Decision for dispute CAC-UDRP-103787

Case number	CAC-UDRP-103787
Time of filing	2021-05-04 10:00:57
Domain names	allinonewpmigration.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	ServMask, Inc

Complainant representative

Organization	Dimov Internet Law Consulting

Respondent

Organization	Theme Price

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of US trademark reg. No. 6,124,087 for All-in-One WP Migration, registered on 11th of August 2020 for class 9 products, first use in commerce in May 2014.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:
In accordance with the provisions of Paragraph 4 (a) of ICANN's Uniform Domain Name Dispute Resolution Policy (hereinafter, referred to as the "Policy"), the Complainant must prove three elements in order to have the disputed domain name allinonewpmigration.com (the "Domain Name") assigned in his favor. The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The Complainant is the owner of the US Trademark Reg. No. 6,124,087 for All-in-One WP Migration (the "Trademark"). The Trademark includes the same letters as the letters of the Domain Name. The main differences between the Domain Name and the Trademark relates to the use of hyphens in the Trademark and the use of .com in the Domain Name.

The addition of a hyphen to a disputed domain name reflecting a trademark does not render it dissimilar from the trademark. See Six Continents Hotels, Inc. v. Georgetown, Inc., WIPO Case No. D2003-0214) ("hyphens do not "serve to dispel Internet user confusion here"). By way of analogy, the incorporation of a trademark in a domain name by removing hyphens and spaces between words is not sufficient to make the disputed domain name dissimilar from the trademark.

As previous UDRP panels have recognized, the incorporation of a trademark in its entirety is typically sufficient to establish that a domain name is identical or confusingly similar to the complainant's registered mark. See RapidShare AG, Christian Schmid v. InvisibleRegistration.com, Domain Admin, WIPO Case No. D2010-1059 ("The incorporation of a trademark in its entirety is typically sufficient to establish that a disputed domain name is identical or confusingly similar to a trademark").

Furthermore, for the purpose of determining whether the Disputed Domain Name is confusingly similar to the Complainant's trademark, the generic Top Level Domain ("gTLD") ".com" is inconsequential. According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.11, the applicable Top Level Domain ("TLD") in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

The Respondent has no rights or legitimate interests in respect of the Domain Name

As of the date of filing complaint, the Domain Name was not used in connection with a bona fide offering of goods or services. The website associated with the Domain Name (the "Website") refers to a home webpage which uses the Trademark to redirects visitors of the website to buy "4800+ Premium WordPress Plugins and Themes at Plugin Pro for just $ 4" and get access to "Unlimited Downloads at $10".

The main webpage uses the following disclaimer: "We are not affiliated or related to All in One WP Migration or its trademark owners. We're just big fans! This site is made for sharing knowledge under fair use policy.". The disclaimer clearly indicates that the Respondent is well aware of the Trademark and, nevertheless, the Respondent decided to utilize the Trademark in order to sell plugins and themes for USD 4 and offer paid access to unlimited downloads at USD 10.

The Website refers to a plugin bearing the Trademark (the "Plugin") and describes the features of the Plugin in detail. The Plugin is developed by the Complainant and has more than 3,000,000 active installations.

The Website (in a combination with the Domain Name) creates a likelihood of confusion with the Trademark as to the source, sponsorship, affiliation, or endorsement of the Website or of a product (the Plugin) on the Website. Many users of search engines and other Internet users will be misled into believing that the Website is affiliated or related to the Trademark. Even though there is a disclaimer, it appears after a user of a search engine visits the website. Once the user of the search engine visits the website, he or she will be offered to be redirected to a website (pluginpro.com) selling "alternatives" of the Plugin.

The Website consists of four pages only, i.e., "Home", "Usage", "Alternatives", and "Blog". A website that consists of four pages which attract visitors by creating a likelihood of confusion with a trademark of another company shall not be regarded as a website engaged in a bona fide offering of goods or services. The same applies for a domain name associated with such a website.

