

Decision for dispute CAC-UDRP-105642

Case number	CAC-UDRP-105642
Time of filing	2023-07-28 10:01:31
Domain names	elementbiosciencescareers.com

Case administrator

Name	Olga Dvořáková (Case admin)
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Complainant

Organization	Element Biosciences, Inc.
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Complainant representative

Organization	Loza and Loza LLP
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Respondent

Name	Haley Luyahs
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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 has demonstrated ownership of unregistered rights in the trademark ELEMENT BIOSCIENCES for the purposes of standing to file a UDRP complaint.

FACTUAL BACKGROUND

The Complainant was founded in 2017 and is a United States biotechnology company focused on creating genetic analysis tools for the research and diagnostic markets.

The Complainant's business and products under the trademark ELEMENT BIOSCIENCES are advertised on the website at the domain name <elementbiosciences.com>, registered on July 7, 2017.

The disputed domain name <elementbiosciencescareers.com> was registered on April 4, 2023 and is not pointed to an active website. According to the documents submitted the Complaint, email addresses based on the disputed domain name have been used to deliver offers of employment in the name of the Complainant's Chief Executive Officer.

PARTIES CONTENTIONS

COMPLAINANT

The Complainant contends that the disputed domain name is confusingly similar to its trademark ELEMENT BIOSCIENCES.

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name since: i) the Respondent does not use, and has not used, the disputed domain name in connection with a bona fide of goods or services, as the disputed domain name has not been used in connection with an active website but only to create email addresses used to deliver fraudulent email communications aimed at scamming unsuspecting individuals into providing sensitive personal information under the guise that the Respondent is associated with the Complainant (which it is not) and wishes to hire such people to work for Complainant; ii) the Respondent is not commonly known by the disputed domain name; iii) the use of the disputed domain name to commit fraud is not a legitimate or non-commercial fair use; and iv) the mere construction of the disputed domain name can be relied upon to infer that a respondent is not making a legitimate use of the disputed domain name.

The Complainant claims that the Respondent registered the disputed domain name in bad faith because: i) the composition of the disputed domain name and the Respondent's use of Complainant's trademark and company details in the correspondence sent from email addresses based on the disputed domain name demonstrate that the Respondent was actually aware of the Complainant's trademark; ii) even if Respondent did not have actual knowledge of the Complainant's trademark (which it likely did), the Respondent had a duty to ensure that the registration of the disputed domain name would not infringe a third party's rights and a simple online search for ELEMENT BIOSCIENCES would have highlighted the existence of the Complainant and its trademark.

With reference to bad faith use, the Complainant contends that the Respondent registered the disputed domain name primarily for the purpose of disrupting the Complainant's business because the Complainant is required to respond to inquiries from the targeted job seekers and to investigate each instance of wrongdoing.

The Complainant highlights that the Respondent sent emails to unsuspecting job seekers (the same day the disputed domain name was created) requesting sensitive personal information, that can be used to perpetuate identity theft and other scams. The Complainant asserts that the emails and accompanying "recruitment" materials are particularly troubling in this case because the Respondent has used an exact copy of the Complainant's figurative trademark, the Complainant's address, links to the Complainant's website, and the name of the Complainant's CEO, all in connection with an email address that incorporates the trademark ELEMENT BIOSCIENCES in their entirety.

Additionally, the Complainant states that the Respondent's failure to use the disputed domain name in connection with an active website is further evidence of bad faith.

RESPONDENT

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

1. The Complainant has provided evidence of ownership of trademark applications for ELEMENT BIOSCIENCES, namely the United States trademark application Nos. 90763884 for ELEMENT BIOSCIENCES (word mark), filed on June 9, 2021, in international classes 1, 5, 9, 10 and 42; and 90763877 for E ELEMENT BIOSCIENCES (figurative mark), filed on June 9, 2021 in international classes 1, 5, 9, 10 and 42.

A pending trademark application does not by itself establish trademark rights within the meaning of paragraph 4(a)(i) of the Policy. However, a complainant can have standing for purposes of the Policy based on unregistered trademark rights.

To establish unregistered or common law trademark rights for purposes of the Policy, a complainant must show that its trademark has become a distinctive identifier which consumers associate with the complainant's goods and/or services.

