

ADMINISTRATIVE PANEL DECISION

Accenture Global Services Limited v. Carl Mazzanti, eMazzanti Technologies
Case No. DCO2017-0013

1. The Parties

The Complainant is Accenture Global Services Limited of Chicago, Illinois, United States of America (“United States”) represented by DLA Piper US LLP, United States.

The Respondent is Carl Mazzanti, eMazzanti Technologies of Hoboken, New Jersey, United States.

2. The Domain Name and Registrar

The disputed domain name <accenturedigital.co> is registered with Wild West Domains, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 10, 2017. On May 12, 2017, the Center transmitted to the Registrar, by email, a request for registrar verification in connection with the disputed domain name. On the same day, the Registrar transmitted to the Center, by email, 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”), 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 that the proceedings commenced on May 16, 2017. In accordance with the Rules, paragraph 5, the due date for Response was June 5, 2017. The Respondent did not submit any response. Accordingly, on June 6, 2017 the Center notified the parties of the Respondent’s default.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on June 12, 2017. 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. Due to exceptional circumstances, the due date for the Panel’s decision to be submitted

to the Center was extended from June 26, 2017 to July 10, 2017.

4. Factual Background

As reflected in the registration record for the disputed domain name in the public Whois database, the disputed domain name was registered on February 12, 2017 and will expire on February 11, 2022. The disputed domain name resolved to a website displaying pay-per-click links. At the time of this Decision, it currently resolves to "www.sedo.com" where the disputed domain name is offered for sale.

A. The Complainant's ACCENTURE marks (the "ACCENTURE Marks")

1. As indicated in the Complaint, the Complainant owns numerous United States and counterpart foreign trademark registrations, collectively spanning 144 countries, for the word "accenture" in the following forms: block letters, stylized and stylized with a design element. The Complainant has provided a copy of its registration certificates for some of its United States marks, the pertinent details of which are:

a. ACCENTURE (stylized with design elements)

United States Registration No. 2,665,373

Registered: December 24, 2002; Renewed: December 21, 2012; Filed: November 17, 2000

This mark is registered for use in connection with: "Computer software for use in designing, installing and executing mainframe and server application programs, for integrating the financial, manufacturing and sales functions of a business, and for managing customer service and support functions of a business" in international class 9; "Pamphlets, books, newsletters, brochures, magazines, reports, journals, manuals and printed guides, all in the fields of business management, information technology, and computerized information processing" in international class 16; "Business management consulting; business consulting; business process management and consulting; business marketing consulting services; procurement services, namely, purchasing computer hardware and software for others; providing information in the fields of business management, business marketing, business acquisitions and mergers consulting; business consulting, and finance; project management in the fields of information systems design, specification, procurement of computer hardware and software for others; business acquisitions consulting; analysis services, namely, market analysis and financial analysis; business appraisals; conducting business and market research surveys; business information services in the field of business change management, business process management, business strategic management and planning services, and business technology; business management planning; business merger consultation; business networking; conducting business research and surveys; business supervision; commercial and industrial management assistance; economic forecasting and analysis; personnel management consultation; preparing business reports; arranging and conducting trade shows and conferences in the field of business and business management providing information in the field of business consulting" in international class 35; "Providing financial information; monetary exchange; venture capital financing, financial analysis and consultation" in international class 36; "Computer installation, repair, and maintenance with respect to computer hardware namely, computer systems and computer networks" in international class 37; "Educational services, namely, conducting courses, seminars, workshops, and classes in the fields of computer software development and implementation, computer software usage, business, and business operations and distributing course materials in connection therewith; developing educational materials for others in the fields of computer software development and implementation, computer software usage, business, and business operations" in international class 41; and "Mediation services; providing information in the fields of information technology, computers, and computer systems; consulting in the areas of computers, computer systems and computer systems design; computer services, namely, design of computers systems for others; computers services, namely, providing databases in the fields of business consulting, information technology, computers and computer systems; information technology consulting services; computer software design for others; computer site design; installation, implementation, maintenance, and repair services with respect to computer software" in international class 42.

