

## **ADMINISTRATIVE PANEL DECISION**

**Pexco LLC v. Super Privacy Service LTD c/o Dynadot / Oliver George**  
Case No. D2022-0660

### **1. The Parties**

The Complainant is Pexco LLC, United States of America (“United States”), represented by Nelson Mullins Riley & Scarborough, L.L.P., United States.

The Respondent is Super Privacy Service LTD c/o Dynadot, United States / Oliver George, Turkey.

### **2. The Domain Name and Registrar**

The disputed domain name <pexcobrand.com> (the “Domain Name”) is registered with Dynadot, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 25, 2022. On February 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 28, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. 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 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 1, 2022.

The Center appointed Jon Lang as the sole panelist in this matter on April 8, 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 was founded in 2009 and is a North American leader in the design and fabrication of specialty plastic products with multiple manufacturing plants across the United States and Mexico. It is the owner of the PEXCO trademark. Whilst founded in 2009, through its various predecessors in interest, the Complainant first adopted the PEXCO trademark in connection with electrical insulation and plastic tubing for medical equipment on November 29, 1961, and has been using the PEXCO trademark in commerce ever since.

As a result of the Complainant's extensive, continuous and substantial investment in and use of the PEXCO trademark in commerce, it has acquired substantial reputation and goodwill in the marketplace which consumers recognize as belonging exclusively to the Complainant. In order to fully protect such reputation and goodwill associated with its trademark, the Complainant applied for, and obtained, a United States federal trademark registration for the PEXCO trademark, namely, United States Registration Number 2581523 (issued on June 18, 2002). The Complainant's common law and registered rights in the PEXCO trademark are hereinafter referred to as the "PEXCO Mark."

The Complainant also owns the <pexco.com> domain name registered (through its predecessors in interest) on June 11, 1997. The Complainant and its predecessors in interest have continuously used this domain name to host and operate the Complainant's website.

The Respondent registered the Domain Name on February 8, 2022.

To the best of the Complainant's knowledge, the Respondent has only ever used the Domain Name to redirect visitors to a Dan.com webpage where the Respondent is soliciting offers to purchase the Domain Name.

#### **5. Parties' Contentions**

##### **A. Complainant**

The following is a brief summary of the main assertions of the Complainant.

The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The Complainant clearly has rights in the PEXCO Mark. The Domain Name incorporates the entirety of the PEXCO Mark and also includes the descriptive/generic term, "brand".

If a domain name wholly incorporates a complainant's trademark, that is sufficient evidence that the domain name is identical or confusingly similar. Where the relevant trademark is recognizable within the domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity. Here, there can be no question that the Domain Name is confusingly similar to the Complainant's well-known, distinctive and coined PEXCO Mark.

The Respondent has no rights or legitimate interests in respect of the Domain Name

The Respondent is not commonly known by the highly distinctive PEXCO Mark.

The Complainant has not authorized the Respondent to use the PEXCO Mark and the Respondent is not a licensee of the PEXCO Mark.

The Respondent cannot assert that it has been using the Domain Name, prior to any notice of the present dispute, in connection with a *bona fide* offering of goods or services or that he has made demonstrable preparations to do so; the Domain Name is being used to redirect visitors to a Dan.com webpage soliciting offers for the purchase of the Domain Name. Such use cannot provide the Respondent with any rights or legitimate interests for the purposes of the Policy.

Use which intentionally trades on the fame and reputation of a complainant's trademark should not be regarded as *bona fide* use for the purposes of the Policy.

To the best of the Complainant's knowledge, the Respondent has only ever used the Domain Name to redirect Internet users to the Dan.com webpage to solicit offers to purchase the Domain Name. The Respondent's use makes it clear that he registered the Domain Name with the intent to trade on the fame and reputation of the Complainant's PEXCO Mark.

There is no evidence that the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a legitimate noncommercial use.

The domain name was registered and is being used in bad faith

Numerous panels have found bad faith registration and use under the theory of "initial interest confusion", finding that such initial confusion is enough to demonstrate bad faith. Here, there can be no question that the Domain Name creates initial interest confusion.

Given that the PEXCO Mark is readily identifiable within the confusingly similar Domain Name and is followed by the word "brand", a term synonymous with "trademark", and that the Respondent's actual use of the Domain Name is to redirect visitors to a website soliciting offers to purchase the Domain Name, it is more likely than not that the Respondent was aware of the Complainant's PEXCO Mark and specifically and intentionally targeted the Complainant in bad faith.

Bad faith registration can be found where a respondent knew or should have known of a complainant's trademark rights but nevertheless registered a domain name in which he had no right or legitimate interest. It is more likely than not that the Respondent knew of the Complainant's PEXCO Mark at the time the Domain Name was registered and intentionally targeted the trademark.

The Complainant contends that it is more likely than not that the Domain Name was registered primarily with the intention of selling, renting, or otherwise transferring it to the Complainant or to a competitor of the Complainant for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the Domain Name.

## **B. Respondent**

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

## 6. Discussion and Findings

Paragraph 4(a) of the Policy requires a complainant to prove: (i) that a respondent has registered a domain name which is identical or confusingly similar to a trademark or service mark in which a complainant has rights; (ii) that the respondent has no rights or legitimate interests in respect of the domain name; (iii) that the domain name has been registered and is being used in bad faith. A complainant must prove each of these three elements to succeed.

### A. Identical or Confusingly Similar

The Complainant is the owner of the PEXCO Mark and thus clearly has rights therein.

Ignoring the generic Top-Level Domain “.com” (as the Panel may do for comparison purposes), the Domain Name comprises the PEXCO Mark followed by the word “brand”. Accordingly, the PEXCO Mark and Domain Name are not identical and thus the issue of confusing similarity must be considered. Application of the confusing similarity test under the UDRP typically involves “a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name” (section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). Section 1.7 of [WIPO Overview 3.0](#) goes on to provide “...in cases where a domain name incorporates the entirety of a trademark, .... the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing”.

