

ADMINISTRATIVE PANEL DECISION

AXA SA v. Brian Grider

Case No. D2023-0586

1. The Parties

The Complainant is AXA SA, France, represented by Selarl Candé - Blanchard - Ducamp, France.

The Respondent is Brian Grider, United States of America (the “United States”).

2. The Domain Name and Registrar

The disputed domain name <axabrand.com> is registered with CloudFlare, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 8, 2023. On February 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 10, 2023, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 20, 2023, 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 amendment to the Complaint on February 20, 2023.

The Center verified that the Complaint together with the amendment to the 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 February 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 20, 2023. On the Respondent’s request, the Center extended the due date for Response to March 24, 2023. The Center received email communications from the Respondent on February 22 and March 20, 22, and 23, 2023. The Response was filed with the Center on March 24, 2023 (in the Respondent’s time zone). Prior to the filing of the Response the Respondent sought a suspension of the proceeding to enable him to transfer the disputed domain name on terms agreed with the Complainant but the latter did not agree to the suspension of proceedings which consequently,

support from both parties being required, did not occur. The proceeding continued without any period of suspension.

The Center received supplemental filings from the Complainant on April 3, 2023, and from the Respondent on April 5, 2023.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on April 13, 2023. 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 is one of the largest insurance companies in the world. In 2018, it in fact became the world's number one commercial property and casualty insurer. It has an operational presence in 50 countries, employs 110,447 people worldwide and has 95 million customers. Its shares are traded on the Paris and New York stock exchanges.

The Complainant has numerous registered trademarks including:

- International trademark AXA No.490030 registered on December 5, 1984 in classes 35, 36 and 39, in particular for “advertising and business. Insurance and financial services”, duly renewed and designating *inter alia* Algeria, Austria, Bosnia, Croatia, Egypt, Spain, Hungary, Italia, Morocco, Monaco, Portugal, North Korea, Romania, Russia, Sudan, Ukraine, Vietnam, Yugoslavia, Benelux, and Switzerland;
- International trademark AXA No.1519781 registered on May 29, 2019 in classes 35, 36, 37, 39, 44, and 45, in particular for “Advertising, business assistance for industrial and commercial companies; Insurance underwriting and financial services; banking, real estate agency services, real estate affairs” and designating the following countries: Australia, Colombia, the European Union, Japan, Mexico, Norway, the Philippines, Singapore, Thailand, Turkey, the United States, China, Algeria, Morocco, Russia, and Ukraine;
- EU trademark AXA No.000373894 registered on July 29, 1998 in classes 35 and 36, in particular for “financial, monetary affairs; fund investments; financial evaluations and appraisals, financial investment consultancy, financial analysis; management of portfolios, financial investments; financing services; investment and mutual capital; banking; debt collection” and duly renewed;
- EU trademark AXA No.008772766 registered on September 7, 2012 in classes 35 and 36 in particular for the following services: “Insurance and finance; banking services” and duly renewed;
- and French trademark AXA No.1270658 registered on January 10, 1984 in classes 35, 36 and 42, in particular for “insurance and finance” and duly renewed.

The Complainant also operates websites at its following domain names: <axa.com> registered on October 23, 1995; <axa.fr> registered on May 20, 1996; <axa.net> registered on November 01, 1997; and <axa.info> registered on July 30, 2001.

The disputed domain name was registered on October 18, 2022 and does not resolve to an active website. The Respondent offered to transfer the disputed domain name to the Complainant once he was notified of the Complaint, which offer was refused by the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant says that its distinctive AXA trademark is identically reproduced in the disputed domain name. It contends that when a disputed domain name incorporates the entirety of a Complainant's

trademark, particularly where that mark is famous, it is difficult, if not impossible, regardless of added terms, to distinguish the mark from the domain name. Because the trademark AXA is associated with the generic term "brand" the Complainant says there is a strong possibility that internet users may believe that the disputed domain name is another official website of the Complainant.