In the case at hand, the Complainant has submitted a declaration of the Complainant's General Counsel in which it is stated that the Complainant has made public use of the trademark ELEMENT BIOSCIENCES since at least 2019, that the Complainant's goods have been available for sale in connection with the trademark ELEMENT BIOSCIENCES since at least March 2022 and that the Complainant shipped goods to a consumer in connection with the ELEMENT BIOSCIENCES trademark in June 2022. It is also stated that the Complainant paid for advertising in the form of banners at the San Diego International Airport in 2022 and that the Complainant promoted the ELEMENT BIOSCIENCES trademark at several prominent trade conferences throughout the United States and beyond since 2022. The Complainant has also provided historical screenshots taken from the Internet Archive at <archive.org> showing that its website at the domain name <elementbiosciences.com> - registered on July 7, 2017 - was active and featured the ELEMENT BIOSCIENCES trademark at least as of October 2020.

In addition, the Complainant submitted copies of third-party news websites, including an article taken from the online edition of San Diego Union Tribune dated January 9, 2020, dedicated to Complainant's startup company, and an article published on <https://www.labiotech.eu/> on August 16, 2022 mentioning the Complainant as one of the biggest private biotech companies in San Diego.

Based on the records, the Panel finds that the Complainant has demonstrated ownership of unregistered rights in the trademark ELEMENT BIOSCIENCES for the purposes of standing to file a UDRP complaint.

The Panel also finds that the disputed domain name is confusingly similar to the Complainant's trademark ELEMENT BIOSCIENCES as it reproduces the trademark in its entirety with the mere addition of the dictionary term "careers", which is not sufficient to prevent a finding of confusing similarity. As to the gTLD ".com", as established in a number of prior UDRP cases, it is viewed as a standard registration requirement and as such can be disregarded for the purpose of assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy.

2. With reference to the Respondent's rights or legitimate interests in the disputed domain name, the Panel finds that the Complainant has made a *prima facie* case and that the Respondent, by not submitting a Response, has failed to provide any element from which a Respondent's right or legitimate interest in the disputed domain name could be inferred.

The Panel notes that, based on the records, the Complainant has not authorized the Respondent to register and use its trademark ELEMENT BIOSCIENCES. Moreover, there is no evidence that the Respondent might be commonly known by the disputed domain name or a name corresponding to the disputed domain name.

As highlighted above, the disputed domain name, confusingly similar to the Complainant's trademark, has not been pointed to an active website but, according to the records submitted, has been used for the creation of email addresses used to send emails to job seekers passing off as the Complainant and requesting users to provide personal information. The Panel finds that the Respondent's use does not amount to a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name without intention to misleadingly divert the consumers or to tarnish the Complainant's trademark. Moreover, the disputed domain name, combining the Complainant's trademark with the term "careers", is inherently misleading and suggests an affiliation with the Complainant that, according to the records, does not exist.

3. As to bad faith at the time of the registration, the Panel finds that, in light of the prior use of ELEMENT BIOSCIENCES as company name, trademark and domain name by the Complainant, the activity of which is promoted online via the Complainant's website www.elementbiosciences.com since 2020, the Respondent could have been aware of the Complainant's trademark when it registered the disputed domain name in April 2023. The fact that, according to the evidence submitted by the Complainant - which has not been contested by the Respondent -, the Respondent mentioned the Complainant's company details and the name of its CEO in communications sent via email addresses based on the disputed domain name, reproducing also the Complainant's trademark and providing a link to the Complainant's website, demonstrates that the Respondent was indeed well aware of, and intended to target, the Complainant and its trademark.

The disputed domain name has not been pointed to an active website. As established in a number of prior cases, the concept of "bad faith use" in paragraph 4(b) of the Policy includes not only positive action but also passive holding.

Furthermore, the Panel finds that, as established in a number of prior UDRP decisions, the use of a domain name for purposes other than to host a website may constitute bad faith. The use of the disputed domain name to send deceptive emails aimed at obtaining sensitive or confidential personal information from prospective job applicants certainly amounts to bad faith use.

Therefore, the Panel finds that the Respondent registered and is using the disputed domain name amounts to bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **elementbiosciencescareers.com**: Transferred
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PANELLISTS

Name	Luca Barbero
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DATE OF PANEL DECISION	2023-09-05
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Publish the Decision
