

## **ADMINISTRATIVE PANEL DECISION**

**AEW Capital Management v. Registration Private, Domains by Proxy, LLC /  
Roman Malecki  
Case No. D2022-2737**

### **1. The Parties**

Complainant is AEW Capital Management, United States of America, represented by Inlex IP Expertise, France.

Respondent is Registration Private, Domains by Proxy, LLC, United States of America / Roman Malecki, United States of America.

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

The disputed domain name <aew-us.com> (the “Domain Name”) 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 July 26, 2022. On July 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On July 26, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email to Complainant on July 27, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on July 28, 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 Respondent of the Complaint, and the proceedings commenced on August 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 29, 2022. Further to communications from the Respondent on August 30, 2022, the Response was filed with the Center on September 8, 2022.

The Center appointed Robert A. Badgley as the sole panelist in this matter on September 12, 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.

On September 22, 2022, the Panel issued Procedural Order No. 1, as follows:

“In view of the arguments raised by the Respondent, the Panel asks Respondent to provide, on or before October 4, 2022, contemporaneous documentation (notwithstanding the WhatsApp messages annexed to the Response) to corroborate his assertion that, “Respondent has received written permission from AEW Pune Aashu Engineering Works (hereinafter “Aashu”) to use to use ‘AEW’ in marketing materials, as well within registered domains, including www.aew-us.com and www.aew-usa.com in order to sell ‘AEW’ branded products manufactured by Aashu Engineering Works.” Such documentation may include, though is not limited to, correspondence from Aashu, an actual executed contract between Respondent and Aashu, drafts of a contract between Respondent and Aashu, and the like.”

“Complainant may respond to Respondent’s submission on or before October 13, 2022.”

“The Panel reserves the right to seek additional information or documentation from the Parties.”

Respondent replied to Procedural Order No. 1 on October 4 and 11, 2022, and provided a signed and unsigned version of the same document, discussed below.

On October 13, 2022, Complainant replied to Respondent’s submissions, asserting that the document should be disregarded as untimely and essentially inauthentic.

On October 17, 2022, Respondent sent an unsolicited email to the Center, attempting to fortify his position on various respects, but adding nothing new except to request a finding of Reverse Domain Hijacking and claiming that use of a parking page did not indicate intent.

On October 18, 2022, Complainant sent its own unsolicited email to the Center, attempting to fortify its position on various respects, but adding nothing new.

On October 18, 2022, Respondent sent another unsolicited email to the Center, attempting to fortify his position on various respects, but adding nothing new except to mention that due to the Domain Name being locked, he pointed the site content to “www.aewusa.com” to demonstrate the unrelated and noncompetitive nature of this business.

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

Complainant is a financial services company founded in 1981 and based in Boston, Massachusetts. According to the Complaint, Complainant has been a pioneer in the creation of commingled real estate products and the developer of innovative real estate investment strategies on behalf of major institutional investors. According to Complainant, it is one of the world’s largest real estate investment managers, with more than USD 93 billion in assets under management. It has 800 clients and has offices in 17 financial centers around the world.

Complainant’s main website is located via the domain name <aew.com>, a domain name it has owned since 1995 and used since 1997 as its commercial website.

Complainant holds several registered trademarks for AEW in various jurisdictions, including United States Patent and Trademark Office Reg. No. 5,310,289 (registered October 17, 2017), and European Union Intellectual Property Office Trade Mark Reg. No. 016056293 (figurative) (registered May 2, 2017).

The Domain Name was registered on May 23, 2022. It resolves to a parking page containing hyperlinks such as “Crédit en Pour Frontalier,” “Crédit Privé,” and “Crédit Privé En.” According to Respondent, he has no control over these hyperlinks, which were generated by the Registrar.

Respondent asserts:

“Prior to the date of the Notification of Complaint (July 27<sup>th</sup>, 2022), Respondent conducted verifiable communications with AEW Pune Aashu Engineering Works to establish a business relationship that would result in the Respondent selling their products in the US market. Aashu Engineering Works, more commonly known as ‘AEW’, ‘AEW Pune’ or ‘AEW India’, is a very well, globally known motorcycle parts manufacturing company, which is actively trademarked for the usage of “AEW” (WIPO registration number 3029692; Application Date August 12<sup>th</sup>, 2015).”

Information regarding AEW Pune Aashu Engineering Works (“Aashu”) and Aashu’s India trademark registration is annexed to the Response. Aashu apparently is based in the Indian city Pune. The registered trademark under Reg. No. 3029692 is, in word form, AEW PUNE AASHU ENGINEERING WORKS. The registration date for the mark is August 12, 2015, and the registration covers “exhaust silencers.” Aashu operates a website at the domain name <aewindia.co>, a domain name that it has owned since April 10, 2019. A Google search result screenshot annexed to the Response indicates that there are thousands of results for the search “AEW mufflers” (muffler being essentially synonymous with exhaust silencer).

Respondent asserts further:

“Respondent has received written permission from AEW Pune Aashu Engineering Works to use to use ‘AEW’ in marketing materials, as well within registered domains, including www.aew-us.com and www.aew-usa.com in order to sell ‘AEW’ branded products manufactured by Aashu Engineering Works. Please note that the disputed domain is one of the domains mentioned within the communications between the Respondent and AEW Pune Aashu Engineering Works (registered trademark holder).”

Annexed to the Response is a series of communications, via WhatsApp, between Respondent and Aashu (identified in the thread as “AEW HQ”). In this thread, Respondent expresses his interest in being a United States distributor of Aashu’s products, and requests permission from Aashu to use the “AEW” trademark in a domain name.

