Panel Decision for dispute CAC-ADREU-007510

Case number	CAC-ADREU-007510
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Domain names	asendia-logistics.eu

Case administrator

	Aneta Jelenová (Case admin)

Complainant

Organization	ASENDIA MANAGEMENT

Respondent

Name	APOSTOLOS ANAGNOSTAKIS

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

None of which the Panel is aware.

FACTUAL BACKGROUND

The Complainant is one of the world's three leading international mail, shipping and distribution organizations, delivering packages, parcels and documents to more than 200 destinations across the globe. It operates in the fields of ecommerce, business mail, direct mail, the delivery of media publications and parcel delivery.

The Complainant has obtained the registration of several trademarks for ASENDIA in various jurisdictions and has also registered numerous domain names incorporating the ASENDIA mark in various extensions, such as <asendia.group>.

The Complainant has taken issue with the fact that the Respondent has registered the disputed domain name that consists of the Complainant's ASENDIA trademark with the addition of the word "logistics", giving rise to the inference that the domain name invokes the Complainant itself and the logistics services that it offers to customers around the world. The Complainant maintains that this may well result in internet users being confused as to whether the domain name and any website to which it resolves are those of the Complainant. Moreover, the Complainant is of the view that this danger is exacerbated by the fact that the website offers mail and distribution services bringing it into direct competition with the Complainant.

The Respondent registered the disputed domain name on 28 January 2013 and on 16 August 2017 the Complainant filed this Complaint seeking the transfer of the domain name to itself.

The Respondent did not file a Response. A Notification of Respondent's Default was accordingly issued on 30 January 2018.

On 6 February 2018, the Czech Arbitration Court appointed The Honourable Neil Anthony Brown QC as sole panellist in this proceeding and on 6 February 2018 the panelist lodged his Statement of Acceptance and Declaration of Impartiality and Independence.

A. COMPLAINANT

1. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. (Article 21 (1) of Regulation (EC) No. 874/2004 of the Commission dated 28 April 2004)

2. Trademarks and domain names belonging to the Applicant:

• The Complainant is in particular the owner of the following trademarks:

French trademark registration for ASENDIA No. 11 3 828 137 filed and
registered on 3 May 2011 in classes 9 ; 16 ; 20 ; 35 ; 36 ; 38 ; 39 ; 40 ; 41 ; 42 and 45 ;

International trademark registration ASENDIA No. 1 111 830 filed
and registered on 27 October 2011 in classes 9 ; 16 ; 20 ; 35 ; 36 ; 38 ; 39 ; 40 ; 41 ; 42 and 45 under priority of French trademark registration ASENDIA No. 11 3 828 137 filed and registered on 3 May 2011 and covering among other jurisdictions, the European Union.

The said trademarks will hereinafter be referred to collectively as " the ASENDIA trademark."

The applicant is also the owner of numerous domain names incorporating the ASENDIA trademark and which the Complainant uses in its business.

3. Comparison of the Applicant's trademark and the disputed domain name.

(a) the disputed domain name < asendia-logistics.eu >
copies the ASENDIA trademark and domain names, all of which are highly distinctive;
(b) the construction of the domain name is such that the ASENDIA trademark is the most dominant part of the domain name and the addition of the word " logistics" ,which remains highly descriptive in the shipping and logistics community with the Complainant's business, does not detract from its confusing similarity to the trademark;
(c) the gTLD extension <.eu> is disregarded in the comparison with the trademark as it does not serve to distinguish domain names. The relevant comparison to be made is with the second level portion of the disputed domain names;
(d) It is also well established that where a domain name wholly
incorporates a Complainant's distinctive trademarks in its entirety, it
is confusingly similar to that mark despite the addition of a word or,
in this case, of descriptive terms. Thus, the addition of the descriptive term "logistics" which is a common English word remains, as such, insufficient to negate confusing similarity as it suggests to internet users that the disputed domain name is related to the Complainant and the logistics services it offers, as the Complainant's mark is the dominant component of the disputed domain name. That view is consistent with previous UDRP decisions. In fact, the addition of descriptive terms to trademarks has been found in previous decisions to increase the confusing similarity.
(e) It is therefore clear that the Respondent created the disputed
domain name in a specific attempt of free-riding on the coat tails of
Complainant's ASENDIA trademark, regardless of the addition of the
generic term "logistics".

