

Decision for dispute CAC-UDRP-104234

Case number CAC-UDRP-104234

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Domain names customwritings.co

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization Writera Limited

Respondent

Name Baklan Iaroslav

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 a recorded assignment document indicating it is the assignee on record of the trademark containing the word element "CUSTOMWRITINGS.COM":

(i) 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, from which the Complainant claims unregistered trademark rights to the "CUSTOMWRITINGS.COM" denomination prior to the priority date of the Complainant's registered trademark.

FACTUAL BACKGROUND

The Complainant, through its website <customwritings.com> provides services consisting primarily of custom writing services for various purposes including academic writing, admission writing, calculations, and programming among others. The Complainant asserts, and the Respondent does not dispute, that the Complainant has provided these services since 2006. The Complainant is the assignee holder on record of the US (class 41) trademark CUSTOMWRITINGS.COM, with a priority filing date of 1 August 2018.

The disputed domain name <customwritings.co> was registered on 30 December 2016 and is held by the Respondent. The website associated with the disputed domain name is currently used by the Respondent for promoting and offering services similar to those of the Complainant, i.e. custom on-demand writing for various purposes including academic writings,

speeches, admission essays etc.

According to amended Complaint as filed, the Complainant seeks transfer of the disputed domain name from One Freelance Limited (Reg. number 06547172) domiciled in London, England ("One Freelance"). However, the Registrar Verification confirmed that the domain is not registered to One Freelance, but rather to the Respondent. Because One Freelance is not the registrant of the disputed domain name, the Panel concludes that the reference to One Freelance was included in error, and Complainant sought for the disputed domain name to be transferred to it from the Respondent.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

IDENTICAL OR CONFUSING SIMILARITY

Complainant asserts:

- The "CUSTOMWRITINGS.COM" denomination has acquired distinctiveness and reputation through long public use since 2006 and it has acquired secondary meaning attributable to the Complainant as an unregistered trademark;
- Complainant's rights to the "CUSTOMWRITINGS.COM" denomination (as an unregistered trademark) predates registration of the disputed domain name despite the fact that the Complainant's registered trademark was applied for only after the registration of the disputed domain name;
- The disputed domain name contains the "CUSTOMWRITINGS.COM" word elements, but without the letter "m" in the ".com" part, and it is thus insufficient, not of a distinctive nature and does not serve to alter the overall impression of the disputed domain name with respect to Complainant's trademark rights;
- The modification of the TLD from ".com" to "co" is not sufficient to escape confusing similarity between the disputed domain name and the Complainant's trademark, because there is a high level of optical, phonetic and conceptual similarity between the terms; and
- The website associated with the disputed domain name improperly includes the denomination "Custom Writings", in which Complainant asserts rights.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant asserts:

- The Respondent has not been commonly known by the disputed domain name;
- The Respondent has no connection or affiliation with the Complainant;
- Respondent's use of the disputed domain name is neither a bona fide offering of services nor legitimate non-commercial fair use;
- The disputed domain name was used for attracting internet users to services provided by the Respondent which are similar to Complainant's services and members of the public would assume an association between the businesses; and
- The website associated with the disputed domain name has an appearance very similar to Complainant's website.

BAD FAITH REGISTRATION AND USE

The Complainant asserts:

- Seniority of the Complainant's rights to the "CUSTOMWRITINGS.COM" denomination due to its unregistered rights predating the registration of the disputed domain name;
- There is a strong likelihood that Respondent purposely targeted Complainant's mark to attract, for commercial gain, internet users by creating a likelihood of confusion with Complainant's trademark as to the source, sponsorship, affiliation or endorsement of Respondent's website;
- Lack of contact details on Respondent's website and Respondent's failure to respond to either the Complainant's DMCA letter or its request to the Registrar of the disputed domain name is a further indication of bad faith; and
- "CustomWritings" is a made-up collocation of words with an intentional mistake ("s" at the end).

