Carolina Rodrigues / Fundacion Comercio Electronico). As one of the previous panels noted in respect of the Respondent: "the Respondent's history of bad faith registration and use of domain names indicates also for the Panel that the disputed domain name has been registered in bad faith" (see The Terminix International Company Limited Partnership v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico, WIPO Case No. D2018-2112).

Based on the above, it is inconceivable that the Respondent registered the disputed domain name without having in mind the Complainant and its trademark.

Previous conduct of the Respondent clearly indicates that the Respondent had actual knowledge of the Complainant and targeted the Complainant. The addition of the "us" element in the beginning of the disputed domain name refers to the United States of America where the Complainant does business;

4) Taking into account circumstances and facts set out above, there is a clear absence of rights or legitimate interests in this case coupled with no credible explanation for the Respondent's choice of the disputed domain name. Besides, as some panels have already confirmed use of a domain name which is identical or confusingly similar to an incorporated mark in order to host third-party hyperlinks may be evidence of bad faith registration and use (see e.g. FORUM Case No. FA1805001786279, Airbnb, Inc. v.  /  and Deutsche Telekom AG v. WWW Enterprise, Inc., WIPO Case No. D2004-1078).

The Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **USAMUNDIPIONEER.COM**: Transferred

## PANELLISTS

| Name | **Igor Motsnyi** |
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DATE OF PANEL DECISION 2018-11-26

Publish the Decision