

## **ADMINISTRATIVE PANEL DECISION**

### **MLP Finanzberatung SE v. Johan Berg**

### **Case No. D2022-3226**

#### **1. The Parties**

The Complainant is MLP Finanzberatung SE, Germany, represented by Ullrich & Naumann PartGmbH, Germany.

The Respondent is Johan Berg, Germany.

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

The disputed domain name <mlpberatung.com> is registered with PSI-USA, Inc. dba Domain Robot (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 31, 2022. On August 31, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 1, 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 (Privacy Service Provided by PSI-USA, Inc. dba Domain Robot, United States of America) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 2, 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 amendment to the Complaint on September 7, 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 September 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 28, 2022. Apart from an email communication received from the technical contact of the disputed domain name dated September 15, 2022 indicating that the website at the disputed domain name had been taken down, no response was submitted. Accordingly, the Center notified the Commencement of Panel Appointment Process on October 11, 2022.

The Center appointed Torsten Bettinger as the sole panelist in this matter on October 19, 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 financial services company for private, corporate and institutional clients based in Wiesloch, Germany. The Complainant has registered and used marks corresponding to the MLP name since 1998.

The Complainant provided evidence of the of the following trademark registrations:

Trademark	Jurisdiction	Registration Number	Registration Date
MLP	European Union	17874874	May 22, 2001
MLP (and design)	European Union	17874875	May 17, 2006
MLP (and design)	United Kingdom	UK00917874875	May 17, 2006

The disputed domain name was registered on August 12, 2022. The disputed domain name resolves to a website that purportedly offers financial services, and contains the following statements:

“MLP Asset Managers London ist die in Europa ansässige Fondsplattform von MLP Asset Managers. Als Verwaltungsgesellschaft nach Chapter 15 London verwalten wir OGAW-Fonds sowie alternative Anlagen. Mit mehr als 20 Mitarbeitern und einem Vermögen von über 500 Millionen Euro sind wir einer der exklusivsten Vermögensverwalter des Landes. Unser Büro befindet sich seit 2006 im Londoner Banken- und Finanzviertel Kirchberg. Unser strategischer Fokus MLP Asset Managers London initiiert und verwaltet Immobilien-, Infrastruktur- und Kreditfonds für institutionelle Investoren. Über einen OGAW-Umbrella- Fonds verwalten wir auch Aktien, Renten und gemischte Sondervermögen. Unser Kerngeschäft umfasst Fondsverwaltung, Risikomanagement, Compliance, Rechnungslegung sowie Rechts-, Marketing- und Kundenberatung. Diese Produkte vertreiben wir unter anderem über unsere Niederlassung London und konzerninterne Partner.” (which may be translated in English as “MLP Asset Managers London is the European-based fund platform of MLP Asset Managers. As a Chapter 15 London management company, we manage UCITS funds as well as alternative investments. With more than 20 employees and assets of over 500 million euros, we are one of the most exclusive asset managers in the country. Our office has been located in London’s Kirchberg banking and financial district since 2006. Our strategic focus MLP Asset Managers London initiates and manages real estate, infrastructure and credit funds for institutional investors. We also manage equities, bonds and mixed funds via a UCITS umbrella fund. Our core business includes fund administration, risk management, compliance, accounting, legal, marketing and client consultancy services. mWe distribute these products through our London office and intra-group partners, among others.”)

The website prominently displays the Complainant’s MLP word mark and device logo..

#### 5. Parties’ Contentions

##### A. Complainant

The Complainant states that it is one of the leading financial service providers in Europe and that the MLP trademark is well known throughout Europe in connection with financial services.

With regard to the requirement of identity or confusing similarity between the trademark and the disputed domain name pursuant to paragraph 4(a)(i) of the Policy, the Complainant asserts that:

- the disputed domain name is confusingly similar to its registered trademark MLP as the disputed domain name contains the Complainant's complete MLP trademark;
- the addition of generic term "berating" ("consultancy" in English) does not negate the confusing similarity between the disputed domain name and the Complainant's trademark under the Policy.

With regard to the Respondent having no rights or legitimate interests in the disputed domain name, the Complainant submitted that:

- the registration of the disputed domain name was not authorized by the Complainant;
- the unauthorized use of the disputed domain name for a website displaying the Complainant's logo and trademark MLP cannot be considered as a use of the disputed domain name for a *bona fide* offering of goods or services or as a legitimate noncommercial or fair use of the disputed domain name;
- the Respondent claims to be located at an address in London where no company is registered according to the United Kingdom government Companies House database.