The Complainant included the following supporting evidence with its Complaint:

- Brief background information about the Complainant and its business, its history and reviews concerning the services provided by the Complainant;
- Excerpt from a trademark database, including the original trademark registration and evidence of the recordal of assignment of the trademark to Complainant;
- Excerpt from a WHOIS database regarding Complainant's domain name and the disputed domain name;
- Screenshots of relevant websites; and
- Copy of Complainant's DMCA Notice requesting registrant contact details.

RESPONDENT:

IDENTICAL OR CONFUSING SIMILARITY

The Respondent asserts:

- The disputed domain name should not be treated as identical or confusingly similar to Complainant's trademark;
- The denomination "CUSTOM WRITINGS" is non-distinctive and refers to the services but not the service provider;
- The word "CUSTOM" has a meaning of 'made to order', and "WRITINGS" refers to any writing work such as books or other textual publications etc and therefore the denomination is descriptive for the services for which the trademark and the domain names are used;
- The denomination "CUSTOM WRITINGS" is not attributable or connected solely to Complainant's business but is commonly used on the Internet, including before Complainant registered its trademark or the customwritings.com domain name; and
- The term "Custom Writings" would be used not only for searching for the Complainant but also by internet users describing their needs.

NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent asserts:

- An internet search for the term "custom writings" shows several service providers use the same term within the business name and/or description of services;
- The words "custom writings" have been widely used by different service providers and in different publications and discussions about online essays and other textual services for many years, including prior to Complainant's use of the denomination;
- Respondent registered the disputed domain name prior to Complainant's registered trademark priority date; and
- Because the term "custom writings" is strongly associated with the relevant services but not with a particular service provider, Respondent did not use the denomination in the disputed domain name for the purpose of indicating an association with Complainant.

BAD FAITH REGISTRATION AND USE

Respondent asserts:

- No attempt has been made to sell the disputed domain name to Complainant;
- The disputed domain name was registered to offer services associated with “custom writings”, but not for the purpose of disrupting any competitor;
- The design of the website associated with the disputed domain name is entirely different from the Complainant’s website design, and there is no likelihood of confusion for the Internet user;
- Respondent registered the domain name before the priority date of Complainant’s registered trademark; and
- Because Complainant used a denomination which could not be recognized as inherently distinctive in its customwritings.com domain, it cannot assert unregistered trademark protection in the term.

Respondent included the following supporting evidence with its Response:

- Recent Google search of the term “custom writings” ;
 - Google search limited to results before 1 January 2005 of the term “custom writings”.
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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

This element was not considered by the Panel.

Since the three elements of paragraph 4(a) of the Policy are conjunctive and because the Complainant did not satisfy the requirement of paragraph 4 (a) (iii) of the Policy discussed below, it was not necessary for the Panel to consider whether the Complainant satisfactorily established this second element.

BAD FAITH

The Complainant has not, 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

RIGHTS

The Complainant has provided evidence of assigned ownership of a United States trademark for the “CUSTOMWRITINGS.COM” wordmark in class 41. It is well established that a registered trademark may be prima facie evidence of rights in a name for the purpose of establishing standing for a UDRP dispute.

As to registered trademark rights for the purpose of establishing standing, the Panel notes that the disputed domain name incorporates the “CUSTOMWRITINGS” part of the Complainant’s mark in its entirety, with merely a change from the generic top-level domain “.com” to the country-code top level domain “.co”. Generally, under the UDRP, the applicable TLD is disregarded because it is a mere technical requirement of registration. The present case deviates from the normal approach as to consideration of the TLD because the Complainant’s registered trademark is “CUSTOMWRITINGS.COM”, that is, it includes the “.COM”. As stated in 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, the Panel finds that the Complainant's registered trademark and the disputed domain name are confusingly similar for the purpose of the UDRP, because a dominant feature of the relevant mark, namely "Custom Writings" is recognizable as being exactly reproduced in the disputed domain name. As to the differences, the disputed domain name merely excludes the final "m" as included in Complainant's registered trademark – to read ".co" rather than ".com". The Panel finds there is both visual and phonetic (aural) similarity between the disputed domain name and Complainant's registered trademark. Therefore, the Panel finds Complainant has properly relied on its registered trademark for the purpose of establishing standing to file a UDRP complaint.

