Decision for dispute CAC-UDRP-103069

Case number	**CAC-UDRP-103069**
Time of filing	**2020-05-25 10:38:45**
Domain names	**tigeressay.com**

Case administrator

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

Complainant

Organization	**COREFORCE LTD**

Respondent

Name	**Uasya Utkin**

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

Complainant is COREFORCE LTD, a limited company that was incorporated in Cyprus on September 30, 2016 and is a worldwide distributor of writing services.

Complainant owned registered US trademark ESSAYTIGERS n° 6032409, dated of April 14, 2020.

Complainant also purchased the rights to the domain name <essaytigers.com> registered on October 4, 2012 pursuant to the Website Purchase Agreement with the Complainant's predecessor dated September 30, 2016.

Complainant also owns the domain name <essaytigers.com> registered on October 4, 2012. It also registered social networks accounts, namely a Facebook and a Twitter one, in 2013.

Respondent is Uasya Utkin, located in London.

Respondent did not respond to Complainant's contentions.

The disputed domain name is <tigeressay.com> which was registered on August 10, 2018.

FACTUAL BACKGROUND

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

All the arguments are explained in detail above.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Firstly, Complainant alleges that the disputed domain name is confusingly similar to its ESSAYTIGERS trademark. Complainant states that it has both common law and US trademark rights in the sign ESSAYTIGERS, as well as the website's domain name used for its commercial activity (essaytigers.com). It alleges that it started using the ESSAYTIGERS sign as a trademark in 2012.

It argues that that the disputed domain name is composed with the words "essay" and "tiger" which are the words composing its trademark, even if the two words are inverted and the letter "s" at the end of the word "tiger" is absent.

Complainant considers that those elements are not sufficient to prevent the risk of confusion between the disputed domain name and Complainant's trademark.

Complainant also adds that the words are dictionary words but the combination makes it unusual.

Therefore, Complainant considers the domain name to be confusingly similar to its common law trademarks rights.

Thus, Complainant believes that Respondent owned the disputed domain name with the intent to exploit the Complainant's goodwill.

Secondly, Complainant alleges that Respondent has no rights nor legitimate interests in the disputed domain name, in view of Complainant's prior statutory and common law rights in the trademark, as a result of the continued use of the sign ESSAYTIGERS as a trademark by the Complainant in trade for a long time before Respondent's registration of the disputed domain name.

It adds that Respondent has not been authorized by nor affiliated to Complainant. Complainant did not grant any license nor authorization to Respondent.

Furthermore, Complainant points that the Respondent's website at <tigeressay.com> is offering services that are indistinguishable from those supplied by Complainant and its official website.

Complainant believes the Respondent uses the disputed domain name to falsely suggest affiliation with its business.

Thirdly, Complainant considers that the disputed domain name has been registered and is being used in bad faith. It alleges that Respondent deliberately calls itself as "EssayTigers" several times across its website, which is identical to Complainant's trademark and domain name while Respondent's domain name is <tigeressay.com>.

Therefore, it alleges that Respondent chose to register the disputed domain name in order to create a risk of confusion with Complainant's website offering the same services. It argues that Respondent registered the disputed domain name with full knowledge of Complainant's existence since the Complainant's website appears as first result on Google search.

Complainant also alleges that Respondent attempted to attract customers for commercial gain on its own website, benefiting from Complainant's reputation. As the name of the company or the individual providing the services is not specified on the website, Complainant assumes that Respondent wishes to attracts business under the name of Complainant and solicit payments for services through the website in question.

Complainant finally stated that the fact that Respondent hides its identity behind a privacy shield might prove that the disputed domain name was registered and is used in bad faith.

RESPONDENT:

Respondent did not reply to Complainant’s contentions.

RIGHTS

FINDINGS:

In consideration of the Factual Background, the Parties’ Contentions stated above and its own web searches, the Panel comes to the following conclusions:

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 10 (a) of the Rules provides that the Panel “shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules.

A. The disputed domain name is identical or confusingly similar to Complainant’s trademarks

Paragraph 4(a)(i) of the Policy requires that the Complainant demonstrates that the disputed domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or European Union law.

Complainant has duly shown the existence of its registered trademark rights for the “ESSAYTIGERS” mark registered on April 14, 2020. Even if the trademark was not registered until 2020, the sign has been used as a trademark, both on the website and on social networks since at least 2012.

Indeed, the domain name <essaytigers.com> is exploited since December 31, 2012, on a website using the said sign as a trademark. Regarding social networks, the Facebook account was created on January 18, 2013 and the Twitter account on June 2013. The Glassdoor profile was also created on September 4, 2013.

Therefore, Panel finds that Complainant has duly shown that it is using the ESSAYTIGERS sign as a trademark prior to the disputed domain name’s registration and can therefore benefit from Common law rights.

