

ADMINISTRATIVE PANEL DECISION

Accenture Global Services Limited v. Domains By Proxy, LLC/
Mohammed Moin Ahmed, Accenture Instrumentation and Automation
Company
Case No. D2022-0220

1. The Parties

The Complainant is Accenture Global Services Limited, Ireland, represented by McDermott Will & Emery LLP, United States of America ("United States").

The Respondent is Domains By Proxy, LLC, United States / Mohammed Moin Ahmed, Accenture Instrumentation and Automation Company, India.

2. The Domain Name and Registrar

The disputed domain name <accentureinst.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 January 22, 2022. On January 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 25, 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 January 26, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amended Complaint. The Complainant filed an amended Complaint on January 28, 2022.

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 January 31, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 20, 2022.

The Respondent filed a substantive communication with the Center on February 17, 2022 to which the Center acknowledged receipt and started the process of Panel appointment. On February 21, 2022, the Complainant submitted a supplemental filing following the Respondent's communication.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on February 25, 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 is a management consulting firm operating in 51 countries. It is the owner, amongst others, of the following trademark registration (Annex D to the Amended Complaint):

- United States Trademark Registration No. 3,091,811 for the word mark ACCENTURE, registered on May 16, 2006.

The disputed domain name was registered on September 4, 2021 and is being used in connection with a modest webpage displaying the Respondent's contact information and statements that the Respondent: "supplies all types of process measuring instrument"; "are expert in the installation of all type of measuring instrument"; "provide automation system and are expertise to run your process plant in automation" and "are expert in testing and troubleshooting for any type of instrument and automation system", being a "leading provider of industrial automation and test and measurement solutions".

5. Parties' Contentions

A. Complainant

The Complainant asserts to have started using its ACCENTURE trademark on January 2001 in connection with management consulting, technology services, and outsourcing services, currently operating in more than 200 cities in 51 countries, and holding trademark rights in more than 140 countries.

The Complainant further asserts to have extensively used and promoted its ACCENTURE trademark which has become distinctive and globally famous, enjoying notoriety and having acquired substantial goodwill, as can be illustrated by its rankings in Interbrand's *Best Global Brands Report* since 2002, Kantar Millward Brown's *BrandZ – Top 100 Brand Rankings* since 2006, and Fortune Global 500's *The World's Most Valuable Brands*.

In addition, the Complainant claims to support numerous social projects worldwide as well as to sponsor sports events such as the World Golf Championships and cultural activities such as a collaboration with the Louvre Museum to develop new technological programs to spread culture and reach new segments of the public.

According to the Complainant, the disputed domain name incorporates its well-known ACCENTURE trademark in its entirety with the addition of the letters "inst" which also creates a reference to the Complainant's automation services business providing strategy and consulting services in the field of intelligent automation and does not preclude a finding of confusing similarity thereof.

As to the absence of rights or legitimate interests, the Complainant argues that:

- i. the Complainant's trademark is not a generic or descriptive term in which the Respondent might have an interest;

- ii. the Respondent is neither affiliated with, nor has it been licensed or permitted to use the Complainant's trademark or any domain name relating to it;
- iii. the Respondent is not commonly known by the disputed domain name, nor was it known as such prior to the registration date of the disputed domain name, not having been located the name "Accenture Instrumentation & Automation Company" before the Ministry of Corporate Affairs in India;
- iv. the Respondent appears to have chosen the disputed domain name to create a direct affiliation with the Complainant and its business;
- v. the Respondent is using the disputed domain name, to hold itself out as the Complainant or to advertise and promote an automation consulting business that competes or has the potential to compete directly with the Complainant's automation consulting and implementation services, what does not characterize a *bona fide* use of the disputed domain name.

In what it relates to the bad faith registration of the disputed domain name, the Complainant asserts that the Respondent had notice of the ACCENTURE trademark, duly registered and well-known in many jurisdictions worldwide, being it unlikely that the Respondent was not aware of it when registering the disputed domain name. Furthermore, the Complainant states that the disputed domain name is being used to mislead Internet users who are searching for the Complainant, but instead reach the Respondent's webpage, where the Respondent is holding itself out as the Complainant and/or holds itself out as offering, competing with, or have the potential to compete with, the Complainant's goods and services.

B. Respondent

The Respondent asserts to have followed India's legal process for registering a company in that country, firstly obtaining the name approval by having registered its company name, Accenture Instrumentation and Automation Company, before the Ministry of Corporate Affairs Office of the Registrar Companies on August 18, 2021 and subsequently registering its company before India's Ministry of Micro, Small, and Medium Enterprises ("MSME") on August 23, 2021.

The Respondent further states that it is not in competition with the Complainant, rendering different services to those of the Complainant and that losing the disputed domain name would create a big loss since it would lose all "contracts" with its clients.

Lastly the Respondent indicates that it would be interested in settling down the dispute but would request a settlement as per its losses.

The Respondent files copy of its company's registration certificate from the MSME dated August 23, 2021 (UDYAM-TS-02-0035655) indicating its enrollment as "architecture and engineering activities; technical testing and analysis" and the name approval letter from the Government of India Ministry of Corporate Affairs Office of the Registrar of Companies dated August 18, 2021.