As to Complainant's unregistered or common law rights in the denomination, Complainant submits that "CUSTOMWRITINGS.COM" denomination has acquired distinctiveness and reputation through long public use since 2006 and it has acquired secondary meaning attributable to the Complainant as an unregistered trademark. As noted above, generally, for UDRP purposes, the TLD may be ignored. Regarding unregistered rights, it is therefore appropriate to disregard the ".COM" as a technical requirement and to focus the analysis on the substantive part of the denomination. Accordingly, consideration of unregistered rights rests on Complainant's rights in the denomination CUSTOMWRITINGS.

To establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services. Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys.

Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning. In cases involving unregistered or common law marks that are comprised solely of descriptive terms which are not inherently distinctive, there is a greater onus on the complainant to present evidence of acquired distinctiveness/secondary meaning.

Here, Complainant has failed to meet the heightened burden of demonstrating acquired distinctiveness that applies to unregistered marks comprised solely of descriptive terms.

Although the principle of stare decisis does not apply in this proceeding and the Panel is not bound by decisions reached by earlier panels, a review of similar cases supports the conclusions reached.

Previous disputes where unregistered rights were at issue have, in some instances, resulted in rejection of the complaint (see, for example, Amsec Enterprises, L.C. v Sharon McCall, WIPO D2001-0083 <backgroundfacts.com>, WIPO D2005-1194; Alpine Entertainment Group, Inc v. Walter Alvarez WIPO D2006-1392 <realspanking.com> and similar). For example, in the <backgroundfacts.com> case, the Panel held that a claim of long-term use (which was only partially supported by evidence) and an additional claim of multi-million dollar gross sales were insufficient to establish evidence of a secondary meaning as needed to prove enforceable rights in the mark. Similarly, in K-Tek Computers, Inc., d/b/a Computer Refurb v. Domains By Proxy, LLC / mail: and Fred Serham WIPO D2015-0225 <computerrefurb.com>, the panel held that, other than a bare reference to the term "computer refurb" on its website, the complainant in that case failed to indicate how it used the purported mark in commerce to identify and distinguish its goods and services. Accordingly, the complainant in <computerrefurb.com> failed to establish that the purported mark had any acquired distinctiveness, ie that a relevant sector of the public had come to associate the relevant term specifically with that complainant's offerings. The same line of reasoning may be applied to the instant case.

Complainant submits that "CustomWritings" is a made-up collocation of words with an intentional mistake consisting of an

“s” at the end of “writing”. The Panel is not persuaded by this argument, because in this context the pluralization of “writings” may refer to the various types of outputs that can be procured through the service, such as essays, research papers and the like.

Respondent argues, and the Panel tends to agree, that Complainant’s mark consisting of the “CUSTOM WRITINGS” denomination is non-distinctive. It is apparent the words “CUSTOM” and “WRITINGS” are both descriptive and laudatory of the services in respect of which the trademark and domain names are used, that is, to offer to its customers a range of writings which are customized to the customers’ needs.

Further, evidence submitted by Respondent of a Google search of the term “custom writings” with results generated before 1 January 2005 – i.e. before Complainant claims to have started to use the denomination - showed use of the term “Custom Writings”, including the “s” within the domain and service description of another business <https://smartcustomwritings.org>. Thus at least one other business was using the relevant term prior to Complainant, making it less likely that the relevant public specifically associated the denomination with Complainant.

Complainant asserts that at the time the disputed domain name was registered, i.e. 30 December 2016, its trademark CUSTOMWRITINGS.COM had acquired distinctiveness and reputation through long public use since the year 2006. Complainant also asserts that due to its efforts, the mark CUSTOMWRITINGS.COM was recognizable among customers and the services had received many positive reviews. Complainant’s only evidence to support this claim was a link to the “Site Jabber” website as evidence of many reviews and customer feedback. Panel found that while the “Site Jabber” review site included around 186 customer reviews related to Complainant’s business and services, of these only around seven reviews appeared to be dated prior to 30 December 2016.