Furthermore, there is clear evidence that, in the past, the Respondent used the Domain Name and the Website for the purpose of selling copyrighted versions of the Plugin without the authorization of the Complainant. After the Complainant sent copyright infringement notices in relation to the copyright infringement committed by the Respondent, the Respondent stopped doing so. The copyright infringement notices are attached to this complaint as annexes 10 and 11. The copyright infringement notices were sent in April 2021. The website hostinger.com which provided hosting services to the Respondent suspended the account of the Respondent as a result of a copyright infringement notice sent by the Complainant to hostinger.com.

On the 2 February 2021, the Complainant received from the Respondent or a representative of the Respondent a message

that reads as follows: “Hello, we own domain names of your brand- allinonewpmigration.com, net and org. I am selling it, If you wish to protect your brand name by getting the domains, your company can get it. I have some other extensions too. Thank you.” The message was sent by AWADESH HARNANI <harnaniawadesh@gmail.com>.

The Respondent has not been commonly known by the Domain Name and has not acquired any trademark rights. The Domain Name is used to briefly describe the Plugin. As mentioned above, the Plugin has more than 3,000,000 active installations. Needless to say, it is difficult to believe that the Respondent can become commonly known by a domain name which redirects to a four-page website containing a brief description of a plugin owned by another party.
Although the Respondent argues in its disclaimer that the Website “is made for sharing knowledge under fair use policy”, the Respondent uses the Domain Name and the Website with the intent for commercial gain to misleadingly divert customers of the Complainant to another website (www.pluginpro.com) where they can buy plugins and themes and get paid access to unlimited downloads. Furthermore, the fact that the Respondent uploaded content owned by the Complainant, without the authorization of the Complainant, clearly indicates that the Domain Name and the Website were not used for “legitimate non-commercial or fair use”. Using a domain name and/or a website for the unlawful distribution of copyrighted content is not and shall not be regarded as “legitimate non-commercial or fair use”.

The Domain Name has been registered and is being used in bad faith
The Trademark was registered on the 11 August 2020. The Domain Name was registered on the 17 August 2020. After registering the Domain Name, the Respondent or a representative of the Respondent contacted the Complainant and offered to sell the Domain Name to the Complainant. The following facts clearly indicate that the Domain Name was registered primarily for the purpose of selling it to the Complainant: (i) the Domain Name was registered after the Trademark (this means that the Respondent was likely aware of the Trademark or was able to become aware of the Trademark); (ii) less than one year after purchasing the Domain Name, the Respondent offered to sell the Domain Name to the Complainant.
Just six days after the registration of the Trademark, the Respondent registered the Domain Name. Furthermore, the Respondent or a representative of the Respondent was aware that the Complainant can protect its brand name if the Complainant gets the Domain Name. The factual statements in the preceding two sentences clearly indicate that the Domain Name was registered in order to prevent the Complainant from reflecting the Trademark in a corresponding domain name. The Respondent or a representative of the Respondent informed the Complainant that the Respondent bought not only “.com” reflecting the Trademark, but also “.net” and “.org”. The Respondent even stated “I have some other extensions too.”
Taking into account the facts that: (i) the Respondent used the Website and the Domain Name to upload copyright content owned by the Complainant without the authorization of the Complainant; and (ii) the Website redirects to a website (www.pluginpro.com) selling “ALL IN ONE WP MIGRATION ALTERNATIVES”, it can be concluded that (a) the Respondent acts on behalf of a competitor (www.pluginpro.com) and (b) aims to disrupt the business of the Complainant by uploading illegal content and misleadingly diverting customers of the Complainant to the website of the competitor of the Complainant.
The Respondent uses the Domain Name to intentionally attract, for commercial gain, Internet users to the Website and the website www.pluginpro.com by creating a likelihood of confusion with the Trademark as to the source, sponsorship, affiliation, or endorsement of the Website. To achieve this, the Respondent has published a description of the Plugin on the Website, thus misleading Internet users that the Website is somehow associated with the Plugin bearing the Trademark. Although there is a disclaimer, it may not be read by every user. A mere insertion of a disclaimer in a website shall not be accepted as giving “carte blanche” to the Respondent to attract users to the Website by creating a likelihood of confusion with the Trademark. Actually, the inclusion of a disclaimer is an evidence of bad faith as it indicates that the Respondent was likely aware that a UDRP proceeding may be initiated with regard to the Domain Name and the Respondent prepared to defend itself by arguing that it uses the Domain Name for “fair use” purposes. However, as mentioned above, the Website is not used for fair use purposes which seriously undermines the legal value of the disclaimer.