C. Complainant's Unsolicited Submission of February 21, 2022

On February 21, 2022 the Complainant requested the Panel to accept an Additional Submission in view of the documents filed by the Respondent stating that:

- a) The Respondent has not demonstrated any legitimate interest in the disputed domain name since the "mere registration of the company, without more, is not enough to demonstrate that the Respondent was commonly known by the domain name." (*The Dannon Company Inc., Compagnie Gervais Danone v. Muhammad Bashir Ibrahim*, WIPO Case No. [D2016-2270](#));
- b) In *Barclays Bank PLC v. New City Resources Inc.* (WIPO Case No. [D2011-1584](#)), the respondent was required to transfer the domain name <barclayinvest.com> to the complainant, because the panel found

that the Respondent's "certificate of registration of the 'Barclay Investment Co., Ltd'; the business registration receipt of the company; and a statement of the Respondent's intention to use the disputed domain name for a legitimate purpose" did not show "sufficient demonstrable evidence" of its interest in the domain name;

c) The Respondent's registration of Accenture Instrumentation and Automation Company with the MSME Ministry in India does not provide sufficient demonstrable evidence of an interest in the disputed domain name, as local counsel in India has advised that such registration does not amount to a trademark registration, and per se does not amount as registration as a trade name;

d) the Name Approval letter submitted by the Respondent does not show a legitimate interest in the disputed domain name given that it specifically states that "The Applicant Cannot Start Business Or Enter Into Any Agreement, Contract, Etc. In The Name Of The Proposed Company Until And Unless A Certificate Of Registration Is Issued By The Registrar Of Companies As Per The Provisions Of The Companies Act'2013 And The Rules Made Thereunder", not providing such document rights to operate under such business name;

e) upon information and belief, the Respondent never completed the certificate of registration process and never incorporated the company under Indian law and, therefore, does not have the right to operate a business under Indian law by that name. Indeed, a recent search of the Indian corporate records did not reveal any company registered under the name ACCENTURE INSTRUMENTATION AND AUTOMATION.

Given that these appear to address contentions that would not have been foreseen at the time of filing the Complaint, and noting no prejudice to the Respondent, the Panel admits the filing.

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met for this Panel to order the transfer of the disputed domain name:

(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.

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present so as to have the disputed domain name transferred, according to the Policy.

A. Identical or Confusingly Similar

The Complainant has established its rights in the ACCENTURE trademark.

The disputed domain name incorporates the Complainant's trademark in its entirety and the addition of "inst" does not avoid a finding of confusing similarity under the Policy, as recognized by the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), Section 1.9.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark. The first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that may indicate a respondent's

rights to or legitimate interests in a domain name. These circumstances are:

- (i) before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, even if it has not acquired trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

There is a consensus in previous decisions under the Policy that a Complainant may establish the second element by making out a *prima facie* case, shifting the burden of production to the respondent to bring forward evidence of such rights or legitimate interests in the disputed domain name (with the burden of proof always resting with the complainant).

In that sense, the Panel is satisfied that the Complainant has established the *prima facie* case, based on its submissions that ACCENTURE trademark is well-known and that the Respondent is neither affiliated with, nor has it been licensed or permitted to use the Complainant's trademark or any domain name relating to it.

The question then as to whether the Respondent has completed the registration process to obtain a registered trade name and effectively became an incorporated company under Indian law and, therefore, has the ability to legitimately operate a business under Indian law by the name "Accenture Instrumentation and Automation Company" is unclear to this Panel under the limited scope of this procedure and scarce evidence produced by both Parties.

Most importantly however, the Respondent does not explain his choice to adopt "Accenture" as the leading element of this company name and his field of activities which could potentially coincide with the Complainant's services, thus bearing the disputed domain name a potential risk of creating an impression of affiliation with the Complainant and its business and misleadingly divert the Complainant's consumers.

The Panel refers to a similar case where "[i]n addition to there being no actual evidence of the use of the company name, other than to obtain the documentation produced, there is no evidence to support a submission that the Respondent is making a *bona fide* offering of goods and services under that name. There is no independent verification of the nature and extent of the Respondent's alleged business offerings. There are no details of customers, suppliers or institutions served, no advertising or promotional materials, no details of an online presence, no financial information such as the level of sales achieved, no example invoices and no evidence of dealings with professional advisors or investors. In short, where the Respondent claims to have a business which has been trading for some years the Panel would reasonably expect it to be in a position to provide more than merely a variety of certificate(s) of incorporation and trading license(s) to support a submission that it is commonly known by, and/or actively making an offering of goods or services under, the name concerned. The lack of any such additional evidence reasonably calls the credibility of the Respondent's case into question". (*The Dannon Company Inc., Compagnie Gervais Danone v. Muhammad Bashir Ibrahim*, WIPO Case No. [D2016-2270](#)). Moreover, the Panel cannot escape the clear inference that the name was opportunistically chosen to take unfair advantage of the Complainant's mark, and cannot therefore support a claim to a right or legitimate interest under the Policy in respect of the Respondent; see e.g., *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#) (stating "it would be a mistake to conclude that mere registration of a [business name] creates a legitimate interest under the Policy. [...] To establish cognizable rights, the overall circumstances should demonstrate that the registration was obtained in good faith for the purpose of making *bona fide* use of the [business name], and not obtained merely to circumvent the application of the Policy.").

The Panel finds that the Complainant has met its burden under the second element of the Policy.

C. Registered and Used in Bad Faith

The Policy indicates in paragraph 4(b)(iv) that bad faith registration and use can be found in respect of a disputed domain name, where, by using the disputed 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 website or location or of a product or service on the website or location.

In this case, both the registration and use of the disputed domain name in bad faith can be found in view of the apparent use of the disputed domain name seeking to create an affiliation with the Complainant and its business, as seen above.

Other factors that corroborate with the Panel's finding of bad faith of the Respondent is the reputation and distinctiveness of the Complainant and its ACCENTURE trademark, as well as the implausibility of any good faith use to which the disputed domain name may be put.

For the reasons above, the Respondent's conduct has to be considered, in this Panel's view, as bad faith registration and use of the disputed domain name pursuant to paragraph 4(b)(iv) of the Policy.

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 <accentureinst.com> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: March 11, 2022