

ADMINISTRATIVE PANEL DECISION

ProjectPay Pty Ltd. v. Rohit Sur
Case No. D2022-2900

1. The Parties

The Complainant is ProjectPay Pty Ltd., Australia, represented by Dentons Canada LLP, Canada.

The Respondent is Rohit Sur, Canada, represented by John Berryhill, Ph.d., Esq., United States of America (“United States”).

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 5, 2022. On August 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On August 10, 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.

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 August 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 9, 2022. The Response was filed with the Center September 8, 2022. On September 20, 2022, the Complainant filed a Supplemental Filing.

The Center appointed Willem J. H. Leppink, Haig Oghigian, and Douglas M. Isenberg as panelists in this matter on October 3, 2022. The Panel finds that it was properly constituted. Each member of 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 following facts are undisputed.

The Complainant is in the business of providing an online payment and accounting platform for use in the construction industry.

Complainant is the owner of various trademark registrations for PROJECTPAY (word mark), including the Australian trademark registration with registration number 1848060, registered on May 29, 2017; the United Kingdom trademark registration with registration number UK00003330070, registered on December 7, 2018; and the Canadian trademark registration with registration number TMA1128302, registered on May 11, 2022. These registrations will hereinafter collectively and in singular be referred to as the "Trademark". The Complainant is also the owner of the United States trademark registration on the United States Patent and Trademark Office ("USPTO") Supplemental Register, with registration number 5823592, registered on July 30, 2019.

The Complainant registered the domain names <projectpay.com.au> on May 26, 2017, and <projectpay.co.uk> on January 12, 2018.

The Domain Name was registered on June 27, 2001.

5. Parties' Contentions

A. Complainant

Insofar as relevant the Complainant contends the following.

The Complainant has started its business under the name ProjectPay offering electronic payment services in 2015.

The Complainant is the owner of the Trademark, and the Domain Name is confusingly similar to the Trademark, more specifically, the Domain Name incorporates the Trademark in its entirety. If a domain name incorporates a trademark in its entirety, where the relevant trademark is recognizable in the domain name, the domain name will normally be considered confusingly similar (*Red Bull GmbH v. Shen Xingyu*, WIPO Case No. [D2019-0549](#)).

The Respondent has no rights or legitimate interests in respect of the Domain Name. There is no evidence that the Respondent has used the Domain Name to offer any goods or services or has had legitimate website content at any time since registration. As of June 30, 2022, the Domain Name resolves to one of three different webpages. Upon refreshing the page or re-accessing the Domain Name, one of the other webpages is displayed. Each of the three webpages is used only to display hyperlinks that lead Internet users to various advertisement pages. This type of use is not considered *bona fide* use of the Domain Name and the Respondent does not have rights or legitimate interests in the Domain Name.

Furthermore, the Domain Name has been registered and used in bad faith. On two of the accessible webpages to which the Domain Name resolves, the Respondent is offering items that are identical or directly related to the goods and services registered in association with the Trademark. The Respondent is aware of the Complainant's business and is intentionally attempting to attract for financial gain, Internet users to the

Domain Name and the hyperlinked advertising pages, by creating a likelihood of confusion with the Trademark as to the source, sponsorship, affiliation, or endorsement of the Domain Name, or of the products or services advertised. The Respondent has further demonstrated bad faith by attempting to interfere with the Complainant's business. In particular, the Respondent is preventing the Complainant from reflecting its business name in the corresponding Top-Level Domain ".com".

Moreover, the Respondent used the Domain Name to advertise and display pornographic video content. Previous panels have found that linking a domain name to pornographic websites is *prima facie* evidence of bad faith. Therefore, the Respondent's activity clearly constitutes bad faith registration and use of the Domain Name under the Policy and the Rules on several established grounds.

B. Respondent

The Respondent submitted a comprehensive Response and contends – insofar as relevant for the decision – the following.

The Complainant's claimed evidence of showing rights in the United States Supplemental Register trademark registration No. 5823592 is insufficient. As indicated by its "Supplemental" register designation, this document is evidence of a lack of rights in the United States. Supplemental registrations are those that the USPTO has refused as merely descriptive, but they are allowed to proceed to the Supplemental Register as a notice of potential future acquired distinctiveness. Further to this, the Complainant does not describe the conduct of any actual business with customers of any sort. Moreover, the Respondent registered the Domain Name in 2001, and the Complainant first used the Trademark "as early as 2015," prior to its formation in 2017. The Complainant thus admits the Respondent possessed the Domain Name prior to the Complainant's existence, and hence the Complainant's alleged rights in connection with any mark are well junior to the Respondent's registration of the Domain Name.

The second criterion of the Policy requires the Complainant to show that the Respondent has no rights or legitimate interests in the Domain Name. These "rights and interests" are not required to be trade or service mark rights, but include a range of equitable interests such as continued use of the Domain Name for a *bona fide* purpose. The Respondent registered and has held a two-word domain name for prospective development by the real estate development company with which the Respondent is engaged, since long prior to the Complainant's existence. The Complainant has therefore not substantiated that the Respondent has no rights or legitimate interests in the Domain Name.

The final criterion required to be proven by the Complainant is whether the Respondent has registered and used the Domain Name in bad faith. Bad faith registration cannot be found where the Domain Name pre-dates the claimed rights at issue, except for a narrow form of anticipatory bad faith in which a domain registrant has reason to believe that a specific party plans to launch a particular mark and which is not relevant here. The Domain Name simply could not have been registered in bad faith by the Respondent in 2001 in relation to the Complainant's then non-existent rights. Further to this, the Complainant makes no attempt to explain how the Domain Name was registered in bad faith.

