

Decision for dispute CAC-UDRP-105599

Case number CAC-UDRP-105599

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Domain names mention.me

Case administrator

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

Complainant

Organization Mention Me Limited

Complainant representative

Organization Stobbs IP Ltd

Respondent

Name Brendan Hernou

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 the following trademark registrations for the sign "MENTION ME" (the "MENTION ME trademark"):

- the United Kingdom trademark MENTION ME (combined) with registration No. UK00917440884, registered on 20 February 2018 for in International Class 35; and
- the European Union trademark MENTION ME (combined) with registration No. 017440884, registered on 20 February 2018 for in International Class 35.

FACTUAL BACKGROUND

The Complainant operates a referral marketing platform and has offices in the United Kingdom and the United States of America. Since 2013, it has delivered more than 6 million referrals totalling US Dollars 1.8 billion in revenue for 500 brands around the globe.

The Complainant is the owner of the domain name <mention-me.com>, which resolves to its official website operating since 2013.

The disputed domain name <mention.me> was registered on 4 September 2020. It is currently inactive. According to the evidence submitted by the Complainant, it previously resolved to a website displaying a replica of the MENTION ME trademark and containing

the following text:

“Influencer Marketing for Professionals. MentionMe is an end-to-end marketing platform that lets brands work with influencers. It takes care of all the heavy lifting and enables you to focus on running successful campaigns that grow your business.”

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

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant submits that the disputed domain name is confusingly similar to its MENTION ME trademark, as it incorporates the trademark entirely, taking into account the “.me” gTLD. According to the Complainant, a TLD may be taken into account for comparison purposes where it forms part of the trademark to which the respective domain name is being compared.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name, because it is not commonly known by it and is not making a legitimate non-commercial or fair use of it or using it for a bona fide offering of goods or services. Rather, the disputed domain name resolved to a website that impersonated the Complainant by using the MENTION ME trademark and copied the look and feel of the Complainant's official website. The Complainant notes that it sent a cease-and-desist letter to the Respondent via the email address listed on the website at the disputed domain name on 13 October 2022, but the Respondent failed to respond. Subsequently, a takedown notice was sent to the webhost on 30 November 2022, after which the MENTION ME trademark was removed from the Respondent's website, and the website was suspended by the web host on 6 January 2023. According to the Complainant, in view of the reputation of the MENTION ME trademark and its targeting by the Respondent through the content of the website at the disputed domain name, there is no realistic reason for the registration or use of the disputed domain name other than to take advantage of the Complainant's rights and brand reputation.

The Complainant states that the disputed domain name was registered and is being used in bad faith. It submits that its MENTION ME trademark predates the registration of the disputed domain name and has wide reputation, and the Respondent has registered the disputed domain name with knowledge of it, which is evident from the use of this trademark on the Respondent's website. According to the Complainant, the Respondent registered the disputed domain name in order to divert Internet traffic to the associated website, which offered competing services for commercial gain by impersonating the Complainant.

RESPONDENT:

The Respondent states that the Complainant has failed to explain as to how it adopted and used its own domain name <mention-me.com>. According to the Respondent, the Complainant is trying to monopolize trademarks and domain names that incorporate the word “mention”, which is a common English word.

The Respondent maintains that the disputed domain name is visually, phonetically, structurally and conceptually different from the

Complainant's domain name.

The Respondent denies having prior knowledge about the Complainant, and explains that the disputed domain name was acquired by it as part of a college project in September 2020 for bona fide purposes. The Respondent maintains that he is continuously using the disputed domain name for educational purposes, and notes that it has built up a significant online presence associated with the disputed domain name in Instagram, Facebook and LinkedIn.

The Respondent alleges that a search on the Internet shows no presence of the Complainant and no relation of it with the word "mention", and that the social media profiles of the Complainant have only a few thousand followers, which according to the Respondent shows that the word "mention" is not exclusively associated with the Complainant.

Principal Reasons for the Decision

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name:

- (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 was registered and is being used in bad faith.

Identical or confusingly similar

The Complainant has provided evidence and has thus established its rights in the MENTION ME trademark.

