

## **ADMINISTRATIVE PANEL DECISION**

**AEW Capital Management v. Domains By Proxy, LLC / Roman Malecki**  
Case No. D2022-1988

### **1. The Parties**

The Complainant is AEW Capital Management, United States of America (“U.S.”), represented by Inlex IP Expertise, France.

The Respondent is Domains By Proxy, LLC, U.S. / Roman Malecki, U.S.

### **2. The Domain Name and Registrar**

The disputed domain name <aew-usa.com> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 1, 2022. On June 2, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 3, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint.

The Center sent an email communication to the Complainant on June 14, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on June 15, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 12, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 14, 2022.

The Center appointed Andrew J. Park as the sole panelist in this matter on July 21, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of

Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### 4. Factual Background

The Complainant AEW Capital Management is a financial services company with its main headquarters in Boston. It was founded in 1981 by Peter Aldrich, Tom Eastman, and Mark Waltch. The Complainant became a pioneer in the creation of commingled real estate products, launching the first in its long series of real estate opportunity funds in 1988 and it has been leading the way in creating and executing real estate investment strategies on behalf of the world's foremost institutional investors for over 40 years.

The Complainant opened offices in Europe, including in France and the United Kingdom ("U.K."), and expanded its public real estate investment trusts ("REIT") platform by adding portfolio management teams in Asia, including in Singapore, Hong Kong, and Japan to provide exposure to REIT investments across the globe. The Complainant also opened offices in Sydney and Madrid to expand platforms in Australia and Spain.

The Complainant owns U.S., European Union, U.K., and International trademarks including "Aew", and is also the holder of the domain name <aew.com> registered on May 12, 1995, redirecting to the website of the Complainant.

The Complainant has rights on the following AEW trademarks:

Trademark	Jurisdiction/TM Office	Registration No.	Registration Date
AEW	U.S.	No. 5310289	October 17, 2017
AEW	U.S.	No. 5310286	October 17, 2017
AEW	U.K.	No. UK00801348979	November 10, 2017
AEW	U.S.	No. 5310286	2October 17, 2017
AEW	EUIPO	No. 016056293	October 2, 2017
AEW	EUIPO	No. 009931684	October 5, 2011
AEW EUROPE	EUIPO	No. 008733925	June 2, 2010
AEW	International	No. 1349401	March 13, 2017
AEW	International	No. 1348979	March 13, 2017

The disputed domain name was registered on May 20, 2022, and according to the evidence submitted with the Complaint, it resolved to a parking page with pay-per-click ("PPC") commercial links. The descriptions of these links are all related to the Complainant's business.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant contends that the disputed domain name should be transferred to the Complainant for the following reasons.

(a) The disputed domain name is confusingly similar to the Complainant's trademark AEW in which the Complainant has rights. The Complainant's ownership of the trademark, AEW and the Complainant's exclusive right to use the AEW trademark in commerce on or in connection with the relevant goods or services are *prima facie* evidence of the validity of the term, AEW as a trademark through its registration in the U.K. in the U.S. and with the EUIPO.

The disputed domain name incorporates the Complainant's trademark AEW in its entirety and merely added "usa", a geographic identifier, and, thus, rendering it identical to the Complainant's trademark. "Aew" is the

distinctive and prominent component of the disputed domain name and the addition of “-usa” does nothing to negate the confusing similarity between the disputed domain name and the Complainant’s AEW trademark. Incorporating the geographic term “-usa” that identifies a location where the Complainant has its headquarters increases the likelihood of confusion.

(b) The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant contends that the Respondent has no right including trademark rights in respect of the name “aew” and there is no business or legal relationship between the Complainant and the Respondent. Also, the Complainant has neither authorized nor licensed the Respondent to use its trademarks in any way. The Complainant also claims that the disputed domain name points to a parking page displaying PPC links. The use of a domain name to host a parking page comprising PPC links does not represent a *bona fide* offering and therefore, the Respondent does not make a *bona fide* offering of goods or services or a legitimate noncommercial use under the disputed domain name.

(c) The disputed domain name was registered and is being used in bad faith. First, the Complainant claims that the Respondent registered the disputed domain name in bad faith. The disputed domain name was registered with the aim of taking advantage of the reputation of the Complainant’s well-known trademark AEW. The Complainant’s trademark AEW is well-known in North America, in Europe and in Asia Pacific in the field of investment services. AEW is one of the largest real estate investment managers in the world with USD 93.0 / EUR 82.2 billion in assets under management across all property types in North America, Europe, and the Asia Pacific. It has 800 clients and 780 employees in 17 offices across the globe. The Respondent must have been well-acquainted with the Complainant’s trademark when it registered the disputed domain name and it definitely registered the disputed domain name to create confusion between the disputed domain name and the Complainant’s trademark in the public’s mind. In addition, when registering the disputed domain name, the Respondent employed a privacy service in order to hide its identity and to avoid being notified of a UDRP proceeding. This constitutes an another inference of the Respondent’s bad faith registration of the disputed domain name.

