

ADMINISTRATIVE PANEL DECISION

Akiem Holding v. Domain Sales -

(Expired domain caught by auction winner) c/o Dynadot

Case No. D2023-0188

1. The Parties

The Complainant is Akiem Holding, France, represented by Casalonga Avocats, France.

The Respondent is Domain Sales - (Expired domain caught by auction winner) c/o Dynadot, United States of America.

2. The Domain Name and Registrar

The disputed domain name <fullservicebyakiem.com> is registered with Dynadot, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 13, 2023. On January 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 16, 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 January 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 7, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 10, 2023.

The Center appointed Steven A. Maier as the sole panelist in this matter on February 20, 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. Identity of Respondent

In this case the Respondent, whose details have been verified by the Registrar, appears to be some form of a privacy or proxy service that may be operated by the Registrar. Typically, when a registrar timely discloses the identity of the underlying registrant or “beneficial holder” of a disputed domain name, the panel may find that only that underlying registrant, and not the registrar, should properly be regarded as the respondent in the proceeding (see e.g. section 4.4.5. of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”)).

In this regard, as the panel in *NETANY S.A. v. Domain Sales - (Expired domain caught by auction winner) c/o Dynadot*, WIPO Case No. [D2022-5029](#) stated “It is not clear who exactly is the registrant of the Domain Name, but the Respondent name suggests that at some point it was acquired via an auction conducted by the Registrar following the Domain Name’s expiry. However, to what extent this statement is consistent with a creation date of May 6, 2022 is also unclear.” Similarly, the Panel notes in this proceeding that the creation date as per the Registrar’s public Whois is August 5, 2022, which casts some doubt on the possibility of the disputed domain name having been registered further to an auction after expiration, as the provided registrant’s name appears to suggest.

In this case also, the Registrar has not disclosed any underlying or beneficial registrant of the disputed domain name and “Domain Sales - (Expired domain caught by auction winner) c/o Dynadot” therefore remains the Respondent in the proceeding. In the view of the Panel, this approach on the part of the Registrar would fall (similarly) under the scenario of not disclosing an underlying registrant behind a privacy or proxy service. If so, such conduct has potential consequences, particularly in circumstances where, as further discussed below, adverse findings have previously been made against the Respondent and other privacy or proxy services apparently operated by the Registrar. However, the Panel cannot dismiss the possibility of the actual registrant providing the name “Domain Sales - (Expired domain caught by auction winner) c/o Dynadot” at the time of the registration of the disputed domain name.

5. Factual Background

The Complainant is a simplified joint stock company registered in France. It is a provider of railway traction solutions and manages a fleet of locomotives and other railway stock in Europe.

The Complainant is the owner of:

- European Union Trade Mark registration number 7262454 for the word mark AKIEM, registered on July 21, 2009 in numerous International Classes.
- France trademark registration number 4889564 for the word mark FULL SERVICE BY AKIEM filed and registered in numerous International Classes with effect from August 4, 2022; and
- European Union Trade Mark registration number 018742537 for the word mark FULL SERVICE BY AKIEM, registered on January 14, 2023 in numerous International Classes. The Complainant’s application for this trademark was filed on August 5, 2022.

The disputed domain name was registered on August 5, 2022.

The Complainant provides evidence that the disputed domain name has resolved to a website named “dan.com (A GoDaddy Brand)” offering the disputed domain name for sale for USD 4,995.

6. Parties' Contentions

A. Complainant

The Complainant states that it is widely known in the railway industry as managing a fleet of over 600 locomotives and working with a network of over 1,000 manufactures, maintenance specialists and other partners in Europe and worldwide. It states that it has operated an official website at "www.akiem.com" since March 3, 2007 and also maintains the domain names <akiem.fr> and <akiem.net> which resolve to that website.

The Complainant provides details of a service offered on its website under the heading "Full Service". In particular, the Complainant offers a "one shop solution" for the provision and maintenance of locomotives. The relevant website text is accompanied by a logo comprising a design and the words "Full service by Akiem". The Complainant does not state on what date this content first appeared.

The Complainant submits that the disputed domain name is identical to its trademark FULL SERVICE BY AKIEM and confusingly similar to its trademark AKIEM.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It states that it has never authorized the Respondent to use its trademarks AKIEM or FULL SERVICE BY AKIEM, that the Respondent has not commonly been known by the disputed domain name and that the Respondent's offer to sell the disputed domain name for USD 4,995 cannot constitute legitimate use of it. The Complainant submits that the Respondent cannot demonstrate any of the circumstances under paragraph 4(c) of the Policy that may indicate rights or legitimate interests in respect of the disputed domain name.

