Decision for dispute CAC-UDRP-106459

Case number	CAC-UDRP-106459
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Domain names	investinstlouis.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Invest St. Louis LLC

Complainant representative

Organization	John B. Berryhill LLC

Respondent

Name	Femby Femby

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 claims unregistered or common law trademark rights for the signs “INVEST IN ST LOUIS REAL ESTATE”, “Invest St. Louis” and “Invest Saint Louis”.

FACTUAL BACKGROUND

The Complainant, Invest St. Louis LLC, is a licensed real estate association founded in 2012 in St. Louis, Missouri, United States (hereinafter “US”).

The Complainant does not own a registered trademark containing the terms “invest in St Louis”.

According to the Complainant’s evidence, the disputed domain name was first registered on January 14, 2011, by the Complainant. In February 2024, the disputed domain name was transferred out of the Complainant’s control to the Respondent.

According to the Complainant’s evidence, the disputed domain name resolved to the Complainant’s website displaying the“Invest Saint Louis” logo at least from 2013 to October 2023. The disputed domain name currently redirects to a gambling website in Indonesian.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant considers the disputed domain name to be identical or confusingly similar to a trade or service mark in which it has rights. Although it has no registered trademark containing “invest in St Louis”, the Complainant claims that:

- it has made prominent use of a logo including the terms “Invest Saint Louis” and the branding “Invest in St Louis (Real Estate)” and "Invest St. Louis" which are reflected in the disputed domain name;
- the terms “Invest St. Louis”, “Invest in St. Louis” or the “Invest Saint Louis” logo are not descriptive of a real estate agency;
- it has advertised its services not only at the website denominated by the disputed domain name, but through various third party services;
- its Google business profile refers substantial traffic and physical traffic seeking its website and physical location as a consequence of consumer recognition of the Complainant's reputation and goodwill;
- the Complainant has done business with the “Invest St. Louis" branding since 2011.

The Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name. According to the Complainant, the disputed domain name has been misappropriated from the Complainant and is currently being used to siphon the Complainant's goodwill by misdirecting visitors to a site which advertises gambling services in Indonesian.

Finally, the Complainant considers that the disputed domain name was registered and is used in bad faith, as according to the Complainant:

- the Respondent's motivation for acquiring the disputed domain name is related to the Complainant's rights in the mark and the goodwill signified thereby (including the Complainant’s previous use of the disputed domain name. It is the only apparent explanation for the use which the Respondent is making of a domain name which has nothing to do with either slot machines or Indonesia;
- the registrant data for the disputed domain name appears to be false or incomplete;
- it has found several other domain names which appear to have been misappropriated and redirecting to the same Indonesian-language gambling site as the one linked to the disputed domain name.

RESPONDENT:

The Respondent did not reply to the Complainant’s contentions.

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 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are administrative, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
2. The Respondent has no rights or legitimate interests in respect of the domain name; and
3. The domain name has been registered and is being used in bad faith.

The Panel has therefore dealt with each of these requirements in turn.

1. Identity of confusing similarity

The Complainant must first establish that there is a trademark or service mark in which it has rights. The Complainant seems to claim that it is the holder of unregistered or common law trademark rights for the signs "INVEST IN ST LOUIS REAL ESTATE", “Invest St. Louis” and "Invest Saint Louis" (hereafter the “Signs”).

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, and (iv) the degree of actual public (e.g., consumer, industry, media) recognition (see section 1.3 WIPO Overview 3.0).

The Complainant has established or declared that:

- it has used the Signs for more than 10 years, notably on its website formerly linked to the disputed domain name and on social media;
- it has closed more than $250M worth of real estate transactions over the course of its operations under its company name “Invest St. Louis LLC”;
- it has also advertised its services under the Signs through third-party websites;
- its website that was linked to the disputed domain name used to receive regular traffic.

Based on the above, the Panel finds that the Signs, although being comprised of descriptive terms which are not inherently distinctive, probably have become distinctive identifiers which consumers in Saint-Louis can associate with the Complainant’s real estate business. The fact that secondary meaning may only exist in a particular geographical area or market niche does not preclude the Complainant from establishing trademark rights (and as a result, standing) under the UDRP (see section 1.3 WIPO Overview 3.0).

