

## **ADMINISTRATIVE PANEL DECISION**

XNT Ltd. v. UnitedHealth Group Incorporated

Case No. D2023-3648

### **1. The Parties**

The Complainant is XNT Ltd., Malta, internally represented.

The Respondent is UnitedHealth Group Incorporated, United States of America (“United States”), represented by Seyfarth Shaw LLP, United States.

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

The disputed domain name <exante.com> is registered with CSC Corporate Domains, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 30, 2023. On the following day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 1, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 September 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 8, 2023. The Response was filed with the Center on October 6, 2023.

The Center appointed Matthew Kennedy as the sole panelist in this matter on October 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.

Nothing on the record indicates that any other legal proceedings have been commenced or terminated in connection with or relating to the disputed domain name.

#### **4. Factual Background**

The Complainant is a provider of investment and financial services. It holds the following trademark registrations, each one for EXANTE and a colored gemstone device:

- European Union trademark registration number 015567928, registered on October 24, 2016, (cancellation is pending);
- United Kingdom trademark registration number UK00915567928, registered on October 24, 2016, (the outcome of the European Union cancellation proceeding may be applied to this mark);
- Hong Kong, China trademark registration number 304975903, registered on June 28, 2019;
- Russian Federation trademark registration number 745664, registered on February 7, 2020; and
- United States trademark registration number 6,213,473, registered on December 8, 2020.

The Complainant also uses the domain name <exante.eu> in connection with its official website.

The Respondent is a provider of products and services to advance health care systems, including health savings and spending accounts. It uses the domain name <unitedhealthgroup.com> in connection with its official website. The Respondent acquired Exante Bank, Inc in 2002. It obtained United States trademark registrations number 3119530 for a stylized E EXANTE FINANCIAL SERVICES mark and number 3166057 for EXANTE FINANCIAL SERVICES, registered on July 25, 2006, and October 31, 2006, respectively. The Respondent acquired the registration of the disputed domain name no later than May 2007 and used it in connection with a website for Exante Financial Services. In 2008, Exante Bank and Exante Financial Services were renamed Optum Health Bank and Optum Health Financial Services, respectively. The Respondent's EXANTE FINANCIAL SERVICES trademark registrations were cancelled on March 1, 2013, and June 7, 2013, respectively. The disputed domain name no longer resolves to an active website.

The Complainant sent a letter to the Respondent dated November 22, 2022, giving notice of its trademark rights and seeking to discuss the terms of a transfer of the disputed domain name. The Complainant sent follow-up emails on November 25, 2022, December 7, 2022, January 10, 2023, January 18, 2023, February 6, 2023, and February 13, 2023, advising that it would like to buy the disputed domain name. The Respondent replied by email on January 18, 2023, and January 20, 2023, but nothing on the record indicates that it ever provided details of a contact person to discuss a transfer.

#### **5. Parties' Contentions**

##### **A. Complainant**

The disputed domain name is identical to the Complainant's EXANTE trademark.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent does not hold a registered trademark for EXANTE. "Exante" is an arbitrary term which has no meaning other than to identify the Complainant as a source of certain products and services. The Respondent does not have any affiliation, association, sponsorship, or connection with the Complainant and neither the Complainant nor any subsidiary or affiliated company has authorized, licensed, or otherwise permitted the Respondent to use its registered trademark in the disputed domain name. The Respondent is not commonly known as "Exante". There is no evidence publicly available which shows that the Respondent

is using, or preparing to use, the disputed domain name in connection with a *bona fide* offering of goods or services. Moreover, the trademark registration for EXANTE FINANCIAL SERVICES was abandoned and subsequently cancelled almost a decade ago, and the website to which the disputed domain name resolves has been inactive since 2007. There is no information available publicly that shows that the Respondent has ever been commonly known by the disputed domain name. According to the Respondent's website, it established Exante Financial Services which was renamed OptumHealth Financial Services in 2008. The Respondent's subsidiaries renamed to abandon the "Exante" name in 2008.

