

Decision for dispute CAC-UDRP-104983

Case number **CAC-UDRP-104983**

Time of filing **2022-11-24 09:52:43**

Domain names **doctors.express**

Case administrator

Organization **Denisa Bilík (CAC) (Case admin)**

Complainant

Organization **Mr Samuel Banks (Intellectual Holdings, Ltd)**

Complainant representative

Organization **Dr. Daniel Dimov (Dimov Internet Law Consulting)**

Respondent

Organization **phil harris (synergy media)**

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings relating to the disputed Domain Name.

IDENTIFICATION OF RIGHTS

The Complainant owns the following trademarks:

- UK trademark No. UK00003118366 for “DOCTORS EXPRESS” registered on the 16 of October 2015; and
 - EU trademark No. 015457765 for “doctors express” was registered on the 17 of October 2016.
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FACTUAL BACKGROUND

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

The disputed Domain Name was registered on the 19 of July 2015. The Complainant's UK Trademark was filed on the 17 of July 2015.

The Complainant's corporate group owns the website 'www.doctorexpress.ky', and uses it for selling services under the trademark “DOCTORS EXPRESS”.

The disputed Domain Name was registered on the 19 of July 2015.

COMPLAINANT:

1. THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO COMPLAINANT'S TRADEMARK

The Complainant's Trademarks are identical to the disputed Domain Name. This is because the Complainant's Trademarks consist of two elements, namely, (i) "DOCTORS" and (ii) "EXPRESS". The disputed Domain Name also includes the same two elements. Actually, the only difference between the Complainant's

Trademark and the disputed Domain Name is one dot (".").

However, the aforementioned dot is used in all domain names with the aim to divide second-level domain names from top-level domain names. Since there is no domain name without a dot, the dot should not be taken into account for the purposes of the UDRP when assessing the confusingly similarity between the Complainant's Trademarks and the disputed Domain Name.

2. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DISPUTED DOMAIN NAME

The Respondent has no rights or legitimate interests in respect of the disputed Domain Name because the following circumstances specified in Section 4(c) of the Policy are not present:

First Group of Circumstances Indicating Rights or Legitimate Interests: "before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services".

The disputed Domain Name has not been used in connection with a bona fide offering of goods and services. It refers to a webpage showing the following error page: "Error. Page cannot be displayed. Please contact your service provider for more details. (32)". The use of the disputed Domain Name in association with such an error page cannot be regarded as use in connection with a bona fide offering of goods and services. In fact, there is no use at all.

Second Group of Circumstances Indicating Rights or Legitimate Interests: "you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights". To Complainant's knowledge, the Respondent does not have any trademarks corresponding to the disputed Domain Name. Furthermore, the Respondent is not commonly known by the disputed Domain Name. As mentioned above, the disputed Domain Name is not used. A legal or a natural person cannot become known through an unused domain name.

Third Group of Circumstances Indicating Rights or Legitimate Interests: "you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue". As per the Complainant's argument, it states it is clear that the Respondent is not making a legitimate noncommercial or fair use of the disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The error page associated with the disputed Domain Name cannot and should not be regarded as a legitimate noncommercial or fair use of the disputed Domain Name. The term "legitimate noncommercial or fair use" implies the use of the domain name for, for example, free of charge provision of information without commercial purposes. However, in this case, the webpage associated with the disputed Domain Name contains no valuable information.

Actually, by associating the disputed Domain Name with an error page, the Respondent misleads the customers of the Complainant into believing that the website of the Complainant is inactive or incomplete. This harms the reputation of the Complainant's Trademarks and leads to trademark tarnishment. In this regard, it is worth mentioning that a company from the Complainant's corporate group owns the website 'www.doctorexpress.ky', and uses it for selling services under the trademark "DOCTORS EXPRESS".

Since the Complainant's Trademarks and the disputed Domain Name are confusingly similar, many customers of the Complainant may be misled into believing that the disputed Domain Name and the associated error page are owned by the Complainant.

3. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITHThe disputed Domain Name was registered on the 19 of July 2015, i.e., two days after the date (the 17 of July 2022) when Complainant's UK trademark No. UK00003118366 for "DOCTORS EXPRESS" was filed.

In the current case, it is clear that the disputed Domain Name was registered shortly after the Complainant's filing of the Complainant's UK application. This means that the Respondent likely found the information about the new trademark application in the database of the UKIPO and registered the disputed Domain Name quickly afterwards to ensure that the Complainant will not be able to reflect its UK trademark in the disputed Domain Name. This is a clear indicator of bad faith.

Furthermore, the Respondent uses a privacy service to hide its contact details and, thus, to avoid being notified of a UDRP proceeding

filed against the Respondent.

In the current case, there are no reasons to believe that the privacy service is used for legitimate purposes. On the contrary, it appears to be used for block or intentional delay disclosure of the identity of the actual underlying registrant.