Moreover, the fact that the Respondent may have been targeting the Complainant’s disputed domain name (see Section 2 “No rights or legitimate interests”) supports the Complainant’s assertion that its mark has achieved significance as a source identifier (see section 1.3 WIPO Overview 3.0).

The Panel observes that the disputed domain name either corresponds or is confusingly similar to the Signs for which the Complainant claims unregistered trademark rights.

Finally, it is well established that the Top-Level Domains (“TLDs”) such as “.com” may be disregarded when considering whether a disputed domain name is identical or confusingly similar to the trademark in which the Complainant has rights (see section 1.11 WIPO Overview 3.0).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the unregistered trademark rights claimed by the Complainant. Accordingly, the Complainant has made out the first of the three elements that it must establish.

2. No rights or legitimate interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is established case law that it is sufficient for the Complainant to make a prima facie showing that the Respondent has no right or legitimate interest in the disputed domain name in order to shift the burden of proof to the Respondent (see section 2.1 WIPO Overview 3.0 and Champion Innovations, Ltd. V. Udo Dussling (45FHH), WIPO case No. D2005-1094; Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO case No. D2003-0455; Belupo d.d. v. WACHEM d.o.o., WIPO case No. 2004-0110).

The Panel notes that the Respondent has not been commonly known by the disputed domain name and that the Respondent has not

acquired trademark or service mark rights. According to the information provided by the Registrar, the Respondent is known as “Femby Femby”. The Respondent’s use and registration of the disputed domain name was not authorized by the Complainant. In fact, according to the Complainant’s evidence, the disputed domain name belonged to the Complainant before it seemed to be somehow misappropriated from of the Complainant.

Beyond looking at the domain name(s) and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, such as content of the website linked to the disputed domain name and the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 of the WIPO Overview 3.0).

The disputed domain name currently redirects to a gambling website in Indonesian. In this case, the Panel is of the opinion that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. Given the associated Internet traffic built up when the disputed domain name was linked to the Complainant’s website, the Panel finds that this does not amount to any legitimate noncommercial or fair use or use in connection with a bona fide offering of goods and services.

The Respondent had the opportunity to demonstrate rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the prima facie case established by the Complainants has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the disputed domain name. In light of the above, the Complainant succeeds on the second element of the Policy.

3. Bad faith

The Complainant must prove on the balance of probabilities that the disputed domain name was registered in bad faith and that it is being used in bad faith (see section 4.2 WIPO Overview 3.0 and e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006-1052).

According to the Panel, the awareness of a respondent of the complainant and/or the complainant’s trademark rights at the time of registration can evidence bad faith (see Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz, WIPO Case No. D2011-2209; Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite, WIPO Case No. D2001-1070).

In the present case, the Panel finds that there are at least indirect indications that the Respondent was aware of the Complainant and its unregistered trademark rights when it registered the disputed domain name. The disputed domain name belonged to the Complainant for more than 10 years before it seemed to be misappropriated from of the Complainant. Although the Complainant was not able to prove that the Respondent is responsible for this misappropriation, the fact that other domain names appear to have been misappropriated as well and redirect to the same web page as the one currently linked to the disputed domain name strongly suggests that the Respondent is at least related to some kind of domain name hijacking scheme.

Although the disputed domain name is solely composed of descriptive or geographical terms and could therefore be subject to good faith use unrelated to the Complainant, the Panel finds that in the circumstances of this case, the Respondent’s use of the disputed domain name does not fall into that category. In the Panel’s view, there are indications that the Respondent registered and used the disputed domain name to make a commercial profit from the associated Internet traffic that was generated when the disputed domain name was linked to the Complainant's website.

Finally, the Respondent did not formally take part in the administrative proceedings and appears to have provided a false name. According to the Panel, this serves as an additional indication of the Respondent’s bad faith.

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the disputed domain name was registered and is being used in bad faith. In light of the above, the Complainant also succeeds on the third and last element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **investinstlouis.com**: Transferred

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2024-06-03

Publish the Decision