

ADMINISTRATIVE PANEL DECISION

Sanford L.P. v. Super Privacy Service LTD c/o Dynadot / hayal simsek
Case No. D2022-2674

1. The Parties

The Complainant is Sanford L.P., United States of America (“United States”), represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Super Privacy Service LTD c/o Dynadot, United States / hayal simsek, Türkiye.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 21, 2022. On July 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 25, 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 July 25, 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 July 26, 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 July 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 17, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 19, 2022.

The Center appointed Luca Barbero as the sole panelist in this matter on August 29, 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 1857 by Frederick W. Redington and William H. Sanford, Jr. in Massachusetts, United States, as the “Sanford Manufacturing Company”. In 1866, the company moved to Chicago and, in 1847, to Bellwood. In 1992, the Complainant was acquired by the company that is now known as Newell Brands Inc.

ELMER’S was first introduced in 1947 and has become a popular brand for adhesives, being used by over 47 million school students on a daily basis. Elmer’s product range has expanded over time, to include craft and hardware adhesives, liquid glues and slime products, reaching between 2017 and 2021 annual sales of USD 225,000,000 per year.

The Complainant is the owner of several trademark registrations for ELMER’S, including the following, as per excerpts of the trademark registration details submitted as Annex 1 to the Complaint:

- United States trademark registration No. 0566899 for ELMER’S (figurative mark), filed on April 26, 1951, and registered on November 18, 1952, in International class 16;
- United States trademark registration No. 1229794 for ELMER’S (figurative mark), filed on September 10, 1979, and registered on March 8, 1983, in International class 17;
- European Union Trade Mark registration No. 000510735 for ELMER’S (word mark), filed on April 8, 1997, and registered on December 16, 1998, in International class 16;
- United Kingdom trademark registration No. UK00900510735 for ELMER’S (word mark), filed on April 8, 1997, and registered on December 16, 1998, in class 16;
- United States trademark registration No. 2239290 for ELMER’S (word mark), filed on September 19, 1996, and registered on April 13, 1999, in International class 16;
- United States trademark registration No. 2246272 for ELMER’S (word mark), filed on September 1, 1998 and registered on May 18, 1999, in International classes 1, 2 and, 16.

The Complainant also filed the following trademark application four days before the registration of the disputed domain name:

- United States trademark application No. 97319922 for ELMER’S SQUISHIES, filed on March 18, 2022, in International class 28.

The Complainant is also the owner of the domain name <elmers.com>, registered on October 10, 1996, and used by the Complainant to promote its products under the trademark ELMER’S.

The disputed domain name <elmerssquishies.com> was registered on March 22, 2022, and is currently redirecting to a Registrar parking page.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to the trademark ELMER’S in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the descriptive term “squishies” and the generic Top-Level Domain “.com”.

The Complainant submits that the descriptive term “squishies” in the disputed domain name only serves to increase the confusing similarity since it is closely associated to one of the Complainant’s latest brand ELMER’S SQUISHIES, for which the Complainant’s United States trademark application is currently pending.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that the Respondent i) is in no way sponsored by or affiliated with the Complainant ii) has never been granted permission to use the Complainant’s trademark in any way and iii) is not commonly known by the disputed domain name.

The Complainant further indicates that, at the time of the filing of the Complaint, the Respondent was using a Whois privacy service, which past panels have also found to equate to a lack of legitimate interest.

Moreover, the Complainant emphasizes that the Respondent’s use of the disputed domain name to redirect Internet users to a Registrar page indicating the disputed domain name is “taken” and promoting that Registrar’s brokerage service, does not constitute a *bona fide* offering of goods or services, or a legitimate noncommercial or fair use.

The Complainant also underlines that, prior to the above-described use, the Respondent had been offering to sell the disputed domain name by listing it on the domain name marketplace Dan.com for USD 995. As the price to purchase was less than the cost of a dispute, the Complainant elected to engage and, when Dan.com confirmed receipt of the funds, the listing was cancelled. Soon thereafter, the disputed domain name was again listed for sale, this time on multiple platforms and for thousands more as the Respondent was offering to sell the disputed domain name through the Dynadot marketplace for USD 9,800 and the Sedo.com platform for USD 17,836, both amounts far exceeding the Respondent’s out-of-pocket expenses in registering the disputed domain name. The Complainant submits that such conduct is further evidence of the Respondent’s lack of rights and legitimate interests.

With reference to the circumstances evidencing bad faith, the Complainant indicates that, considering its trademark ELMER’S is well-known worldwide, and that the disputed domain name was registered only four days after the Complainant filed its United States trademark application for ELMER’S SQUISHIES, it is highly unlikely that the Respondent would have been unaware of the Complainant and its trademarks, especially considering it chose to add the term “squishies” to the disputed domain name, which only serves to increase the likelihood of knowledge of the Complainant and its rights.

