# Decision for dispute CAC-UDRP-106659

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| Case number | CAC-UDRP-106659 |
| Time of filing | 2024-07-02 10:01:46 |
| Domain names | soundeon.com |

## Case administrator

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

## Complainant

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| Organization | Proper Partners LLC |

## Complainant representative

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| Organization | Dimov Internet Law Consulting |

## Respondent

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| Name | Aleksejs Nikitins |

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 United States registered trademark SOUNDEON, registration number 5,613,625 registered on the Principal Register on November 20 2018 for services in international class 42.

FACTUAL BACKGROUND

The Complainant provides services hosting of computer applications for clients using the SOUNDEON trademark and service mark in which it claims registered rights established by its ownership of the United States trademark registration described above.

The disputed domain name was registered on January 15, 2018.

The Complainant’s registered its SOUNDEON service mark registered on November 20, 2018.

The disputed domain name was updated on January 16, 2024.

The Complainant has adduced uncontested evidence archived in the WayBack Machine, that it controlled and used the disputed

domain name as its website address in the years 2018 and 2020.

The Complainant has also adduced uncontested evidence that on 25 June 2024, the Respondent caused or permitted the disputed domain name to resolve to a website that was almost identical to the Complainant's archived website and purported to offer the disputed domain name for sale to the public for USD $250.00.

There is no information available about the Respondent except for that provided in the Complaint, the Registrar's WhoIs and the information provided by the Registrar in response to the request by the Center or details of the registration of the disputed domain name in the course of this proceeding.

PARTIES CONTENTIONS

**The Complainant**

The Complainant claims rights in the SOUNDEON mark established by its ownership of the abovementioned United States registered service mark and contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

The Complainant firstly alleges that the disputed domain name is identical or confusingly similar to the SOUNDEON mark.

It is argued that for the purpose of determining whether the disputed domain name is confusingly similar to the Complainant's trademark, the generic Top Level Domain ("gTLD") <.com> is inconsequential. According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), section 1.11, the applicable Top Level Domain ("TLD") in a domain name (e.g., <.com>, <.club>, <.nyc>) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

The Complainant next alleges that the Respondent has no rights or legitimate interests in the disputed domain name explaining that the disputed domain name was initially purchased and managed by the representative of the Complainant identified in an annex to the Complaint.

The Complainant adds that due to an oversight, the registration of the disputed domain name was allowed to lapse when it expired, becoming available for purchase by the Respondent. In support of this assertion the Complainant has provided copies of purchase receipts of the disputed domain name illustrating that the Complainant owned the disputed domain name within the time period between 2018 and 2022.

In arguing that the Respondent has no rights or legitimate interests in the disputed domain name the Complainant further submits and alleges that:

- the disputed domain name has not been used by the Respondent in connection with a bona fide offering of goods and services;
- the Respondent used the unintentional expiration to register the disputed domain name it in order to sell it for a minimum price of USD 250 as shown in a screen capture of the website to which the disputed domain name resolves which is exhibited in an annex to the Complaint;
- furthermore, as shown by a comparison of screen captures of an archive page from the Complainant's website when it controlled the disputed domain name in 2018 and 2020, and the website to which the disputed domain name resolved on 25 June 2024 when controlled by the Respondent, which are exhibited in an annex to the Complaint, the Respondent has used the disputed domain name for the purposes of infringing on the copyright and the trademark rights of the Complainant;
- the Complainant adds, referring to a screen capture exhibited in an annex to the Complaint that it has found clear evidence showing that the current website of the Respondent associated with the disputed domain name includes source code copied from the Complainant's Internet archive webpage associated with the Complainant's website;
- the Respondent is not commonly known by the disputed domain name, as a legal or a natural person cannot become known through the unlawfully replicating the website of another person and using the trademark of the replicated website;
- the aforementioned observations clearly indicate that the disputed domain name is not and has not been used in connection with a bona fide offering of goods or services, but on the contrary, it is used for mala fide purposes, i.e., a copyright and trademark infringement;
- the Respondent does not have any trademarks corresponding to the disputed domain name;

- a screen capture of the Registrar's website on Tuesday 25 June 2024 shows that the disputed domain name was offered for sale to the public for USD$250 on that date;
- it is therefore clear that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Complainant next alleges that the disputed domain name was registered and is being used in bad faith, and its principal arguments are as follows:

The Complainant's SOUNDEON trademark was registered in 2018, however the Respondent obtained the disputed domain name in 2022, so it follows that at the time of registering the disputed domain name, the Respondent was or should have been aware of the Complainant's mark.

The copyright and trademark infringements illustrated by the exhibited screen captures of the Complainant's archived website and the website to which the disputed domain name currently resolves, also clearly demonstrate that the Respondent was aware of the Complainant's mark at the time when the Respondent registered the disputed domain name.

