

DISPUTE RESOLUTION SERVICE

D00022880

Decision of Independent Expert

AXA SA

and

Privacy Department

1. The Parties:

Complainant: AXA SA
25, avenue Matignon
Paris
France
75008
France

Respondent: Privacy Department
Klapparstigur 7
Reykjavik
101
Iceland

2. The Domain Name(s):

axa-vp.co.uk (“the Domain Name”)

3. Procedural History:

The Complaint was submitted to Nominet on 30 July 2020 and was validated and notified to the Respondent by Nominet on the same day. The Respondent was informed in the notification that it had 15 working days, that is until 20 August 2020, to file a response to the Complaint.

The Respondent did not file a Response. On 24 August 2020, Nominet notified the Parties that no Response had been received and, pursuant to section 12 of Nominet’s Dispute Resolution Service Policy Version 4 (“the Policy”), invited the Complainant to

pay the fee for referral of the matter for an expert decision. On the same day, the Complainant paid the fee for a full expert decision. On 25 August 2020, Andrew D S Lothian, the undersigned (“the Expert”), confirmed to Nominet that he was not aware of any reason why he could not act as an independent expert in this case. Nominet duly appointed the Expert with effect from 28 August 2020.

4. Factual Background

The Complainant is a French registered company and is the holding company of AXA Group, whose main business is in the field of insurance and financial services. The Complainant’s group has roots which go back to the 18th century and it has traded as AXA since 1985. It has been listed on the Paris Stock Exchange since 1988 and on the New York Stock Exchange since 1996. It is present in 57 countries worldwide, focusing on the Europe, North America and Asia Pacific regions and employing 160,000 people serving 108 million customers. In the UK, it employs approximately 10,000 people, has over 10 million customers and, in 2015, ranked 19th in a national newspaper’s “Top 25 Best Big Companies to work for” survey. It does business under a range of domain names including axa.com, registered on 23 October 1995, and axa.fr, registered on 20 May 1996.

The Complainant has an affiliated global technology venture capital firm of USD 425 million named “AXA Venture Partners”. It has invested in more than 45 early and growth equity deals to date. It operates under the domain name axavp.com, registered on 24 January 2018. The corresponding website states that said affiliate offers portfolio companies access to the Complainant’s risk managers, financial advisers, data scientists, distribution networks, client base, global franchises and lines of expertise.

The Complainant is the owner of a variety of registered trade marks for the mark AXA including UK registered trade mark no. 1272911 for the word mark AXA registered on 30 September 1988 in classes 35 and 36.

The Domain Name was registered on 13 November 2019. According to the Complainant’s screenshot of 29 July 2020, on an attempted visit to the Domain Name with a web browser, an NXDOMAIN message was returned, indicating that it was not configured. This is consistent with the current WHOIS record, which shows that no nameservers are listed for the Domain Name.

The owner of the Domain Name as listed in Nominet’s database is an entity named “Privacy Department” with an address in Reykjavik, Iceland. While this entity may appear to be a privacy service, that is, a proxy registrant which is intended to mask the identity of the beneficial owner of the Domain Name in WHOIS records, neither a privacy service nor any underlying or beneficial owner has come forward in respect of the Respondent’s interest in this case.

5. Parties’ Contentions

Complainant

The Complainant asserts that the Domain Name is identical or similar to a trade mark in which the Complainant has rights and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

The Complainant says that its AXA trade mark has no inherent meaning and is highly distinctive, adding that where a disputed domain name incorporates such mark it is difficult or impossible to distinguish such domain from the mark, regardless of added terms. The Complainant submits that the use of the letters “vp” in the Domain Name represents the acronym of Venture Partners and increases the likelihood of confusion, leading Internet users to believe that AXA Venture Partners is present in the UK and that the website associated with the Domain Name is that entity’s official website devoted to UK individuals and companies when it is not.

The Complainant refers to two previous DRS decisions in which the appointed experts each held that a domain name containing the AXA mark and the letters “vp” was identical or similar to the Complainant’s trade mark and name within the meaning of the Policy. The cases concerned are AXA v. Privacy Department, DRS 22450 (axavp.co.uk) and AXA SA v. Privacy Department, DRS 22589 (axavp.org.uk).

The Complainant notes that it has not granted the Respondent any permission to use its trade marks and that there is no relationship between the Parties, asserting that the Respondent has used privacy facilities to hide its real identity. The Complainant argues that the Domain Name is a match for well-known marks and a name in which the Complainant has rights and that there is no valid reason why the Respondent would choose the Domain Name, other than to take advantage of the reputation and goodwill established in the Complainant’s mark.

The Complainant asserts that the Respondent cannot deny prior knowledge of the Complainant’s AXA marks, adding that the Domain Name is exclusively referable to the Complainant and that it is an Abusive Registration in term of section 5.1.6 of the Policy. The Complainant submits that the Respondent has no intention of providing a legitimate service from the Domain Name and is using it to confuse people or businesses within the scope of section 5.1.2 of the Policy. The Complainant adds that the Expert in AXA SA vs Privacy Department, *supra* reached a similar conclusion on similar facts.

The Complainant states that although the Domain Name is unused, any realistic use of it by the Respondent would constitute passing off and/or trade mark infringement, adding that this means it is an Abusive Registration even if the Respondent has done no more than register the name. The Complainant also notes the presumption of Abusive Registration in terms of section 5.3 of the Policy and provides details of five recent decisions of independent experts in the period concerned where such experts have been convinced that the same Respondent has registered domain names similar to trade marks in the field of finance in order to take unfair advantage of the mark owner’s rights. The Complainant asserts that such presumption should therefore be held to apply in the present case.