4. Accordingly, the disputed domain name is confusingly similar to the Complainant's ASENDIA trademark.

5. The Respondent has no rights or legitimate interest in the disputed domain name.

(Article 21 (1) (a) of the Regulation (EC) No. 874/2004 of the Commission dated 28 April 2004)

That is so because:

(a) The Respondent's name has no resemblance with the term ASENDIA, which has no specific meaning and which is therefore very distinctive per se.
(b) The Respondent does not have any prior right or legitimate interest to justify the use of the trademark and domain names of the Complainant which are already very well-known in France and in other countries.
(c) The Complainant has never licensed or otherwise authorized the Respondent to use its trademark or to register any domain name including the ASENDIA trademark.
(d) Consequently, there is no relationship whatsoever between the parties and the Respondent has clearly modified the Complainant's trademark and domain names for its own use and incorporated them into its domain name without the Complainant's authorization.
(e) The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services, so as to confer a right or legitimate interest in it in accordance with Regulation (EC) No. 874/2004.
(f)The disputed domain name resolves to a competing website which
offers shipping and logistics services, which encompasses Complainant's

core business. The domain name has therefore been registered only for the purpose of unfairly attracting Complainant's consumers, as is clearly revealed on the Respondent's web page.
(g) It follows from the above that the disputed domain name was registered for the sole purpose of misleadingly diverting consumers into thinking that the Respondent is, in some way or another, connected to, sponsored by or affiliated with the Complainant and its business; or that the Respondent's activities are approved or endorsed by the Complainant. None of this is, in fact, the case and the consequences of such conduct indicate bad faith on the part of the Respondent.
(h)The Respondent has therefore clearly taken the Complainant's trademarks and domain names for its own use and incorporated them into its domain name in order to confuse internet users into believing Respondent is linked to Complainant, which in any case does not constitute a bona fide offering of goods and services.
(i) The foregoing submissions are consistent with previous UDRP decisions.
(j) Accordingly, the Respondent has no rights or legitimate interests in the disputed domain name.

6. The domain name was registered or has been used in bad faith.

(Article 21 (1) (b) of the Regulation (EC) No. 874/2004 of the Commission dated 28 April 2004)

It is not necessary to prove registration AND use in bad faith, the one or the other being sufficient to fulfill the conditions of Article 21 (1) (b) of Regulation No. 874/2004, in accordance with previous CAC decisions.

Moreover, where it has been shown that the defendant has no legitimate interests in the domain name, it is not necessary for the applicant to prove bad faith, as illustrated by several prior CAC decisions.

The Complainant will nonetheless demonstrate that the disputed domain name was registered and used in bad faith by the Respondent.

(a)The domain name was registered in bad faith.

It cannot be a co-incidence that the Respondent registered a domain name so similar to the Complainant's ASENDIA mark.

(b)Respondent's name does not bear any resemblance to ASENDIA, which has no particular meaning and is highly distinctive.

(c)The Respondent has neither prior right nor legitimate interest to justify the use of the trademarks and domain names of the Complainant.

(d) The domain name must have been registered for the purpose of attracting Internet users to the Respondent's website by creating a likelihood of confusion – or at least an impression of association – between the Complainant's trademarks and domain names and the disputed domain name.

(e)The Respondent had constructive, if not actual notice, of the Complainant's mark.
There exists no tangible explanation for choosing this domain name other than to deliberately ride-off the Complainant's reputation.

(f)This suggests that the Respondent acted with opportunistic bad faith in having registered the domain name in order to make an illegitimate use of it.

