

ADMINISTRATIVE PANEL DECISION

Minnow IT Ltd v. Domains By Proxy, LLC / David Hanley
Case No. D2022-0600

1. The Parties

The Complainant is Minnow IT Ltd, United Kingdom, represented by Veale Wasbrough Vizards, United Kingdom.

The Respondent is Domains By Proxy, LLC, United States of America (“United States”) / David Hanley, United States, represented by Yoffe & Cooper, LLP, United States.

2. The Domain Name and Registrar

The disputed domain name <foldr.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 17, 2022. On February 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 22, 2022, the Registrar transmitted by email to the Center its verification response;

- (a) confirming it is the Registrar for the disputed domain name;
- (b) disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint; and
- (c) confirming that English is the language of the registration agreement.

The Center sent an email communication to the Complainant on March 1, 2022, 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 March 4, 2022.

The Center verified that the Complaint together with the amended 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 March 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 28, 2022. On March 29, 2022, the Respondent requested an extension of time in which to file a Response. Later that day, the Center granted the Respondent an automatic four-day extension, thereby making the due date for the Response April 1, 2022. The Complainant submitted a supplemental filing on March 31, 2022. The Response was filed with the Center on April 1, 2022. The Complainant submitted another supplemental filing on April 8, 2022.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on April 11, 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.

On May 3, 2022, the Panel issued Procedural Order No. 1 inviting the Respondent to submit any comments in answer to the Complainant's supplemental filings. On the same date, the Respondent confirmed that it was happy with its response.

4. Factual Background

The Complainant is a company with its headquarters in the United Kingdom. It provides services relating to online and on-site computer file management and related matters. According to the Complaint, it has been doing so under and by reference to the trademark FOLDER since 2012.

The Complainant's main website is hosted at "www.foldr.io". It does have a number of other domain names as well including <foldr.cloud>, <foldr.com.au>, <foldrhq.co>, <foldrhq.net>, <foldrhq.com>, <foldrhq.uk>, and <foldrhq.co.uk>.

The Complainant owns a number of registered trademarks:

- (a) European Union Trade Mark (EUTM) No. 011559168, FOLDER, which has been registered since June 14, 2013, with effect from February 8, 2013 in respect of a range of computer, computer software and Internet related goods and services in International Classes 9, 35, 38 and 42;
- (b) United Kingdom Registered Trademark No. UK00911559168, FOLDER, which has been derived from the EUTM; and
- (c) United States Registered Trademark No. 4,603,405, FOLDER, which has been registered since September 9, 2014, in the Supplemental Register in respect of a similar wide range of computer, computer software and Internet related goods and services but in International Classes 9, 38 and 42 only.

The disputed domain name was first registered on September 19, 2004. On October 20, 2021, the Complainant was approached by a Tom Brandes, who was a premium domain broker at Sedo.com, to inquire if the Complainant was interested in acquiring the disputed domain name for USD 14,000. The Respondent, however, became the registrant in late October or November 2021 when he "bought" it through some form of sale process. The price paid has not been disclosed.

As at November 3, 2021, the disputed domain name resolved to a parking page provided by Namecheap which included pay-per-click (PPC) links to file sharing services and the message "This name was recently registered at Namecheap.com. Please check back later."

As at January 31, 2022, the disputed domain name resolved to a webpage which stated "This domain name is for sale." and included a contact form to be completed for inquiries. No price was stated. A Whois search on that date stated an asking price of USD 92,000. A listing on Afternic.com, however, showed the asking price as USD 80,000.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

A. Supplemental Filings

The Complainant has submitted two supplemental filings. The first was submitted after the identity of the Respondent was disclosed in response to the request for Registrar verification and after the Respondent's email of March 29, 2022, requesting an extension of time in which to file a Response. The second was submitted after receipt of the Response.

Apart from documents requested by the Panel pursuant to paragraph 12 of the Rules, neither the Policy nor the Rules expressly provide for supplemental filings. Their admissibility is therefore in the discretion of the Panel bearing in mind the requirements under paragraph 10 of the Rules to ensure that the proceeding is conducted with due expedition and both parties are treated equally, with each party being given a fair opportunity to present its case.

Where unsolicited supplemental filings are admitted, it is usually because the material corrects some error or addresses something raised in a Response which could not reasonably have been anticipated or which was not otherwise appropriate to deal with until a respondent's position on a particular point was clear.

The materials submitted by the Complainant are relevant to the matters in issue in the proceeding. To a considerable extent they arise out of claims made in the Response or the disclosure of the Respondent's identity behind the privacy shield.

