Decision for dispute CAC-UDRP-102282

Case number	CAC-UDRP-102282
Time of filing	2019-01-02 09:36:02
Domain names	amundidigitalassets.com

Case administrator

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

Complainant

Organization	AMUNDI ASSET MANAGEMENT

Complainant representative

Organization	Nameshield (laurent Becker)

Respondent

Name	Joshua Johnson

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of an international word trademark registration n°1024160 “AMUNDI”, registered on 24 September 2009 for various designated countries. The Complainant also owns the domain name <www.amundi.com>.

FACTUAL BACKGROUND

The disputed domain name was registered on 19 December 2018.

The domain is currently not in use. The domain is currently a so called "parked domain", containing the following message: "Welcome to amundidigitalassets.com. This Web page is parked FREE, courtesy of GoDaddy. Find similar domains."

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant ("AMUNDI ASSET MANAGEMENT") is a subsidiary of the French companies "Crédit Agricole" and "Société

Générale". The Complainant claims to rank in the global top 10 of asset management companies, with more than 100 million customers worldwide, and offices in 37 countries in Europe, Asia-Pacific, the Middle-East and the Americas.

The Complainant is the owner of the international trademark n°1024160 AMUNDI, registered since 24 September 2009.

The Complainant also owns the domain name <www.amundi.com>.

1.The Complainant contends that the disputed domain name is confusingly similar to its registered trademarks AMUNDI and to its domain name. The Complainant argues that the addition of the terms “DIGITAL ASSETS” is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark AMUNDI, since it does not change the overall impression of the designation as being connected to the Complainant’s trademark. On the contrary, the addition of the terms “DIGITAL ASSETS” increases the likelihood of confusion with the Complainant’s denomination and activity, as the Complainant is specialised in asset management. Other UDRP decisions have recognised that the addition of a generic term associated to a trademark does not create a new or different right to the mark or diminish confusing similarity. The Complainant also refers to prior cases regarding the Complainant‘s rights over the term “AMUNDI”.

2. The Complainant further argues that the Respondent does not have any rights or legitimate interest in the disputed domain name. The Complainant contends that the Respondent is not commonly known by the disputed domain name, but as “Joshua Johnson”. Given the fact that the Whois information of the Respondent is not similar to the disputed domain name, the Complainant argues that the Respondent is not known by the disputed domain name. The Respondent dit not acquire any rights to the disputed domain name. The Complainant confirms that the Respondent is not affiliated or related in any way to the Complainant, and was not authorised or licensed by the Complainant to use its trademark "AMUNDI" or register the domain name. The Complainant emphasises that no use has been made of the disputed domain name since its registration. The Complainant contends that there are no reasons to believe that the Respondent has any demonstrable plan to effectively use the disputed domain name.

3. The Complainant contends that the disputed domain name has been registered and is being used in bad faith. The Complainant claims that its trademark "AMUNDI" is wellknown. The Complainant asserts that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks. The Complainant emphasises that the disputed domain name has been inactive since its registration, as the disputed domain name redirects to a Registrar parking page. The Complainant furthermore claims that the incorporation of its well-known mark into the disputed domain name, coupled with an inactive website, is evidence of bad faith registration and use.

RESPONDENT:

1. The Respondent contends that the disputed domain name is neither identical nor confusingly similar to the marks of the Complainant. The Respondent states that the word "Amundi", as referenced in <www.amundidigitalassets.com> is not by itself representative of more than one third of the total amount of characters within the disputed domain name. Furthermore, the Respondent contends that the Complainant is not active in the market of "digital assets" such as crypto currencies like Bitcoin or Ethereum. The Respondent concludes: "thus the complainants regard for this nascent term is especially confusing".

2. The Respondent also contends that it has rights and/or legitimate interests in the disputed domain name. The Respondent claims that, since only little time (i.e., 3 weeks and 5 days) has passed between the registration of the disputed domain name and the writing of its response in the current ADR proceeding, he has not been given a sufficient time frame to design and develop his website. The Respondent emphasises that he intends to continue developing a site for the disputed domain name. The Respondent did not further elaborate on this intended use.

3. The Respondent did not further elaborate on the issue of bad faith.

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

1. Confusing similarity

The Complainant is the company “AMUNDI ASSET MANAGEMENT”, with its address at 90 Boulevard Pasteur, 75015 Paris, France.

The Complainant claims to be the owner of several trademarks including the term “AMUNDI”. The Complainant submitted evidence of an international word trademark registration n°1024160 “AMUNDI”, registered on 24 September 2009 for various designated countries, including the USA (i.e. the home country of the Respondent). This international trademark is valid for several sub-classes in Nice class 36, including "financial asset management services".

