

ADMINISTRATIVE PANEL DECISION

Eight Advisory v. Casey Wong, eight advisory group
Case No. D2024-3454

1. The Parties

The Complainant is Eight Advisory, France, represented by Gevers & Ores, France.

The Respondent is Casey Wong, eight advisory group, Australia.

2. The Domain Name and Registrar

The disputed domain name <eightadvisorygroup.com> is registered with Squarespace Domains II LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 23, 2024. On August 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 26, 2024, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 27, 2024, 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 August 28, 2024.

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”).

The Respondent sent email communications to the Complainant on August 28, 2024, and August 29, 2024. The Complainant responded to the Respondent on September 10, 2024. On August 28, 2024, the Center sent an email to the Parties regarding a possible settlement, followed by a reminder on September 11, 2024. Although the Complainant sent an email communication to the Respondent on September 10, 2024, the Complainant did not request suspension.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 6, 2024. The Respondent sent email communications to the Center on September 16, 23 and 24, 2024 and October 7, 2024. On October 7, 2024, the Center informed the Parties that it would proceed with Panel Appointment.

The Center appointed Willem J. H. Leppink as the sole panelist in this matter on October 9, 2024. 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 following facts are undisputed.

The Complainant is a strategic and financial consulting firm, founded in 2009. The Complainant provides services in handling transactions, restructurings, and business transformations, and offers services ranging from financial due diligence to digital transformation. The Complainant has offices around Europe and has a global network of partner firms.

The Complainant owns several registrations in relation to the trademark EIGHT ADVISORY, including the International trademark EIGHT ADVISORY (word mark) with registration number 1025536, registered on September 25, 2009, for goods and services in classes 35 and 36, designating inter alia Australia.

The Complainant also registered the domain names <8advisory.com> in 2009 and <eightadvisoryavocats.com> in 2019. The domain names have been subject to uninterrupted use by the Complainant.

The trademark of the Complainant was registered before the disputed domain name, which was registered on April 16, 2024.

The disputed domain name resolves to an inactive page with the announcement that the website is under construction.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends the following.

The disputed domain name is confusingly similar to the trademark of the Complainant. The full incorporation of a trademark within the disputed domain name is sufficient to establish identity or confusing similarity. Also, the addition of a term is insufficient to avoid the risk of confusion.

The Respondent must be deemed to have no rights or legitimate interests in the disputed domain name. The Complainant asserts that it has no relationship with, nor has it granted any authorization or license to the Respondent. Also, the Respondent is not commonly known through the disputed domain name and the Respondent intends to derive advantage from the confusion of Internet users. The fact that the disputed domain name resolves to an inactive page, asserts that the Respondent has no legitimate interests arising from a bona fide offering of goods and services or a legitimate non-commercial or good faith use of the

disputed domain name. Furthermore, the Complainant sent a cease-and-desist letter to the Registrar of the disputed domain name, but did not receive a reply from the Respondent. Concluding, the Complainant submits that the Respondent registered the disputed domain name solely for the purpose of creating confusion among Internet users by impersonation of the Complainant.

The Complainant asserts that the existence of the disputed domain name undermines its efforts and constitutes an obstacle to its development, while the Respondent could not have been unaware of the trademark of Complainant. Passive use can, in certain circumstances, also constitute abusive use. Also, the Respondent remained silent after the cease-and-desist letter sent to the Registrar, which would prove abusive intent. Therefore, the disputed domain name can be used to harm Internet users and the Respondent registered and planned to use the disputed domain name with the intention to create confusion. This constitutes bad faith.

B. Respondent

The Respondent did not substantively reply to the Complainant's contentions. The Respondent communicated informally with the Center and the Complainant. In its communication, the Respondent agreed that the disputed domain name was quite similar to the name of the Complainant. Therefore, the Respondent notified the Center and the Complainant that it will alter its registered name and domain name. According to the Respondent, it has cancelled all names and accounts associated with the disputed domain name.

The Respondent contends that it tried to cancel the disputed domain name, but that it no longer had visibility or ownership of the disputed domain name. Furthermore, the Respondent requested the Complainant to provide an address for the transfer of the disputed domain name and mentioned that once it gains control of the disputed domain name it will pursue with the cancellation or transfer of the disputed domain name.

The Respondent contends that it kept trying to transfer or cancel the disputed domain name, but was not successful in this pursuit.

Finally, the Respondent contends that it had no malice and that it tried ceasing the disputed domain name.

The Respondent contends that it is a newly founded company based in Australia. The Respondent started under the name "eight advisory group".

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here the word "group", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which a respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, 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 domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not substantively rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise. It has e.g. not provided any evidence of its activities under the name “eight advisory group”.

Certainly, in the light of the facts concerning the wish of the Respondent to cancel or transfer the disputed domain name and the fact that Respondent did not provide any substantive evidence, the Panel finds that there is no (i) use of the disputed domain name (or demonstrable plans for such use) with a bona fide offering; (ii) the Respondent is not commonly known by the disputed domain name; and there is (iii) no legitimate noncommercial or fair use of the disputed domain name.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel refers to its considerations under section 6.B above.

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel finds that the Complainant has made out a prima facie case that notes that the Respondent was in bad faith. The Panel finds that the Respondent has not sufficiently rebutted such allegations and takes into account that the Respondent has consented to the cancellation and/or transfer of the disputed domain name.

In the event that parties to a UDRP proceeding have not been able to settle their dispute prior to the issuance of a panel decision using the “standard settlement process”, but where a respondent has nevertheless given its consent on the record to the transfer (or cancellation) remedy sought by the complainant, panels can order the requested remedy solely on the basis of such consent.

In some cases, despite such respondent consent, a panel may in its discretion still find it appropriate to proceed to a substantive decision on the merits. In this case the Panel noted that the Respondent, while consenting to the requested remedy, has denied any bad faith. However, in light of what the Panel considered above, the Respondent did not substantiate sufficiently that it was not in bad faith and contended

that it wanted to cancel the disputed domain name. Therefore, the Respondent has the willingness to transfer the disputed domain name, [WIPO Overview 3.0](#), section 4.10.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have found that the non-use of a domain name, including a "coming soon" page, would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds that the Complainant has established the third element 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 <eightadvisorygroup.com> be transferred to the Complainant.

/Willem J. H. Leppink/

Willem J. H. Leppink

Sole Panelist

Date: October 18, 2024