The Complainant submits that the disputed domain name has been registered and is being used in bad faith. The Complainant states that its trademark AKIEM is well known and that the Respondent must have been aware of it when registering the disputed domain name. The Complainant further submits that the Respondent's knowledge of the Complainant's trademark FULL SERVICE BY AKIEM is obvious from the Respondent having registered the disputed domain name the day following the Complainant's French trademark filing for that mark.

The Complainant provides evidence from a website named "Domain Price Check" that the estimated value of the disputed domain name is in the region of USD 100. It submits that the Respondent is clearly seeking to take unfair advantage of the Complainant's trademark rights by offering the disputed domain name for a price significantly in excess of market price.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

7. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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 established that it has registered trademark rights in the marks FULL SERVICE BY AKIEM and AKIEM. The Panel finds the disputed domain name is identical to the first of those trademarks and confusingly similar to the second, which is clearly recognizable within the disputed domain name. The Panel therefore finds that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

In the view of the Panel, the Complainant's submissions set out above give rise to a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. However, the Respondent has failed to file a Response in this proceeding and has not submitted any explanation for its registration and use of the disputed domain name, or evidence of rights or legitimate interests on its part in the disputed domain name, whether in the circumstances contemplated by paragraph 4(c) of the Policy or otherwise.

As further discussed below, the Panel finds that the Respondent's offer of the disputed domain name for sale represents a targeting of the Complainant's trademarks, which cannot in the circumstances give rise to rights or legitimate interests on the part of the Respondent.

The Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

The Panel finds that the disputed domain name precisely replicates the Complainant's highly distinctive trademark FULL SERVICE BY AKIEM and was registered one day following the Complainant's filing for that trademark in France, and on the same date of the filing for that trademark in the European Union. There can be no reasonable doubt in the circumstances that the Respondent registered the disputed domain name in the knowledge of the Complainant's trademark and with the intention of taking unfair advantage of the Complainant's rights.

Further, as observed above, the Registrar has not disclosed any underlying or beneficial registrant of the disputed domain name. While the Panel takes note of the Respondent's "name" provided by the Registrar, there is no indication that the disputed domain name was in fact acquired in an auction. On the contrary, and especially noting the registration timing which corresponds exactly to the publication of the Complainant's trademark application by the EUIPO which is also the "creation" date in the public Whols, it seems that the registrant name merely happens to (arguably disingenuously) use such "expired/auction" nomenclature.

The Panel finds further that the Respondent has offered the disputed domain name for sale for USD 4,995, being a sum which plainly exceeds its out-of-pocket costs conceivably incurred in connection with the disputed domain name. In the circumstances, including the highly distinctive nature of the Complainant's trademark FULL SERVICE BY AKIEM, the Panel infers that the Respondent registered the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant for valuable consideration in excess of its out-of-pocket costs directly related to the domain name (paragraph 4(b)(i) of the Policy).

Based on its review of prior decisions under the UDRP, the Panel notes that the Respondent has been the subject of at least three prior adverse findings under the UDRP since December 2022 and that other privacy or proxy services apparently operated by the Registrar (where no underlying or beneficial registrant has been disclosed) have been the subject of a very significant number of prior adverse findings.

In one of those recent proceedings involving the Respondent itself, namely *Definity Insurance Company v. Domain Sales - (Expired domain caught by auction winner) c/o Dynadot*, WIPO Case No. [D2022-4763](#), the panel found, based on evidence of the Respondent's prior activities, that "... this establishes a pattern of conduct on its part for the purpose of a finding of bad faith registration and use under paragraph 4(b)(ii) of the Policy, namely that the Respondent has registered the disputed domain names in order to prevent the Complainant from reflecting its... marks in corresponding domain names and has previously engaged in a pattern of such conduct".

The Panel finds similarly in this case that 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 and has engaged in a pattern of such conduct (paragraph 4(b)(ii) of the Policy).

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

8. 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, <fullservicebyakiem.com>, be transferred to the Complainant.

/Steven A. Maier/

Steven A. Maier

Sole Panelist

Date: March 6, 2023