b. ACCENTURE (block letters)

United States Registration No. 3,091,811

Registered: May 16, 2006; Renewed: December 21, 2016; Filed: October 26, 2000

This mark is registered for use in connection with: "Computer software for use in designing, installing and executing mainframe and client/server application programs, for integrating the financial, manufacturing and sales functions of a business, and for managing customer service and support functions of a business" in international class 9; "Pamphlets, books, newsletters, brochures, magazines, reports, journals, manuals and printed guides, all in the fields of business management, information technology, and computerized information processing" in international class 16; "Business management consulting; business consulting and project management; business process re-engineering; business marketing consulting; procurement services, namely, purchasing computer hardware and software for others; providing information in the fields of business management consulting, business consulting; business acquisition and merger consultation; market analysis; business appraisals; conducting business and market research surveys; business information services in the field of business change management, business process management, business strategic management and planning, and business technology; business management planning; business merger consultation; business networking; conducting business research and surveys; business supervision; commercial and industrial management assistance; economic forecasting and analysis; personnel management consultation; preparing business reports; arranging and conducting trade shows and conferences in the field of business and business management; providing information in the field of business management, business marketing, business acquisitions and mergers consulting" in international class 35; "Providing financial information; monetary exchange; venture capital financing, financial analysis and consultation" in international class 36; "Computer installation, repair, and maintenance with respect to computer hardware namely, computer systems and computer networks" in international class 37; "Educational services, namely, conducting courses, seminars, workshops, and classes in the fields of computer software development and implementation, computer software usage, business, and business operations and distributing course materials in connection therewith; developing educational materials for others in the fields of computer software development and implementation, computer software usage, business, and business operations" in international class 41; and "Mediation; computer consulting services namely, design of computer systems of others; computer software design for others; computer web site design for others; installation, implementation, maintenance and repair services with respect to computers software; providing technical consultation in the field of computer information systems" in international class 42.

2. The Complainant also has a United States trademark registration for ACCENTURE DIGITAL in block letters, the salient details of this registration are as follows:

United States Registration No. 4,976,407

Registered: June 14, 2016; Filed: May 18, 2015

This mark is registered for use in connection with: "Computer software, namely, software for business analytics and database management in the fields of social media, marketing, merchandising, customer service, website performance, search engine optimization, financial services, communication, mobile technology, consumer goods, retail, loyalty programs, manufacturing and insurance" in international class 9; "Business consulting services; business marketing consulting services; project management services in connection with business management; conducting business research and surveys; business consulting services in the fields of customer service, marketing, content management, e-commerce, social media, brand management, distribution, loyalty programs, retail, fashion, media, entertainment, non-profit, banking, finance, healthcare, merchandising and distribution; business management consulting and business outsourcing services for customers operating in the fields of automotive, industrial, infrastructure, travel, banking, capital markets, chemicals, communications, consumer goods, electronics, technology, energy, financial services, health, insurance, life sciences, media and entertainment, resources, mining, public services and government operations, and utilities" in international class 35; "Installation, implementation, maintenance and repair services in the field of computer hardware systems, computer hardware networks

and computer hardware” in international class 37; “Providing training, including, holding courses, seminars, workshops and lessons in the fields of computer software development and use, business and business activities, and for the distribution of related teaching materials” in international class 41; and “Information technology consulting, research and information services in the fields of IT services, analytics, website development, mobile application development, software development, data management, and search engine optimization; design and development of non-downloadable software for social media, marketing, merchandising, customer services, website performance, search engine optimization, financial services, communication, mobile technology, consumer goods, retail, loyalty programs, manufacturing and insurance; technical support services in the nature of troubleshooting in the nature of diagnosing computer hardware and software problems, including, support services for operation and maintenance of computer software and computer systems; platform as a service (PaaS) featuring computer software platforms for business analytics and database management in the fields of ecommerce and digital media delivery; providing cloud-based, non-downloadable software for use in business analytics and database management in the fields of social media, marketing, merchandising, customer service, website performance, search engine optimization, financial services, communication, mobile technology, consumer goods, retail, loyalty programs, manufacturing and insurance” in international class 42.