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

I. RIGHTS

The disputed domain name is confusingly similar to the Complainant's registered trademarks since it reproduces the Complainant's mark 'All-in-One WP Migration', merely removing the hyphens and spaces between words.

II. NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent has not submitted any response. Therefore, it has submitted no information on possible rights or legitimate interests it might hold. On its part, the Complainant has submitted information and arguments which allow it to be reasonably assumed that the Respondent has no rights or legitimate interest in the domain name in dispute.

As the WIPO Arbitration and Mediation Center pointed out in UDRP case No. D20020856:

"As mentioned [in the decision], the Respondent has not filed a Response and is therefore in default. In those circumstances when the Respondent has no obvious connection with the disputed Domain Name, the prima facie showing by the Complainant that the Respondent has no right or legitimate interest is sufficient to shift the burden of proof to the Respondent to demonstrate that such a right or legitimate interest exists." WIPO Case No. D20020273 <sachsenanhalt>; WIPO Case No. D20020521 <volvovehicles.com>.

Furthermore, the Complainant has established that the Respondent's website contains links to download applications from the Complainant's competitors, all against payment. Clearly, such use cannot be regarded as non-commercial fair use.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

III. BAD FAITH

The Respondent has, as a result of his default, not invoked any circumstances which could invalidate the Complainant´s allegations and evidence with regard to the Respondent´s registration and use of the disputed domain name in bad faith.

The Complainant has supplied evidence of commercial use of the disputed domain name by the Respondent, trying to impersonate the Complainant. As mentioned above, the Respondent's website contains links to download applications from the Complainant's competitors, all against payment, using for that purpose a domain name identical to the Complainant´s trademark. Generally speaking, UDRP panels have found that domain names identical to a complainant's trademark carry a

high risk of implied affiliation (see Section 2.5.1 of WIPO Jurisprudential Overview 3.0).

Clearly, in view of a domain name identical to the Complainant's trade mark followed by tld .com, any Internet user would immediately think that this was the Complainant's website.

This risk of impersonation is not avoided by the disclaimer on the Respondent's website, as the very nature of the domain name, identical to the Complainant's trademark, necessarily leads at first glance to an affiliation or sponsorship of the Complainant. The Respondent was also making a profit by offering "alternatives" to the Complainant's services.

Paragraph 4(b) (iiii) of the Policy provides that the following circumstances are deemed to be evidence that the Respondent has registered and is using the disputed domain name in bad faith:

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or location or of a product or service on its website or location.

As mentioned in Andrey Ternovskiy dba Chatroulette v. Alexander Ochki, WIPO Case No. D2017-0334:

"It is clear in the Panel's view that in the mind of an Internet user, the disputed domain names could be directly associated with the Complainant's trademark, which is likely to be confusing to the public as suggesting either an operation of the Complainant or one associated with or endorsed by it (see AT&T Corp. v. Amjad Kausar, WIPO Case No. D2003-0327)."

There is also evidence of an intent to sell the domain name. Although it has not been demonstrated that the communication came from the Respondent, it is an indication that would also confirm that the domain name was registered for the purpose of making a financial gain at Complainant's expense.

It has, therefore, been satisfactorily demonstrated to the Panel that the disputed domain name has been registered and 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. **ALLINONEWPMIGRATION.COM**: Transferred

PANELLISTS

Name	**José Ignacio San Martín**

DATE OF PANEL DECISION 2021-06-02

Publish the Decision