Decision for dispute CAC-UDRP-102261

Case number	CAC-UDRP-102261
Time of filing	2018-12-14 10:29:33
Domain names	essay-sharks.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	FrogProg Limited

Respondent

Name	Igor

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant is the owner of certain trademark registrations as follows:

- European Union Trademark Reg. No. 014969083 for ESSAYSHARK and Design filed on December 31, 2015 and registered since May 26, 2016;

- United States Trademark Reg. No. 5021885 for ESSAYSHARK filed on December 31, 2015 and registered on August 16, 2016; and

- United States Trademark Reg. No. 5021887 for ESSAYSHARK and Design filed on December 31, 2015 and registered on August 16, 2016.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is a worldwide distributor of writing services. The Complainant registered the domain name <essayshark.com> on November 13, 2009 and uses this for its own website. The first commercial use of the ESSAYSHARK trademarks was on January 4, 2011. The Complainant also owns certain trademark registrations in the United States and the European Union for ESSAYSHARK claiming “education; providing of training; entertainment; sporting and cultural activities. These applications were filed in 2015 and registered in 2016.

The disputed domain name was created on February 23, 2017, long after the Complainant developed rights in its ESSAYSHARK trademark, and resolves to a website that features the ESSAYSHARK trademark and offers writing services that are identical to those offered by the Complainant. The phrase “EssayShark” is unique and arbitrary such that it is unlikely

that the Respondent devised the phrase “essay-sharks” on its own and without reference to the Complainant’s trademark. Use of the ESSAYSHARK trademark by the Respondent is not authorized by the Complainant and is likely to cause confusion and mistake, and to deceive as to the affiliation, connection, or association of the Respondent with the Complainant. The Respondent is seeking to commercially profit from this confusion with the Complainant’s ESSAYSHARK trademark.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Identity or Confusing Similarity:

The Complainant has submitted sufficient evidence to prove that it is the owner of trademark rights in the trademark ESSAYSHARK. The existence of registration certificates from national trademark registration offices such as the United States Patent and Trademark Office or the European Intellectual Property Office have long been accepted by UDRP Panels as proof of trademark rights under Paragraph 4(a)(i) of the Policy.

Next, the disputed essay-sharks.com domain name differs from the ESSAYSHARK trademark only by the addition of a hyphen, the letter “s”, and the addition of the .com top-level domain. Such minor differences are insufficient to avoid confusing similarity between the two. See, e.g., VINCI S.A. v. Susan Patrick, CAC Case No. 102227 (December 28, 2018) (the domain name <vinci-faci1ities.com> is found confusingly similar to the Complainant’s VINCI FACILITIES trademark noting that “previous Panels have stated that a mere hyphen added between two words in a disputed domain name does nothing to distinguish the disputed domain name from a Complainant's previous trademark (see for instance WIPO Case No D2017-0504 Mr. Michel Teman vs. Domain Admin, Whois Privacy Corp. <MICHEL-TENAM.COM>).”).

In light of the above, the Panel finds that the essay-sharks.com domain name is confusingly similar to the ESSAYSHARKS trademark under Paragraph 4(a)(i) of the Policy.

Rights or Legitimate Interests:

Paragraph 4(a)(ii) of the Policy directs an examination of the facts to determine whether a Respondent lacks rights or legitimate interests in the disputed domain name. Although the Complainant bears the ultimate burden of establishing all three elements of Paragraph 4(a) of the Policy, panels have recognized that this could result in the often impossible task of proving a negative proposition, requiring information that is primarily if not exclusively within the knowledge of the Respondent. Thus, the consensus view is in that, once a Complainant has made a prima facie showing indicating the

absence of rights or legitimate interests in a disputed domain name, Paragraph 4(c) of the Policy shifts the burden to the Respondent to come forward with evidence that such rights or legitimate interests do, in fact, exist.

Paragraph 4(c) of the Policy lists a number of ways in which a Respondent may demonstrate that it does have such rights or interests. Under Paragraphs 4(c)(i) and 4(c)(iii) of the Policy the Panel considers whether the Respondent is using the disputed domain name to make a bona fide offering of goods or services or whether it is making a legitimate noncommercial or fair use of the disputed domain name. Offering the identical goods or services as those offered by a Complainant is, absent unusual circumstances, not considered a bona fide offering or a legitimate noncommercial or fair use under past UDRP decisions. See, General Motors LLC v. MIKE LEE, Claim No. FA 1659965 (FORUM, March 10, 2016) (finding that "use of a domain to sell products and/or services that compete directly with a complainant's business does not constitute a bona fide offering of goods or services pursuant to Policy ¶ 4(c)(i) or a legitimate noncommercial or fair use pursuant to Policy ¶ 4(c)(iii).")