The PEXCO Mark is incorporated in its entirety within the Domain Name. It is clearly recognizable within the Domain Name. The addition of the word “brand” does not prevent confusing similarity.

The Panel finds that the Domain Name is confusingly similar to the PEXCO Mark for the purposes of the Policy and thus paragraph 4(a)(i) of the Policy has been established.

### B. Rights or Legitimate Interests

By its allegations, the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name.

Accordingly, the burden of production shifts to the Respondent to come forward with arguments or evidence demonstrating that it does in fact have such rights or legitimate interests. The Respondent has not done so and accordingly, the Panel is entitled to find, given the *prima facie* case made out by the Complainant, that the Respondent indeed lacks rights or legitimate interests in the Domain Name. Despite the lack of any answer to the Complaint, the Panel is entitled to consider whether there would be anything inappropriate in such a finding.

A respondent can show it has rights or legitimate interests in a domain name in various ways even where, as is the case here, it is not licensed by or affiliated with a complainant. For instance, it can show that it has been commonly known by the domain name or that it is making a legitimate noncommercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Here, however, there is no evidence to suggest that the Respondent is commonly known by the Domain Name. Further, given the use to which the Domain Name has been put, namely to re-direct Internet users to Dan.com (a market place for domain names) where the Domain Name is offered for sale, it would be difficult to conclude that there is anything noncommercial or, given that the Domain Name is confusingly similar to the PEXCO Mark, fair about the Respondent’s use. As to an absence of an intent to mislead (for commercial gain), the Respondent’s choice of Domain Name, the dominant element being the Complainant’s PEXCO Mark, suggests the very opposite.

A respondent can also show that it is using a domain name in connection with a *bona fide* offering of goods or services. However, it seems clear that the Respondent set out to acquire a domain name that would

create a misleading impression of association with the Complainant, which has then been used to resolve to an online market place where the Domain Name is offered for sale. These circumstances cannot amount to a *bona fide* offering of goods or services for the purposes of the Policy.

The Respondent has sought to create an impression of association with the Complainant and has chosen not to attempt to justify his actions. That, perhaps, is not surprising given that it appears to the Panel that there is very little the Respondent could say to challenge the Complainant's assertion that the Respondent lacks rights or legitimate interests in the Domain Name.

The Panel finds that the Complainant has fulfilled the requirements of paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy provides a number of non-exclusive scenarios, which may evidence a respondent's bad faith. They include, for instance, a respondent registering a domain name in order to prevent an owner of the trademark or service mark to which it is said to be confusingly similar or identical, from reflecting the mark in question in a corresponding domain name (provided that the respondent has engaged in a pattern of such conduct). A respondent registering a domain name primarily for the purposes of disrupting the business of a competitor is another scenario, as is a respondent intentionally attempting to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or of products or services on it.

If circumstances are such as to indicate that a respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark, or to a competitor of that complainant for valuable consideration in excess of out-of-pocket costs directly related to the domain name, that too can be indicative of registration and use of a domain name in bad faith.

A complainant does not have to demonstrate a precise literal application of one of the paragraph 4(b) scenarios. They are non-exclusive and illustrative only, and as long as there is evidence demonstrating that a respondent is seeking to take unfair advantage of, or to abuse a complainant's trademark, such behaviour would satisfy the general principle underlying the bad faith requirement of the Policy.

The Complainant asserts, *inter alia*, that the Respondent is more likely than not to have registered the Domain Name primarily with the intention of selling, renting, or otherwise transferring it to the Complainant or a competitor of the Complainant, for profit.

However, the mere practice of registering a domain name for subsequent resale (including for a profit) does not in itself support a claim that the respondent registered the domain name in bad faith with the primary purpose of selling it to a trademark owner (or its competitor). That claim often requires a highly fact-specific analysis. Section 3.1.1 of the [WIPO Overview 3.0](#), provides some helpful guidance here, suggesting that where "...circumstances indicate that the respondent's intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant's trademark, panels will find bad faith on the part of the respondent. While panel assessment remains fact-specific, generally speaking such circumstances, alone or together, include: (i) the respondent's likely knowledge of the complainant's rights, (ii) the distinctiveness of the complainant's mark, .... (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name.

Particularly where the domain name at issue is identical or confusingly similar to a highly distinctive or famous mark, panels have tended to view with a degree of skepticism a respondent defense that the domain name was merely registered for legitimate speculation (based for example on any claimed dictionary meaning) as opposed to targeting a specific brand owner".

It seems unlikely, given the distinctiveness, and wide and extensive use of the PEXCO Mark, that the Respondent would not have known of the Complainant and its PEXCO Mark at the time of registration of the Domain Name. The Respondent appears to have targeted the Complainant. Moreover, it would have been obvious to the Respondent that the Domain Name creates an impression of association with the Complainant and that such impression is false and misleading. In these circumstances, it is difficult to contemplate any legitimate use of the Domain Name without permission of the Complainant. Given the foregoing, the fact that the Respondent has caused the confusingly similar Domain Name to be offered for sale, without any explanation having been provided, leads the Panel to conclude that the Domain Name has been registered primarily with the intention of selling, renting, or otherwise transferring it to the Complainant or a competitor of the Complainant, for profit.

In all the circumstances, the Panel finds that, for the purposes of the Policy, there is evidence of both registration and use of the Domain Name in bad faith.

## **7. Decision**

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <pexcobrand.com> be transferred to the Complainant.

*/Jon Lang/*

**Jon Lang**

Sole Panelist

Date: April 21, 2022