

## Decision for dispute CAC-UDRP-105289

Case number CAC-UDRP-105289

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Time of filing 2023-03-17 09:49:04

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Domain names amundiholdings.com

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### Case administrator

Name Olga Dvořáková (Case admin)

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### Complainant

Organization AMUNDI ASSET MANAGEMENT

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### Complainant representative

Organization NAMESHIELD S.A.S.

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### Respondent

Organization Codexslack inst

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#### OTHER LEGAL PROCEEDINGS

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

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#### IDENTIFICATION OF RIGHTS

The Complainant is the owner of the international trademark registration number 1024160 AMUNDI registered on September 24, 2009.

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#### FACTUAL BACKGROUND

The Complainant is Europe's number one asset manager by assets under management and has offices in Europe, Asia-Pacific, the Middle-East and the Americas. With over 100 million retail, institutional and corporate clients, the Complainant ranks in the top 10 globally. The Complainant is the owner of the international trademark registration number 1024160 AMUNDI registered on September 24, 2009. The Complainant is the owner of domain names containing the trademark AMUNDI:<amundi.com>, registered and used since August 26, 2004; and <amundi-finance.com>, registered and used since April 17, 2020.

The disputed domain name was registered on March 9, 2023, and resolves to a parking page.

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#### PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

(i) The Complainant is the owner of the international trademark registration number 1024160 AMUNDI registered on September 24, 2009. The disputed domain name is confusingly similar to the Complainant's mark because the disputed domain name incorporates the Complainant's mark in its entirety with the addition of the term "HOLDINGS" and the ".com" gTLD.

(ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not related in any way to the Complainant's business. The Respondent is not affiliated with the Complainant nor authorized by the Complainant in any way to use the trademark AMUNDI. The Complainant does not carry out any activity for, nor has any business with the Respondent. The Respondent has no demonstrable plan to use the disputed domain name.

(iii) The Respondent registered and uses the disputed domain name in bad faith. The Respondent had knowledge of the Complainant's rights in the AMUNDI mark before registering the disputed domain name. The incorporation of the Complainant's famous mark "AMUNDI" into the disputed domain name, coupled with an inactive website constitutes the Respondent's bad faith registration and use of the disputed domain name. The disputed domain name has been set up with MX records which suggests that it may be actively used for email purposes. This is also indicative of bad faith registration and use.

RESPONDENT: NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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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).

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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).

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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).

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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.

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PRINCIPAL REASONS FOR THE DECISION

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
- (2) respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

**Rights**

The Complainant claims rights in the mark "AMUNDI" as identified in the section 'Identification of Rights' above. The Panel notes

that an international trademark registration is sufficient to establish rights in that mark. As such, the Panel finds that the Complainant has established its rights in the mark "AMUNDI." The Complainant contends that the disputed domain name <amundiholdings.com> is confusingly similar to the Complainant's mark because the disputed domain name incorporates the Complainant's mark in its entirety with the addition of the term "HOLDINGS" and the ".com" gTLD.

The Panel notes that the use of a mark in its entirety with the mere addition of a descriptive term and a gTLD fails to sufficiently distinguish a disputed domain name for the purposes of paragraph 4(a)(i) of the Policy. See *MTD Products Inc v J Randall Shank*, FA 1783050 (Forum June 27, 2018) ("The disputed domain name is confusingly similar to Complainant's mark as it wholly incorporates the CUB CADET mark before appending the generic terms 'genuine' and 'parts' as well as the '.com' gTLD."); see also *Wiluna Holdings, LLC v. Edna Sherman*, FA 1652781 (Forum Jan. 22, 2016) (Finding the addition of a generic term and gTLD is insufficient in distinguishing a disputed domain name from a mark under Policy paragraph 4(a)(i).). The disputed domain name incorporates the AMUNDI mark in its entirety, merely adding the generic term "HOLDINGS," and the ".com." gTLD. Therefore, the Panel finds that the disputed domain name is confusingly similar to the AMUNDI mark under Policy paragraph 4(a)(i).