The Respondent is represented in the proceeding by legal counsel and, as discussed below, has experience in proceedings under the Policy. Neither he nor his counsel have claimed any prejudice arising from or objected to the admission of the supplemental filings.

Having regard to all these matters, therefore, the Panel proposes to admit the supplemental filings into the record.

B. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of the registered trademarks for FOLDR identified in section 4 above.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of “likelihood of confusion” under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top-Level Domain (“gTLD”) component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the “.com” gTLD, therefore, the disputed domain name is identical to the Complainant’s trademark.

Accordingly, the Panel finds that the requirement under the first limb of the Policy is satisfied.

C. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed 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 organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark 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 to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The disputed domain name is not derived from the Respondent’s name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain name could be derived. From the available record, the Respondent does not appear to hold any trademarks for the disputed domain name.

The Respondent became the registrant of the disputed domain name a number of years after the Complainant had registered its trademark and also after the Complainant began using its trademark.

The Respondent does not dispute any of these matters which are ordinarily sufficient to raise a *prima facie* case that the Respondent does not have rights or legitimate interests in the disputed domain name.

The Respondent, however, denies knowledge of the Complainant.

He points out that the Complainant's trademarks do not give it exclusive rights in relation to the classes of goods and services which are not covered by those trademarks. The Respondent appears to claim that he registered the disputed domain name as he had ideas to use it for a website perhaps for a device for folding clothing, or a band or a cooking implement. He points out further that the disputed domain name is an ordinary word in English with the "e" omitted and says there are many such domain names registered uncontroversially such as <powr.com>, <winnr.com>, and <playr.com>. Thus, the Respondent claims the disputed domain name has value unrelated to the Complainant.

To the extent that the Respondent may be claiming he registered the disputed domain name in connection with some proposed website for a device for folding clothing, a band or cooking implement, that claim cannot be accepted.¹ It is simply a bare assertion unsupported by any contemporaneous evidence of those plans. See e.g. [WIPO Overview 3.0](#), section 2.2.

Those plans (if that is what is being claimed) are also inconsistent with the fact that the disputed domain name has been offered for sale throughout the period the Respondent has been the registrant.

In section 2.10.1 of the [WIPO Overview 3.0](#), it is noted that merely registering a domain name comprised of a dictionary word does not automatically confer rights or legitimate interests. Generally speaking, there must be a demonstration of genuine use, or a demonstrated intention so to use, in connection with the asserted dictionary meaning. The [WIPO Overview 3.0](#) gives as an example of the different outcomes use of "orange" in respect of the fruit (which is legitimate) or a use which targeted telecommunications services (which would not have been legitimate at the time if not associated the telecommunications provider).

In the present case, the Respondent denies that any of the offers to sell the disputed domain name made while he has controlled it have targeted the Complainant or its trademark and points out that he did not approach the Complainant with an offer to sell (until the Complaint was filed and, even then, he merely pointed out that the Complainant had not sought to buy the disputed domain name).

Against this claim must be set the very high price which the Respondent is seeking for the disputed domain name. That is the only use the Respondent appears to have made of the disputed domain name.

The evidence submitted by the Complainant includes evidence of a Reverse Whois search which shows that the Respondent holds over 3,000 domain names. Many (if not all) are merely offered for sale. At least some are descriptive terms. Others are trademarks or the names of celebrities or corporate organisations. For example, <335i.com>, <alanismorriset.com>, <alcantargroup.com>, <algorithmllc.com>, and <aliceagroup.com> all of which, like the disputed domain name, are offered for sale through GoDaddy and Afternic.

There is also evidence that a Google search shows results on the first page connected with either (1) the Haskell programming language – in which "foldr" appears to be a programming function or command and (2) the Complainant's service.

¹ In the letter to the Center requesting an extension of time, legal counsel then acting for the Respondent stated "Mr. Hanley bought the domain "foldr.com" on the open market in late 2021, and intends to use it to market a clothes folding device." (original emphasis). The Response itself is more ambiguous and refers to the wider range of possibilities.

It does not seem at all likely to the Panel that the price being sought by the Respondent reflects the programming language usage or, having regard to the matters discussed in section 5D below, otherwise than by reference to the Complainant's adoption of its trademark.

Panels have frequently held that demands for such high prices by domainers indicate a lack of rights or legitimate interests and registration in bad faith. See *e.g.*, *WesTrac Pty Ltd v. Domain Asset Holdings, LLC*, WIPO Case No. [D2014-2032](#), *Tracy Anderson Mind and Body LLC v. Domain Asset Holdings*, WIPO Case No. [D2013-0699](#), *Arne Jacobsen Design I/S v. Domain Administrator, DomainMarket.com*, WIPO Case No. [D2017-0552](#), and *Supermac's (Holdings) Limited v. Domain Administrator, DomainMarket.com*, WIPO Case No. [D2018-0540](#).