B. The Parties

The Complainant is an international business that provides management consulting, technology services and outsourcing services, and has its principal place of business in Dublin, Ireland.

Since January 2001, the Complainant has extensively used and continues to use its mark ACCENTURE in connection with the services it provides. In each of its fiscal years 2009, 2010, 2011, 2012, 2013 and 2014, the Complainant expended in excess of USD 65-70 million globally and of that amount between USD 32-41 million in the United States alone for advertising, including newspaper advertisements, magazine advertisements, sponsorships, billboards, online advertisements and television advertisements. Over the years, the Complainant has also received considerable coverage in the media. A representative sample of the Complainant’s global advertisements and press clippings, which include its mark ACCENTURE, appears in an annex to the Complaint. The Complainant has also received numerous awards for its business, products and services provided under its mark ACCENTURE. A list of some of those awards appears in the Complaint.

Interbrand, a globally recognized brand consulting company, has ranked the ACCENTURE brand in terms of its global brand value. In its “Best Global Brands Report for 2002”, the brand is ranked as 53rd out of the top 100 global brands and, in the same report for 2015, the brand is ranked at 42nd out of 100. A copy of the 2015 *Global Brands Report* appears in an annex to the Complaint. The ACCENTURE brand also has been recognized by Millward Brown Optimor, a market research and brand valuation company, in its annual “BrandZ – Top 100 Brand Ranking”. Optimor ranked the brand 58th in 2006 and 38th in 2016. A copy of the 2016 *Brand Z* report appears in an annex to the Complaint.

In addition, the Complainant uses the Internet as a vehicle to promote and disseminate detailed information regarding service offerings it provides under its mark ACCENTURE. In that regard, the Complainant owns and operates its website at “www.accenture.com”.

The Respondent previously used the disputed domain name to resolve to its website which provided a web page containing list of click-through links (the label of some of which incorporate the mark ACCENTURE) to third-party websites. A copy of that webpage appears in an annex to the Complaint. Currently, the disputed domain name resolves to a third-party website, specifically “www.sedo.com”, through which the disputed domain name is offered for public sale at a minimum price of Euro 5,000. A copy of the relevant page of the “www.sedo.com” website appears in an annex to the Complainant.

During March / April 2017, the Complainant sent several email messages to the Respondent regarding the disputed domain name but never received a response. A copy of this correspondence appears in an annex to the Complaint.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to its mark ACCENTURE and identical to its mark ACCENTURE DIGITAL.

With respect to confusing similarity, the disputed domain name contains the mark ACCENTURE to which the word "digital" has been appended, with that word being incapable of adding sufficient distinctiveness whatsoever to the name to mitigate any resulting user confusion between the disputed domain name and the Complainant's mark. Furthermore, the Complainant provides various products and services in the "digital" field, thus heightening a potential for confusion to occur among Internet users between the mark and the name.

As to assessing identity, the disputed domain name is identical to the Complainant's mark ACCENTURE DIGITAL, as the country code Top-Level Domain ("ccTLD"), here ".co", is ignored in any such assessment.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that, for any of several reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraphs 4(a)(ii) and 4(c) of the Policy.

The Complainant did not authorize the Respondent to register the disputed domain name, nor does the Complainant maintain any licensing relationship with the Respondent which permits the latter to use any of the Complainant's ACCENTURE Marks.

Further, the Respondent is not known and has never been commonly known by any name or trade name that incorporates the term ACCENTURE.

Lastly, as the Respondent is currently just offering the disputed domain name for sale through a third-party website, the Respondent is not using the disputed domain name in connection with: (a) a *bona fide* offering of goods or services under paragraph 4(c)(i) of the Policy, or (b) a legitimate noncommercial or fair use, without intent for commercial gain, under paragraph 4(c)(iii) of the Policy.

(iii) Registered and Used in Bad Faith

The Complainant also contends that the Respondent has registered and is using the disputed domain name in bad faith in violation of paragraph 4(a)(iii) of the Policy.

