Panel Decision for dispute CAC-ADREU-005534

Case number	CAC-ADREU-005534
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Domain names	worldfinancialgroup.eu

Case administrator

Name	Josef Herian

Complainant

Organization / Name	World Financial Group, Inc., Leesa Easley

Respondent

Organization / Name	Mikel Sanches

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 Respondent is an individual who has given addresses in both the United States, and Austria. He registered the Domain Name worldfinancialgroup.eu on 2 June 2009. He has no relationship with the Complainant.
The Complainant World Financial Group, Inc, is a company within the group of companies headed by AEGON N.V. AEGON N.V. was formed in 1983 as a result of a merger between two Dutch insurers, and its roots go back much further. The Complainant itself is a financial services organisation which markets investment and insurance products through a network of associates in the United States and Canada.
The Domain Name has been used by the Respondent for the purposes of a website which, as at 8 July 2009, used the name World Financial Group, and an associated logo which is used by the Complainant. The website also referred to that company as “an AEGON” company and apparently offered an opportunity for investment with World Financial Group (including an on-line payment mechanism). Following a complaint by the Complainant’s legal representatives on 2 September 2009, the website in question was changed, so that it became less overtly a pretence of being linked with or connected to the Complainant. As at the date of this decision the majority of the text is in Russian, but there nevertheless remains a suggestion (in the English language) of a connection with the World Financial Group Insurance Agency of Canada, Inc at an address in Ontario.
The Complaint was lodged on 11 March 2009. No Response has been received from the Respondent.

A. COMPLAINANT

The Complainant asserts that:-
1. the worldfinancialgroup.eu Domain Name is identical or confusingly similar to a name or names in respect of which the Complainant has a right that is recognised or established by national and/or Community law, within the meaning of ADR Rule B1 (b) (10) (i) (A); and
2. the worldfinancialgroup.eu Domain Name has been registered by the Respondent who has no rights or legitimate interest in respect of the worldfinancialgroup.eu Domain Name, within the meaning of ADR Rule B1 (b) (10) (i) (B); and/or
3. the worldfinancialgroup.eu Domain Name had been registered or is being used in bad faith, within the meaning of ADR Rule B1 (b) (10) (i) (C).
The Complainant seeks “at the least revocation” of the Domain Name, and preferably a transfer of the Domain Name to the Complainant. The Complainant suggests in that respect that it has a “registered office” within the EU at an address in the Netherlands, which appears to be a lawyer’s address at AEGON N.V..
The Complainant’s case as to each of the above is as follows:
Confusing Similarity
The suffix .eu in the Domain Name may be excluded from consideration as being merely a functional component of a domain name.

The Complainant says that it is the owner of several trade mark registrations consisting of or containing the words World Financial Group and AEGON. The Complaint does not, however, distinguish clearly between which company owns the relevant marks. It says that "World Financial Group and AEGON own over 400 domain names (over 25 of which use the terms "world", "financial" and "group") and several trade marks, a limited number of which are discussed below…". The relevant trade marks cited include a US registration for WORLD FINANCIAL GROUP, with a first use date of June 2001, another US mark WORLD FINANCIAL GROUP and design, with a first use date of June 2001, and a Taiwanese mark, WORLD FINANCIAL GROUP and design. World Financial Group and AEGON are also said to be owners of several other relevant trade mark registrations, including two US registrations WORLD FINANCIAL GROUP CAPITAL BUILDER and WORLD FINANCIAL GROUP INSURANCE AGENCY.
The Complainant says that it has a worldwide presence, and as a result, World Financial Group and AEGON are both famous marks. It says that it has major operations in the United States, the Netherlands, and the United Kingdom as well as elsewhere in Europe and other parts of the world. It claims that the World Financial Group and AEGON marks are therefore famous marks, covered under the Paris Convention.
No rights nor legitimate interest
The Complainant says that it is sufficient for it to show a prima facie case in respect of this aspect in order to shift the burden of proof onto the Respondent. The Respondent is not connected to the Complainant, nor licensed to use the Domain Name. The Respondent has never generally been known by the Domain Name, as an actual person, undertaking, or organisation, nor does he have any other registered rights in the Domain Name.
Bad faith
The Complainant says that it is sufficient for it to make reasonable demonstration of bad faith, rather than to bring absolute evidence, as it is generally impossible for a Complainant to demonstrate with absolute certainty the existence of bad faith. In this case, the Complainant points to it being well known under the names of World Financial Group and AEGON, "certainly in the area where Respondent lives and trades". It is obvious from the website as at 8 July 2009 that the Respondent was aware of the existence of the Complainant, the Respondent would presumably have carried out a search before registering the mark, to establish whether there were earlier rights, and it is unlikely that the Respondent registered the Domain Name by coincidence.
The Complainant asserts that the registration was in order to seek to benefit from its well known names and to attract visitors, seeking the Complainant, to the Respondent's website. A substantial number of such visitors might be misled into believing that the Complainant is somehow linked to the goods and/or services offered (or to be offered) via the website at worldfinancialgroup.eu. The online payment mechanism, use of the Complainant's brands, and references to companies within the Complainant's group of companies (including World Financial Group Insurance Agency of Canada, Inc) further demonstrate the Respondent's intentions.