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RESPONDENT

The Respondent alleges the following via a non-standard communication which will be considered as the Response.

The Respondent alleges he has never been involved in a UDRP matter in the 20 years the Respondent has owned over 3000 generic domains used by its media company.

The Respondent purchased the disputed Domain Name with plans to develop access to online healthcare in the United States.

The Respondent purchased the disputed Domain Name a few days after general availability and after the Sunrise / trademark period and after the early access program.

The Respondent lives in the United States and has no concerns in the United Kingdom.

The Respondent received an e-mail from the Complainant back in 2015 asking if the Respondent would be interested in selling the disputed Domain Name. At the time, the Respondent informed the Complainant about plans the Respondent had on using it for a project. Since then, the Respondent has not heard anything from the Complainant in the past 7 years.

The Complainant never talked about having a UK trademark on this generic term.

The Respondent believes the Complainant is trying to hijack the disputed Domain Name.

There are many extensions available with doctors express including ".com", ".org", ".net" even ".uk" that are not owned by the Complainant.

The Respondent states that in the US trademark system there are several marks that have doctors and express in the mark.

With the new gTLD Program they had set up trademark holders an opportunity to keep these names off general availability. The Complainant did not file any such form.

The Respondent claims it has always acted in good faith and the names that the Respondent has usually do not resolve until the Respondent is ready to launch its sites. The Respondent does this so there could never be an accusation of acting in bad faith.

The disputed Domain Name is not listed in a market place and never has been.

The Respondent simply bought a two-word generic term that fits the Respondent's business model, 2 days after it became available for anyone to register after sunrise period.

In no way does the Respondent harm a Cayman Island company with a UK mark that was applied for a year after the disputed Domain Name was registered.

According to the Respondent the Complainant simply likes the disputed Domain Name better than his .ky name and is trying to reverse hijack the disputed Domain Name.

RIGHTS

To the satisfaction of the Panel, the Complainant has shown that the disputed Domain Name is identical or confusingly similar to the trademark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

To the satisfaction of the Panel, the Complainant has 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

To the satisfaction of the Panel, the Complainant has 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

Before turning to the substance of the matter at hand, the Panel needs to determine a preliminary matter, which relates to an unsolicited supplemental filing by the Complainant dated December 20, 2022.

The Panel notes that the UDRP is meant to be a simple and swift process with one bit at the apple, meaning one Complaint and one Response. As such, unsolicited supplemental filings are generally discouraged unless specifically requested by the Panel. In this case, the Panel did not make such a request. As cited in WIPO Overview 3.0 paragraph 4.6 and under paragraphs 10 and 12 of the UDRP Rules, these vest the panel with authority to determine the admissibility, relevance, materiality, and weight of the evidence and also to conduct the proceedings with due expedition, as well as expressly provide that it is for the Panel to request, in its sole discretion, any further statements or documents from the parties it may deem necessary to decide the case.

Having established this and considering equity and procedural efficiency, the Panel will disregard the unsolicited supplemental filing by the Complainant dated December 20, as there is further no justification as to why the unsolicited filing should be considered as being an "exceptional" circumstance for its acceptance.

Having dealt with this preliminary matter, the Panel is satisfied that all procedural requirements under UDRP have been met. There is no other reason why it would be unsuitable for providing the Decision.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or Confusingly Similar

First, the Panel is satisfied that the Complainant has shown it owns rights to the "DOCTORS EXPRESS" trademark, with the earliest registration dating to October 16, 2015.

Turning to analyze if there is a confusing similarity between the disputed Domain Name and the trademark, the Panel notes, based on the record at hand, that the disputed Domain Name reproduces the trademark in its totality, namely "DOCTORS EXPRESS", with one exception. This exception relates to the addition of the letter "." between the two elements of the trademark, namely "DOCTORS" and "EXPRESS". The Panel notes that the "." is a technical requirement separating the TLD, which in this case is "EXPRESS". Typically, the TLD element is disregarded in determining the confusing similarity with a disputed Domain Name, as per the persuasive paragraph 1.11 of WIPO Overview 3.0.

Nevertheless, as contained under the same paragraph of the WIPO Overview 3.0, the Panel notes "that panels may consider the domain name in its entirety for purposes of assessing confusing similarity", including the TLD, which in this case would mean that the disputed Domain Name is confusingly similar for UDRP standing purposes. Additionally, this slight difference of the "." is immaterial to dispel the confusing similarity between the disputed Domain Name and the Complainant's trademarks.

Consequently, the Panel determines that the Complaint has satisfied the Policy's first element set under paragraph 4(a)(I).

B. Rights or Legitimate Interests

In the case at hand, the Respondent submitted an email on December 13, 2022, which serves as its Response. The Response addresses some of the elements in the Complaint, which the Panel will now examine as to what they pertain to the second element.

