# Panel Decision for dispute CAC-ADREU-007958

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| Case number | CAC-ADREU-007958 |
| Time of filing | 2020-09-09 09:22:18 |
| Domain names | asendiaexpressltd.eu |

## Case administrator

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

## Complainant

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| Organization | ASENDIA MANAGEMENT |

## Respondent

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| Name | Martina Deml |

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

The Panel is not aware of any other legal proceedings

FACTUAL BACKGROUND

Asendia is one of the world's top three international mail, shipping and distribution organizations, delivering packages, parcels and documents to more than 200 destinations across the globe.

Asendia combines the experience and expertise of its founding companies, La Poste and Swiss Post. As a joint venture, Asendia brings together a wealth of international and local expertise and connections, employing over 1,000 people in fifteen country offices in Europe, Asia and the USA.

Asendia operates in the following sectors:

- ECOMMERCE
Asendia offers a wide range of integrated solutions and international delivery expertise. Many of its e-commerce clients are fast-growing online retailers and established global brands. Asendia supports them with acquiring new customers, managing and delivering orders and with their transactions and returns.

- BUSINESS MAIL
For daily and periodic correspondence, Asendia provides straightforward solutions for international businesses of all sizes, with priority and economy delivery solutions. Asendia can handle all planned communications, including letters with fixed deadlines and standard formats like invoices.

- DIRECT MAIL
Asendia offers a wide range of preparation and delivery services for worldwide distribution. Its expertise covers catalogues, brochures, leaflets, marketing and promotional letters, to target potential and existing customers flexibly and reliably.

- PRESS & PUBLISHING
As a full service international press distributor to over 200 destinations worldwide, Asendia is a partner for magazine, newspaper and contract publishers.

- PARCELS
Based upon many years of experience in shipping parcels and packages around the globe, Asendia has developed a range of Goods

services to meet the needs of retailers, ecommerce businesses and other B2B and B2C distributors that ensures the swift, reliable and secure international delivery of your goods to your customers and intended recipients.

From the foregoing, it can be seen that ASENDIA is a major and important player in the mail, shipping and distribution market.

In that the Respondent in this case has wrongfully registered and used the disputed domain name which corresponds to the trademarks and domain names belonging to the Complainant, it is clear that the latter has a legitimate interest in having the transfer of the disputed domain name pronounced.

A. COMPLAINANT

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

1. Trademarks and domain names belonging to the Applicant:

• Asendia is in particular the owner of the following trademarks:

- French trademark registration 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 amongst other countries, the European Union.

• The applicant is also the owner of the following domain names:

- <asendia-north.com> registered on 17 July 2012;
- <asendia.asia> registered on 13 April 2012;
- <asendia.com> registered on 22 February 2011;
- <asendia.group> registered on 2 February 2017;
- <asendia.info> registered on 16 December 2011;
- <asendia.net> registered on 16 December 2011;
- <asendia.org> registered on 16 December 2011;
- <asendia.us> registered on 13 April 2012;
- <asendia.xyz> registered on 2 February 2017;
- <asendiahk.com> registered on 22 August 2014;
- <asendiahk.net> registered on 3 October 2014;
- <asendiaitaly.com> registered on 1 February 2013.

These domain names are registered and used by the Complainant in connection with its business activities.

It should be stressed that all the trademarks referred to above and domain names registered throughout the world carrying the distinctive term “asendia” are all prior to the reservation/registration of the disputed domain name of <asendiaexpressltd.eu> on 22 March 2020.

The Complainant has never licensed or otherwise authorized the Respondent to use its trademarks or to register any domain name including the above-mentioned trademarks.

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.

The disputed 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).

For all these reasons, there is no doubt that the domain name <asendiaexpressltd.eu> was registered in bad faith by the Respondent.

On 7 May 2020, ASENDIA'S attorney sent to the Registrant a cease and desist letter, by e-mail, in which it explained that the use of the domain name <asendiaexpressltd.eu> constituted a breach of ASENDIA'S prior rights over the trademarks ASENDIA and requested the immediate transfer of the litigious domain names.

Consequently, the disputed domain name <asendiaexpressltd.eu> has been both registered and used intentionally in bad faith without any rights or legitimate interest by the Respondent.

