

ADMINISTRATIVE PANEL DECISION

Accenture Global Services Limited v. otto dave
Case No. D2022-4254

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 otto dave, United States.

2. The Domain Name and Registrar

The disputed domain name <accenture-trade.ltd> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 8, 2022. On November 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 9, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on November 11, 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 amended Complaint on November 17, 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 the Respondent of the Complaint, and the proceedings commenced on December 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 23, 2022.

The Center appointed Andrea Jaeger-Lenz as the sole panelist in this matter on January 3, 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. Factual Background

The Complainant is engaged in providing various services including management consulting, business process, technology and outsourcing services and has offices and operations in more than 200 cities in 50 countries. Since 2001, the Complainant has been using the mark ACCENTURE in connection with these services.

The Complainant owns more than 1,000 registrations comprising of or containing the ACCENTURE mark in over 140 countries worldwide for a variety of goods and services including, but not limited to, management consulting, technology and outsourcing services (Annexes D and E of the Complaint). To name only a few, the Complainant owns the following trademarks:

- United States trademark registration no. 3,091,811 ACCENTURE (word) for goods and services in Classes 9, 16, 35, 36, 37, 41 and 42, registered on May 16, 2006
- United States trademark registration no. 3,340,780 ACCENTURE (word) for goods in Classes 6, 8, 9, 14, 16, 18, 20, 21, 24 and 28, registered on November 20, 2007
- United States trademark registration no. 2,884,125 ACCENTURE (word) for goods in Classes 18, 25 and 28, registered on September 14, 2004
- United States trademark registration no. 3,862,419 ACCENTURE (& Design) for services in Classes 35 and 36, registered on October 19, 2010.

The Complainant registered its official domain name <accenture.com> as early as August 30, 2000, and has been using it ever since to promote its services and to disseminate information.

The disputed domain name was registered on August 27, 2022. The Respondent has so far not put the disputed domain name to any use but limited itself to holding it inactively.

5. Parties' Contentions

A. Complainant

The Complainant claims that it enjoys strong worldwide rights in, and recognition of, its ACCENTURE marks by virtue of intensive use of and advertisement for its goods and services under the ACCENTURE marks. It has relied on the Internet, including the Complainant's website under the domain name <accenture.com>, as a forum for its various offerings with detailed information about its global offices.

The Complainant argues that the goodwill developed in its ACCENTURE mark is the result of substantive advertising expenditures over the last decades, ranging from USD 77 million in 2009 to USD 90 million in 2022. As a result, reputed brand consulting companies in the industry have recognized ACCENTURE as a leading global brand, including Interbrand's Best Global Brands Report, where it was ranked 53rd in 2002 and 32nd in 2021, of Kantar Milward Brown' annual BrandZ – Top 100 Brand Rankings, where it was ranked 58th in 2006 and 27th in 2021. For the past 21 years, the Complainant was listed in the Fortune Global 500 ranking of the world's largest companies. It has achieved numerous awards for social initiatives and is sponsor to sports teams and cultural initiatives around the world. Consequently, the ACCENTURE mark has become globally famous long before the disputed domain name was registered.

The Complainant contends that the disputed domain name is nearly identical to the Complainant's famous mark, the only difference being a hyphen and the descriptive word "trade" following the ACCENTURE mark. ACCENTURE is a coined term and therefore distinctive per se, its distinctiveness immensely increased as a result of the Complainant's advertisement expenditures and other achievements, thus enjoying a broad scope of protection. Thus, ACCENTURE is the most distinctive element within the disputed domain name,

the addition “trade” merely suggesting a resource for trade matters in relation to the Complainant.

Consequently, the disputed domain name is confusingly similar to a trademark, in which the Complainant owns right.