Inasmuch as the mark ACCENTURE is a coined term invented by the Complainant, it is rather likely that the Respondent, having no connection whatsoever with the Complainant, intentionally registered the disputed domain name, which fully incorporates that mark, with full knowledge of and in spite of the Complainant's exclusive and substantial trademark rights in the United States in that mark — rights that predate by over 15 years the date on which the Respondent registered the disputed domain name.

The Respondent's apparent motive in doing so was to intentionally exploit the substantial reputation inherent in the Complainant's ACCENTURE Marks by using the disputed domain name to cause confusion with those marks and, by doing so, divert Internet users away from the Complainant's website to the Respondent's own website containing a list of click-through links to third-party sites, through which the Respondent would financially benefit in some fashion, whether through receiving click-through or other

compensation. The Respondent used the disputed domain name in this manner for a period of time before ceasing that activity in favor of just offering the disputed domain name for public sale for an amount (EUR 5,000) well in excess of its out-of-pocket costs of registration. Both this present and past usage are in bad faith.

B. Respondent

In view of the lack of any Response, this administrative proceeding continued by way of default. Hence, under paragraphs 5(f), 14(a) and 15(a) of the Rules, the Panel decided this proceeding on the basis of the Complainant's undisputed factual allegations which the Panel finds are not inherently implausible.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is identical to the Complainant's mark ACCENTURE DIGITAL and confusingly similar to its mark ACCENTURE.

From simply comparing the disputed domain name to the mark ACCENTURE DIGITAL, no doubt exists that the disputed domain name is identical to the mark. The only difference between the two is the addition of the ccTLD ".co" to the mark to form the disputed domain name, with that addition being generally irrelevant in assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy and thus ignored. A finding of identity is itself sufficient to meet the requirements of paragraph 4(a)(i) of the Policy.

Nevertheless, in light of the strong emphasis which the Complainant places in its argumentation in the Complaint on its mark ACCENTURE presumably because the ACCENTURE Marks are the Complainant's principal marks under which it developed industry and public recognition and goodwill far earlier in time and to a considerably greater extent than it has thus far accomplished in its ACCENTURE DIGITAL mark, the Panel will also assess the disputed domain name with respect to the mark ACCENTURE. In that context, by simply comparing the disputed domain name to the mark ACCENTURE, the Panel finds that the disputed domain name is confusingly similar to that mark. The disputed domain name <accenturedigital.co> consists of the mark ACCENTURE followed by the generic term "digital", with as noted the ccTLD being ignored for this assessment.

It has become very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation to a mark is usually insufficient in and of itself, when used in forming a domain name, particularly a Second-Level Domain ("SLD"), that results from modifying the mark, to confer requisite and sufficient distinctiveness to the resulting domain name to avoid a finding of confusing similarity. Here, the Respondent's incorporation of the common, well-known word "digital" to form the SLD clearly constitutes such a minor variation. See, e.g., *SAP SE v. Lakshmi Reddy Bhumireddy and P. Hareesh*, WIPO Case No. D2017-0396; *Compagnie Générale des Etablissements Michelin v. Cameron Jackson*, WIPO Case No. D2016-2392; *Kumfs Brand Limited v. George*, WIPO Case No. D2016-1272; *Dubizzle Limited BVI v. Rana Anabtawi*, WIPO Case No. D2016-0843; *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill*, WIPO Case No. D2015-1842; *Cummins Inc. v. Jamie Lent*, WIPO Case No. D2015-0188; *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, WIPO Case No. D2013-1687; *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; and *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711.

Therefore, the Panel finds that the disputed domain name is identical or respectively confusingly similar to at least one or more marks within the Complainant's ACCENTURE Marks. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent in the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize any of the Complainant's ACCENTURE Marks and does not have any relationship, affiliation or connection whatsoever with the Respondent.

