

Decision for dispute CAC-UDRP-105208

Case number **CAC-UDRP-105208**

Time of filing **2023-04-13 09:22:35**

Domain names **paperowl.org**

Case administrator

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

Complainant

Organization **RATATATA LTD**

Respondent

Name **GENNADIJ BAKUTEJEV**

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 Registration number 6,855,924 "PAPERSOWL" registered on September 27, 2022.

FACTUAL BACKGROUND

The Complainant is a Bulgarian Company active in the sector of writing services.

First of all, the Complainant has proved to be the owner of US Registration number 6,855,924 PAPERSOWL registered on September 27, 2022, with first use in commerce on January 13, 2016, and therefore after the registration of the disputed domain name <paperowl.org> (September 8, 2022).

The Complainant also states that it had recognizable rights on the unregistered trademark PAPERSOWL before the registration of the domain name in dispute.

In particular, the Complainant has proved to be the holder of the domain name <papersowl.com> registered since January 13, 2016 and to have actively used it at least since February 14, 2016 to offer writing services under the mark PAPERSOWL.

In addition, the Complainant has proved that before the registration of the domain name in dispute its PAPERSOWL trademark was mentioned on numerous independent websites.

The Complainant has also demonstrated to be active on social media such as Twitter, Instagram, YouTube, Pinterest, TikTok with a considerable number of followers before the registration of the domain name in dispute.

According to the Complainant, the disputed domain name is confusingly similar to the PAPERSOWL unregistered trademark of the Complainant since the difference between the signs is minimal.

Furthermore, it is the Complainant's view that the Respondent does not have any rights or legitimate interests in respect of the disputed domain name since the Complainant has never grant the Respondent a license or permission to use the PAPERSOWL mark.

Finally, the Complainant considers that the disputed domain name has been registered and is being used in bad faith. This especially in consideration of the fact that Respondent uses the disputed domain name for its commercial benefit, as it sells writing services through the website corresponding to the domain name in dispute and said website presents many points in common with the website corresponding to the Complainant's domain name <papersowl.com>.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED - The Panel has decided to not consider the late submission of the Respondent (e-mail dated May 18, 2023) since it is not relevant for the decision.

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

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

- (i) the disputed 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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

1) According to paragraph 4(a)(i) the Complainant has to demonstrate that the domain name in dispute is identical or confusingly similar to a trademark or service mark in which the same Complainant has rights. According to WIPO Jurisprudential Overview 3.0, the term "trademark or service mark" as used in paragraph 4(a)(i) encompasses both registered and unregistered (sometimes referred to as common law) marks.

The US Registration number 6,855,924 PAPERSOWL was not yet registered at the time of the disputed domain name registration. Said US Registration claims first use in commerce on January 13, 2016 and this is a slight indication of the use of the Complainant rights before the registration of the domain name in dispute.

Anyway, to concretely establish unregistered trademark rights for purposes of the Policy, the Complainant must show that its mark has become a distinctive identifier which consumers associate with the Complainant's goods and/or services. The Panel finds that the Complainant's PAPERSOWL trademark has become distinctive identifier associated with the Complainant writing services because the Complainant has been promoting and selling its services through the website corresponding to the domain name <papersowl.com> at least since February 14, 2016 using the mark PAPERSOWL as clearly showed by the Complainant. Furthermore, the extensive use of the above mark in the principal social media confirms the recognizability of the sign which actually has been also mentioned in numerous independent websites before the registration of the domain name in dispute. In consideration of the evidence filed, the Panel

agrees that the Complainant has expended considerable time, effort and money in advertising, promoting and selling services in connection with the PAPERSOWL mark before the registration of the domain name in dispute. Thus, the Panel finds that the Complainant has established unregistered trademark rights for the purposes of the Policy.

The disputed domain name differs only from the Complainant's domain name and unregistered trademark in that it omits the letter S (which merely indicates the plural form) in PAPER(S)OWL. However, this still leaves the visual and auditive impression near to identical. This is, according to this Panel, not sufficient to distinguish the disputed domain name from the Complainant rights, as the overall impression, including the visual, auditive and conceptual, of both the Complainant rights and the disputed domain name remain quasi-identical and confusingly similar. Accordingly, the Panel finds that the first condition of paragraph 4(a) of the Policy has been fulfilled.

2) The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and as the Respondent was never authorized to use the domain name by the Complainant. The Respondent has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant has not licenced or otherwise permitted the Respondent to use the Complainant's mark in the disputed domain name. On the basis of the evidence submitted, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant therefore succeeds also on the second element of the Policy.

3) In the present circumstances the Panel concludes that the Respondent chose to register a name confusingly similar to the Complainant's trademark in order to facilitate a business where the Respondent's website could in effect impersonate the Complainant and offer for sale services directly competing with those offered by the Complainant. Manifestly the choice of name was not coincidental given that the combination of the words PAPER(S) and OWL is, in the Panel's view, unusual and distinctive.

Under paragraph 4(b) of the Policy a non-exhaustive list of factors evidencing registration and use in bad faith comprises:

"(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 web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

In the present circumstances the Panel agrees with the Complainant that factor (iv) applies as the Respondent was seeking to attract customers by creating a likelihood of confusion with the Complainant's PAPERSOWL trademark. The Panel also notes that the Respondent has not availed itself of the opportunity to present any case of good faith that it might have. The Panel infers that none exists.

Accordingly, the Panel finds that the disputed domain name has been registered and is being used in bad faith and the third condition of paragraph 4(a) of the Policy has been fulfilled.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **paperowl.org**: Transferred

PANELLISTS

Name	Guido Maffei
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DATE OF PANEL DECISION 2023-05-22

Publish the Decision