Finally, with regard to the disputed domain name having been registered and being used in bad faith, the Complainant argues that:

- the Respondent's use of the disputed domain name for services identical with those of the Complainant demonstrates that the Respondent had knowledge of the Complainant's MLP mark when registering the disputed domain name;
- by registering and using a domain name that is nearly identical to the Complainant's well-known MLP mark in connection with services which are identical to those of the Complainant, the Respondent intentionally attempts to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's MLP mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website;
- the Respondent passes off the goodwill of the Complainant's well-known MLP mark through consumer confusion as to the source, sponsorship, affiliation, or endorsement of the Respondent's website with the Complainant.

## **B. Respondent**

Apart from an email communication from the technical contact of the disputed domain name as mentioned under section 3 above, the Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy states that the Complainant must prove each of the three following elements:

- (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**

The Complainant has demonstrated that it owns multiple trademark registrations for the mark MLP prior to the registration of the disputed domain name on August 12, 2022.

It is well-established that the test of identity or confusing similarity under the Policy is confined to a comparison of the disputed domain name and the trademark alone, independent of the products for which the trademark is used or other marketing and use factors usually considered in trademark infringement cases (see sections 1.1.2 and 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

In this case, the disputed domain name contains the Complainant's trademark MLP in its entirety and only differs from the Complainant's trademark MLP by the addition of the descriptive term "beratung" (the German word for "consulting").

The Panel notes that it has long been established under the UDRP that the addition of a merely descriptive wording to a trademark in a domain name does not prevent a finding of confusing similarity under the first element of the UDRP (see section 1.8 of the [WIPO Overview 3.0](#)). The Panel therefore agrees with the Complainant's assertion that the addition of the descriptive term "beratung" does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark.

Furthermore, it is well accepted under the UDRP that the specific generic Top-Level Domain ("gTLD") designation such as ".com", ".net", ".org" is not to be taken into account when assessing the issue of identity and confusing similarity, except in certain cases where the applicable Top-Level suffix may itself form part of the relevant trademark (see [WIPO Overview 3.0](#), section 1.11).

For the foregoing reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's MLP trademarks in which the Complainant has exclusive rights.

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

Pursuant to paragraph 4(c) of the Policy a 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 [the 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 [the 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 [the 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 Complainant states that it has not authorized the Respondent to register and used the disputed domain name and has provided evidence of its extensive use of its MLP trademark and a screen shot that shows that the Respondent was purportedly offering financial services and made unauthorized use of the Complainant's trademark and device logo on the website to which the disputed domain name resolves.

These assertions and evidence are sufficient to establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

Where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent has chosen not to contest the Complainant's allegations and has failed to come forward with any evidence to refute the Complainant's *prima facie* showing that the Respondent lacks rights or legitimate interests. The Panel therefore accepts these allegations as undisputed facts.

Moreover, the term "beratung" (the German word for "consulting") included in the disputed domain name relates to the services provided by the Complainant. Such composition of the disputed domain name cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant (see section 2.5.1 of the [WIPO Overview 3.0](#)).

The Respondent's use of the disputed domain name for a website purportedly offering financial services and prominently displaying the Complainant's MLP device mark indicates that the Respondent has attempted to create the false impression that the website was created by or belonging to the Complainant and the Panel therefore concludes that the Respondent lacks 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 four, non-exclusive, circumstances that, if anyone is found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the Respondent has registered the disputed 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 disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) 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 Respondent's website or location or of a product or service on the Respondent's website or location.

The Complainant holds multiple trademark registrations for the MLP trademark in various countries that predate the registration of the disputed domain name. The MLP mark is distinctive and is clearly associated with the Complainant and its financial services through widespread and intensive use.

In view of the fact that the Respondent prominently uses the Complainant's trademark and device logo on the website available under the disputed domain name, it is inconceivable that the Respondent coincidentally registered the disputed domain name without knowledge of the Complainant's rights in the MLP mark.

Moreover, prior UDRP panel decisions have found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)). The Panel therefore concludes that the Respondent registered the disputed domain name in bad faith.

Furthermore, by using the disputed domain name, for a website which reproduces the Complainant's trademark and device logo and purportedly offers financial services competing with those of the Complainant, the Respondent intentionally mislead Internet users into believing that the disputed domain name and its associated website are in some way associated with or endorsed by the Complainant.

The Panel therefore concludes that the disputed domain name has intentionally been registered and used in an attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's MLP trademark as to the source, sponsorship, affiliation, or endorsement of the website.

The Panel thus finds that the Complainant has also proved the requirements under paragraph 4(a)(iii) of the Policy and that the disputed domain name has been registered and is being used in bad faith.

## **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 <mlpberatung.com> be transferred to the Complainant.

*/Torsten Bettinger/*

**Torsten Bettinger**

Sole Panelist

Date: November 2, 2022