This international trademark n°1024160 is registered in name of the company “AMUNDI ASSET MANAGEMENT”, with the same name and the same address as the Complainant in the current domain name procedure. The Panel considers that the Complainant has, as such, rights in the trademark under the UDRP for purposes of standing to file this complaint.

The disputed domain name consists of the Complainant's trademark "AMUNDI", with the addition of the words "DIGITAL" and "ASSETS".

Numerous previous panels have accepted that the incorporation of a trademark in its entirety into a domain name is sufficient to establish that the disputed domain name is identical or confusingly similar to a registered trademark. Indeed, in most cases where a domain name incorporates the entirety of a trademark, the domain name is, for the purposes of the Policy, considered as confusingly similar to the trademark (see for example, the detailed discussion of this topic in Research in Motion Limited v. One Star Global LLC WIPO Case No. D2009-0227).

In this case, the Panel notes that the disputed domain name incorporates the entirety of the Complainant’s "AMUNDI" trademark. The Panel finds that the addition to the Complainant’s trademark of the descriptive terms "DIGITAL" and "ASSETS" and the “.com” gTLD does not prevent a finding of confusing similarity under the first element of paragraph 4(a) of the Policy. Rather, the addition of the words "DIGITAL" and "ASSETS ", to the "AMUNDI" trademark serves to induce the association that the public can be expected to make, considering that the "AMUNDI" trademark is registered for - inter alia - asset management services and that the ".com" gTLD is of a potentially global scope. Furthermore, the above mentioned association by the public is amplified by the fact that the disputed domain name is also similar to the Complainant’s name, “AMUNDI ASSET MANAGEMENT“.

The ".com" suffix may be disregarded when it comes to considering whether a domain name is confusingly similar to a trademark in which the Complainant has rights.

The Panel concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. Rights or legitimate interests

As regards paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous Panels have found that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the Respondent fails to come forward with such appropriate allegations or evidence, the Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the Respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the panel then has to weigh all the evidence, with the burden of proof always remaining on the Complainant.

The Panel notes that the Complainant contends that: (1) the Respondent is not commonly known by the disputed domain name; (2) the Respondent is not related in any way to the Complainant, and is not authorised or licensed by the Complainant to use the trademark "AMUNDI" or register the domain name; and (3) the disputed domain name has been inactive since its registration and the Respondent has no demonstrable plan to use the disputed domain name.

The Panel notes that the Respondent contends that: (1) the disputed domain name is neither identical nor confusingly similar to the Complainant's registered mark; (2) the Complainant is not active in the market of "digital assets" such as cryptocurrencies; and (3) the Respondent has not been given enough time to design and develop his website.

The Panel weighs these arguments as follows:

The Complainant states that the Respondent is not related to the Complainant. This is not refuted by the Respondent. The Complainant further states that the Respondent was not authorised or licensed by the Complainant to register the disputed domain name or to make use of its trademark "AMUNDI", let alone in combination with the words "DIGITAL" and "ASSETS". Given the fact that the Respondent is not related to the Complainant or the trademark owner; given the fact that the Complainant's registered trademark "AMUNDI" is registered for (financial) asset management services (amongst others) and that the Respondent added the words "DIGITAL" and "ASSETS" to the Complainant's trademark; and given the fact that the Complainant’s full name is “AMUNDI ASSET MANAGEMENT“, which is very similar to the disputed domain name, the Panel finds that the Complainant has at least made a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name. The Respondent did not come forward with convincing evidence of relevant rights or legitimate interests in the disputed domain name.

The Panel finds the other arguments of the parties of little persuasiveness:

The fact that the Whois information is not similar to the disputed domain name does not automatically result in a finding of lack of rights or legitimate interests.

The fact that the disputed domain name points to a Registrar parking page since the date of registration does not necessarily point to a lack of rights or legitimate interests. The Panel emphasises that the disputed domain name was created on 19 December 2018, and that the complaint was filed only 5 days later. Given this short time period, the lack of use of the disputed domain name can not be held against the Respondent.

The fact that the Complainant is not active in the market of "digital assets" such as cryptocurrencies does not mean that, as the Respondent claims, the disputed domain name might lead the public to believe otherwise. After all, the disputed domain name <www.amundidigitalassets.com> and the Complainant’s full name “AMUNDI ASSET MANAGEMENT“ are very similar, and contain several identical words, including the Complainant’s registered trademark. Indeed, the public might also think that the word “DIGITAL“ in the disputed domain name refers to, for instance, an online platform for asset management of the

Complainant.