(g)The defendant was necessarily aware of the adverse impact the registration of the disputed domain name would have on Complainant's prior rights. The Respondent must have been aware of the risk of confusion generated by the registration of the disputed domain name, because it knew that internet users searching for a web site reflecting the ASENDIA trademark would invariably be led to click on the disputed domain name.

(h)Accordingly, the disputed domain name was registered in bad faith by the Respondent.

(i)The disputed domain name was also used in bad faith.

(j)Given the highly distinctive nature of the ASENDIA mark , Respondent is likely to have had, at least, constructive, if not actual notice, as to the Complainant's marks at the time he registered the domain name.

(k)The disputed domain name is being used to disrupt Complainant's business through the attraction of Internet users to the Respondent's website by creating a likelihood of confusion.

(l) The Respondent's website offers mail and distribution services, thus directly competing with Complainant's activities.

(m) On May 12, 2017, the Complainant's attorney sent to the Registrant a cease and desist letter, but the Respondent did not reply.

(n) Accordingly, the disputed domain name has been both registered and used in bad faith.

B. RESPONDENT

The Respondent did not file a Response.

DISCUSSION AND FINDINGS

Under Article 21(1) of Regulation (EC) 874/2004 ("the Regulation"), the disputed domain name may be revoked if it is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law, for example the rights specified in Article 10(1) of the Regulation if it has been registered by its holder without rights or legitimate interests in the disputed domain name or if it has been registered or is being used in bad faith.

Accordingly, the first obligation on the Complainant is to establish a right that is recognized or established by national and/or Community law, such as the rights mentioned in Article 10(1).

Article 10(1) of the Regulation refers to: "registered national and community trade marks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trade marks, trade names, business identifiers, company names".

In the present case the Complainant relies on registered national and community trademarks for ASENDIA and, in particular, the following:

(a)French trademark registration for ASENDIA No. 11 3 828 137 filed and
registered on 3 May 2011 in classes 9 ; 16 ; 20 ; 35 ; 36 ; 38 ; 39 ; 40 ; 41 ; 42 and 45 ;

(b)International trademark registration ASENDIA No. 1 111 830 filed
and registered on 27 October 2011 in classes 9 ; 16 ; 20 ; 35 ; 36 ; 38 ; 39 ; 40 ; 41 ; 42 and 45 under priority of French trademark registration ASENDIA No. 11 3 828 137 filed and registered on 3 May 2011 and covering amongst other jurisdictions, the European Union.

The Panel has examined copies of the registration certificates for each of the trademarks that have been submitted by the Complainant and finds that they are registered in the name of the Complainant and that they are valid trademark registrations. On that basis, the Panel accepts the submission and evidence of the Complainant and finds that the Complainant has the trademark rights required by Regulation 21 and that it is entitled to bring this proceeding.

The Complainant also submits that the disputed domain name is registered in the name of the Respondent as the registrant of the domain name. The evidence in support of this is that the Complainant has so described the Respondent in the Complaint and has warranted that the information is correct. The Panel therefore accepts the Complainant's submission in that regard and finds that the Respondent is the registrant of the disputed domain name which was registered on January 28, 2013.

The Panel will now turn to the three elements under Art. 21 (1) Regulation (EC) No 874/2004.

Identical or Confusingly Similar

The first question that arises is whether the disputed domain name is identical or confusingly similar to the ASENDIA trademark. The domain name consists of the ASENDIA trademark, a hyphen and the word " logistics", followed by the generic Top Level Domain ".eu"

which of course, as it is well-established, is ignored when making this comparison. That being so, the Panel finds that the disputed domain name is confusingly similar to the trademark, as the evidence establishes that the word "logistics" is a word that describes the activities of the Complainant and the activities of any company engaged in the mail, shipping and distribution business for which the Complainant is renowned. The objective bystander, making a comparison between the domain name and the trademark, would therefore conclude that the domain name was invoking the trademark of the Complainant and its prominent activities in the logistics of mail, shipping and distribution and would therefore find the domain name confusingly similar to the trademark. That view is well established and supported by numerous Panel decisions: see CAC Overview of CAC panel views , Second Edition, on several questions of the alternative dispute resolution for .eu domain name disputes, page 39 and the decisions there cited.

