

Dispute Resolution Service

DRS 22589

Decision of an Independent Expert

AXA SA

and

Privacy Department

1. Parties

Complainant: AXA SA
25, avenue Matignon
Paris
75008
France

Respondent: Privacy Department
Klapparstigur 7
Reykjavik
101
Iceland

2. Domain Name

axavp.org.uk (the "Domain Name")

3. Procedural Background

On 22nd April 2020 the Complaint was lodged with Nominet UK Limited (“Nominet”) and it was validated on 22nd April 2020. On the same day Nominet sent the notification of the complaint letter to the Respondent by e-mail and post, advising the Respondent to log into Nominet’s Online Services to view the details of the Complaint, and giving the Respondent 15 business days within which to lodge a Response on or before 14th May 2020. No Response was received and on 15th May 2020 Nominet sent the parties the notification of no Response. On 18th May 2020, the Complainant paid the appropriate fee for a Decision to be made by an Expert pursuant to paragraph 6 of Nominet’s DRS Policy (“the Policy”).

On 22nd May 2020 Mr. Niall Lawless (“the Expert”) was appointed to act as Expert in this dispute and is required to give his Decision by 15th June 2020. The Expert has confirmed that he is independent of each of the parties, and that to the best of his knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need to be disclosed as they might be of such a nature as to call in to question his independence in the eyes of one or both of the parties.

4. Outstanding Formal or Procedural Issues

There are no outstanding formal or procedural issues.

5. Factual background

The Complainant, AXA SA, is registered at French Companies House under the name AXA. AXA SA is the holding company of AXA Group. AXA Group has three major business streams: property and casualty insurance, life insurance and savings, and asset management. With roots going back to the 18th century, currently the AXA Group employs 160,000 people in 57 countries worldwide, serving about 108 million customers with insurance and financial services. AXA Group is traded on the Paris Stock Exchange, and in 1996 it was listed on the New York Stock Exchange.

The Complainant is the owner of well-known AXA registered trademarks across the world. The Complainant and/or its subsidiaries are the owners of domain names, which reproduce identically the AXA trademarks.

The Respondent is named as the Privacy Department above.

The Domain Name <axavp.org.uk> was registered on 20th March 2020. The Domain Name is currently resolving to a 'Default Web Site Page' hosted by cPanel Inc. which provides a hosting automation platform.

6. The Parties' contentions

The Complainant

The Complainant seeks transfer of the Domain Name. The Complainant says that the Domain Name is an abusive registration under Nominet's DRS Policy because:-

- The Domain Name is confusingly similar to the trademarks, company name and domain names in which the Complainant has prior rights.
- The Respondent is using the Domain Name in a way which will have confused people or businesses into believing that the domain name is registered to, operated or authorised by or otherwise connected with the Complainant.
- The Respondent registered the Domain name as a blocking registration.
- The Respondent has no rights or legitimate interests in respect of the Domain Name.
- The Respondent has not been granted any licence or other authorisation to use the Complainant's trademarks.
- The Respondent has registered the Domain Name in bad faith.
- There is no evidence that the Respondent intends to use the Domain Name for any fair purpose or to provide any legitimate service.
- Although the Domain Name is unused, any realistic use of it by the Respondent would constitute passing off and/or trade mark infringement. The Domain Name in the hands of the Respondent is therefore an "instrument of fraud".

The Respondent

The Respondent has not responded to the Complainant's contentions as set out above.

7. Discussions and Findings

7.1 General

The Policy requires that for a Complaint to succeed the Complainant must prove to the Expert on the balance of probabilities that:-

- i. the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

ii. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Rights include, but are not limited to, rights enforceable under English Law.

In order to show that the Domain Name is an Abusive Registration, the Complainant must prove, on the balance of probabilities, that the Domain Name either:-

- i. 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. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

7.2 Complainant's Rights

The Domain Name incorporates the AXA company name and trademarks. Whereas the use of the letters "vp" could mean a number of things, the Complainant asserts that "vp" is the acronym for "Venture Partners", and is therefore identical to the company name of AXA Venture Partners. The Complainant has provided evidence that it is recognised internationally as "AXA" and that it has a strong global presence. The Complainant has numerous AXA trademarks all over the world, and it owns:

- EU trademark "AXA" (+design) n°373 894 filed on August 28, 1996 in classes 35 and 36 for "insurance; savings banks; financial, monetary affairs".
- EU trademark "AXA" n°008 772 766 filed on December 21, 2009 in classes 35 and 36 for "Insurance and finance; banking services".
- UK trademark "AXA" n°1 272 911, filed on October 1, 1986 in classes 35 & 36 for "insurance services; financial banking services".