The disputed domain name was registered and is being used in bad faith. In particular, the Complainant cites the circumstances set out in paragraphs 4(b)(ii) and (iii) of the Policy. The website to which the disputed domain name resolves has been inactive for over a decade. The most recent activities took place in 2007. There is no evidence that the Respondent is establishing a website or other online presence which will use the disputed domain name or that the Respondent is taking any other positive action in relation to the disputed domain name. The Complainant has attempted reaching the Respondent on numerous occasions to discuss the terms on which the Respondent is willing to transfer the disputed domain name to the Complainant but the Respondent has not provided any meaningful and substantial response to any of the Complainant's requests. In the meantime, the Respondent has renewed its registration of the disputed domain name. The Respondent has also presumably renewed that registration several times since it became inactive in 2007, since the Respondent changed its corporate name to OptumHealth in 2008, and since the Respondent abandoned its trademark registrations in 2013. The Respondent renewed the disputed domain name registration knowing that the Complainant was the only party with a right and legitimate interest to use it and the word "Exante". Thereby, the Respondent conducted an abusive (re-) registration of the disputed domain name by seeking to profit from or exploit the trademark of another by willingly preventing the Complainant's use of the same.

Further, the Respondent is liable under the United States Anticybersquatting Consumer Protection Act for its use of the disputed domain name in bad faith. The EXANTE trademark is registered in the United States while the Respondent is incorporated in Delaware and has its global headquarters in Minnesota. Due to these connections to the United States, the Panel ought to take United States' laws into account in accordance with paragraph 15(a) of the Rules. The Complainant cites 15 USCS § 1125 (d)(1) and United States judicial decisions thereunder. It argues that evidence of bad faith may arise well after registration of a domain name and a claimant trademark owner may win even if a domain name was not originally registered in bad faith. Further, the term "registers" extends to renewals. The Respondent is willingly preventing the Complainant's *bona fide* use of the word "Exante". The Respondent has renewed the registration of the disputed domain name numerous times since its initial registration, and it has also renewed its registration since being made aware of the Complainant and the Complainant's use of the word "Exante". As a result, the Respondent is knowingly and willingly preventing the Complainant's legitimate use and interest in the word "Exante" without acting with any legitimate purpose recognized and protected under the Act.

## **B. Respondent**

The Complainant has failed to establish valid prior trademark rights. The Complainant's trademark registrations are for design marks, and do not convey exclusive rights to an EXANTE wordmark. The earliest priority date for these registrations is June 22, 2016, more than a decade after the Respondent's priority date in the United States and nearly ten years after the Respondent began using the disputed domain name with an active website in 2007.

The Respondent has rights and legitimate interests in respect of the disputed domain name. The Respondent can claim rights in the EXANTE FINANCIAL SERVICES mark dating back to at least its priority filing date of May 20, 2004. At that time, the Respondent was using that mark in connection with financial services. The Respondent obtained rights in the disputed domain name in good faith in connection with legitimate business dealings. Although the Respondent is not currently using the EXANTE FINANCIAL SERVICES mark and the disputed domain name no longer resolves to an active website, the Complainant cannot point to any indicia of an attempt to use the disputed domain name to divert business from the Complainant or engage in any other bad faith activity.

The disputed domain name was not registered or used in bad faith. The Complainant must demonstrate the conjunctive requirements that the Respondent registered the disputed domain name in bad faith and continues to use it in bad faith. The Complainant's claim fails because it cannot demonstrate bad faith registration by the Respondent. The Respondent obtained the rights to the disputed domain name and began using it in connection with a legitimate website in 2007, nearly a decade prior to any attempt by the Complainant to register its trademarks in 2016. The Respondent has never used the disputed domain name in bad faith. It has never attempted to sell the disputed domain name to the Complainant. The Complainant attempts to salvage its position by pointing to precedent under United States law regarding bad faith renewal of domain names. However, the Complainant has not explained how the Panel would have jurisdiction to determine that the Respondent is liable under the Anticybersquatting Consumer Protection Act or the authority to even consider United States case law in deciding whether transfer of the disputed domain name is appropriate under the UDRP. In any event, the case law that the Complainant cites is inapposite.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following conditions is met:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

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

Based on the evidence presented, the Panel finds that the Complainant has registered rights in the EXANTE and device marks. It is sufficient for the purposes of this condition that a complainant's trademark rights were in existence at the time when it filed its complaint, as in the present case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.1.2. The Panel will consider the timing of the Complainant's trademark registrations in its evaluation of bad faith in Section 6.C below.

