Decision for dispute CAC-UDRP-102659

Case number	CAC-UDRP-102659
Time of filing	2019-09-03 15:39:47
Domain names	matmutinnovation.com

Case administrator

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

Complainant

Organization	MATMUT

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Name	chen Ki

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant is the owner of a number of trademark registrations covering various jurisdictions including the following:

- EU trademark Registration No. 003156098 for MATMUT, registered on May 26, 2005;

- International Trademark Registration No. 98728962 for MATMUT, registered on April 17, 1998.

FACTUAL BACKGROUND

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

Created in 1961, the Complainant MATMUT (for „Mutuelle Assurance des Travailleurs MUTualistes“) is a mutual insurance company. Complainant is a major player on the French market with nearly 3.2 million members and more than 6.8 million insurance contracts. The Complainant is also the owner of several domain names including the trademark MATMUT, such as <matmut.com> registered since 1998 and <matmut.fr> registered since 1997.

The disputed domain name, which was registered on July 15, 2019, is confusingly similar to the Complainant’s trademark as

it incorporates the entirety of the MATMUT name and merely adds the generic term „innovation“ plus the .com TLD. Although there is no website that resolves from the disputed domain name, the Respondent has no rights or legitimate interests in the disputed domain name as it is not authorized to use the Complainant’s trademark, it is not commonly known by the name, and it is not making a bona fide or fair use of the disputed domain name. Further, despite its lack of a resolving website, the Respondent’s pattern of conduct with regard to domain names indicate that it has registered or acquired the disputed domain name primarily for the purpose of causing confusion amongst the Complainant’s customers and other members of the public.

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. Trademark Rights and Identity or Confusing Similarity:

Sufficient evidence has been submitted by the Complainant of its trademark rights in the term MATMUT for various insurance related services. Further, the Complainant is the owner of certain domain names that incorporate its trademark including <matmut.com> and <matmut.fr>. All of the above were created and registered prior to the creation date of the disputed domain name. As such, the Panel finds that the Complainant possesses rights in its MATMUT trademark.

Next, UDRP panels have consistently held that where the asserted trademark is recognizable within a disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy. See, e.g., LEGO Juris A/S v. DBA David Inc/ DomainsByProxy.com, Case No. D2011-1290 (WIPO, September 20, 2011) („the mere addition of the words ‚Ninjago‘ and ‚Kai‘ is not sufficient to exclude the likelihood of confusion between the disputed domain name and the Complainant’s trademark.“)

In the present case, the disputed domain name consists of the entirety of the MATMUT trademark followed by the generic term „innovation“. The use of this additional word does not, in this case, reduce the confusing similarity between the disputed domain name and the Complainant’s trademark. Visiomed Group v. Joris Wille, Familyware, BeWell Innovations NV, Case No. D2017-0344 (WIPO, May 10, 2017) („the Complainant's trade mark BEWELL is plainly recognisable within the disputed [bewellinnovations.com] domain name and, in the Panel's view, the term ‚innovations‘ is insufficient to prevent threshold confusing similarity.“).

In light of the above, the Panel concludes that the Complainant possesses rights to the MATMUT trademark and that the

disputed domain name is confusingly similar to such mark under Paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interest:

Paragraph 4(a)(ii) of the Policy directs an examination of the facts to determine whether a respondent has rights or legitimate interest in a domain name. Paragraph 4(c) lists a number of ways in which a respondent may demonstrate that it does have such rights or interests.

The first example, under Paragraph 4(c)(i) of the Policy, is where "before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services". Here, the disputed domain name resolves to a „coming soon" registrar parking page with no substantive content as shown by the screenshot submitted into evidence by the Complainant. The lack of any substantive website content or other use cannot, by definition, constitute a bona fide offering of goods or services and, thus, cannot support a claim of any rights or legitimate interests in a domain name. Guess IP Holder L.P. and Guess, Inc. v. xi long chen, FA 1786533 (FORUM June 15, 2018) ("The disputed domain name resolves to a parked [inactive] page with the message, ‚website coming soon!' The Panel finds that this use does not amount to a bona fide offering or good or services or a legitimate noncommercial or fair use per paragraph 4(c)(i) & (iii) of the Policy and Respondent does not have rights or legitimate interests with respect of the domain name.") This Panel finds that there is no evidence of record to indicate that the Respondent is using the disputed domain name in connection with the making of a bona fide offering of goods or services.

The second example, under Paragraph 4(c)(ii) of the Policy, is a scenario in which a respondent is commonly known by the domain name. Complainant has made an unrebutted prima facie case showing that the name used by the Respondent in the Whois record for the disputed domain name is „chen ki". This name does not bear any similarity to the word MATMUT as used in the disputed domain name. There is no other evidence in the record to suggest that the Respondent is commonly known by the disputed domain name or that it has acquired any trademark rights relevant thereto. As such, this sub-section of the Policy is of no help to the Respondent.