### **No rights or legitimate interests**

The Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), then the burden shifts to the Respondent to show it does have rights or legitimate interests. See *Croatia Airlines d. d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455 (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 Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP). See also *Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not related in any way to the Complainant's business. The Respondent is not affiliated with the Complainant nor authorized by the Complainant in any way to use the trademark AMUNDI. The Complainant does not carry out any activity for, nor has any business with the Respondent. The Complainant further contends that the Respondent did not use the disputed domain name, and the Respondent has no demonstrable plan to use the disputed domain name.

The Panel finds that nothing in the records suggests that the Respondent is commonly known by the disputed domain name or authorized to use the Complainant's mark. Failure to make an active use of a website does not represent a bona fide offering of goods and services or a legitimate or fair use per Policy paragraph 4(c)(i) and (iii). See *CrossFirst Bankshares, Inc. v Yu-Hsien Huang*, FA 1785415 (Forum June 6, 2018) ("Complainant demonstrates that Respondent fails to actively use the disputed domain name as it resolves to an inactive website. Therefore, the Panel finds that Respondent fails to actively use the disputed domain name for a bona fide offering of goods or services or legitimate noncommercial or fair use under Policy ¶ 4(c)(i) or (iii)."). The Complainant provides screenshot evidence of the resolving website. The Panel therefore finds the Respondent fails to use the disputed domain name in connection with a bona fide offering of goods and services or a legitimate or fair use per Policy ¶ 4(c)(i) and (iii).

The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

### **Bad faith**

The Complainant contends that the Respondent registered and uses the disputed domain name in bad faith. The disputed domain name resolves to a parking page. The Respondent has not demonstrated any activity in respect of the disputed domain name. The incorporation of the Complainant's famous mark "AMUNDI" into the disputed domain name, coupled with an inactive website constitutes the Respondent's bad faith registration and use of the disputed domain name.

The Panel agrees that the passive holding of a domain name does not necessarily circumvent a finding that the domain name is being used in bad faith within the requirements of paragraph 4(a)(iii) of the Policy. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003 (finding that in considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii), the panel must give close attention to all the circumstances of the respondent's behaviour, and a remedy can be obtained under the Policy only if those circumstances show that the respondent's passive holding amounts to acting in bad faith.)

The particular circumstances of this case that the Panel has considered are:

- (i) The Complainant is Europe's number one asset manager by assets under management and has offices in Europe, Asia-Pacific, the Middle-East and the Americas. With over 100 million retail, institutional and corporate clients, the Complainant ranks in the top 10 globally. As such, the Complainant's mark 'AMUNDI' is considered as being a well-known and reputable trademark; and
- (ii) The Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name.

Taking into account all of the above, the Panel concludes that the Respondent's passive holding of the disputed domain name constitutes bad faith under Policy, paragraph 4(a)(iii) and that the Respondent is using the disputed domain name in bad faith.

The Complainant further contends that the Respondent had knowledge of the Complainant's rights in the AMUNDI mark before registering the disputed domain name. The Complainant points out that the disputed domain name is confusingly similar to its trademark AMUNDI and domain names associated, and that its mark AMUNDI is well-known. Besides, the addition of the term "HOLDINGS" increases the likelihood of confusion, as they directly refer to the Complainant's subsidiaries. The Complainant provides an outcome of Internet search, which shows that all the results for the denomination "AMUNDIHOLDINGS" are related to the Complainant and its subsidiaries.

The Panel infers, due to the notoriety of Complainant's mark and the manner of use of the disputed domain name that the Respondent had knowledge of the Complainant's rights in the AMUNDI mark at the time of registering the disputed domain name, and finds that the Respondent registered the disputed domain name in bad faith under Policy paragraph 4(a)(iii).

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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

**Accepted**

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

1. **amundiholdings.com**: Transferred

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## PANELLISTS

Name	<b>Mr. Ho-Hyun Nahm Esq.</b>
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DATE OF PANEL DECISION **2023-04-24**

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Publish the Decision

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