Firstly, the disputed domain name reproduces the ESSAYTIGERS trademark in a very similar way. It only reverses the words “essay” and “tiger” and the absence of the letter “s” at the end of the word “tiger” does not dismiss the risk of confusion. Panels already considered that “The reversal of the elements does not distinguish the disputed domain name from the Trademark so as to prevent a finding of confusing similarity (See for example AtomGate. c. Bolloré (SA), CAC case n° 102013). Moreover, the absence of a letter such a “s” has already been found irrelevant. See for example Fundacion Comercio Electronico v. ArcelorMittal (SA) CAC Case No. 102179: “the deletion of a letter from a trademark, does not prevent a finding of confusing similarity to the relevant mark for the purpose of paragraph 4(a)(i) of the Policy”).

Secondly, Panel usually considers that the addition of a gTLD does not dispel the likelihood of confusion between a trademark and a domain name Since it only constitutes a technical requirement of domain names (See e.g. Crédit Agricole S.A. v. Roy M Oishi, CAC case No. 101545).

Therefore, the Panel finds the disputed domain name to be confusingly similar to “ESSAYTIGERS” sign in which Complainant has Common Law rights.

To the satisfaction of the Panel, Complainant has shown that the disputed domain name is confusingly similar to a trademark or service trademark in which it has rights. The requirement of Paragraph 4(a)(i) of the Policy is therefore met.

NO RIGHTS OR LEGITIMATE INTERESTS

B. The disputed domain name has been registered without rights or legitimate interests in the name

Pursuant Paragraph 4(a)(ii) of the Policy, the Complainant is required to prove that the disputed domain name has been registered without rights or legitimate interests in the name.

Complainant is required to make a prima facie case demonstrating that Respondent lacks the rights and legitimate interests in the disputed domain name. If the prima facie case is successful, then the burden of proof shifts to Respondent.

Complainant has duly shown that it did not provide any license nor authorization to Respondent, to use the “ESSAYTIGERS” sign nor to register the disputed domain name. Furthermore, Respondent is not known by the disputed domain name.

The Panel finds that Complainant has made a prima facie case showing that Respondent has no right nor legitimate interests in the “ESSAYTIGERS” sign.

Furthermore, the fact that Respondent did not answer to Complainant’s contentions is commonly considered as an evidence of this second required condition. In fact, if Respondent had rights or legitimate interests in the disputed domain name, it would have at least tried to convince the Panel. See for example CAC Case No. 102988 in which Panel used this argument to establish the second requirement, “The Respondent has not come forward to rebut the Complainant’s assertion in this regard.”.

Panel finds that Respondent has therefore, no rights nor legitimate interests in the disputed domain name.

To the satisfaction of the Panel, Complainant has proven that Respondent has no rights or legitimate interests in respect of the disputed domain name. The requirement of Paragraph 4(a)(ii) of the Policy is therefore met.

BAD FAITH

C. Bad faith

Pursuant Paragraph 4(a)(iii) of the Policy, the Complainant is required to prove that the disputed domain name has been registered or that is being used in bad faith.

Firstly, Complainant has duly shown the reputation of its trademarks and its existence in its field of activity and in trade under the name ESSAYTIGERS.

Panel considers that Respondent could not have ignored Complainant when registering the disputed domain name. A simple internet search on the sign “ESSAYTIGERS” displays many results related to Complainant. Furthermore, even an Internet research on the terms “essaytiger” also points to Complainant. Yet, the official website of Complainant appears in first result.

Therefore, it is clear that Respondent registered the disputed domain name in bad faith, being fully aware of Complainant’s existence and Complainant’s rights in the “ESSAYTIGERS” sign.

Secondly, Complainant has duly proven that Respondent is using the disputed domain name in bad faith. In fact, Respondent reproduces the “ESSAYTIGERS” sign in a similar way in the disputed domain name. Panel also notes that the disputed domain name is used for the same services than Complainant, namely for online essay writing service. It can be legitimately considered that Respondent tried to benefit from Complainant’s reputation.

Furthermore, Respondent makes references to “EssayTigers” several times across its website which is identical to “ESSAYTIGERS” sign in which Complainant has rights and under which it is known. This shows again that Respondent wanted to take commercial advantage of Complainant’s reputation or wishes to create a potential confusion with its business.

Therefore, Panel finds that it can be legitimately considered the disputed domain name was registered and is used in bad faith.

To the satisfaction of the Panel, Complainant has proven that the disputed domain name was registered and is being used in bad faith. The requirement of Paragraph 4(a)(iii) of the Policy is therefore met.

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

DECISION

Having established all three elements required by the Rules, the Panel concludes that relief shall be granted, without prejudice to a future judicial decision.

For all the foregoing reasons, the Panel orders the disputed domain name <tigeressay.com> to be transferred to Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **TIGERESSAY.COM**: Transferred

PANELLISTS

Name	**Nathalie Dreyfus**

DATE OF PANEL DECISION 2020-07-03

Publish the Decision