The Complainant has thus made out the first of the three elements that it must establish.

Rights and Legitimate Interests

The next question that arises is whether the disputed domain name "... has been registered by its holder without rights or legitimate interests in the name."

The Complainant submits that this is so and its submissions and evidence make that conclusion clear.

First, the Complainant says that the Complainant has no association with the Respondent and has never authorised or licensed the Respondent to use its name. The Panel agrees that this fact alone shows that the Respondent has no rights or legitimate interests in the domain name. The case is a clear one of Respondent simply taking the Complainant's trademark, adding the generic word “logistics”, a description of its known business activities and then using the resulting domain name, all without authority or licence. The Panel accepts the evidence to that effect. There is no way in which such conduct can give rise to a right or legitimate interest in a domain name and the Panel so finds in the present case.

Secondly, the Complainant points to the fact that the Respondent is using the website to which the disputed domain name resolves to offer services similar to those offered by the Complainant and for which the Complainant is renowned. In particular, the Complainant uses the domain name for a website to offer those similar services to the public. The Panel has examined the website relied on by the Complainant and finds that its submission is correct. The Panel is struck by the fact that the Respondent has clearly gone out of its way to highlight by photographs the services for which the Complainant is famous and is in effect stating to the public that it, the Respondent, can provide the same services by land, air and sea. This is a clear attempt to ride on the coat tails of the Complainant and to trade on its good name.

The most egregious aspect of the website and its contents is that it presents itself by name as ASENDIA and states in addition that “We Can Deliver Your Cargo Worldwide” and thus virtually pretends that it is the Complainant and is offering the services for which the Complainant is well known.

There is no need to analyse this evidence further. Suffice to say that the Panel has examined it all in detail and finds that it supports the Complainant's allegations and proves conclusively that the Respondent has no rights or legitimate interest in the disputed domain name and none that could arise by virtue of Article 21(2)(a)of the Regulation.

The Complainant has also argued that it must be the case that the disputed domain name was registered for the sole purpose of misleadingly diverting consumers into thinking that the Respondent is, in some way or another, connected to, sponsored by or affiliated with the Complainant and its business; or that the Respondent’s activities are approved or endorsed by the Complainant. The Complainant has also argued that the Respondent has clearly taken the Complainant’s trademarks and domain names for its own use and incorporated them into its domain name in order to confuse internet users into believing Respondent is linked to Complainant, which does not constitute a bona fide offering of goods and services.

The Panel agrees with those submissions and so finds.

The Panel also finds that on the evidence it would be impossible for the Respondent to bring itself within any of the recognised circumstances giving rise to a right or legitimate interest in the domain name.

All of these factors go to show first, that the Complainant's detailed submission shows that the Complainant has proved more than a prima facie case that has not been rebutted, as the Respondent has not filed a Response.

The Complainant has thus made out the second of the three elements under Art. 21 (1) Regulation (EC) No 874/2004.

Bad Faith

In view of the Panel's decision on the previous elements it is not strictly necessary, as the Complainant submits, to discuss the allegation that the Respondent registered or has used the disputed domain name in bad faith. However, for completeness and as the Complainant has gone to some effort to prepare a persuasive case on this issue, the Panel will address some remarks on the subject.

The Complainant has submitted that the domain name was registered in bad faith as:

(a) the Respondent registered a domain name so similar to the Complainant's ASENDIA mark;

(b) Respondent's own name has no resemblance to ASENDIA, which has no particular meaning and is highly distinctive;

(c) the Respondent has neither prior right nor legitimate interest to justify the use of the trademark and domain names of the Complainant;

(d) the Respondent's intention must have been to create confusion;

(e) the Respondent must have had notice of the Complainant's trademarks, and it acted in opportunistic bad faith.