Respondent

The Respondent did not file a Response and has not replied to the Complainant’s contentions.

6. Discussions and Findings

General

In terms of section 2.2 of the Policy the onus is on the Complainant to prove to the Expert on the balance of probabilities each of the two elements set out in sections 2.1.1

and 2.1.2 of the Policy, namely that the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

There is no system of precedent under the Policy, although experts generally strive for consistency (see the Foreword to the Expert Overview, version 3). Accordingly, each dispute is decided on its own merits and its own evidence. Appeal decisions likewise do not have precedent value, but are of persuasive value to Experts in future decisions (see section 20.12 of the Policy).

Complainant's Rights

Section 1 of the Policy provides that Rights means "rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning". The requirement to demonstrate Rights under the Policy is not a particularly high threshold test. Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.

On this topic, the Expert is satisfied that the Complainant has Rights as defined in the Policy in terms of its AXA registered trade mark described in the factual background section above. The Domain Name reproduces such mark in its entirety as the first and most prominent element of its third level, together with the non-distinctive letters "-vp". The Expert accepts the Complainant's submission that such letters do not distinguish the Domain Name from the Complainant's AXA mark. The Expert also accepts the Complainant's submissions regarding the use of these letters by the Complainant's associate as an acronym for "Venture Partners" and agrees that this adds to, rather than detracts from the perceived similarity to the Complainant's mark. The Expert notes that a similar argument was accepted by the experts in DRS 22450 and DRS 22589, *supra* which each related to similar domain names in which the letters "vp" were reproduced alongside the Complainant's AXA mark. The first and second levels of the Domain Name, together making up the ".co.uk" suffix, are typically disregarded for the comparison exercise under the first element of the Policy.

The Respondent has neither disputed that the Complainant has rights in the AXA mark, nor asserted that the Domain Name is not identical or similar thereto, nor otherwise taken any issue with the Complainant's various submissions under the first element of the Policy.

In all of these circumstances, the Expert finds that the Complainant has proved on the balance of probabilities that it has Rights within the meaning of the Policy in the mark AXA and that such mark is similar to the Domain Name. The Complainant therefore succeeds on the first element of the Policy.

Abusive Registration

Section 1 of the Policy defines "Abusive Registration" as a domain name which either:

i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or

ii. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;

This general definition is supplemented by section 5.1 of the Policy which provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Section 8.1 of the Policy provides a similar non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration.

The Domain Name is not delegated to any nameservers and is therefore not in use for any Internet services. The Complainant asserts that due to the prominence of its AXA registered trade mark and the activities of its affiliate named "AXA Venture Partners", the only reasonable explanation for the Respondent's registration and use of the Domain Name is to target the Complainant's Rights in a manner likely to constitute passing off or to infringe said mark and that this is more likely than not to constitute Abusive Registration. Among other arguments, the Complainant contends that the Domain Name is an Abusive Registration in terms of section 5.1.2 of the Policy, summarised as an assertion that there are circumstances indicating that the Respondent is threatening to use the Domain Name in a way which is likely to confuse people or businesses into believing that it is registered to, or otherwise connected with, the Complainant.

The Expert is satisfied that section 5.1.2 of the Policy is engaged in the present case. The Complainant's AXA mark is reasonably distinctive and is prominent in the Domain Name. The letters "-vp" which accompany such mark in the third level of the Domain Name do not distinguish the Domain Name from such mark and may even be an attempt on the part of the Respondent to heighten confusion, as the Complainant contends. The Expert accepts that these letters are closely connected with the Complainant's activities, in that they are an established acronym which the Complainant's affiliate has been using for some time to represent "Venture Partners", for example in the domain name and corresponding website through which it promotes its business. In these circumstances, any use of the Domain Name by the Respondent would be likely to confuse people or businesses as to a probable affiliation between the Respondent and the Complainant where none exists. While the Domain Name itself is not currently in use, its existence nevertheless constitutes a threat within the meaning of section 5.1.2 of the Policy because, in the Expert's opinion, it is inherently confusing and could be rendered active very swiftly by the Respondent with minimal time and effort by the simple expedient of delegating it to nameservers pointed to one or more Internet services, whereby it would come to the attention of Internet users.

The Expert has nothing before him which would suggest that the Respondent registered the Domain Name for any purpose that might be independent of or unconnected to the Complainant and its rights, or that was not intended to target these. The Respondent has been provided with an opportunity to explain its purpose for the Domain Name both by way of the Complainant's cease and desist notice and/or in response to the Complaint and has failed to avail itself of either of these opportunities. It is reasonable to infer, therefore, that the Respondent has no realistic answer to the Complainant's case in terms of section 5.1.2 of the Policy.

In all of these circumstances, the Expert finds that, in the hands of the Respondent, the Domain Name is an Abusive Registration in terms of section 5.1.2 of the Policy. In light of such finding, it is unnecessary for the Expert to address the Complainant's other contentions regarding Abusive Registration in the present case. The Complainant therefore succeeds on the second element of the Policy

7. Decision

The Expert finds that the Complainant has proved that it has Rights in a name or mark which is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Expert therefore directs that the Domain Name be transferred to the Complainant.

Signed
Andrew D S Lothian

Dated 8 September, 2020