

ADMINISTRATIVE PANEL DECISION

Documo Inc. v. Matthew Herrera (now known as Matthew Valeo)
Case No. DIO2023-0024

1. The Parties

The Complainant is Documo Inc., United States of America ("United States"), represented Morris, Manning & Martin, LLP, United States.

The Respondent is Matthew Herrera (now known as Matthew Valeo), United States.¹

2. The Domain Names and Registrar

The disputed domain names <mfax.io> and <msign.io> are registered with NameCheap, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 18, 2023. On July 20 and 26, 2023, the Center transmitted by email to the Registrar requests for registrar verification in connection with the disputed domain names. On July 20 and 26, 2023, the Registrar transmitted by email to the Center its verification responses disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Matt Valeo) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 26, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on July 26, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the .IO Domain Name Dispute Resolution Policy (the "Policy"), the Rules for .IO Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for .IO Domain Name Dispute Resolution Policy (the "Supplemental Rules").

¹ The Complainant asserted, and such assertion has not been disputed, that Matthew Herrera and Matthew Valeo are the same person. This is a sufficient basis to consolidate the two disputed domain names into one matter. For purposes of clarity, the Registrar is ordered to transfer the disputed domain names to the Complainant whether the listed registrant's name for such disputed domain name is Matthew Herrera or Matthew Valeo.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 17, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 18, 2023.

The Center appointed Evan D. Brown as the sole panelist in this matter on August 22, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is in the business of providing software for document workflow. The Complainant asserts that it has used the mark MSIGN since at least as early as 2018, that it has used the mark MFAX since at least as early as 2017, and that it has continuously used these marks in commerce since such times. The Complainant asserts that its services are used by more than 4,000 customers, including by well-known companies.

Additionally, the Complainant asserts that it has spent nearly USD 2 million since the company's inception on advertising the services provided under its marks. Further, the company has provided evidence that the marks are well-recognized in the marketplace, as shown from Internet search results and coverage of the services and the marks in relevant online press and media.

The Respondent was an officer of the Complainant from 2017 to 2022, serving as the CEO. According to the Complainant, the Respondent registered the disputed domain names using his personal name and information, rather than in the Complainant's name, without the knowledge or consent of the Complainant.

The disputed domain name <mfax.io> was registered on May 18, 2017 and the disputed domain name <msign.io> was registered on September 12, 2018. The disputed domain names resolve to the Complainant's websites for MFAX and MSIGN products respectively.

Despite being registered in the Respondent's name, payment for renewal of the disputed domain names has occurred using the Complainant's credit card.

In connection with a sale of the company's stock in December 2021, the Respondent executed an agreement wherein the Respondent asserted that the disputed domain names were owned by the Complainant.

The Respondent resigned from the Complainant on September 30, 2022. But upon his resignation, he did not provide access to the disputed domain names.

The Complainant has sought to obtain the disputed domain names from the Respondent without success.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain names are identical or confusingly similar to the Complainant's trademarks; that the Respondent has no rights or legitimate interests in respect of the disputed domain names; and, that the disputed domain names were registered or are being used in bad faith.

B. Respondent

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

6. Discussion and Findings

The Panel draws on decisions and principles established under the Uniform Domain Name Dispute Resolution Policy ("UDRP") since requirements under the Policy are similar and prior panels have seen fit to draw on this jurisprudence. See, e.g., *International Business Machines Corporation v. Murat Satir*, WIPO Case No. [DIO2021-0001](#) ("As will be appreciated, [the Policy] requirements are very similar to the requirements under the [UDRP] save that, in particular, it is necessary for the Complainant to establish only that the disputed domain name was registered in bad faith or is being used in bad faith").

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain names are 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 names, and (iii) the disputed domain names have been registered or are being used in bad faith. The Panel finds that all three of these elements have been met in this case.

A. Identical or Confusingly Similar

This first element under the Policy requires the Panel to determine whether the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant has not asserted that it owns registrations for the marks MSIGN and MFAX, and the Panel has found no such registrations in the records of the United States Patent and Trademark Office. Accordingly, the validity of the Complainant's assertions of trademark rights depends on whether it can show it has rights in these unregistered marks.

To establish unregistered or common law trademark rights for purposes of the UDRP, a complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.3.

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, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys. *Id.*

Based on the nature and extent of the use of the MSIGN and MFAX marks as asserted by the Complainant (and not disputed by the Respondent), the Panel finds that the Complainant has rights in these unregistered marks.

The disputed domain names incorporate the MSIGN and MFAX unregistered marks in their entirety. This is sufficient for showing that the disputed domain names are identical to these unregistered marks under the Policy.

Accordingly, the Panel finds that the Complainant has established this first element under the Policy.

B. Rights or Legitimate Interests

The evidence before the Panel demonstrates a *prima facie* case that the Respondent retains no rights or legitimate interests in the disputed domain names, and the burden of production of evidence shifts to the Respondent. The Respondent has provided no response to the Complainant's assertions that the disputed

domain names have at all relevant times been considered by the Complainant as assets of the Complainant. The Respondent admitted as much in the course of his performance of his duties as CEO during a stock transaction. The Respondent resigned from the Complainant and there is no basis in the record for showing that the arrangement between the Complainant and the Respondent provided for him to retain ownership or any other rights in the disputed domain names.

Accordingly, the Panel finds that the Complainant has satisfied this second element under the Policy.

C. Registered or Used in Bad Faith

The Policy differs from the UDRP in an important respect, one that is particularly germane to this case. Though the UDRP requires a complainant to show that a disputed domain name was registered and is being used in bad faith, the Policy requires only that either of these things be shown.

In this case, the Panel finds that the disputed domain names have been used in bad faith. The Respondent is continuing to exercise bad faith by refusing to relinquish control over the disputed domain names to the Complainant, effectively prohibiting the Complainant from having control over its company websites. See *Blue On Highland LLC v. Matthew Sullivan*, WIPO Case No. [D2021-3168](#) (“Respondent acted opportunistically and in bad faith when he registered the disputed domain name in his personal name, assumed control of the disputed name and later refused to take steps to transfer the disputed domain name to Complainant when asked to do so.”).

The Panel finds that the Complainant has satisfied this third element under the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain names, <mfax.io> and <msign.io>, be transferred to the Complainant.

/Evan D. Brown/

Evan D. Brown

Sole Panelist

Date: September 6, 2023