The Panel agrees with those submissions and finds that they are all supported by the evidence and are consistent with previous domain name decisions.

The same approach also shows that the domain name was used in bad faith.

In that regard the Complainant submits that the domain name has been used to disrupt Complainant's business through the attraction of Internet users to the Respondent's website by creating a likelihood of confusion. That is clearly the case and the evidence of the website to which the domain name resolves shows it to be true, as internet users, faced with assertions that the website offers the same services as the Complainant and under the Complainant's name and trademark, would naturally assume the website was that of the Complainant or that it was authorised by the Complainant.

In addition to these specific matters and having regard to the totality of the evidence, the Panel finds that, in view of Respondent's registration of the disputed domain name using the ASENDIA trademark mark and in view of the conduct that Respondent has engaged in when using the domain name, Respondent registered and used it in bad faith within the generally accepted meaning of that expression.

Accordingly, the disputed domain name has been both registered and used in bad faith.

The Complainant has thus made out the third of the three elements under Art. 21 (1) Regulation (EC) No 874/2004.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name ASENDIA-LOGISTICS.EU be transferred to the Complainant.

PANELISTS

Name	**Neil Anthony Brown**

DATE OF PANEL DECISION 2018-02-15

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: <asendia.logistics.eu>

II. Country of the Complainant:France, country of the Respondent: Greece

III. Date of registration of the domain name: 28 January 2013.

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. French trademark registration for ASENDIA No. 11 3 828 137 filed and
registered on 3 May 2011 in classes 9 ; 16 ; 20 ; 35 ; 36 ; 38 ; 39 ; 40 ; 41 ; 42 and 45 ;

2. International trademark registration ASENDIA No. 1 111 830 filed
and registered on 27 October 2011 in classes 9 ; 16 ; 20 ; 35 ; 36 ; 38 ; 39 ; 40 ; 41 ; 42 and 45 under priority of French trademark registration ASENDIA No. 11 3 828 137 filed and registered on 3 May 2011 and covering among other jurisdictions, the European Union.

V. Response submitted: No

VI. Domain name is confusingly similar to the protected right/s of the Complainant.

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004): No. Why:
The Complainant has no association with the Respondent and has never authorised or licensed the Respondent to use its name. The Respondent has taken the Complainant's trademark, adding the generic word “logistics”, a description of the Complainant's known business activities and then using the resulting domain name, all without authority or licence. The Respondent is also using the resolving website to offer services similar to those offered by the Complainant. In particular, the Complainant uses the domain name for a website to offer those similar services to the public and thereby to ride on the coat tails of the Complainant and to trade on its good name.The Panel draws the conclusion from the evidence that the disputed domain name was registered for the sole purpose of confusing and misleadingly diverting consumers into thinking that the Respondent is connected to,
sponsored by or affiliated with the Complainant and its business; or
that the Respondent’s activities are approved or endorsed by the
Complainant.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):Yes. Why. The Respondent registered the disputed domain name which is very similar to the Complainant’s ASENDIA mark; Respondent’s own name has no resemblance to ASENDIA, which is distinctive; the Respondent has no right nor legitimate interest to use the trademark and domain names of the Complainant; the Respondent’s intention must have been to create confusion; it must have had notice of the Complainant’s trademarks, and to have acted in opportunistic bad faith.The domain name was used in bad faith because the domain name has been used to disrupt Complainant’s business by creating a likelihood of confusion. Moreover, the Respondent’s registration of the disputed domain name using the ASENDIA trademark mark and its use as so described show that the Respondent registered and used the domain name in bad faith.

IX. Other substantial facts the Panel considers relevant: N/A

X. Dispute Result: Transfer of the disputed domain name to the Complainant Asendia Management.

XI. Procedural factors the Panel considers relevant:N/A.

XII. [If transfer to Complainant] Is Complainant eligible? Yes.