According to the Complainant, the Respondent has no demonstrable plan to use the disputed domain name. The Respondent answers that he intends to continue developing a website for the disputed domain. However, the Respondent did not provide any explanation or evidence of the use he intends to make of this domain name. Given the substantiated claims of the Complainant, and in particular the trademark rights of the Complainant, the Panel expected the Respondent to provide appropriate evidence and convincing arguments of the rights or legitimate interests he claims in the disputed domain name. The Panel has not been given any details of the reasons why the Respondent wants to make use of a domain name that refers to the registered trademark of the Complainant ("AMUNDI") and to the services for which this trademark is registered ("asset management"). The Respondent did not provide any evidence of his intended use, nor of the preparations that he has taken for this use.

The Panel realises that the time period between the creation of the disputed domain name and the filing of the complaint was short, and that the Respondent had relatively little time to make any preparations to use the disputed domain name. On the other hand, in light of a credible, well-documented and convincing claim (constituting a so called 'prima facie' case), the Panel finds that the response should also be inherently credible and supported by evidence or at least by an explanation of the circumstances of the case.

In sum, the Panel finds that the Complainant did make a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Panel further finds that the Respondent failed to provide appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. In particular, the Panel finds that the Complainant provided sufficient evidence that the Respondent is not related to the Complainant and did not have any authorisation to use the Complainant's mark in combination with the words "digital assets" in the disputed domain name. The Respondent claims that he will develop a website for the disputed domain name "at a reasonable pace", but failed to support his claim by any evidence or any explanation of the circumstances surrounding this statement. In conclusion, the Panel finds that the claim of the Respondent is non-verifiable and lacks credibility.

The Panel concludes that the Respondent does not have rights or legitimate interests in the disputed domain name.

3. Bad faith

The Complainant contends that its trademark "AMUNDI" is well-known, and that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark. The Complainant contends that the incorporation of its well-known mark into the disputed domain name, coupled with an inactive website, is evidence of bad faith registration and use.

The Respondent did not develop his argumentation with regard to the claim of bad faith under paragraph 4(a)(iii) of the Policy. However, from the arguments developed by the Respondent under paragraphs 4(a)(i) and (ii) of the Policy, it can be understood that the Respondent is of the opinion that he has been given insufficient time to properly develop his website.

The Panel considers the following:

The Complainant’s "AMUNDI" trademark registration predates the registration of the disputed domain name.

The disputed domain name reflects the Complainant's registered trademark "AMUNDI" in its entirety, with the addition of the words "DIGITAL ASSETS".

The Complainant's "AMUNDI" trademark is valid for several services in class 36, inter alia "asset management" services.

The combination of the Complainant's trademark "AMUNDI" and the word "ASSETS" (covering a sub-class for which the Complainant's trademark is registered) is an indication of bad faith.

Moreover, the Panel finds that this finding of bad faith is confirmed by the following factors.

The Complainant claims that it ranks in the global top 10 of asset management companies worldwide, with more than 100 million customers worldwide, and offices in 37 countries in Europe, Asia-Pacific, the Middle-East and the Americas. The Complainant provided screenshots of its website that confirm this claim. The Respondent did not refute this claim.

The Complainant's international trademark "AMUNDI" is valid for several designated countries, including the United States of America, where the Respondent has his address.

On the balance of probabilities, it may be expected that the Respondent had knowledge of the existence of the Complainant and its activities, and of the existence of the Complainant's trademarks and the scope of these trademarks (i.e. coverage of asset management services). In light of this, it seems unlikely that the Respondent would not have been aware of the unlawful character of the disputed domain name at the time of its registration and use.

As discussed above, there is no evidence supporting the claim of the Respondent that he is developing a website under the disputed domain name. Indeed, the Respondent failed to provide any evidence of this claim or of the factual circumstances surrounding this claim.

The Respondent did not provide any evidence whatsoever to prove that the disputed domain name was not registered and is not being used in bad faith.

Given the combination of the words "DIGITAL ASSETS" (and especially the word "ASSETS") and the Complainant's trademark "AMUNDI" in the disputed domain name; given the scope of the activities of the Complainant; given the well-known or at least highly specific character of the Complainant's trademark in the sector of (financial) asset management services; given the fact that the Complainant is a global asset management company and that it can therefore be expected that the Respondent had knowledge of the Complainant; given the lack of evidence of any actual or contemplated good-faith use; and given the lack of evidence of any circumstances refuting the claim of bad faith, the Panel finds it likely that the Respondent was aware or should have been aware of the Complainant's trademark rights when registering the disputed domain name.

In conclusion, the Panel finds that the Respondent has registered and used the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **AMUNDIDIGITALASSETS.COM**: Transferred

PANELLISTS

Name	**Bart Van Besien**

DATE OF PANEL DECISION 2019-02-04

Publish the Decision