The Complainant alleges that:

1. The Respondent is not commonly known by the disputed Domain Name.
2. The Respondent has no trademark, license, or authorization to use the trademarks.
3. The Respondent is not authorized to carry out any activity for the Complainant.
4. The Respondent is not using the disputed Domain Name and has no demonstratable plans to use the disputed Domain Name legitimately.

The Panel finds that the Complainant's above-noted assertions, evidence on record, and on the balance of probability are sufficient to establish the requisite prima facie case. Accordingly, as the Complainant has established a prima facie case, the burden of production shifts to the Respondent to bring forward evidence of rights or legitimate interests in the disputed Domain Name.

The Respondent's Response does not dispute allegations 1), 2) and 3) provided above by the Complainant. However, the Respondent does provide some allegations regarding the last assertion by the Complainant, namely the assertion under 4).

The Respondent alleges he has never been involved in a UDRP matter in the 20 years he has owned over 3,000 generic domain names used by its media company. The Panel notes that the disputed Domain Name was registered on July 19, 2015, just two days after the filing of the UK trademark application by the Complainant, which, as evidenced by the Complainant, occurred on July 17, 2015.

The Respondent also mentions that the Complainant contacted him with an offer to buy the disputed Domain Name back on July 29, 2015. Still, as per the Respondent, he replied that he was not interested in selling the disputed Domain Name because he intended to use it for a project, although he was open to hearing offers for it. The Respondent states that the Complainant did not contact him again or mention anything regarding the trademark application in the past seven years.

The Respondent does not provide any evidence relating to the project it intends for the disputed Domain Name, but bearing in consideration that by its assertion, the Respondent is a seasoned businessperson with over 3,000 domain names and 20 years of experience in the field, it is not unreasonable to consider seven years sufficient time to begin the aforementioned project or at least provide evidence of demonstrable preparations to use the disputed Domain Name, in connection with a bona fide offering of goods or services, as per paragraph 2.2 of WIPO 3.0 Overview.

In all of the above circumstances, the Panel finds that the Respondent has failed to rebut the Complainant's prima facie case and accordingly that the requirements of paragraph 4(a)(ii) of the Policy have been satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

"(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location."

The Complainants' case on this element focuses mainly on the assertion that the disputed Domain Name was registered on July 19, 2015, i.e., two days after the date (July 17, 2022) when Complainant's UK trademark No. UK00003118366 for "DOCTORS EXPRESS" was filed. If this were the case, it would mean that the Respondent targeted the Complainant with the registration of the disputed Domain Name, which would then mean that the Respondent registered the disputed domain name in bad faith.

Regarding this argument, the Respondent states that he registered the disputed Domain Name a few days after general availability and after the Sunrise/trademark period, and after the early access program with plans to develop access to online healthcare in the United States. Assessing these assertions, the Panel, on the balance of probability and based on the record at hand, considers that as an experience domain name professional, the Respondent is familiar with the trademark system. The disputed Domain Name registration two days after filing the UK trademark application is curious. Additionally, the Respondent states its plans to develop access to online healthcare in the United States. Still, the Respondent fails to provide an explanation or evidence justifying the choice of "DOCTORS EXPRESS" for its project. If this were indeed the case, the Respondent could have supplied evidence of the specific choice of "DOCTORS EXPRESS". In addition, the Respondent has not provided evidence of demonstrable preparations to use the disputed Domain Name, in connection with a bona fide offering of goods or services, since the registration of the disputed Domain Name, which was over seven years ago.

The Respondent does provide evidence about other trademarks in the US with the terms "Doctors" and "Express", which, even if true, does not mean that the Respondent did not initially target the Complainant with the registration of the disputed Domain Name.

Furthermore, there is no evidence before the Panel that the Respondent's selecting a privacy service as the holder of the disputed Domain Name is evidence per se of bad faith.

In the present dispute, taking into consideration the explanation by the Respondent (see above) and on the balance of probabilities, the disputed Domain Name appears to be more likely acquired by the Respondent primarily for selling, renting, or otherwise transferring the disputed Domain Name registration to the Complainant for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed Domain Name, as per Paragraph 4(b) of the Policy.

In light of the case's circumstances, based on the available records and balance of probabilities, the Panel finds that the Complainant has proven that the disputed Domain Name was registered and used in bad faith according to paragraph 4(a)(iii) of the Policy.

D. Reverse Domain Name Hijacking

The Panel does not find reverse domain name hijacking in the above-mentioned dispute.

E. Decision

For the preceding reasons and in concurrence with the provisions specified under Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders the transfer of the disputed Domain Name to the first Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **doctors.express**: Transferred

PANELLISTS

Name	Rodolfo Rivas Rea
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DATE OF PANEL DECISION 2022-12-29

Publish the Decision