Here, the Respondent's website prominently states that it is a "Reliable Writing Service Company" and states: "Our team will be glad to help you with any type of academic papers. Our professional writers can complete such assignments as dissertations, courseworks, theses, reviews, essays etc." This website also shows a link, at the top, whereby the user can select its country of origin as either the "USA" or the "UK". For purposes of comparison, the Complainant's <essayshark.com> website states: "GIVE YOUR GRADES A BOOST. Get your paper written by a professional essay writing service" and invites visitors to "Place an order, choose the most suitable essay writer and enjoy the process of your paper being written online. Pay only for approved parts of your paper." Considering this evidence, it is apparent that the Respondent is offering services under the disputed domain name that are substantially identical to those offered by the Complainant under its registered ESSAYSHARK trademark at its essayshark.com website. Thus, the Respondent is not using the disputed domain name for a bona fide offering of goods or services or in connection with a legitimate non-commercial or fair use.

Next, a Respondent may demonstrate rights or legitimate interest in a disputed domain name under Paragraph 4(c)(ii) of the Policy if it can show that it is commonly known by the domain name. Here, the Whois record identifies the Respondent as "Igor". Further, while operating a legitimate business under a disputed domain name may, in some circumstances, suffice under this paragraph, this is not the case where the business is improperly creating confusion with a registered trademark. It is also worth noting that the Complainant states that it has never authorized the Respondent to use its ESSAYSHARK trademark and the Respondent has not submitted any response in this case or otherwise claimed anything to the contrary. See, Navistar International Corporation v. N Rahmany, Claim No. FA 1620789 (FORUM, June 8, 2015) (finding that the Respondent was not commonly known by the disputed domain name where the Complainant had never authorized the Respondent to incorporate its NAVISTAR mark in any domain name registration).

For the reasons stated above, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name under Paragraph 4(a)(ii) of the Policy.

Bad Faith Registration and Use:

The Policy requires a Complainant to demonstrate that the disputed domain name was both registered and used in bad faith. An initial inquiry in this process is to determine whether the Respondent had knowledge of the Complainant's trademark at the time it created the disputed domain name.

Here, the disputed domain name was created in 2017 which is after the issuance of the Complainant's USA and EU trademark registrations and after the Complainant's first claimed commercial use of its ESSAYSHARK trademark in 2011. Although the Respondent has made no reply or other submission in this case, the Panel considers the fact that the Whois record lists the Respondent's address as being in Kiev, Ukraine, whereas the Complainant is located in Nicosia, Cyprus. This raises the question of whether the Respondent was actually aware of the Complainant and its trademark at the time it registered the disputed domain name. The answer to this question, however, is found in the fact that the websites of both parties target English language speaking markets. As such, the Respondent must have been aware of the Complainant as a company using a nearly identical name for identical services and targeting the identical customers. Further, it is worth noting

that, although the essay-sharks.com domain name contains a hyphen, the Respondent's website shows the words "Essay Sharks" without such hyphen thus strongly indicating that it chose the disputed domain name because it was unable to register another version of the name without the hyphen. Finally, the Complainant has owned the domain name essaysharks.com (with no hyphen) since 2011 and so this variation was also likely considered by the Respondent but determined to be unavailable.

Next, Paragraph 4(b)(iii) of the Policy states that disrupting the business of a competitor will suffice as evidence of bad faith registration and use under Paragraph 4(a)(iii) of the Policy. Furthermore, Paragraph 4(b)(iv) of the Policy states that bad faith may be found where a Respondent intentionally attempts to attract, for commercial gain, internet users to its website by creating a likelihood of confusion with a Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of its product or service. It has been held in many prior UDRP decisions that the operation of a competing business using a confusingly similar domain name is evidence of bad faith. See, Ripple Labs Inc. v. Jessie McKoy / Ripple Reserve Fund, Claim No. FA 1790949 (FORUM, July 9, 2018) (finding bad faith perParagraphs 4(b)(iii) and 4(b)(iv) of the Policy where the Respondent used the disputed domain name to resolve to a website upon which the Respondent passes itself off as the Complainant and offers online cryptocurrency services in direct competition with the Complainant's business).

Here, the Respondent provides the same services to the same market using the disputed domain name that is confusingly similar to the Complainant's ESSAYSHARK trademark. As such, the Panel finds that the disputed domain name falls within the descriptions of both Paragraphs 4(b)(iii) and 4(b)(iv) of the Policy and thus satisfies the requirements of Paragraph 4(a)(iii) of the Policy that the disputed domain name was registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **ESSAY-SHARKS.COM**: Transferred

PANELLISTS

Name	**Steven M. Levy, Esq.**

DATE OF PANEL DECISION 2019-01-02

Publish the Decision