As discussed in section 1.10 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), panel assessment of identity or confusing similarity involves comparing the (alpha-numeric) domain name and the textual components of the relevant mark. To the extent that design (or figurative/stylized) elements would be incapable of representation in domain names, these elements are largely disregarded for purposes of assessing identity or confusing similarity under the first element. On this basis, trademark registrations with design elements would prima facie satisfy the requirement that the complainant show "rights in a mark" for further assessment as to confusing similarity. Therefore, the Panel accepts that the Complainant has shown rights in the MENTION ME trademark for the purposes of the Policy, and will consider the word elements of this trademark (the words "mention me") for the purposes of its comparison with the disputed domain name.

As further discussed in section 1.11.3 of the WIPO Overview 3.0, where the applicable TLD and the second-level portion of the domain name in combination contain the relevant trademark, panels may consider the domain name in its entirety for purposes of assessing confusing similarity (e.g., for a hypothetical TLD ".mark" and a mark "TRADEMARK", the domain name <trade.mark> would be confusingly similar for UDRP standing purposes).

The disputed domain name follows this pattern exactly, as it reproduces the MENTION ME trademark entirely when the ".me" gTLD is taken into consideration, and there are no other elements in the disputed domain name.

In view of the above, the Panel finds that the disputed domain name is identical to the MENTION ME trademark in which the Complainant has rights.

Rights and legitimate interests

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, because it is not commonly known under it and the disputed domain name is not used for a bona fide activity, because it has resolved to a website that featured the MENTION ME trademark and offered marketing services in competition with the Complainant. Thus, the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent denies the Complainant's statements and maintains that he has registered and uses the disputed domain name for educational purposes. He refers to his social media profiles which offer marketing services and contain links to the website at the disputed domain name.

The Panel considers that the circumstances of this case do not support a finding that the Respondent has rights or legitimate interests in the disputed domain name.

The evidence submitted by the Respondent about his participation in a business competition shows no relevance to the present

dispute, as it concerns a different trade name that does not contain any of the elements of the disputed domain name, and cannot serve as basis for a finding on the issue of rights or legitimate interests in it. The social media profiles referred to by the Respondent show that he offers marketing services through these profiles and through the disputed domain name, which discredits the Respondent's contention of using the disputed domain name for educational purposes.

It is well-established under the UDRP that the use of a disputed domain name that is identical to the trademark of another to offer competing goods or services is not a bona fide offering of goods or services or a legitimate non-commercial or fair use of a domain name under the Policy. This is more so in cases where, as here, the Respondent has used the Complainant's trademark on its website and has not placed on it any disclaimer for the lack of relationship with the Complainant. This combination of factors creates a risk of implied affiliation and supports a conclusion that the Respondent, having knowledge of the Complainant, purposefully attempted to impersonate it to mislead Internet users and offer them competing services for financial gain. Such conduct cannot give rise to rights or legitimate interests of the Respondent in the disputed domain name.

On this basis, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

"(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 registration of the Complainant's MENTION ME trademark predates the registration of the disputed domain name, which is identical to it, and the associated website offers marketing services that compete with the Complainant's services protected by the MENTION ME trademark. The evidence in the case, undisputed by the Respondent, shows that prior to the sending of the Complainant's cease-and-desist letter to him, the associated website featured the Complainant's trademark and contained no disclaimer for the lack of relationship between the Parties and does not identify the provider of the services offered. This was likely to mislead Internet users to believe that the disputed domain name and the website to which it resolved represented an official online location where the Complainant's services were legitimately offered. The Panel is therefore of the view that the Respondent is more likely to have registered and used the disputed domain name with knowledge of the Complainant's MENTION ME trademark and with the intention of taking advantage of its goodwill by impersonating the Complainant and attracting Internet users to its website to offer them services in competition with the Complainant for commercial gain. The fact that the disputed domain name is currently inactive does not change these conclusions, as it appears to have been deactivated following the Complainant's cease-and-desist letter.

This satisfies 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. **mention.me**: Transferred

PANELLISTS

Name	Assen Alexiev
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DATE OF PANEL DECISION 2023-08-25

Publish the Decision
