Decision for dispute CAC-UDRP-105868

Case number	**CAC-UDRP-105868**
Time of filing	**2023-10-17 09:54:32**
Domain names	**EuRex-Tw.com, Jp-EureX.com, EureXEu.com**

Case administrator

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

Complainant

Organization	**Deutsche Börse AG**

Complainant representative

Organization	**Grünecker Patent und Rechtsanwälte PartG mbB**

Respondents

Name	**Ming Guo**
Name	**Admin Netzlan**

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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the EUREX trademark with several international and national registrations worldwide, including but not limited to:

- German trademark No. 39756930 since 27 November 1997 in classes 9, 16, 35, 36, 38, 42;
- German trademark No. 30309064 since 19 February 2003 in classes 35, 36, 39, 41, 42;
- International trademark No. 635015 since 5 December 1994 in classes 9, 35, 36, 42;
- International trademark No. 812147 since 28 July 2003 in classes 9, 16, 35, 36, 38, 41, 42;
- International trademark No. 812154 since 28 July 2003 in classes 9, 16, 35, 36, 38, 41, 42;
- European Union trademark No. 744763 since 13 February 1998 in classes 9, 16, 35, 36, 38, 42;
- United States trademark No. 2941068 since 10 May 2002 in classes 9, 16, 36;
- United Kingdom trademark No. 900744763 since 13 February 1998 in classes 9, 16, 35, 36, 38, 42;
- Chinese trademark No. 5591453 since 7 September 2006 in class 36;
- Malaysian trademark No. 06018304 since 6 October 2006 in class 36;
- Indian trademark No. 1500199 since 1 November 2006 in classes 9, 16, 35, 36, 42.

FACTUAL BACKGROUND

The Complainant is one of the leading marketplace organizers for financial services, in particular for the trading of shares and other securities worldwide. The Complainant is also a transaction services provider enabling companies and investors to access to global capital markets by means of advanced technology. Its product and service portfolio covers the entire process chain from order input to custody of shares and derivatives. The Complainant has customers in Europe, the USA and Asia serviced by more than 10,000 employees at locations in Germany, Luxemburg, Switzerland and the USA, as well as at representative offices in London, Paris, Chicago, New York, Hong Kong, Dubai, Moscow, Beijing, Tokyo and Singapore. In Germany, the Complainant also operates the Frankfurt Stock Exchange.

Among others, the Complainant organizes one of the world's largest derivative markets under the trademark EUREX. Since its inception in 1998, EUREX has continuously set a proven track record in electronic trading and clearing and is proving the success of its business model by providing highly efficient liquidity pools. Having quickly become an integral part of the global derivatives market, EUREX has closed with record volumes of traded contracts almost every year. EUREX, the futures and options exchange, is one of the world's largest international market organizers for the trading of futures and options on equities and equity indices, as well as of interest rate derivatives. Today, around 370 market participants in 33 countries are connected to the EUREX trading system. More than 7,000 traders are registered with EUREX.

The registration date of the disputed domain names are as follows:

- <eurex-tw.com> was registered on 26 September 2023 by Ming Guo, an individual residing in China;
- <jp-eurex.com> was registered on 28 September 2023 by Ming Guo;
- <eurexeu.com> was registered on 3 October 2023 by Admin Netzlan, an entity located in Saint Vincent and the Grenadines.

The disputed domain names are currently not associated with any active website. In the past, the first disputed domain name resolved to a trading platform for cryptocurrencies and displaying the Complainant's trademark at the top of the webpage, and the second disputed domain name redirected to first one.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain names are confusingly similar to its trademark, since the EUREX trademark is incorporated in its entirety and the addition of geographic terms do not prevent the likelihood of confusion between the disputed domain names and the Complainant's trademark.

