

ADMINISTRATIVE PANEL DECISION

Great Clips, Inc. v. Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico
Case No. D2022-0381

1. The Parties

The Complainant is Great Clips, Inc., United States of America (“United States” or “U.S.”), represented by Greenberg Traurig, LLP, United States.

The Respondent is Domains By Proxy, LLC, United States / Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

2. The Domain Name and Registrar

The disputed domain name <greatclips.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 3, 2022. On February 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 7, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the disputed domain name.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 9, 2022.

The Center appointed David Stone as the sole panelist in this matter on March 14, 2022. 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 Great Clips, Inc. and is a hair salon brand with more than 4,400 hair salons, including locations in all 50 states of the United States and in Canada. The Complainant's business was founded in 1982 and employs nearly 40,000 stylists in more than 180 markets, and serving approximately 2 million customers per week.

The Complainant owns the following registered trade marks (the "Marks"), among others:

- GREAT CLIPS (word), U.S. registration No. 1341594 registered on June 11, 1985, in Nice class 42;
- GREAT CLIPS (word), U.S. registration No. 6446634 registered on August 10, 2021, in Nice class 03; and
-  U.S. registration No. 4048419 registered on November 01, 2011, in Nice class 44.

The Complainant also owns the website located at "www.greatclips.com", which features general and promotional information about the Complainant's services and products.

The disputed domain name was registered on December 14, 2021, and used to resolve to a site with pay-per-click ("PPC") links to third party sites.

On January 14, 2022, the Complainant sent a cease-and-desist letter to the Respondent, setting out the Complainant's rights in the Marks and demanding that the Respondent cease all use of the Marks and immediately transfer the disputed domain name to the Complainant. The Respondent did not respond to the Complainant's letter.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's Marks. Disregarding the Top-Level Domain ("TLD") ".com", the disputed domain name differs from the word Marks only by the inclusion of the letter "l" between the words "great" and "clips". The Complainant submits that the Respondent undoubtedly selected the nearly identical disputed domain name as it is a common misspelling of the Marks and Internet users may advertently insert an extra letter "l" before the word "clips".

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant is not aware of any evidence that the Respondent is commonly known by the disputed domain name. The Complainant submits that the Respondent has not used or prepared to use the disputed domain name in connection with a *bona fide* offering of goods or services, and instead the Respondent is using the disputed domain name to divert Internet traffic to various websites. The Complainant has not authorized the Respondent to make use of its Marks. The Complainant further contends that the fact that the Respondent is offering the disputed domain name for sale at a domain name marketplace does not create rights and legitimate interests under the Policy.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. The Complainant's Marks are well-known and the Complainant's registration and use of the Marks long predate the registration of the disputed domain name and therefore establishes an inference of the Respondent's prior knowledge of the Marks and suggests opportunistic bad faith. Additionally, the Respondent registered the disputed domain name through a privacy service which the Claimant contends further demonstrates bad faith of use and registration. The Complainant also submits that the Respondent's

use of the disputed domain name is in bad faith because the Respondent is redirecting Internet traffic to deceptive offers to download malware and/or to PPC or affiliate advertising pages linking to websites which offer hair salon services that are directly competitive with those offered by the Complainant. Additionally, the Complainant contends that the fact that the Respondent is offering the disputed domain name for sale at a domain name marketplace also constitutes bad faith registration and use of the disputed domain name. Finally, the Complainant submits that the disputed domain name also has active mail exchange ("MX") records, which evidences a likelihood of additional bad-faith use of the disputed domain name to engage in fraudulent email or phishing communications.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets out the three requirements that the Complainant must prove in order to succeed:

- (i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

On the evidence provided by the Complainant, the Panel is satisfied that the Complainant has rights in the Marks. As the Complainant contends, it is not necessary that the Complainant has trade mark registrations in Panama, where the Respondent is purportedly located to demonstrate its rights; rather, the Complainant's registrations of the Marks in the U.S. and other countries are sufficient to demonstrate its trade mark rights (see *Koninklijke KPN N.V. v. Telepathy Inc.*, WIPO Case No. [D2001-0217](#)).

In assessing similarity between the Marks and the disputed domain name, it is permissible to ignore the TLD ".com". As the Complainant contends, the disputed domain name consists of a common, obvious, or intentional misspelling of the Marks. The disputed domain name is almost identical to the Marks, and it only differs by the inclusion of the letter "l" between the words "great" and "clips", which is considered by the Panel to be confusingly similar to the Marks (see section 1.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel concludes that the condition in paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out the criteria that determine whether a domain name registrant has rights or legitimate interests in a domain name:

- (i) before any notice to the Respondent of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent (as an individual, business or other organisation) has been commonly known by the disputed domain name, even if the Respondent has acquired no trade mark or service mark rights; or

(iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain misleadingly to divert consumers or to tarnish the trade mark or service mark at issue.

The Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. Accordingly, the burden shifts to the Respondent to prove that such rights and interests do exist. The Respondent has provided no evidence to prove this.

On the facts before the Panel, the Respondent has not demonstrated that it is commonly known by the disputed domain name, nor that it has been authorised to use the Complainant's Marks. The Respondent has not demonstrated use, or preparations for use, of the disputed domain name in connection with a *bona fide* offering of goods or services. Further, the Respondent has submitted no evidence to prove its legitimate noncommercial or fair use.

The Panel therefore finds that there is no legitimate reason for the Respondent to choose the disputed domain name.

The Panel concludes that the condition in paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out the non-exhaustive criteria for bad faith. Generally, for the purposes of the Policy, bad faith constitutes registration and use of a domain name in order to:

- (i) sell, rent or transfer the domain name to the trade mark owner (or a competitor thereof) for a profit; or
- (ii) prevent the trade mark owner from registering its trade mark in a domain name, provided that the respondent is engaged in a pattern of such conduct; or
- (iii) disrupt the business of a competitor; or
- (iv) divert Internet traffic for commercial gain.

On the evidence put forward by the Complainant, both the registration of the disputed domain name and the use to which it has been put indicate bad faith on the part of the Respondent.

In relation to bad faith registration, the Complainant's registration of the Marks significantly predates the registration of the disputed domain name. The disputed domain name is almost identical to the Marks and the Complainant's own website, creating a composition that effectively impersonates the Complainant. On this basis, the Panel finds that the Respondent was well aware of the Complainant's Marks at the time of registration.

In terms of bad faith use, the disputed domain name is currently being used by the Respondent to redirect Internet traffic to deceptive offers to download malware and/or to PPC or affiliate advertising pages linking to websites which offer hair salon services that are directly competitive with those offered by the Complainant. It is inherently an act of bad faith to redirect Internet users to a third party website containing malware (see *Royal Caribbean Cruises Ltd. v. Domains By Proxy, LLC / Carolina Rodrigues*, WIPO Case No. [D2019-2049](#)). The disputed domain name also has active MX records which indicate that the disputed domain name may be used for fraudulent email communications.

Finally, the Panel finds that the Respondent's pattern of prior bad faith registration of domain names utilising well-known trade marks in which the Respondent has no rights or legitimate interests, provides further evidence of Respondent's bad faith registration and use of the disputed domain name in this case. The Respondent has continued to engage in an extensive pattern of bad faith registration and use of domain names targeting well-known trade marks, with there being over 200 prior Panel decisions under the Policy against the Respondent.

The Panel concludes that the condition in paragraph 4(a)(iii) of the Policy is satisfied.

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 name, <greatclips.com> be transferred to the Complainant.

/David Stone/

David Stone

Sole Panelist

Date: March 29, 2022