Panel notes that Complainant offered no evidence with respect to sales under the mark, advertising, actual public recognition, consumer surveys or the like. Complainant claimed the number of customers and website users was increasing each year prior to the registration of the disputed domain name but provided no evidence to support this claim. As noted above, conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, do not generally suffice to show secondary meaning. Here, the allegations of unregistered rights are disputed by Respondent, including evidence submitted to bolster Respondent’s position. Given the heightened burden that applies to establishing common law trademark rights in descriptive terms under the UDRP, the Panel finds that the Complainant’s limited evidence of: (i) the duration and use of the mark, and (ii) around seven reviews of Complainant’s business, is insufficient to meet this burden. As a result, despite the long-term use and assertion of efforts and advertising by the Complainant during the time prior to the registration of the disputed domain name, nothing in the evidence suggests that the term CUSTOM WRITINGS has become so well-known as to acquire the requisite degree of distinctiveness taking it out of its original generic nature.

On the other hand, under the UDRP, where a respondent is shown to have been targeting the complainant’s mark (e.g., based on the manner in which the related website is used) such conduct may support the complainant’s assertion that its mark has achieved significance as a source identifier. While Respondent is indeed using the disputed domain name in a similar manner to Complainant’s use of its relevant website, in this case Respondent claims that it merely intended to use relevant words that were associated with Respondent’s services. Panel finds Respondent’s claim in this respect plausible. A recent Google search – submitted by Respondent – showed several other businesses - offering writing services - are using the denominations “custom writings” or “custom writing” as descriptive of their service offer. This Google search result indicates that Internet users may be aware that the term “CUSTOM WRITINGS” is legitimately and commonly used by various subjects on the Internet, both as a part of domain names or within Internet content (e.g. on websites, etc.) and, therefore, that such term is not associated solely with the Complainant or its business. In the Panel’s view, absent evidence to the contrary, it may be inferred that the Internet public understands and anticipates that various modifications of such generic and common terms will exist, that they will be used by different subjects, and that the Internet public do not reasonably expect that all of them will be associated with the Complainant.

For the purpose of standing, Complainant has satisfied the requirements of Paragraph 4(a)(i) of the Policy based on Complainant’s registered trademark. However, based on the limited supporting evidence provided, the Complainant has not met its burden of establishing unregistered trademark rights.

NO RIGHTS OR LEGITIMATE INTERESTS

This element was not considered by the Panel.

Since the three elements of paragraph 4(a) of the Policy are conjunctive and because the Complainant did not satisfy the third element requirement of bad faith under 4 (a)(iii) of the Policy (discussed below), it was not necessary for the Panel to evaluate the second element.

BAD FAITH

The Panel finds the Complainant has not shown bad faith on the part of the Respondent in registering and using the disputed domain name.

It is clear from the terms of paragraph 4(a)(iii) of the Policy as well as confirmed by numerous decisions under it that the two elements of this third requirement are cumulative; both registration and use in bad faith must be proved for a complaint to succeed. See, for example, *World Wrestling Federation Entertainment, Inc. v. Michael Bosman*, WIPO D1999-0001, *Telstra Computers Ltd v. Nuclear Marshmallows*, WIPO D2000-0003 and *A. Nattermann & Cie. GmbH and Sanofi-aventis v. Watson Pharmaceuticals, Inc.*, WIPO D2010-0800.

A key issue here is whether the disputed domain name was registered in bad faith.

The Panel finds that the disputed domain name was registered before the priority date of the Complainant's registered trademark. This is a critical fact, because before such priority date the Complainant may rely only on unregistered (trademark) rights to the "CUSTOM WRITINGS" name. As discussed in detail above, the Panel found the evidence supporting Complainant's assertions of acquired distinctiveness and secondary meaning to be unsatisfactory. In this case involving an unregistered (common law) trademark that comprises solely of descriptive terms which are not inherently distinctive, there is an even greater onus on the Complainant to present evidence of acquired distinctiveness and secondary meaning of the term "CUSTOM WRITINGS". Complainant failed to present such evidence. Mere evidence of the duration of use and a handful of reviews for Complainant's business is not sufficient to meet the Complainant's burden for establishing that a relevant section of the public associates the term "CUSTOM WRITINGS" solely with the Complainant and its business.