With regard to the current redirection of the disputed domain name to a Registrar parking page, the Complainant indicates that passively holding a domain name can constitute a factor in finding bad faith registration and use. The Complainant also submits that the Respondent clearly demonstrated an intent to sell the disputed domain name for valuable consideration in excess of the out-of-pocket expenses.

The Complainant emphasizes that, by registering the disputed domain name, the Respondent also intended to cause a likelihood of confusion with the Complainant and its trademarks and contends that any use of the disputed domain name could only be in bad faith. Moreover, the Complainant submits that, at the time of the initial filing of the Complaint, the Respondent had employed a privacy service to hide its identity, which past panels have held, also serves as further evidence of bad faith registration and use.

Lastly, the Complainant informs the Panel that it had attempted to resolve the matter amicably, by sending a cease-and-desist letter sent to the Respondent by email, but received no response. While drafting the Complaint, the Complainant noticed that the privacy service for the disputed domain name had changed and attempted to again send a notice, this time via the Dynadot Domain Holder Contact Request Form, but received no response.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules: “A Panel shall decide a 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.” Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

A. Identical or Confusingly Similar

The Complainant has provided evidence of ownership of numerous trademark registrations for ELMER’S in several countries of the world, as mentioned under Section 4 above.

As highlighted in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), the first element functions primarily as a standing requirement, and the threshold test for confusing similarity 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. Moreover, as indicated in section 1.8 of the [WIPO Overview 3.0](#), “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element”.

The Panel finds that the disputed domain name is confusingly similar to the registered trademark ELMER’S owned by the Complainant as it reproduces the trademark in its entirety with the sole addition of the term “squishies” and the generic Top-Level Domain “.com”, which is commonly disregarded under the first element confusing similarity test (section 1.11.1 of the [WIPO Overview 3.0](#)).

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is confusingly similar to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant must show that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- “(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are 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.”

In the case at hand, by not submitting a Response, the Respondent has failed to invoke any circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name. The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's trademarks.

Furthermore, there is no indication before the Panel that the Respondent is commonly known by the disputed domain name, has made preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services, or that it intends to make a legitimate, noncommercial or fair use of the disputed domain name. As highlighted above, the disputed domain name is currently redirecting to a parking page of the concerned Registrar. The Panel finds that the Respondent's use does not amount to a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name without intention to misleadingly divert the consumers or to tarnish the Complainant's trademarks..

Moreover, the Panel finds that the disputed domain name, encompassing the Complainant's trademark along with a term ("squishies") descriptive of one of the Complainant's ELMER'S products, carries a risk of implied affiliation. As stated in section 2.5.1 of the [WIPO Overview 3.0](#), "Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner".

Furthermore, the Complainant has demonstrated that the disputed domain name, confusingly similar to the Complainant's trademark, was offered for sale at amounts likely exceeding the mere out-of-pocket costs on multiple domain name marketplaces. Such circumstance further demonstrates that the Respondent did not intend to use the disputed domain name for a legitimate noncommercial or fair use.

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain name was registered and is being used by the Respondent in bad faith.

The Panel finds that, in view of i) the prior registration and use of the trademark ELMER'S by the Complainant, ii) the confusing similarity of the disputed domain name to the Complainant's trademark ELMER'S and iii) the identity of the disputed domain name with the Complainant's trademark application ELEMER'S SQUISHIES, which was filed by the Complainant only four days before the registration of the disputed domain name, the Respondent very likely registered the disputed domain name with the Complainant's trademarks in mind.

In the case at hand, considering i) the distinctiveness of the Complainant's trademark, to which the disputed domain name is confusingly similar, ii) the Respondent's failure to submit a response and to provide any evidence of actual or contemplated good-faith use and iii) the Respondent's use of a Whois privacy service to conceal its identity, the Panel finds that the Respondent's use of the disputed domain name, which redirects to a mere Registrar parking page offering the disputed domain name for sale, does not prevent a finding of bad faith.

As an additional circumstance evidencing the Respondent's bad faith, the Complainant has demonstrated that the disputed domain name was offered for sale on multiple domain name marketplaces for amounts likely well in excess of the documented out-of-pocket costs, which further indicates that the Respondent very likely registered the disputed domain name for the purpose of selling it to the highest bidder, profiting from the goodwill and the recognition of the Complainant and its trademarks.

In accordance with prior decisions, the Panel also finds that the Respondent's failure to respond to the Complainant's cease-and-desist letters further demonstrates the Respondent's bad faith. See, *e.g.*, *Spyros Michopoulos S.A. v. John Talias, ToJo Enterprises*, WIPO Case No. [D2008-1003](#), in which the Panel stated: "Any such bad faith is compounded when the Domain Name owner upon receipt of notice that the Domain Name is identical or confusingly similar to a registered trademark, refuses to respond. Such conduct is not consistent with what one reasonably would expect from a good faith registrant accused of cybersquatting."

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and is using the disputed domain name in bad faith according to paragraph 4(a)(iii) of 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 name <elmerssquishies.com> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: September 15, 2022