Further, the Respondent does not currently use nor has it ever made or is not making any demonstrable preparations to use the disputed domain name to resolve to an operational website through which it presently does or will make a *bona fide* offering of any goods or services. Using a domain name, as the Respondent has done, which incorporates a mark of another, to intentionally divert Internet users away from a website of the trademark owner to a page maintained by a domain name registrant which provides links to third-party websites and, by doing so, confuses those users into believing that a relationship of some form exists between the trademark owner and the domain name registrant through which the owner endorses or otherwise authorizes the registrant's actions -- when, in fact, no such relationship exists, is not a *bona fide* offering of goods and services. Thus, the Respondent's prior conduct of having done so does not qualify as legitimate use under paragraph 4(c)(i) of the Policy. Further, offering a domain name that includes the Complainant's trademark for sale, as the Respondent currently does, is also not a *bona fide* offering of goods and services, thus also not a qualifying use.

Moreover, the evidence of record clearly reflects that the Respondent is not commonly known by either the disputed domain name or the Complainant's mark ACCENTURE. Given the Complainant's exclusive rights in its mark ACCENTURE which are substantial and significantly predate, by now at least some 16 years, the date, February 12, 2017, on which the Respondent registered the disputed domain name, the Respondent could not legitimately acquire such a public association or even an association with any mark similar to that of the Complainant — at least for the goods and services provided by the Complainant under its mark ACCENTURE — without interfering with the exclusive trademark rights of the Complainant. See, e.g., *Compagnie Générale des Etablissements Michelin, supra*; *Philip Morris USA Inc. v. Daniele Kanai, iKiss LLC*, WIPO Case No. D2015-1527; *Valero Energy Corporation and Valero Marketing and Supply Company v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID: 62520014085963*, WIPO Case No. D2015-0787; *Chicago Mercantile Exchange Inc., Cummins Inc., supra* and *Staatliche Porzellan-Manufaktur Meissen GmbH, supra*.

Consequently, the Respondent does not satisfy any of one of paragraphs 4(c)(i)-(iii) of the Policy and the Complainant has demonstrated that the Respondent has no rights or legitimate interests in the disputed domain name under paragraphs 4(a)(ii) and 4(c) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions constitute bad faith registration and use.

The mark ACCENTURE is a coined term specifically devised by the Complainant. Through the Complainant's extensive marketing and promotional efforts over the past 17 years, the Complainant indisputably developed substantial goodwill, industry and public recognition in its ACCENTURE Marks -- to the point where those marks have become well-known worldwide. Consequently, it defies all reason to conclude that the Respondent, having selected the disputed domain name which entirely incorporates the mark ACCENTURE, did so without any knowledge whatsoever of the Complainant's mark ACCENTURE and the substantial reputation which that mark enjoys. Any finding to the contrary is so improbable as to lack any reasonable credibility in the circumstances of this proceeding. Consequently and certainly supported by reasonable inferences drawn by the lack of any response, the Panel finds that the Respondent registered the disputed domain name for the express purpose of exploiting that goodwill and reputation for its own pecuniary benefit, which it furthered by having previously used the disputed domain name to resolve to its website containing a page of third-party links from which the Respondent likely derived financial

compensation of some form, whether click-through revenue or otherwise. This conduct constitutes bad faith registration and use under paragraphs 4(b) and 4(b)(iv) of the Policy.

The Respondent is also currently offering the disputed domain name for sale at a minimum price (EUR 5,000) that most likely well exceeds its costs of registration, thus potentially yielding a profit for the Respondent. Given the Complainant's extensive trademark rights, such use of the disputed domain name by anyone other than the Complainant or a party suitably authorized by the Complainant would very likely infringe those rights. Thus, the Panel concludes that, in offering the disputed domain name for sale, the Respondent is likely trying to solicit such an offer either from the Complainant itself or from an intervening third-party which, in turn, would ultimately offer to sell the disputed domain name to the Complainant for quite likely an even higher profit, all to the financial detriment of the Complainant. Consequently, the Respondent's current conduct also reflects bad faith use under general paragraph 4(b)(i) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient evidence of its allegations, with respect to the disputed domain name to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant.

The disputed domain name <accenturedigital.co> is to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: July 3, 2017