The Complainant confirms that it has not licensed or authorized the Respondent to register a domain name including its registered trademark or to use that mark in any other way. It sent three letters with formal notice to the Respondent to which it says no response was forthcoming. This demonstrates that there is no relationship between the parties in this proceeding and the Respondent therefore has no rights or legitimate interests in the disputed domain name, the Complainant maintains. The Respondent has also not been commonly known by the domain name nor had any association with the AXA mark, which the Complainant says is a well-known mark. The passive holding of the disputed domain name is not legitimate non-commercial use.

Further, the Complainant says that it is obvious that when he registered the disputed domain name the Respondent was aware of the Complainant's AXA trademarks, which the latter says it has shown to be internationally famous. Incorporating the entirety of a famous or well-known trademark in a domain name amounts to bad faith, the Complainant maintains, citing previous Panel decisions in support. The Respondent intended to take predatory advantage of the Complainant's reputation by registering the disputed domain name, the Complainant contends. The passive holding of a domain name including a famous trademark, without authorization to use that mark and where multiple cease-and-desist letters have gone unanswered, clearly amounts to bad faith use, the Complainant concludes.

B. Respondent

The Respondent says that he received no notification of the present dispute prior to the commencement of this administrative proceeding, by any means of communication. He also maintains that AXA SA has a very scant reputation in his area of Southern California, with only a few results for a Google search for "AXA insurance California", the businesses that do display having poor reviews and one of those businesses having an exterior image littered with garbage. According to the Respondent this shows that the Complainant AXA SA has no reach whatsoever in his region, and he also says he knows nobody personally who has heard of the Complainant.

The Respondent says that it is an extreme logical stretch to claim that somebody with an interest in including the letters "axa" in a domain name must know of the existence of a random insurer somewhere else in the world named AXA. According to the Respondent it is also wrong to claim that he must have been trying to capitalize on the Complainant's reputation as he had in fact never heard of the Complainant. The Respondent also says he has over 100 domain names now and has had hundreds more in the past and has never had a dispute with any company or registrar. He says he has never intentionally targeted a brand and has never been the subject of a UDRP complaint previously. He says that had he known AXA SA existed prior to purchasing the disputed domain, he would not have registered it.

The Respondent maintains that it was not his "obvious" intention to ride on the coattails of the Complainant, as the latter maintains, but to create a local consumable tea brand, sometime in the next 5-10 years. He points out that the tea and insurance industries could not be more unrelated. He says that choosing the letters "axa" was a matter of simply liking how they sounded together.

The Respondent also contends that he has done everything within his power to comply with the Complainant's desire to have the disputed domain name transferred to it. His multiple requests to transfer the disputed domain name initially for the cost of registration and then without any consideration were rejected by the Complainant, for reasons that he considers unfathomable, and always indirectly via the Center's case manager. He therefore contends that it is the Complainant who is acting in bad faith and wasting everybody's time and money, including the USD 1,000 filing fee. The Complainant's refusal to accept the transfer outside the present process amounts to harassment, according to the Respondent.

Finally, the Respondent says he consents to the remedy sought by the Complainant in the present proceeding.

C. Supplemental filings

Paragraphs 10 and 12 of the Rules grant the Panel discretion to determine the admissibility of Supplemental Filings received from either Party. The Complainant filed a response to the Respondent's contentions, in which it said that it did in fact send three letters of formal notification to the Respondent prior to the commencement of the present proceeding; that AXA is a well-known brand and that on a worldwide basis, as it points out has been accepted by a prior Panel; that it has provided ample evidence of its worldwide reputation, which includes the United States; and that a Google search along the same lines of that undertaken by the Respondent in fact shows multiple results identifying its insurance and corporate presence. The Complainant also points out that it is not a "random insurance company" but has a worldwide reputation in the AXA mark and since that mark was included in its entirety by the Respondent in the disputed domain name, it is more likely that the Respondent knew AXA and registered the disputed domain name in bad faith. It says that the Panel must decide contested factual matters on the balance of probabilities.