Further, the Complainant argues that the Respondent has no legitimate interests in respect of the disputed domain name. First, the Complainant’s ACCENTURE mark is not a generic or descriptive term in which the Respondent could have an interest. Second, the Respondent is neither affiliated with the Complainant nor has been licensed or otherwise permitted to use the Complainant’s ACCENTURE mark. Third, the Respondent neither is nor was commonly known by the disputed domain name prior to the date on which the Respondent registered the disputed domain name.

The Respondent, according to the Complainant, is not making a legitimate noncommercial use of the disputed domain name either. Rather, it merely resolves to a message stating “Account suspended. This Account has been suspended. Please contact your hosting provider for more information”. The Complainant stresses that prior panels have held that the inactive holding of a domain name is neither a *bona fide* offering nor a legitimate noncommercial or fair use.

The Complainant concludes that the Respondent has chosen and registered the disputed domain name to trade off the reputation and goodwill associated with the Complainant’s ACCENTURE mark, to cause confusion among Internet users, benefit from misdirected Internet traffic and to prevent the Complainant from owning the disputed domain name, all of this not being a legitimate, noncommercial use.

On the last element, the Complainant contends that the Respondent has registered and been using the disputed domain name in bad faith.

As to registration in bad faith, the Complainant claims that the Respondent had constructive notice that ACCENTURE was a registered trademark in the United States and other countries in the world. Given the worldwide reputation and ubiquitous presence of the Complainant’s ACCENTURE mark, the Respondent was or should have been aware of the Complainant’s rights.

As to use in bad faith, the Complainant comes back to its argument that the Respondent is not using the disputed domain name for any legitimate noncommercial purpose. Where a domain name incorporates a registered trademark, without a legitimate purpose, even its passive or inactive holding may indicate that the respective domain name is held in bad faith. In this regard, the Complainant points to earlier UDRP decisions on this issue as well as the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) at section 3.3 describing the circumstances under which the passive holding of a domain name will be considered bad faith. Applied to the present case, the Complainant states that the degree of distinctiveness and reputation of the Complainant’s trademark, the failure of the Respondent to submit a response and evidence of good faith use, the Respondent’s concealing of its identity, and the implausibility of any good faith use to be made by the Respondent of the disputed domain name of necessity lead to the disputed domain name having been used in bad faith.

B. Respondent

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

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove that each of the following three elements is present:

- (i) the disputed domain name is identical or confusingly similar to the Complainant’s trademarks; 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.

In the following, the Panel will discuss in consecutive order whether each of these requirements are met.

A. Identical or Confusingly Similar

On the first element, the test for identity or confusing similarity under paragraph 4(a)(i) of the Policy is limited in scope to a direct comparison between the Complainant's marks and the textual string which comprises the disputed domain name.

The Complainant has demonstrated registered trademark rights in the term ACCENTURE. The disputed domain name consists of the word ACCENTURE, a hyphen, the term "trade" and the Top Level Domain ("TLD") ".ltd".

Thus, the disputed domain name contains the ACCENTURE trademark of the Complainant in its entirety, only adding a hyphen and the term "trade", which does not prevent the trademark from being recognizable within the disputed domain name. Therefore, the additional hyphen and the term "trade" do not prevent a finding of confusing similarity ([WIPO Overview 3.0](#), section 1.8). The applicable TLD in a domain name (in this case, ".ltd") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test ([WIPO Overview 3.0](#), section 1.11).

In view of the above, the Panel finds that the disputed domain name is confusingly similar to the ACCENTURE trademark, in which the Complainant has rights. The requirements of paragraph 4(a)(i) of the Policy are, therefore, satisfied.

B. Rights or Legitimate Interests

On the second element, under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the panel, shall demonstrate that the respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

- (i) before any notice to respondent 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 has been commonly known by the disputed domain name, even if the respondent has acquired no 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.

It is a consensus view under the UDRP that it is sufficient for the complainant to make a *prima facie* showing that the respondent has no rights or legitimate interests in the disputed domain name in order to place the burden of production on the respondent ([WIPO Overview 3.0](#), section 2.1). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

In the present case, the Complainant has not licensed or otherwise consented to the Respondent's use of the ACCENTURE trademark in connection with the disputed domain name.