Also, the Complainant claims that the Respondent is using the disputed domain name in bad faith.

The disputed domain name resolved to a parking page on which several PPC links were displayed. These links were all related to the Complainant’s business and a clear indication of bad faith. The purpose of the Respondent in registering the disputed domain name was to mislead, confuse and divert consumers or to tarnish the Complainant’s well-known AEW trademark.

## **B. Respondent**

The Respondent did not reply to the Complainant’s contentions.

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

This element consists of two parts: first, whether the Complainant has rights in a relevant trademark and, second, whether the disputed domain name is identical or confusingly similar to that trademark.

The Panel finds that the Complainant has established registered rights in the AEW trademark, and that the disputed domain name is confusingly similar to the Complainant’s trademark. The disputed domain name incorporates the Complainant’s trademark in its entirety. The mere addition of the term “-usa” does nothing to avoid a finding of confusing similarity to the Complainant’s trademark. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). Further, the addition of the generic Top-Level Domain (“gTLD”) extension “.com” may be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark (see *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#)).

For these reasons, pursuant to the Policy, paragraph 4(a)(i), the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks.

## **B. Rights or Legitimate Interests**

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the Respondent carries the burden of demonstrating its rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

Here, the Panel finds that the Complainant has made out a *prima facie* case. Panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users. See [WIPO Overview 3.0](#), section 2.9.

Moreover, the Panel finds that the Respondent has no relationship with or authorization from the Complainant to use its trademarks AEW. There is nothing in the record to suggest that the Respondent has made a legitimate noncommercial or fair use of the disputed domain name or has been commonly known by the disputed domain name. Also, there is no evidence that the Respondent has an intention to use the disputed domain name in connection with a *bona fide* offering of goods or services. The Panel's view is that these facts may be taken as true in the circumstances of this case and in view of the use of the disputed domain name.

Accordingly, the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

## **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

The Complainant claims that the Respondent registered and is using the disputed domain name in bad faith in violation of the Policy, paragraph 4(a)(iii). Specifically, the Complainant claims that the Respondent violated the Policy, paragraph 4(b)(iv) by registering the disputed domain name in order to attempt to attract, for commercial gain, Internet users to the Respondent's website which the disputed domain name resolves to by creating a likelihood of confusion with the Complainant's trademark.

As stated previously, the Respondent did not file any response to the Complaint, failing thereby to rebut the Complainant's allegations of the Respondent's bad faith registration and use of the disputed domain name.

Nevertheless, the Panel still has the responsibility of determining which of the Complainant's assertions are established as facts, and whether the conclusions asserted by the Complainant can be drawn from the established facts (see *Harvey Norman Retailing Pty Ltd v. Oxford-University*, WIPO Case No. [D2000-0944](#)).

The Panel finds the Respondent intentionally registered the disputed domain name in bad faith. The Respondent registered the disputed domain name, which is confusingly similar to the Complainant's trademark, AEW, while aware of the Complainant's world-wide famous business and its trademark. First, the Complainant's start of business in 1981, its use of the domain name <aew.com> for the Complainant's official website in 1995, and its first registration of the AEW trademark in 2009 all pre-date the registration date of the disputed domain name in 2022, the sum of which clearly show that the Respondent had actual knowledge or likely had such knowledge of the Complainant's trademark and business, when it registered the disputed domain name, and that it tried to falsely imply there was a business relationship between the disputed domain name and the Complainant by creating a likelihood of confusion. Thus, it is clear that the Respondent registered the disputed domain name in bad faith, with full knowledge of the Complainant's trademarks and business.

Second, the website to which the disputed domain name resolves is a parking page containing PPC commercial links. According to the case file, these links refer to "Private Equity Deal Flow", "Family Office Investments", and "Advisory Finance", all of which are the primary components of the Complainant's business. Also, there is a link with the description "Get this Domain" at the top of the website page. The Panel finds that the Respondent attempted to attract, for commercial gain, Internet users to its infringing website by creating a likelihood of confusion with the Complainant's trademark, and there is no evidence whatsoever that the Respondent is currently using or is commonly known by, has used, or has been commonly known under, or has a *bona fide* intent to use or be commonly known under the disputed domain name.

Accordingly, the evidence shows that the Respondent likely knew of and had sought to take unfair advantage of the confusing similarity between the disputed domain name and the Complainant's trademarks and prevented the Complainant from reflecting the mark in a corresponding domain name in order to resell the disputed domain name to the Complainant or its competitors. The Respondent registered and is using the disputed domain name in bad faith.

As the conduct described above falls squarely within paragraph 4(b)(i), (ii), and (iv) of the Policy, the Panel concludes that the Respondent registered and is using the disputed domain name in bad faith pursuant to the Policy, paragraph 4(a)(iii).

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <aew-usa.com> be transferred to the Complainant.

/Andrew J. Park/

**Andrew J. Park**

Sole Panelist

Date: August 3, 2022