B. RESPONDENT

The Respondent has not replied.

DISCUSSION AND FINDINGS

The Complaint does not distinguish properly between the rights and reputation of the Complainant itself, and AEGON N.V., the parent company of the group of companies of which the Complainant itself is a part. AEGON N.V. itself undoubtedly has major operations in many countries of the World, including widely throughout Europe, and is listed on the stock exchanges of Amsterdam, London, New York and Tokoyo. However, the Complaint contains little useful information in respect of the Complainant itself, other than that it is a financial services organisation that markets investment and insurance products through a network of associates in the United States and Canada. The Complainant says that it offers products and services from a broad array of financial services providers in the areas of insurance protection, securities products, etc, but produces no evidence that it is recognised to any degree outside the United States and Canada. The trade marks which are referred to are either US or Taiwanese registrations (and in any event it is not clear whether these are owned by the Complainant, or AEGON N.V., or some other company in the group). It appears the Complainant has a number of registered domain names (including www.worldfinancialgroup.com, which was created on June 21 2000). However, again, there is no link to any reputation or trading outside the United States and Canada, and the website at www.worldfinancialgroup.com as at the date of this Decision provides the user with a choice of only the United States or Canada.
Although the Complaint refers to the ADR Rule B1(b)(10)(i)(A) which sets out what must be contained in the Complaint, it does not refer to the wording of ADR Rule B1(b)(9) (which is expressly referred to in ADR Rule B1(b)(10)(i)(A)). Under ADR Rule B1(b)(9), the Complainant must "specify the names in respect of which a right is recognised or established by the national law of a Member State and/or Community law". This wording is echoed in Rule B11(d)(1)(i), by virtue of which, for the Panel to issue a decision granting the remedies requested, the Complainant needs to prove that "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 Community law". Only if the Complainant has provided that proof is it then necessary for the Panel to consider whether the Domain Name had been registered by the Respondent without rights or legitimate interest in the name and/or has been registered or is being used in bad faith. If the Complainant does not get past this first hurdle, the Complaint fails.
In interpreting this part of the ADR Rules, there is a question as to whether what is required for the Complainant to get past this hurdle is

