

Decision for dispute CAC-UDRP-104217

Case number	CAC-UDRP-104217
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Time of filing	2021-12-07 09:15:36
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Domain names	customwritings.pro
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Case administrator

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

Organization	Writera Limited
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Respondent

Name	Erick Japhet
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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 provided evidence of an owned trademark for "CUSTOMWRITINGS.COM", (word), US Trademark, priority (filing) date 1 August 2018, registration date 14 May 2019, trademark registration no. 5749163, registered for services in the international class 41; (hereinafter "Complainant's registered trademark").

The Complainant is the owner of the domain name <customwritings.com> registered on 10 October 2005.

FACTUAL BACKGROUND

The Complainant is a cooperation of several academic writing websites that help their clients with writing texts for their websites, business projects, on top of providing them with customised guides, samples, and writing directions. Complainant's trademarks are used by the Complainant for academic writing assistance and associated education services.

One of the services offered by the Complainant is custom writing assistance services through its website "customwritings.com" sine 2005, in relation to which it has a registered US trademark since 14 May 2019 (i.e. previous section regarding Complainant's identification of rights).

The disputed domain name, owned by the Respondent, was registered on 15 July 2019.

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

Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of a domain name, a complainant shall prove the following three elements:

- (i) The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) The respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar.

The Complainant has provided evidence of ownership of a US trademark for the "CUSTOMWRITINGS.COM" wordmark in class 41, since May 2019 (which predates the date of registration of the disputed domain name). The Panel agrees that the disputed domain name incorporates the "CUSTOMWRITINGS" part of the Complainant's mark, however, with the difference that the disputed domain name refers to another generic top-level domain (gTLD) ".pro".

As per the UDRP, the applicable gTLD is disregarded because it is a mere technical requirement of registration. Nonetheless, the particular situation of the Complainant's trademark makes the usual test under the UDRP different in this matter, due to the fact that the Complainant's registered trademark includes indeed the gTLD ".com".

According to the WIPO Overview 3.0 "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. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name." (see para 1.7).

In this case, this Panel finds that the Complainant's registered trademark and the disputed domain name are confusingly similar for the purpose of the Policy. In agreement with the Panel of the recent Decision at the CAC, *Writera Limited v. Baklan Iaroslav*, CAC Case No. 104234, there is a dominant feature of the relevant mark, "Custom Writings", which is being clearly visible and exactly reproduced in the disputed domain name, creating confusing similarity under the purpose of the Policy.

B. Rights or Legitimate Interests

The Complainant stated that the Respondent has no rights or legitimate interests in respect of the disputed domain name, that it is not related in any way with the Complainant, that Respondent has not been previously known by the disputed domain name, nor is Respondent's use of the disputed domain name a bona fide offering of goods or services pursuant to paragraph 4(c)(i) of the Policy nor a legitimate non-commercial or fair use pursuant to paragraph 4(c)(iii) of the Policy.

Additional to the statements provided by the Complainant, this Panel has conducted independent open searches and has found no trademark in relation to the Respondent's name (Erick Japhet), nor has this Panel found any relation to Kenya (location provided by the Respondent), with the disputed domain name.

Now, while the Respondent had the possibility to demonstrate it has indeed rights in the disputed domain name, it decided not to engage in the present proceedings and has not filed a response to defend his position and explain why it may have rights in the disputed domain name. Finally, it has been noted by the Panel that the website of the disputed domain name is currently inactive, not resolving to any page, which does not suggest a good faith behaviour.

Hence, this Panel concludes that the Complainant has established paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

This Panel has taken into account all circumstances in this present case, which indicate that the Respondent has registered and is using the disputed domain name in bad faith.

As per the registration in bad faith, the Complainant stated it registered and used the "customwritings.com" domain name since 2005, and it owns trademark rights since May 2019. The Panel notes that the Respondent registered the disputed domain name afterwards, in July 2019, and should have conducted a search before registering the domain name (as per the terms when and before registering a domain name that should not be abusive with a third-party). The Complainant also argues, and provides evidence, that the Respondent was reproducing exact content of the Complainant's website, which the Panel was able to corroborate.

Additionally, the Panel, in accordance with previous UDRP Decisions, notes several accumulating circumstances of bad faith registration and use of domain names, namely: i) Respondent's non-response to the Complainant's cease & desist letter, ii) the use of a privacy shield, iii) providing incomplete contact details to the Registrar, iv) changes in the use of the Disputed Domain Name, i.e. passive holding of domain names (See *Park Place Entertainment Corporation v. Bowno*, WIPO Case No. D2001-1410; and *FMV Opinions, Inc. v. the Fair Market Valuation experts*, WIPO Case No. D2002-0372).

From all circumstances present in this case (i.e. the use of privacy or proxy registration services, the non-response approach of the Respondent since the cease and desist letter, the prior existence and knowledge of the Complainant's rights, the substantial similarity between the website associated with disputed domain name and website associated with the Complainant, the change of content of website to inactive, known as passive holding), it can be concluded that the Respondent registered the disputed domain name for the purpose of attracting internet users for commercial gain by creating a likelihood of confusion with the Complainant.

The Panel notes that the Respondent has not denied any of the statements and assertions of bad faith made by the Complainant in this proceeding, nor has he answered to the previous letter. Hence, it is reasonable to infer that should the Respondent had legitimate purposes for registering and using the disputed domain name, he would have participated in the present proceeding (and not changed the use of said Domain Name as "inactive", as it currently shows).

As a final remark of this Panel, it has noted that there are many other websites and domain names referring to "custom writing" services, which compete with the Complainant. It is important to note that every case is unique and all circumstances in a specific case are different. Nonetheless, the use of a generic term should not be "monopolized" only by one party and restrict

uses of other bona fide offering of services by his competitors (as well stated in the recent Decision at the CAC, Writera Limited v. Baklan Iaroslav, CAC Case No. 104234).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **CUSTOMWRITINGS.PRO**: Transferred

PANELLISTS

Name	Laura Martin-Gamero Schmidt
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DATE OF PANEL DECISION 2022-02-04

Do not publish the Decision