The Complainant also contends that the Respondent has no rights or legitimate interests in respect of the disputed domain names. There is no connection between the Complainant or its subsidiaries and the Respondent. The Respondent does not use the disputed domain names in connection with a bona fide offering of goods or services, or legitimate noncommercial or fair use, because the disputed domain names <eurex-tw.com> and <jp-eurex.com> resolve to a website which operates a trading platform of cryptocurrencies and displaying the Complainant's trademark; and the disputed domain name <eurexeu.com> is inactive.

Finally, the Complainant contends that the Respondent has registered and has been using the disputed domain names in bad faith. The disputed domain names are confusingly similar to the Complainant's reputed trademark. Moreover, the Respondent attempted to attract investors, misleading them about an actually not existing connection with the Complainant.

The Complainant requests the transfer of the disputed domain names.

RESPONDENT:

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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.

Under paragraph 10(e) of the UDRP Rules, the Panel shall decide, on its own discretion, to consolidate multiple domain name disputes in accordance with the Policy and these Rules. At the same time, paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.

In deciding consolidation, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency shall also be taken into consideration by panels (paragraph 10(c) of the UDRP Rules: "The Panel shall ensure that the administrative proceeding takes place with due expedition").

Considered that:

- the disputed domain names were registered nearly on the same date (respectively on 26, 28 September, and 3 October 2023);
- the naming pattern of the disputed domain name consists in the addition to the Complainant's mark two letters referring to geographic locations which are important financial centres (TW for Taiwan, JP for Japan, and EU for the European Union) related to the Complainant's activities (financial services); and
- at the moment of the submission of the Complaint, two disputed domain names resolved to the same webpage.

The Panel finds that, on the balance of the probabilities, the disputed domain names are subject to common control, and the consolidation of the dispute is fair and equitable to the Parties and in line with the principle of procedural efficiency.

PRINCIPAL REASONS FOR THE DECISION

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to succeed in the administrative proceeding:
(i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
(iii) the disputed domain names have been registered and are being used by the Respondent in bad faith.

I. RIGHTS AND IDENTITY OR CONFUSING SIMILARITY

In UDRP disputes the test for identity or confusing similarity involves a reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. While each case is judged on its own merits, 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 (paragraph 1.7 WIPO Overview 3.0).

UDRP panels have also consistently found that the adding, deleting, or substituting letters, numbers, punctuation, or other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) to the relevant trademark, recognizable within the disputed domain name, would not prevent a finding of confusing similarity under the first element (paragraph 1.8 of WIPO Overview 3.0).

UDRP panels also agree that the TLD is to be ignored for the purpose of determination of confusing similarity between the disputed domain name and the complainant’s trademark, as it is a technical requirement of registration (paragraph 1.11.1 WIPO Overview 3.0).

The Complainant has established that it has rights in the EUREX trademark since 1994.

The disputed domain names incorporate the entirety of the Complainant's EUREX trademark and differ from such mark by merely adding a hyphen and/or letters referring to geographic locations (i.e., TW for Taiwan, JP for Japan, and EU for the European Union), and the TLD ".com". The addition of the hyphen and/or letters to the Complainant's mark neither affects the attractive power of such trademark, nor is sufficient to distinguish the disputed domain names from the Complainant's mark. On the contrary, the addition of such letters, referring to important financial markets, even enhances the likelihood of confusion, since the Internet users might erroneously believe that the disputed domain names refer to the Complainant and its activities (financial services).

Consequently, the Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain names are confusingly similar to the Complainant's mark.

II. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAMES

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain names. If a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (see 2.1 WIPO Overview 3.0).

The Complainant contends to have no relationship whatsoever with the Respondent. The Respondent has never received any approval of the Complainant, expressed or implied, to use the Complainant's trademark or to register and use the disputed domain names.

No evidence is available that the Respondent has been commonly known by the disputed domain names or has acquired any rights in a trademark or trade name corresponding to the disputed domain names.

All disputed domain names incorporate the Complainant's trademark plus additional geographic terms (letters), and, thus are confusingly similar to the EUREX trademark.