That is particularly the case where the respondent, as is the Respondent in this case, is engaged in a business of buying and selling domain names.

In these circumstances, therefore, the Panel finds that the Complainant has established the Respondent does not have rights or legitimate interests in the disputed domain name under the Policy.

Accordingly, the Complainant has established the second requirement under the Policy.

D. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see *e.g. Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

The Complainant notes it has been using its trademark since late 2012 in Europe (including the United Kingdom) and the United States. It contends that prior to the Respondent registering the disputed domain name the only use captured by the Wayback Machine over many years was for a website relating to the mathematical or programming function. The domain broker that contacted the Complainant before the Respondent became the registrant sought a price of USD 14,000. Then, the Complainant points to the high price being sought by the Respondent for the disputed domain name – depending on the service and timing between USD 80,000 to USD 92,000.

As already noted in section 5C above, the Respondent denies knowledge of the Complainant or its trademark. The Respondent emphasises the descriptive nature of the word “folder”, the specific nature of the goods and services for which the Trademark is registered meaning that there is (he contends) very wide scope for the disputed domain name to be used in connection with non-infringing activity. The Respondent also contends that he has not targeted the Complainant in any way.

The Panel accepts that “folder” is an ordinary word in English and is prepared to treat “foldr” as effectively the same although one would expect that someone who did wish to use the word “folder” for its ordinary meaning would also use the correct spelling.

The Panel also is not in any position to know whether the Respondent did, or did not, know of the Complainant and its trademark when he registered the disputed domain name. In *Supermac's (Holdings) Limited v. Domain Administrator, DomainMarket.com* WIPO Case No. [D2018-0540](#), the panelist pointed out that panels under the Policy have approached the issue of knowledge *objectively* and not just on the basis of the respondent's subjective knowledge. Thus, [WIPO Overview 3.0](#), section 3.2.3 notes that a respondent who fails to screen potential domain names against available online databases will be responsible for a resulting abusive registration. In the *Supermacs* case, above, the fact that the disputed domain name was

obtained through a “drop-catching” process was an important consideration in finding the respondent was on notice. The present proceeding does not appear to involve drop-catching. As the [WIPO Overview 3.0](#) at section 3.2.3 notes, however, panels have considered there is an affirmative obligation to avoid abusive registrations. This obligation has not been limited merely to domainers and has not required an intentional failure to search.

In the present case, the Respondent is in a business of buying and selling domain names. He has also been involved in a number of disputes under the Policy where he has been found to have registered domain names in bad faith. The Complainant has identified the following disputes:

(a) *Mahendra Singh Dhoni and Rhiti Sports Management Private Limited v. David Hanley*, WIPO Case No. [D2016-1692](#), <msdhoni.com>, Transfer

(b) *The Football Association Premier League Limited v. David Hanley*, WIPO Case No. [D2012-1255](#), <premierleaguetelevision.com>, Transfer

(c) *AOL LLC v. David Hanley*, National Arbitration Forum Claim Number FA0912001297790, Transfer

(d) *The Royal Bank of Scotland Group plc v. David Hanley*, National Arbitration Forum Claim Number: FA0912001300076, Transfer.

The Respondent is also offering for sale other domain names which appear to implicate trademark rights.

Given the nature of the Respondent’s business, he was or should have been aware of the risk of a domain name conflicting with someone else’s trademark. If he did not undertake appropriate searches, therefore, he ran the risk the disputed domain name would conflict with someone else’s rights and should bear the consequences of that risk taking. In the absence of an explanation about how he arrived at the price the disputed domain name is being offered for sale, it is difficult to accept that he was unaware of the Complainant and its trademark (bearing in mind the caveat about subjective knowledge already mentioned). In the absence of that explanation and bearing in mind the price sought from the Complainant by the domain broker in October 2021, the high price the Respondent is asking for the disputed domain name indicates a recognition of its trademark significance and, being otherwise unexplained, appears to take advantage of that trademark.

Further, as the Complainant contends, there is evidence the Respondent has engaged in a pattern of registering abusive names.

Accordingly, having regard to these matters and bearing in mind the finding that the Respondent does not have rights or legitimate interests in the disputed domain name the Panel finds that the Complainant has established the Respondent registered and is using the disputed domain name in bad faith contrary to the Policy.

6. 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, <foldr.com>, be transferred to the Complainant.

/Warwick A. Rothnie/
Warwick A. Rothnie
Sole Panelist
Date: May 4, 2022