While it is possible that the Respondent was aware of Complainant's trademarks, domain name and business in general; it does not necessarily follow that Respondent registered the disputed domain name in bad faith for the purpose of a "free riding" on the Complainant's reputation and or trademarks, since the disputed domain name is descriptive of the services offered by both the Complainant and Respondent. Respondent claims that its purpose for registering the disputed domain name was to offer services connected to the denomination CUSTOM WRITINGS, which Respondent claims are widely associated with such services. Complainant did not provide evidence sufficient to refute Respondent's claim in this regard.

The Complainant claims that the Respondent registered the disputed domain name for the improper purpose of attempting to create a likelihood of confusion with Complainant. Complainant claims Respondent's website "copies substantial elements" of Complainant's website, "including the Complainant's trademark". While it is true that the term "custom writings" is used within the Respondent's website, it is used as a descriptive term. To the Panelist's knowledge, the Complainant's registered trademark "CUSTOMWRITINGS.COM" is not used within Respondent's website. Moreover, the Panel finds that the Respondent's website has a substantially different look and feel to Complainant's relevant website including use of different colors, layout, fonts, text etc. Complainant's website presently features a teal color scheme and predominant use of a circular devices on the home page. On the other hand, Respondent's website presently has a bold green header bar and a predominantly rectangular layout on the home page. Accordingly, in Panel's view, even a cursory comparison of the two websites shows there is little to no likelihood of confusion, even for a casual visitor, in this regard.

As noted by the panel - in similar circumstances - in *One Freelance Limited v Traffic Terminal CAC Case No. 102537 <affordablepapers4u.com>*, the use of a generic term in a domain name may provide certain advantages over competitors

as such domain names are intuitive and likely return better results through search engines compared to made up or fanciful names. Further, a complainant may not "monopolize" a generic term only for himself and restrict uses of other bona fide offering of services by his competitors. Here, like in the UDRP case concerning <affordablepapers4u.com>, the Complainant chose a generic term to promote its services. As such, Complainant may not, without more, restrict the use of the term by competitors, including the Respondent, particularly where Complainant failed to establish common law rights in the mark prior to registration of the disputed domain name. Therefore, in conclusion, Complainant has not met its burden of proof to establish that the domain name was registered to take unfair advantage of or otherwise burden Complainant's mark.

For completeness, Panel notes that bad faith on the part of the respondent was found by the respective panels in the relevant cases *One Freelance Limited v. Vika Korotkova* CAC Case No. 103783 <CUSTOMWRITLNGS.COM> and *Writera Limited v. alexander ershov* CAC Case No. 104144 <CUSTOMWRLTINGS.COM> (collectively, the "Earlier Disputes"), however there are several key distinguishing factors between the Earlier Disputes and this present case. First, unlike in the current case, in the Earlier Disputes, the disputed domain names were registered subsequent to the priority date of the complainant's registered trademark and thus it was not necessary to analyze whether the complainant in those cases could claim that unregistered trademark rights existed at the time of registration. Second, in neither of the Earlier Disputes was a response filed, and thus the complainant's assertions were uncontested. Finally, the Earlier Disputes concerned examples of classic typosquatting, where the letter "I" was deliberately replaced by a visually similar "L", while in the present case the Respondent claims to be making legitimate use of a descriptive denomination, absent classic typosquatting but rather in conjunction with the popular ccTLD ".co". Thus, the present case is clearly distinguished from the Earlier Disputes, and the holdings in those cases are not presently applicable.

In light of the above, the Panel concludes that the Complainant has failed to prove that the disputed domain name is being used in bad faith within meaning of paragraph 4(a)(iii) of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **CUSTOMWRITINGS.CO**: Remaining with the Respondent

PANELLISTS

Name	Claire Kowarsky, LL.M
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DATE OF PANEL DECISION 2022-01-30

Publish the Decision