UDRP panels have found that domain names identical or confusingly similar to a complainant’s trademark carry a high risk of implied affiliation. A domain name consisting of a trademark plus an additional term at the second- or top-level is seen as tending to suggest sponsorship or endorsement by the trademark owner. Thus, UDRP panels have largely held that such composition cannot constitute fair use.

Moreover, there is no evidence that, before any notice to Respondent of the dispute, the Respondent used, or demonstrably prepared to use, the domain names or names corresponding to the domain names in connection with a bona fide offering of goods or services.

Currently, the disputed domain names do not resolve to any active website. In the past, the domain name <eurex-tw.com> resolved to a trading platform of cryptocurrencies displaying the Complainant's EUREX trademark at the top of the webpage and, thus, clearly impersonating the Complainant. The domain name <jp-eurex.com> redirected to <eurex-tw.com>.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain names.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain names.

III. REGISTRATION AND USE OF THE DISPUTED DOMAIN NAMES IN BAD FAITH

The disputed domain names have been registered and are being used in bad faith for the following cumulative reasons.

The Respondent has used a privacy or proxy service when registering the disputed domain names. Although the use of such service is not in and of itself an indication of bad faith, the circumstances and the manner in which such service is used may however impact the Panel’s assessment of bad faith (see 3.6 WIPO Overview 3.0).

The disputed domain names are to be considered confusingly similar to the EUREX trademark, since they incorporate such mark in its entirety and differ from it merely by adding a hyphen and/or letters referring to geographic locations (which are important financial centres related to the Complainant's activities), and the TLD ".com" (which is disregarded for the purpose of determination of confusing similarity between the disputed domain names and the trademarks of the Complainant as it is a technical requirement of registration).

UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a geographic term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see 3.1.4 WIPO Overview 3.0).

Given the distinctiveness and the reputation of the Complainant's prior mark acquired over the years, it is inconceivable that the Respondent could have registered the disputed domain names confusingly similar to the Complainant's trademark for a mere chance without actual knowledge of the Complainant and its mark and the intention to exploit such reputation by diverting traffic away from the Complainant’s website.

Indeed, in the past, two of the disputed domain names (i.e., <eurex-tw.com> and <jp-eurex.com>) resolved to a trading platform for cryptocurrencies with the title "Better trading. Better life" and displaying the Complainant's EUREX trademark at the top of the webpage. Neither were contact details provided, nor was there any reference to a competent financial regulation authority. Therefore, the Respondent had intentionally attempted to attract, for commercial gain, Internet users and mislead potential investors making them believe that the trading platform was safe and operated by the Complainant or that at least an association with the Complainant existed. Financial services are strictly regulated and the Respondent's actions put the Internet users at risk and clearly evidence bad faith under paragraph 4(b)(iv) of the Policy (CAC Case No. 105052 Deutsche Börse AG v. The Oracle <eurextradeoptions.com>).

Therefore, the Panel finds that the Respondent, with registering and using the disputed domain names, has deliberately exploited the Complainant's EUREX trademark to benefit from the associated reputation as a trustworthy and reliable provider of financial services.

Currently, the disputed domain names do not resolve to any active website. UDRP panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding (see 3.3 WIPO Overview 3.0 and in particular Telstra Corporation Limited v. Nuclear Marshmallows WIPO Case No. D2000-0003).

Taken into account all circumstances of this case, the Panel finds that the Complainant has discharged the burden of proof to show that the disputed domain names have been registered and are being used in bad faith (paragraph 4(a)(iii) of the Policy).

Therefore, the disputed domain names are to be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **EuRex-Tw.com**: Transferred
2. **Jp-EureX.com**: Transferred
3. **EureXEu.com**: Transferred

PANELLISTS

Name	**Ivett Paulovics**

DATE OF PANEL DECISION 2023-11-21

Publish the Decision