Apart from the WhatsApp messages noted above, there was nothing in the record to corroborate Respondent’s allegation that he is in the business of distributing motorcycle parts in the United States. In response to Procedural Order No. 1, seeking contemporaneous documentation of a licensing relationship between Respondent and Aashu, Respondent provided a single-page, unsigned and undated document entitled “AEW Pune AASHU Engineering Works Trademark License Agreement,” purportedly granting Respondent the license to use Aashu’s AEW trademark in connection with the distribution of Aashu’s products. Thereafter, Respondent submitted what appears to be the same contract, but this time bearing a signature, a date (October 10, 2022), and a purported corporate stamp (“Aashu Engineering Works Pune”).

Respondent also submits with the Response a list of more than 30 different firms around the world currently using AEW as their trademark or as part of their trademark for a wide variety of goods or services.

It bears noting that these two Parties were recently involved in another UDRP proceeding regarding a very similar domain name, namely, <aew-usa.com>. See *AEW Capital Management v. Domains By Proxy, LLC / Roman Malecki*, WIPO Case No. [D2022-1988](#) (“AEW Prior Case”). In *AEW Prior Case*, the subject domain name was registered on May 20, 2022, *i.e.*, three days before Respondent registered the Domain Name at issue here. The domain name in *AEW Prior Case*, like the Domain Name here, resolved to a parking page set up by the Registrar, and the hyperlinks at both websites related to financial services (for example, in both cases there was a hyperlink to “Family Office Investments”).

In *AEW Prior Case*, Respondent did not file a Response of any sort. With an undisputed record, a well-established trademark, hyperlinks to businesses operating in the same field as Complainant, and no explanation from Respondent, the panel in *AEW Prior Case* transferred <aew-usa.com> to Complainant.

## **5. Parties' Contentions**

### **A. Complainant**

Complainant contends that it has established all three elements required under the Policy for a transfer of the Domain Name.

### **B. Respondent**

Respondent asserts that he is operating a legitimate business and preparing to make a legitimate use of the Domain Name in an area of commerce (selling motorcycle parts) vastly distinct from Complainant's business (financial services). Respondent also asserts that numerous businesses are legitimately using the mark AEW (or a mark including AEW) in a variety of commercial settings, and Complainant does not enjoy a monopoly over those three letters.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

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

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

The Panel concludes that Complainant has rights in the trademark AEW through registration and use demonstrated in the record. The Panel also concludes that the Domain Name is confusingly similar to that mark. The AEW mark is clearly recognizable within the Domain Name, and the additional geographic descriptor "us" does not prevent a finding of confusing similarity between the mark and the Domain Name.

Complainant has established Policy paragraph 4(a)(i).

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

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in connection with the Domain Name. On the record presented, which record the Panel gave Respondent the opportunity to amplify with corroborating contemporaneous documentation of its supposed licensing agreement with Aashu, there is doubt about Respondent's account.

The entire body of evidence Respondent could provide, after two attempts and a unilaterally self-granted extension of time, was a brief WhatsApp message, the authenticity of which is open to question, and a signed and unsigned version of a one-page purported contract. The Respondent submitted the unsigned version on October 4, 2022. The signed version was submitted on October 11, 2022, with a signature date of October 10, 2022 – six days after Respondent's deadline under Procedural Order No. 1 had lapsed – with Aashu, the supposed grantor of licensing rights to Respondent.

The Panel struggles to believe that a genuine distributorship relationship – even a relatively new one – would be memorialized with such documentation. Put another way, if Respondent's business venture and his motives vis-à-vis the Domain Name were genuine, he would have had a much more robust contemporaneous paper trail to document and corroborate his version of events. As it stands, though, Respondent's documentary proffer actually undermines his credibility in general.

In sum, the Panel concludes, on a balance of probabilities and based on the record presented, that Complainant has established Policy paragraph 4(a)(ii).

The Panel reaches this conclusion without reliance on the *AEW Prior Case*, discussed above.

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

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation," are evidence of the registration and use of the Domain Name in "bad faith":

(i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or

(ii) that 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 Respondent has engaged in a pattern of such conduct; or

(iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

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

The Panel incorporates its discussion above in the "Rights or Legitimate Interests" section. Having concluded that Respondent's account is lacking, the Panel concludes, on this record and on a balance of probabilities, that Respondent falls within the meaning of the above-quoted Policy paragraph 4(b)(iv), also noting the commercial hyperlinks appearing on the website to which the Domain Name resolves. Previous UDRP panels have found that a respondent that uses a domain name with automatically generated pay-per-click links cannot disclaim responsibility under the third element, neither the fact that such links are generated by a third party such as a registrar, see section 3.5 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finally notes Respondent's mention of the domain name <aewusa.com> which it is said hosts the same content as was intended to be under the Domain Name. It is not clear why it was possible to host such content in one place, but not in the other. It is also worth noting that this site uses conflicting terminology as to the relationship between Respondent and Ashu Engineering Works (e.g., use of "we" at "Ashu Engineering Works (AEW) started back in 1980 and we were into manufacturing" (which it is noted is copied from the Ashu official page) but then use of "our" at "AEW-USA is an official distributor for AEW India; all of our AEW products"). In all events, it is noted that even though this decision is in favor of Complainant, Respondent is using another domain name to conduct its activities (so to the extent its activities are legitimate, it is not harmed or prevented from conducting its business). Complainant has established 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 Domain Name <aew-us.com> be transferred to Complainant.

*/Robert A. Badgley/*

**Robert A. Badgley**

Sole Panelist

Date: October 26, 2022