By publishing an unauthorized copy of the Complainant's website, it is clear that the Respondent is wilfully, knowingly, and openly attempting to attract, users to its website for commercial gain, by creating a likelihood of confusion with the Complainant's SOUNDEON mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or the products or services provided through that website.

**The 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

**Identical or Confusingly Similar**

The Complainant has provided uncontested convincing evidence of its rights in the SOUNDEON mark established by its the ownership of the abovementioned United States service mark registration.

The disputed domain name <soundeon.com> consists solely of the Complainant's mark in its entirety and the Top Level Domain (" gTLD") extension <.com>.

In the circumstances of this Complaint the gTLD extension <.com> within the disputed domain name may be ignored for the purposes of comparing the mark and the disputed domain name, and therefore does prevent a finding that the disputed domain name is identical to the Complainant's mark.

This Panel finds therefore that the disputed domain name is identical to the SOUNDEON mark in which the Complainant has rights and Complainant has therefore succeeded in the first element of the test in Policy paragraph 4(a)(i).

**Rights or Legitimate Interests**

In its Complaint, Complainant has made out a prima facie case that the Respondent has no rights legitimate interests in the disputed domain names as set out in Complainant's detailed submissions above.

It is well established that once a complainant makes out a prima facie case that a respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts to the respondent to prove its rights or legitimate interests.

Respondent has failed to discharge that burden and therefore this Panel must find that Respondent has no rights or legitimate interests in the disputed domain name.

Complainant has therefore succeeded in the second element of the test in Policy paragraph 4(a)(ii).

**Bad Faith**

The disputed domain name was registered on January 15, 2018.

The Complainant's registered its SOUNDEON service mark registered on November 20, 2018.

The disputed domain name was updated on January 16, 2024.

The Complainant has adduced uncontested evidence archived in the WayBack Machine, that it controlled and used the disputed domain name as its website address in the years 2018 and 2020.

The Complainant has also adduced uncontested evidence that on 25 June 2024, the Respondent caused or permitted the disputed domain name to resolve to a website that was almost identical to the Complainant's archived website and purported to offer the disputed domain name for sale to the public for USD $250.00.

This Panel finds therefore that the Complainant's submission that the Respondent was aware of the Complainant and its rights in the SOUNDEON mark when the disputed domain name was updated on January 16, 2024.

The WIPO Jurisprudential Overview 3.0 is relevant here, and states:

"3.9 Can the respondent's renewal of its domain name registration support a finding of (registration in) bad faith?

Where the respondent provides satisfactory evidence of an unbroken chain of possession, panels typically would not treat merely "formal" changes or updates to registrant contact information as a new registration.

Also, irrespective of registrant representations undertaken further to UDRP paragraph 2, panels have found that the mere renewal of a domain name registration by the same registrant is insufficient to support a finding of registration in bad faith.

On the other hand, the transfer of a domain name registration from a third party to the respondent is not a renewal and the date on which the current registrant acquired the domain name is the date a panel will consider in assessing bad faith. This holds true for single domain name acquisitions as well as for portfolio acquisitions.

In cases where the domain name registration is masked by a privacy or proxy service and the complainant credibly alleges that a relevant change in registration has occurred, it would be incumbent on the respondent to provide satisfactory evidence of an unbroken chain of registration; respondent failure to do so has led panels to infer an attempt to conceal the true underlying registrant following a change in the relevant registration. Such an attempt may in certain cases form part of a broader scenario whereby application of UDRP paragraph 4(b)(iv), read in light of paragraph 4(a)(ii), can support an inference of bad faith registration for the respondent to rebut."

The Respondent has availed of a privacy service; and the Complainant has adduced uncontested evidence that the disputed domain name resolves to a website with content that purports to mimic the Complainant's website, and to impersonate the Complainant, while offering the disputed domain name for sale on the Registrar's website for USD $ 250.

Adopting the approach taken by panelists in similar circumstances as stated in paragraph 3.9 of the WIPO Jurisprudential Overview 3.0, this Panel finds therefore that on the balance of probabilities the Respondent registered the disputed domain name in bad faith on January 16, 2024 when the registration of the disputed domain name was updated.

Furthermore, the Respondent's use of the disputed domain name to resolve to a website which purports to be hosted by the Complainant, while using content taken from the Complainant's archived website, while offering the disputed domain name for sale for USD  250 which on the balance of probabilities is a sum in excess of the Respondent's out-of-pocket costs directly related to the domain name. Such use of the disputed domain name constitutes use in bad faith for the purposes of the Policy.

This Panel finds therefore that the disputed domain name was registered and is being used in bad faith and Complainant has succeeded in the third element of the test in Policy paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **soundeon.com**: Transferred

## PANELLISTS

| Name | **James Bridgeman** |
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DATE OF PANEL DECISION 2024-07-30

Publish the Decision