Despite the Complainant's affirmative allegation that it believes the Domain Name to have been registered by the Respondent in 2001, the Complainant forged ahead with the Complaint premised on rights it claims to have accrued some fifteen years later. The Complainant's professional representative must have known that one of the elements of the Policy was not going to be met and showed an alarming unfamiliarity with the UDRP.

It is incorrect that the Domain Name was used to advertise and display pornographic video content.

6. Discussion and Findings

6.1 Preliminary Matter

Before entering into the merits of the case, the Panel addresses the matter of the unsolicited supplemental filing submitted by the Complainant.

No provision concerning supplemental filings is made in the Rules or Supplemental Rules, except for paragraphs 10 and 12 of the Rules, from which it follows that the panel, in its sole discretion, may determine the admissibility, relevance, materiality, and weight of the evidence, insofar as both parties are treated with equality and are given a fair opportunity to present their case.

The Complainant submitted an unsolicited supplemental filings which is generally discouraged, as is described in section 4.6 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). However, when a complainant proves that the supplemental filing is of utmost importance to the case and it could not have provided the information within its prior complaint, panels may find it justified to accept an unsolicited supplemental filing. The respondent will then be allowed to respond the complainant's unsolicited filing.

The Panel is not satisfied that such exceptional circumstances exist here and, therefore, decides that the unsolicited supplemental filing by the Complainant will not be admitted. As a general principle, a complainant has "one bite at the apple" and the Complainant could have easily foreseen the defenses as raised by the Respondent. In any event, even if the Panel had considered the Complainant's supplemental filing it would not have changed the outcome of this case.

6.2 Substantive Matter

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove each of the following three elements:

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

A. Identical or Confusingly Similar

The Complainant must demonstrate that it has rights in a trademark and, if so, the Domain Name must be shown to be identical or confusingly similar to the trademark. The first element serves as a standing requirement.

The Panel finds that the requirements of the first element are met. The Domain Name includes the Trademark in its entirety and is therefore identical to the Trademark in which the Complainant has rights.

The Panel does not need to address the issue of the United States registration on the USPTO Supplemental Register, because the first element is met on the basis of the other trademark registrations cited above.

B. Rights or Legitimate Interests

In light of the considerations under section 6.C below, the Panel is not required to give its considerations in relation to the second element.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the Domain Name has been both registered and used in bad faith by the Respondent.

The Complainant has failed to make out a case about registration in bad faith. The Complainant has simply failed to argue why the registration of the Domain Name has been in bad faith. Importantly, the Respondent's registration of the Domain Name at least 14 years before the Complainant was established and the rights to the Trademark were acquired also precludes a finding of bad faith since the Domain Name registration was made at a time when the Complainant had not been established and had no rights in the Trademark.

The Respondent could not have known about the Trademark and could not have been aware of the Complainant and its business when the Respondent registered the Domain Name. Therefore, the Panel finds that there is no evidence that the Respondent actually knew the Complainant or knew of the Complainant's intentions to use the Trademark when the Respondent registered the Domain Name.

[WIPO Overview 3.0](#), section 3.8 clearly says, "where a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent". This would only be different if the Respondent would have anticipated the intended use by the Complainant of its Trademark, e.g., if the Complainant would have communicated that it intended to use the Trademark but has not registered it yet – an exception that does not apply here.

In these circumstances, the Panel finds that the Complainant has not established the third requirement under paragraph 4(a) of the Policy.

D. Reverse Domain Name Hijacking

Paragraph 15(e) of the Rules provides: "If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding". Further, the Rules define Reverse Domain Name Hijacking ("RDNH") as "using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name".

Further, as set forth in [WIPO Overview 3.0](#), section 4.16: "Reasons articulated by panels for finding RDNH include... facts which demonstrate that the complainant clearly ought to have known it could not succeed under any fair interpretation of facts reasonably available prior to the filing of the complaint, including relevant facts on the website at the disputed domain name or readily available public sources such as the Whois database, [...] [and] unreasonably ignoring established Policy precedent [...]." Importantly, [WIPO Overview 3.0](#), section 4.16, also says: "Given the undertakings in paragraphs 3(b)(xiii) and (xiv) of the UDRP Rules, some panels have held that a represented complainant should be held to a higher standard". In this case, the Complainant is represented by counsel.

The Panel finds that the Complainant in fact knew or at least should have known at the time that it filed the Complaint that it could not prove one of the essential elements required by the UDRP, namely, it is very clear that the Respondent registered the Domain Name many years before the Complainant came into existence, filed and registered the Trademark.

The Complainant (or rather, its attorney) must have been fully aware of the cumulative requirements of registration and use in bad faith when filing the Complaint. In fact, the Complainant has clearly confirmed that the Domain Name was registered in 2001 and has written under the heading "The Disputed Domain Name was registered and is being used in bad faith": "The Respondent registered and is using the Disputed Domain Name in bad faith, pursuant to Paragraphs 4(a)(iii) and 4(b) of the Policy, and Paragraph 3(b)(ix)(3) of the Rules". And concluded: "All of the Respondent's activity described above clearly constitutes bad faith

registration and use of the Disputed Domain Name under the Policy and the Rules on several established grounds”.

To conclude, the Panel finds that, based on the above, the Complaint was filed in a bad faith attempt to deprive the Respondent of the Domain Name. These facts justify a finding of Reverse Domain Name Hijacking.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Willem J. H. Leppink/

Willem J. H. Leppink

Presiding Panelist

/Haig Oghigian/

Haig Oghigian

Panelist

/Douglas M. Isenberg/

Douglas M. Isenberg

Panelist

Date: October 17, 2022