

ADMINISTRATIVE PANEL DECISION

Ce De Candy, Inc. v. Registration Private, Domains By Proxy, LLC /
Guillaume Lachance
Case No. D2022-1458

1. The Parties

The Complainant is Ce De Candy, Inc., United States of America (“United States”), represented by Tarter Krinsky & Drogin LLP, United States.

The Respondent is Guillaume Lachance, Canada.

2. The Domain Name and Registrar

The disputed domain name <smartiess.com> (the “Disputed Domain Name”) 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 April 22, 2022. On April 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On April 26, 2022, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on April 27, 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 amendment to the Complaint on May 18, 2022. On May 22, 2022 the Registrar sent an email to the Center concerning Respondent identity (see further below).

The Center verified that the Complaint, together with the amendment to 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 May 20, 2022. The Respondent sent two informal emails to the Center on May 24, 2022 and the Complainant requested the suspension of the proceeding, which was confirmed by the Center on May 27, 2022. As the Parties failed to settle, the Complainant requested the

reinstitution of the proceeding. The Center confirmed the reinstatement on July 4, 2022 and the Response due date was then set on July 17, 2022. No formal Response was filed with the Center.

The Center appointed Nick J. Gardner as the sole panelist in this matter on July 25, 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 a US Corporation. It manufactures and sells a range of candy under the brand name SMARTIES. It has been in business since 1949. The filed evidence establishes that its SMARTIES candy is extremely popular and very well known – it produces more than 1 billion SMARTIES candies annually. The Complainant operates its website via the domain name <smarties.com>

The Complainant owns various trademarks for the word “smarties” or which include the word SMARTIES – see for example US Trademark Reg. No. 0788229 registered on April 13, 1965. These trademarks are referred to as the “SMARTIES trademark” in this decision.

The Disputed Domain Name was registered on April 1, 2022. There is no evidence that it has ever been used in any way.

5. Parties’ Contentions

A. Complainant

The Complainant’s contentions can be summarized as follows.

The Disputed Domain Name is confusingly similar to the SMARTIES Trademark – it is simply a typographical variation.

The Respondent has no rights or legitimate interests in the term “smarties” or “smarties”.

In consequence, the Complainant alleges that the Disputed Domain Name was registered and is being used in bad faith. The Complainant says its case is substantially the same as the case in *Ferrari S.p.A v. Contact Privacy Inc. Customer 1247676738 / Warren Welsh, Revolution.app*, WIPO Case No. [D2020-3537](#) and the same principles apply.

B. Respondent

No Response has been filed. The Respondent’s e-mail of May 24, 2022 stated “Hi, Sorry its an error, I will not use this domain. I will delete it and i back you! [sic]”.

6. Discussion and Findings

Preliminary Matters

The Panel notes that, other than the above email, no communication has been received from the Respondent. However, given the Complaint and Written Notice were sent to the relevant addresses disclosed by the Registrar, then the Panel considers that this satisfies the requirement in paragraph 2(a) of the UDRP Rules to “employ reasonably available means calculated to achieve actual notice”. Accordingly, the Panel considers it is able to proceed to determine this Complaint and to draw inferences from the Respondent’s failure to file any Response. While the Respondent’s failure to file a Response does not

automatically result in a decision in favour of the Complainant, the Panel may draw appropriate inferences from the Respondent's default (see, e.g., *Verner Panton Design v. Fontana di Luce Corp*, WIPO Case No. [D2012-1909](#)).

The Panel also notes this is a case where the Respondent appears to be using a privacy or proxy service ("Registration Private, Domains By Proxy, LLC, United States").

The Panel in this case adopts the approach of most UDRP panels, as outlined in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 4.4.5, as follows:

"Panel discretion

In all cases involving a privacy or proxy service and irrespective of the disclosure of any underlying registrant, the appointed panel retains discretion to determine the respondent against which the case should proceed.

Depending on the facts and circumstances of a particular case, e.g., where a timely disclosure is made, and there is no indication of a relationship beyond the provision of privacy or proxy registration services, a panel may find it appropriate to apply its discretion to record only the underlying registrant as the named respondent. On the other hand, e.g., where there is no clear disclosure, or there is some indication that the privacy or proxy provider is somehow related to the underlying registrant or use of the particular domain name, a panel may find it appropriate to record both the privacy or proxy service and any nominally underlying registrant as the named respondent."