(1) to demonstrate that it has rights of a nature which would be recognised as equivalent to protected rights in the Community and/or a Member State (such as, for example, a US registered trade mark), whether or not those rights apply within the EU; or (2) to show that it has rights which are protected within the Community, and/or a Member State (where a US registered mark would not meet the test).
As far as this Panel is aware, there are only two previous decisions of .eu ADR panellists which have addressed this issue. In the first, 01580 AUNTMINNIE, a three person panel decided in favour of the former approach, saying that it was consistent with the UDRP to accept that a US registered service mark was sufficient under ADR Rule B11(d)(1)(i). In the second, 04478 PICMG, a sole panellist (who was one of three panellists involved in AUNTMINNIE) reached the opposite conclusion (preferring the latter approach) by reference to Article 21 of Regulation (EC) No 874/2004, which contains the wording ("a right that is recognised or established by national and/or Community law") which forms the basis for this part of the ADR Rules. The panellist in PICMG declared himself to be unaware of any previous decision in favour of the former approach (despite his involvement in AUNTMINNIE), and held that a registered US trade mark was not sufficient in that case (although without explaining his reasoning).
This Panel does not see the relevance of the ADR Rules needing to be applied in a way which is consistent with the UDRP. The UDRP is a separate and independent set of dispute resolution rules, which applies to other domain name disputes, and not those relating to the .eu domain. Under the UDRP the Complainant needs to demonstrate that it has a trademark or service mark, and the wording used is clearly different from the ADR Rules. Although the wording in the UDRP has been held not to require a link with any particular jurisdiction, this is perhaps not surprising, given that the UDRP will often be the basis for dispute resolution for domains (such as .com) which have no particular geographical link. The Panel does not see the need to follow the lead of the UDRP in connection with a domain which was set up with a view to providing a resource for the EU (and where, unlike the UDRP, a holder of a .eu domain name must have its registered office, central administration or principal place of business, be an organisation established, or be a national person resident within a specific location, namely the EU, under Regulation (EC) No 733/2002, Article 4(2)(b)). The Panel also notes the priority afforded in the Sunrise registration period to those rights which arose within the EU, which did not extend to non-EU rights. The wording used in that respect in Article 10 of Regulation (EC) No 874/2004 referred to holders of prior rights "established by national and/or Community law..", which is the same wording as in Article 21(1)(a), which refers to "a name in respect of which a right is recognised or established by national and/or Community law, such as the rights mentioned in Article 10(1)..". The Panel does not see why the same wording should be interpreted differently in the two contexts.
The wording used in the ADR Rules would also suggest that the Complainant needs to prove that the rights in question are those which arise within the Community and/or a Member State (unlike the wording of Regulation (EC) No 874/2004 the wording of the ADR Rules expressly refers to "the national law of a Member State" – not just "national law", which might perhaps be more ambiguous), and not in other countries. If the wording had intended to extend to equivalent rights recognised elsewhere, then, in the Panel's view, the wording would have needed to have been different to make that clear. Therefore, this Panel prefers the latter approach, and concludes that a non-EU registered trade mark is not sufficient for these purposes (preferring the result in PICMG to that in AUNTMINNIE).
Therefore, although it would appear to the Panel that the Complainant may well have a good case in respect of lack of rights or legitimate interest, and/or bad faith, the Panel does not see how the Complainant can hope to clear the first hurdle. The Complainant has sought to introduce a lack of clarity, by failing to distinguish properly in its Complaint between the Complainant and AEGON N.V. It has then sought in the Complaint to suggest that the Complainant's own reputation is in some way equivalent to that of its parent company. However, the fact remains that the Complainant's rights seem to be confined solely to the United States and Canada. There is nothing to suggest that the mark WORLD FINANCIAL GROUP itself is a famous mark, and covered under the Paris Convention as the Complainant suggests. The registered rights appear to be confined solely to the US and Taiwan, and there is no evidence of unregistered rights which might apply within the EU or a Member State.
Therefore, the Complaint fails.
Although not strictly relevant to its decision, the Panel would also make an observation in respect of the request by the Complainant to have the Domain Name transferred to it, by purporting to have a "registered office" address, care of a "group" lawyer at what appears to be AEGON N.V.'s head office. This, in the Panel's view, would not have been sufficient to have met the requirements of Article 4 of Regulation (EC) No 733/2002, and ADR Rule B1(b)(12) requiring the Complainant to demonstrate that it has its registered office, central administration or principal place of business within the EU, and transfer could not have been ordered in any event.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the Complaint is Denied

PANELISTS

Name	Robert Elliott

DATE OF PANEL DECISION 2010-04-12

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant World Financial Group, Inc is a financial services company, which is part of the international business run by AEGON N.V. The Respondent has used the Domain Name worldfinancialgroup.eu for the purposes of a website which misrepresented that it was connected to or operated by the Complainant. The Complainant sought to have the Domain Name revoked or transferred to it, on the basis of lack of rights or legitimate interests in the Domain Name and/or registration or use in bad faith. However, the Complaint failed at the initial hurdle of the Complainant being able to demonstrate that it had rights recognised or established by the national law of a Member State and/or Community law in a name which was identical or confusingly similar to the Domain Name. Although the Complaint has sought to blur the distinction between the Complainant and its parent company, and the ownership of rights in the European Union, it is apparent that the only rights in question owned by the Complainant are in the United States and Canada, which do not meet that test. Further, if it had been necessary, the Panel would have declined to order transfer, on the basis that the Complainant has failed to establish the required connection with the European Union under Article 4.2 (b) of Regulation EC number 733/2002.
The Complaint therefore fails.