For all the foregoing reasons, pursuant to Art. 22 (1) of Commission Regulation (EC) No. 874/2004, the Complainant asks the Panel to revoke the disputed domain name and transfer it to the Complainant.

B. RESPONDENT

NO ADMINISTRATIVELY COMPLAINT RESPONSE HAS BEEN FILED.

DISCUSSION AND FINDINGS

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 B 11 (d) (1) i) of the Rules).

The addition of "expressltd" is not sufficient elements to escape the finding that the disputed domain name is confusingly similar to the Complainant's trademarks.

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 according to the Rules.

The Complainant contends that the Respondent is not affiliated with him nor authorized by him in any way to use the trademarks "ASENDIAEXPRESSLTD" in a domain name or on a website. The Complainant does not carry out any activity for, nor has any business with the Respondent.

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 B 11 (d) (1) iii) of the Rules).

Given the distinctiveness of the trademark and the content of the website, it is clear that the Respondent registered the disputed domain name in knowledge of the Complainant and its trademarks.

All these elements lead to the conclusion that the Respondent has intentionally attempted to attract Internet users to the Respondent's website for commercial gain by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of such websites.

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. The three essential issues under the paragraph B 11 (d) (1) of the Rules are whether:

(i)The domain name is identical or confusingly similar to a name in respect of which a right is recognised or established by the national law of a Member State and/or European Union law and; either

(ii)The domain name has been registered by the Respondent without rights or legitimate interest in the name; or

(iii)The domain name has been registered or is being used in bad faith.

2. The Panel reviewed carefully all documents provided by the Complainant. The Respondent did not provide the Panel with any documents or statements. The Panel also visited all available websites and public information concerning the disputed domain names, namely the WHOIS databases.

3. The Rules clearly say that any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Rules.

4. The Panel therefore came to the following conclusions:

a) The Complainant has clearly proven that it is a long standing and successful company in the international mail, shipping and distribution services. It is clear that its trademarks and domain names “ASENDIA” are well-known.

The Complainant states that the disputed domain name is confusingly similar to its trademark. Indeed, the trademark is incorporated in its entirety in the disputed domain name.

The disputed domain name is therefore deemed identical or confusingly similar.

b) It has to be stressed that it was proven that there are no fair rights of the Respondent to the disputed domain name. The Respondent is not generally known by the disputed domain name, and has not acquired any trademark or service mark rights in the name or mark.

The Panel therefore finds that the Respondent does not have rights or legitimate interest with respect to the disputed domain name.

c) The disputed domain name was registered with an intention to attract customers of another well-known domain name/registered trademark holder. Therefore there cannot be seen any legitimate interest of the Respondent.

It is clear that the Complainant's trademarks and website(s) were used by the Complainant long time before the disputed domain name was registered and used. It is therefore concluded that the disputed domain name was registered with an intention to attract customers of another well-known domain name/registered trademark holder.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all three elements of paragraph B 11 (d) (1) of the Rules.

DECISION

For all the foregoing reasons, in accordance with Art. 22 (11) of the Regulation (EC) 874/2004, being satisfied that Complainant is eligible for the registration of the disputed domain name <asendiaexpressltd.eu>, the Panel unanimously orders that the disputed domain name <asendiaexpressltd.eu> is transferred to Complainant.

It was proven by the Complainant and from public sources that the Complainant satisfied the general criteria for registration set out in § 4 (2) (b) of Regulation (EC) No. 733/2002.

The decision shall be implemented by the Registry within thirty (30) days after the notification of the decision to the Parties, unless the Respondent initiates court proceedings in a Mutual Jurisdiction.

## PANELISTS

| Name | **Vít Horáček** |
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DATE OF PANEL DECISION 2020-09-01

## Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: ASENDIAEXPRESSLTD

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

III. Date of registration of the domain name: March 22, 2020

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:
1. Word trademarks
2. Domain names
3. Company name.

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):
1. Yes.
2.Addition of wors only.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes.
2. Why: No legitimate interest proven.

IX. Other substantial facts the Panel considers relevant: None.

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

XI. Procedural factors the Panel considers relevant: No answer filed.

XII. Is Complainant eligible? Yes.