As to the third example, under Paragraph 4(c)(iii) of the Policy, there is no evidence that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the MATMUT trademark. Although the disputed domain name does not resolve to any substantive website content, this does not rebut the assertion that its use is not fair as it does not fit in to any accepted category of fair use such as news reporting, commentary, political speech, education, nominative or generic use, etc.

In light of the above analysis, this Panel finds that the facts of this case do not demonstrate that the Respondent has rights or legitimate interest in the disputed domain name under Paragraph 4(a)(ii) of the Policy.

C. Bad Faith:

Finally, the Complainant must prove, by a preponderance of the evidence, that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. Hallmark Licensing, LLC v. EWebMall, Inc., Case No. D2015-2202 (WIPO, February 12, 2016) ("The standard of proof under the Policy is often expressed as the ‚balance of the probabilities' or ‚preponderance of the evidence' standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true.").

The Complainant first asserts that the Respondent was on actual notice of the MATMUT trademark at the time it registered the disputed domain name. The evidence in this case demonstrates that this trademark has been in longstanding use and the trademark is also rather distinctive. With no explanation or submission from the Respondent, this Panel concludes that it is more likely than not that the term „matmut" would be used in the disputed domain name with knowledge of the Complainant's trademark rights.

Next, the Complainant claims that „there are present circumstances indicating that the Respondent has registered or acquired the domain name primarily for the purpose of impersonating the Complainant and „to capitalize on or otherwise take advantage of the likely confusion with Complainant's trademark rights.“ There is no direct evidence of the Respondent's intention to exploit the disputed domain name for commercial gain.

However, the evidence submitted in this case supports the fact that the disputed domain name does not resolve to any website content and there is no evidence in the record to indicate that the disputed domain name has been used for any purpose at all. It is well accepted that the scenarios of paragraph 4(b) of the Policy are not exclusive and so panels are free to consider other circumstances that may give rise to a finding of bad faith registration and use. Beginning with the decision in Telstra Corporation Limited v. Nuclear Marshmallows, Case No. D2000-0003 (WIPO, February 18, 2000), many UDRP panels have held that, after considering all the circumstances of a given case, it is possible that a "[r]espondent's passive holding amounts to bad faith." The Telstra decision states that "paragraph 4(b) recognizes that inaction (e.g., passive holding) in relation to a domain name registration can, in certain circumstances, constitute a domain name being used in bad faith.... [I]n 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 Administrative Panel must give close attention to all the circumstances of the Respondent's behaviour.") See also, Autoshop 2 Di Battaglia Ferruccio C. S.N.C. v. Willamette RF Inc., WIPO Case No. D2004-0250 (collecting cases citing Telstra); and Chartered Professional Accountants of Canada v. Zakaria Frouni, FA 1795339 (FORUM August 6, 2018) ("Respondent is simply passively holding the disputed domain name. Respondent's inactive use of the disputed domain name constitutes bad faith registration and use under paragraph 4(a)(iii) of the Policy.") In view of the evidence presented in this case, including the facts that the disputed domain name copies the Complainant's distinctive long-used trademark and the non-use of the disputed domain name for some time, the circumstances support the conclusion that Respondent registered and uses the non-resolving disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

Finally, the Complainant contends that further evidence of bad faith his found in the fact that the Respondent has engaged in a pattern of cybersquatting conduct. Evidence of prior adverse UDRP decisions against a respondent can demonstrate bad faith registration. Fandango, LLC v. 21562719 Ont Ltd, FA 1464081 (FORUM November 2, 2012) ("Respondent's past conduct and UDRP history establishes a pattern of registered domain names in bad faith under Policy 4(b)(ii)."). Here, the Complainant cites prior UDRP cases that have been lost by the Respondent. These include Comerica Bank v. chen ki, D2017-0849 (WIPO, July 14, 2017) and Coupang Corporation v. chen ki, FA 1844179 (FORUM, June 13, 2019) („evidence that a respondent has demonstrated a pattern of bad faith registrations may support a subsequent finding of bad faith registration under Policy 4(b)(ii).") This Panel agrees and finds that the Respondent's prior adverse UDRP decisions supports a finding of bad faith registration and use of the currently disputed domain name.

In light of the above analysis, this Panel finds that the Respondent has registered and uses the disputed domain name in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all of the elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MATMUTINNOVATION.COM**: Transferred

PANELLISTS

Name	**Steven M. Levy, Esq.**

DATE OF PANEL DECISION 2019-10-03