The disputed domain name wholly incorporates the non-figurative element of the Complainant's trademarks, i.e., "exante". For technical reasons, the figurative elements of those trademarks cannot be reflected in a domain name, hence they can be disregarded in the comparison between the disputed domain name and the Complainant's marks. See [WIPO Overview 3.0](#), section 1.10.

The only additional element in the disputed domain name is a generic Top-Level Domain ("gTLD") extension (.com). As a standard requirement of domain name registration, that element may be disregarded in the comparison between the disputed domain name and the Complainant's marks. See [WIPO Overview 3.0](#), section 1.11.

Therefore, the Panel finds that the disputed domain name is identical to a trademark in which the Complainant has rights. The Complainant has satisfied the first element in paragraph 4(a) of the Policy.

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

Given the Panel's conclusion regarding bad faith in section 6.C below, it is unnecessary to consider the second condition in paragraph 4(a) of the Policy.

### C. Registered and Used in Bad Faith

The third condition in paragraph 4(a) of the Policy sets out two requirements separated by the conjunction “and”, indicating that they apply cumulatively. The Complainant must show that the disputed domain name was registered in bad faith and also that the disputed domain name is being used in bad faith. Failure to demonstrate either requirement will result in rejection of the Complaint.

Paragraph 4(b) of the Policy provides that certain circumstances, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, but these circumstances are not exhaustive. In any case, in order to demonstrate that the disputed domain name was registered in bad faith, the Complainant must show that the Respondent knew, or should have known, of the Complainant at the time when it registered, or acquired the registration of, the disputed domain name.

In the present case, the evidence shows that the Respondent acquired the registration of the disputed domain name no later than May 2007. At the time, it held trademark registrations for two EXANTE FINANCIAL SERVICES marks. The Complainant did not file its earliest trademark application until nine years later, on June 22, 2016 (in the European Union). In these circumstances, UDRP panels will not normally find bad faith on the part of a respondent. See [WIPO Overview 3.0](#), section 3.8.1. It is not suggested that there are any exceptional circumstances in the present case in which the Respondent could have registered the disputed domain name in anticipation of the Complainant’s later trademark rights. Nothing on the record indicates that the Complainant or its trademark existed or had been conceived of at the time when the disputed domain name was registered. See [WIPO Overview 3.0](#), section 3.8.2. Even though the disputed domain name is identical to the figurative element in the EXANTE mark, which is not itself a dictionary word, it is composed of the dictionary phrase “ex ante” (meaning based on forecasts rather than actual results) written without the space between the words. Accordingly, it is plausible that “Exante” could have been devised by different parties independently of each other.

The Complainant submits that the Respondent has renewed the disputed domain name registration periodically since 2007, including once since the Complainant contacted the Respondent directly and gave notice of its trademark rights. However, the Panel recalls that the mere renewal of a domain name registration by the same registrant is insufficient to support a finding of registration in bad faith under the Policy. It is not suggested in the present case that the Respondent’s possession of the registration has ever been interrupted. See [WIPO Overview 3.0](#), section 3.9.

The Complainant also refers to United States legislation and jurisprudence regarding the prevention of cyberpiracy. In support, the Complainant cites paragraph 15(a) of the Rules which provides, relevantly, that a panel shall decide a complaint in accordance with the Policy, the Rules, “and any rules and principles of law that it deems applicable”. However, it suffices for the Panel to recall that the UDRP applies to the present case, and that references to rules of national law and practice cannot avoid the need to demonstrate both conjunctive requirements in the third condition of paragraph 4(a) of the Policy.

The Respondent does not allege that any of its business units has traded under a name that includes “Exante” since it rebranded them in 2008; it only alleges that it continues to offer the same services. The Respondent has not made active use of the disputed domain name for up to 15 years and it provides no explanation as to why it chooses to renew the disputed domain name in the meantime. However, the Panel finds that the Respondent is under no obligation as such to provide any such explanation in the circumstances of the present case, in which the Complainant has failed to show that the Respondent acquired the registration of the disputed domain name in bad faith.

Therefore, the Panel does not find that the disputed domain name has been registered in bad faith. Accordingly, it is unnecessary to consider whether the disputed domain name is being used in bad faith. The Complainant has failed to satisfy the third condition in paragraph 4(a) of the Policy.

## 7. Decision

For the foregoing reasons, the Complaint is denied.

*/Matthew Kennedy/*

**Matthew Kennedy**

Sole Panelist

Date: October 27, 2023