The Complainant has registered many domain names incorporating "AXA", for example <axa.com> registered on 23rd October 1995; <axa.net> registered on 1st November 1997; <axa.info> registered on 30th July 30; <axa.fr> registered on 20th May 1996; and <axavp.com> registered on 24th January 2018.

The Complainant uses the domain name <axavp.com> to promote its subsidiary AXA Venture Partners, located in Paris, and which is a \$425M venture capital firm investing in seed as well as early development stage companies. The use of the letters "vp" is an acronym for the words "Venture Partners".

Accordingly, based on the evaluation of the evidence presented, the Expert decides that the Complainant has Rights in respect of a name or mark that is identical or similar to the Domain Name.

7.3 Abusive Registration

The Complainant says that the Domain Name controlled by the Respondent is an Abusive Registration under the Policy. Under paragraph 5 “Evidence of Abusive Registration” guidance is given as to what factors may be evidence that the Domain Name is an Abusive Registration.

“A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows :-

5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.1 for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;

5.1.2 Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.”

Confusion

The Complainant says that the Domain Name is confusingly similar to the trademarks, company name and domain names in which the Complainant has prior rights, and that the Respondent is using the Domain Name in a way which will have confused people or businesses into believing that the domain name is registered to, operated or authorised by or otherwise connected with the Complainant.

On 23rd March, 31st March and 8th April 2020 the Complainant sent the Respondent cease and desist letters. The 23rd March 2020 letters states *“Further, your registration and use of the Domain Name misleads consumers that some association exists between AXA Group and you, which tarnishes the goodwill and reputation of AXA Group’s products, services and trademarks.”*

The Expert accepts the Complainant's assertion that there is no association between the Complainant and the Respondent.

Confusion would arise where the Internet user incorrectly assumes that the website the Domain Names resolves to, and the Complainant's other official websites, are either both authorised by or belong to the Complainant.

The Domain Name incorporates "AXA" a well-known financial and insurance services brand and the Domain Name incorporating the letters "vp" and the ".org.uk" gTLD, maps itself exactly to the Complainant's subsidiary AXA Venture Partners.

Given the Complainant's global visibility and its extensive use of domain names in many other countries using the "AXA" brand, the Expert therefore considers that it is likely that an internet user arriving at the website linked to the Domain Name would assume that it relates to goods or services provided by the Complainant, and be confused into believing that it is a domain and site owned and provided by the Complainant.

It is noteworthy that in DRS 22450, another dispute between the Complainant and the Privacy Department identified above regarding <axavp.co.uk>, on 11th May 2020 the Expert in that matter recorded *"The Panel is satisfied, on the evidence provided by the Complainant and not denied by the Respondent, that the Respondent registered the domain name with the Complainant's well-known AXA name and mark in mind and is using it fraudulently to masquerade as the Complainant's associated company AXA Venture Partners in order to obtain commercial advantage."*

There is no evidence that the Respondent intends to use the Domain Name for any conceivable non-abusive use, any fair purpose, or to provide any legitimate service. As set out in the in paragraph 5.1.6 of the Policy one of the factors which may be evidence that the Domain Name is an Abusive Registration is *"The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name"*.

Whereas in this Complaint there is no evidence of actual confusion, in the Expert's view, the Respondent registered the Domain Name irrespective of and reckless as to what confusion its use might result in.

The Expert decides on the balance of probabilities that even in the absence of evidence of actual confusion, the Respondent's use of the Domain Name will confuse users into believing that the Respondent is affiliated or associated with the Complainant. Therefore, under the test as set out in paragraph 5.1.2 of the Policy, in the hands of the Respondent the Domain Name is an Abusive Registration.

Accordingly, the Expert concludes that the Respondent's use of the Domain Name is abusive under paragraph 5.1.2 of the Policy.

In light of this finding, it is unnecessary for the Expert to address the Complainant's other contentions.

7.4 Conclusion

The Expert finds on the balance of probabilities that the Complainant has Rights in respect of a name or mark identical or similar to the Domain Name and the Complainant has proved, on the balance of probabilities, that the Domain Name in the hands of the Respondent is an Abusive Registration.

8. Decision

For the reasons set out in detail above, the Expert directs that the Domain Name be transferred to the Complainant.

Niall Lawless, Nominet Expert

6th June 2020