The Complainant also points out that the fact that the Respondent has never had a dispute about a registered domain name does not mean he would never register a domain name in bad faith. As for the project related to consumable tea that the Respondent mentions, the Complainant points out that he does not provide any concrete evidence of the existence of the project, so that, as stated in the Complaint, the disputed domain name is actually passively held, leading to a page which is not accessible, such passive holding of a domain name including a well-known trademark amounting to bad faith in any case.

Finally, the Complainant says it is entirely within its rights not to consent to a transfer and to continue this proceeding in the face of a transfer offer. It also says that the offer of a transfer for out of pocket expenses is inadmissible and offensive given the infringement of the rights of the Complainant constituted by the registration of a domain name obviously including its distinctive trademark. The Complainant says it is very concerned about defending its rights, which is why it retains lawyers in the present proceeding. It is entitled to enforce its rights as it sees fit without being accused of bad faith or harassment.

In his further Response the Respondent queries whether the Complainant made a genuine attempt to communicate with him by traditional mail, email or telephone prior to the initiation of the present proceeding. He maintains that the first he heard of the Complainant's demand in relation to the disputed domain name was through the Cloudflare contact form, Cloudflare being the relevant registrar. Further, the Respondent takes issue with the Complainant calling in aid prior panel decisions to the effect that it has a worldwide reputation and to the effect that on the balance of probabilities, he must have known of the Complainant and therefore acted in bad faith. The Respondent points out that no response was filed in the cited cases, and they are thus devoid of any precedential value in relation to the arguments they are intended to support. The Respondent maintains that Panel decisions based on uncontested claims are irrelevant to this proceeding, which, by contrast, he himself is contesting vigorously. The Respondent also says that the fact he tendered no evidence supporting his claim that he had the idea of building a tea brand around the term Axa is irrelevant as he was simply only at the stage of mulling over an idea, and further the fact that he did not establish an active website also supports his argument that he is not acting in bad faith.

Finally, the Respondent says that he made the offer to transfer the disputed domain name in return for out of pocket expenses, whereas the Policy indicates that bad faith is occasioned by a demand for a sum exceeding such expenses, and he therefor exactly did not act in bad faith. The Respondent questions the Complainant's motives for continuing with this proceeding and not accepting his offer to transfer the disputed domain name. He maintains that this proceeding is an unnecessary waste of judicial resources and a vexatious, unnecessary, and frivolous abuse of the alternative dispute resolution process.

6. Discussion and Findings

Supplemental Filings

Paragraphs 10 and 12 of the Rules grant the Panel sole discretion to determine the admissibility of Supplemental Filings received from either Party. In this case the Complainant filed a response to the Respondent's contentions and the Respondent then filed a further Response to the Complainant's response to the Respondent's initial arguments in response to the complaint. Neither party objected to the supplemental filings in the proceeding, or argued that the Panel should not have regard to the content or arguments made in the supplemental filings. The supplemental filings by and large responded directly to arguments made in previous filings rather than airing additional arguments or further evidence. In the circumstances there is no apparent detriment, injustice or unfairness in the Panel considering the content of the supplemental filings. Both parties have had a sufficient opportunity to put their arguments and responses before the Panel. The supplemental filings were not excessively long or repetitive.

Therefore, the Panel exercises its discretion in favor of admitting all the supplemental filings by both parties. The Panel's findings below are based on the initial Complaint and Response, and all further supplemental filings.

A. Identical or Confusingly Similar

The disputed domain name is not identical to the AXA registered trademark of the Complainant. However, it contains that distinctive trademark in its entirety. The AXA trademark is immediately recognizable within the disputed domain name. This is sufficient to satisfy the requirements of paragraph 4(a)(i) of the Policy. The addition of the term "brand" is of no consequence in this regard.

Therefore the Panel holds that the disputed domain name is confusingly similar to the AXA brand of the Complainant.