Indeed, the Complainant has provided evidence that it is the legitimate holder of the ACCENTURE trademark rights and has used those trademarks in commerce long before the registration of the disputed domain name. Conversely, there is no evidence in the case file that the Respondent holds any unregistered

rights in a mark corresponding to the disputed domain name. There is also no evidence that the Respondent is commonly known by the disputed domain name. Therefore, paragraph 4(c)(ii) of the Policy does not apply.

Furthermore, the Complainant has stated, without having been contested by the Respondent, that there is no website to which the disputed domain name resolves, *i.e.* that the Respondent merely holds the disputed domain name in a passive way.

The Panel does not consider such passive holding of the disputed domain name as covered by legitimate interests because the Respondent's mere choice and registration of the disputed domain name effectively suggests a non-existing affiliation with the Complainant. This neither constitutes a use in connection with a *bona fide* offering of goods or services under paragraph 4(c)(i) of the Policy, nor a fair or legitimate noncommercial use without intent for commercial gain to misleadingly divert customers under paragraph 4(c)(iii) of the Policy.

Rather, the Panel holds that the Respondent's use was designed to take unfair advantage of the reputation of the Complainant's by profiting from misdirected Internet traffic intended to reach the Complainant.

Considering the above, the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks any rights or legitimate interests in the disputed domain name. Although given the opportunity, the Respondent has not replied to the Complainant's contentions and therefore failed to invoke any circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy or otherwise, any rights or legitimate interests in respect of the disputed domain name.

Thus, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(a)(iii) of the Policy, the Complainant has to establish that the Respondent registered and is using the disputed domain name in bad faith. 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.

As regards to registration, the disputed domain name was registered on August 27, 2022, about 20 years after the Complainant started use of and obtained its first trademark registration for the ACCENTURE trademark. Furthermore, the Panel accepts the Complainant's contention that, offering and advertising its services intensively on a worldwide basis offline and over the Internet, it has grown into a well-known and reputable service provider operating under the reputed ACCENTURE trademark in the area of management consulting, technology and outsourcing services with customers all around the world long before the disputed domain name was registered.

According to [WIPO Overview 3.0](#), section 3.1.4, the registration of a domain name that is identical or confusingly similar to a widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Given the reputation of the Complainant's ACCENTURE trademark, the timing of the registration of the disputed domain name, and the close connection of the disputed domain name and the trademark, reinforcing the association between the disputed domain name and the website, into which it resolved, with the services, for which the trademark of the Complainant is used, by the descriptive term "trade" in its textual string, the Panel concludes that the disputed domain name has not been chosen coincidentally but consciously in order to take advantage of the Complainant's trademark (see also *Canva Pty Ltd v. Varinder Rajoria, KnotSync Ltd*, WIPO Case No. [D2021-2577](#)).

This point is further confirmed by the Respondent's use in bad faith. As discussed above, the Panel takes – in line with the consensus view of WIPO Panelists after *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and as laid down in [WIPO Overview 3.0](#) at section 3.3 – the

view that also the inactive holding of a domain name may amount to use in bad faith. The circumstances leading to this conclusion are met in the present case, given the distinctiveness and worldwide repute of the Complainant's ACCENTURE mark, the lack of rights or legitimate interests on the Respondent's side, and that it is inconceivable that the Respondent had not known about the Complainant's rights in ACCENTURE and that the Respondent could put the inherently misleading disputed domain name to any legitimate noncommercial use.

In conclusion, the Panel determines that, for all of the above reasons, the disputed domain name has been registered and is being used in bad faith and, accordingly, that the Complainant has satisfied the requirement of paragraph 4(a)(iii) 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, <accenture-trade.ltd> be transferred to the Complainant.

/Andrea Jaeger-Lenz/

Andrea Jaeger-Lenz

Sole Panelist

Date: January 17, 2023