On May 22, 2022 the Registrar sent an email to the Center which read as follows: "We are in receipt of the Notification of Complaint and Commencement of Administrative Proceeding. Section B6 of the complaint (attached) identifies Domains By Proxy, LLC as the registrant of the domain name. The Complaint's amended complaint (also attached) adds Guillaume Lachance. Domains By Proxy is not the registrant of the domain name and should not be listed as a respondent. We ask that you please relay this information to the Panelist."

In the present case, the Panel considers the substantive Respondent to be Guillaume Lachance and references to the Respondent are to that person.

Substantive Matters

To succeed, in accordance with paragraph 4(a) of the Policy, the Complainant must satisfy the Panel that:

- (i) the Disputed Domain Name is identical with 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 Name;
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has rights in the SMARTIES trademark. The Disputed Domain Name simply adds an additional letter "s" to that trademark. That results in a term which could easily be misread as the SMARTIES trademark or which could inadvertently be typed by mistake when typing the word SMARTIES. The Panel agrees in this regard with the approach set out in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.9, namely:

“Is a domain name consisting of a misspelling of the complainant’s trademark (*i.e.*, typosquatting) confusingly similar to the complainant’s mark?”

A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element.”

Accordingly the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a domain name:

(i) before any notice to the respondent of the dispute, use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) the respondent has been commonly known by the 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 domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

None of these apply in the present circumstances. The Complainant has not authorised, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use the SMARTIES trademark. The Complainant has prior rights in the SMARTIES trademark which precede the Respondent’s acquisition of the Disputed Domain Name. The Complainant has therefore established a *prima facie* case that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name and thereby the burden of production shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the Disputed Domain Name (see, for example, *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#); *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

The Panel finds that the Respondent has failed to produce any evidence to establish his rights or legitimate interests in the Disputed Domain Name. Accordingly the Panel finds the Respondent has no rights or any legitimate interests in the Disputed Domain Name and the second condition of paragraph 4(a) of the Policy has been fulfilled.

C. Registered and Used in Bad Faith

On the evidence that the Respondent has made no use of the Disputed Domain Name in the time he has owned it. In the circumstances of this case, the Panel adopts the approach set out in the [WIPO Overview 3.0](#) at 3.3 as follows:

“Can the ‘passive holding’ or non-use of a domain name support a finding of bad faith?”

From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or ‘coming soon’ page) would not prevent a finding of bad faith under the doctrine of passive holding.

While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its

identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.”

In the present case the Panel adopts this approach and notes in particular the Respondent’s failure to provide any evidence of actual or contemplated good-faith use.

Overall it does not generally matter that the Respondent has not as yet used the Disputed Domain Name. “Passive holding” can itself amount to bad faith registration and use where the holding involves a domain name deliberately chosen because of its association with the Complainant. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *Jupiters Limited v. Aaron Hall*, WIPO Case No. [D2000-0574](#); *Ladbroke Group Plc v. Sonoma International LDC*, WIPO Case No. [D2002-0131](#); *Westdev Limited v. Private Data*, WIPO Case No. [D2007-1903](#); *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#); *Intel Corporation v. The Pentium Group*, WIPO Case No. [D2009-0273](#); *Advance Magazine Publishers Inc. and Les Publications Conde Nast S.A. v. ChinaVogue.com* WIPO Case No. [D2005-0615](#). The Panel also agrees with the Complainant that the same principles were applied in *Ferrari S.p.A v. Contact Privacy Inc. Customer 1247676738 / Warren Welsh, Revolution.app*, WIPO Case No. [D2020-3537](#) and apply to the present case.

Further, the Panel notes the respondent has not provided any credible explanation for any case of good faith he may have. His email saying “its an error” is not in the Panel’s opinion a satisfactory or credible explanation for the registration.

Accordingly, and applying the principles in the above noted UDRP decisions the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith.

As a result the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith. Accordingly the third condition of paragraph 4(a) of the Policy has been fulfilled.

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 <smartiess.com> be transferred to the Complainant.

/Nick J. Gardner/

Nick J. Gardner

Sole Panelist

Date: August 8, 2022