B. Rights or Legitimate Interests

The Complainant has not authorized the inclusion of its trademark AXA in any domain name nor its use in any other manner by the Respondent. There is no indication that the Respondent is known by the disputed domain name and the Respondent does not claim to have any rights by way of registration or legitimate use of the trademark AXA or the disputed domain name or anything similar. However, the Respondent does claim that he has a right to acquire the disputed domain name for the avowed purpose of using it in aid of a consumable tea brand, and that he is not compelled to immediately put this business idea into effect and populate a website linked to the disputed domain name for that purpose.

However, the Respondent has submitted no evidence that he is preparing to use the disputed domain name for the type of purpose suggested. There is no reason advanced for the Respondent to choose a domain name incorporating a widely known trademark of a third party for the sake of establishing a tea business "sometime in the next 5-10 years" and because of "simply liking how [the letters AXA] sounded together". A cursory Google search readily reveals the existence of the Complainant as a large insurer with worldwide reach and that AXA is its proprietary registered trademark. The Complainant has in fact provided ample evidence of its size and reach and the extent of its reputation in the insurance business. Whether prior Panels have held the mark AXA to be well-known or not is of no real consequence in light of the size of its business, its presence in many countries including the United States, the extent of its client base, the number of its employees and the consistent use of its AXA mark. That the Respondent was by his own protestations, unaware of the Complainant's AXA mark and its insurance business, is more likely to be a disingenuous claim, and is not persuasive. The Respondent's attempt to constrain the issue to AXA SA's reputation in his immediate area in Southern California is unconvincing. The Panel considers it more likely than not that the Respondent registered the disputed domain name with knowledge of the Complainant and its rights, and not as a first step towards establishing an as yet entirely unrealized business for which no evidence whatsoever has been provided.

Therefore the Panel holds that the Complainant has met its burden as to the second element.

C. Registered and Used in Bad Faith

As indicated above, a simple Google search would have revealed the Complainant as the owner of the AXA trademark, including in the United States, and its exclusive rights in that mark. The Complainant is a major insurance company with worldwide activities including within the United States, as mentioned above. The composition of the disputed domain name with the distinctive leading element "AXA" also suggests that the Respondent registered the disputed domain name in the full knowledge of the Complainant's trademark rights.

Whether the Respondent received notification of the Complainant's claims prior to the instigation of the present proceeding is of no consequence, as the Complainant is under no obligation to somehow establish its own good faith by warning a registrant before instigating a UDRP proceeding. The Complainant is also entitled to choose not to settle the matter when a proceeding is underway. It is the Respondent who intentionally selected a domain name for registration, which includes a distinctive and widely known trademark belonging to a third party, and therefore it is the Respondent who must suffer the consequences when that third party chooses to vindicate its rights by the present means..

Further, the Respondent initially used a privacy shield, which seems inconsistent with his plan to initiate a tea brand and give it a presence on the Internet – in "5-10 years". It seems more likely than not that the intention of the Respondent was to benefit financially from abusing the Complainant's established reputation, and it moreover seems clear that when he was confronted with this proceeding, he was intent on avoiding adverse findings in relation to his registration and use of the disputed domain name.

The reputation or otherwise of the Complainant by way of its AXA mark in the Respondent's immediate vicinity is of no consequence (and ignores the global reputation of the Complainant, and the reach of the Internet, at minimum) as the Complainant has established that it is a very large insurer with a worldwide reputation vested in its distinctive trademark. As said before, a simple Google search is indicative enough of that reputation, including in the United States, and of the Complainant's exclusive rights. As is well known, acquiring a domain name that includes a distinctive and highly known trademark belonging to a third party, and then holding onto it without a legitimate non-infringing reason, is in itself indicative of bad faith for the purposes of the present element.

Therefore the Panel holds that the third element is met.

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, <axabrand.com> be transferred to the Complainant.

/William A. Van Caenegem/

William A. Van Caenegem

Sole Panelist

Date: April 27, 2023