

## **ADMINISTRATIVE PANEL DECISION**

Muitas Ltd. v. Michal Kalasek, Poste restante  
Case No. D2022-2963

### **1. The Parties**

The Complainant is Muias Ltd., United States of America (“United States”), represented by Silverstein Legal, United States.

The Respondent is Michal Kalasek, Poste restante, Czech Republic.

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

The disputed domain name <sclips4sale.com> is registered with Gransy, s.r.o. d/b/a subreg.cz (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 10, 2022. On August 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 16, 2022, the Registrar transmitted by email to the Center its verification response 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 August 17, 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 August 17, 2022.

On August 17, 2022, the Center transmitted an email in Czech and English to the Parties regarding the language of the proceeding. The Complainant confirmed the request that English be the language of the proceeding on even date. The Respondent did not comment on the language of the proceeding.

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 August 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 13, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 19, 2022.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on September 30, 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 owns and operates the website at the domain name <clips4sale.com>, providing a platform that allows users to post and sell audiovisual content through clip stores under the CLIPS4SALE.COM, CLIPS4SALE, CLIPS4 and CLIP4 trademarks.

The Complainant is the owner, amongst others, of the following United States trademark registrations (Annex C to the Complaint):

- No. 3,508,680 for CLIPS4SALE.COM registered on September 30, 2008, in class 41, claiming first use on July 1, 2002;
- No. 3,554,200 for CLIPS4SALE registered on December 30, 2008, in class 41, claiming first use on July 1, 2002;
- No. 4,800,900 for CLIPS4 registered on August 25, 2015, in class 9, claiming first use on March 26, 2015; and
- No. 4,814,248 for CLIP4 registered on September 15, 2015, in class 9, claiming first use on March 26, 2015.

The disputed domain name <sclips4sale.com> was registered on July 14, 2022 and presently does not resolve to an active webpage. It has been used in the past to redirect Internet users to third party websites displaying adult content in competition with the Complainant's services.

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

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

The Complainant asserts to have extensively used its CLIPS4SALE.COM, CLIPS4SALE, CLIPS4, and CLIP4 trademarks in connection with its platform that allows users to post and sell audiovisual content through clip stores on the Internet.

The disputed domain name is, according to the Complainant, confusingly similar to the Complainant's CLIPS4SALE and CLIPS4SALE.COM trademarks, creating a likelihood of confusion, given that the disputed domain name reproduces exactly the Complainant's trademarks with the addition of the letter "s", which does not prevent a finding of confusing similarity thereof.

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name given that:

(i) the Respondent is not a licensee of the Complainant, nor is the Respondent otherwise authorized to use the Complainant's trademarks for any purpose;

(ii) the Respondent, on information and belief, is not commonly known as "SCLIPS4SALE" or "SCLIPS4SALE.COM"; and

(iii) the Respondent is using the disputed domain name to redirect Internet users to third-party websites that offers adult entertainment services in direct competition with the Complainant's services, what does not characterize a *bona fide* offer of goods or services under the Policy.

As to the registration of the disputed domain name in bad faith, the Complainant asserts that its trademarks consist of arbitrary terms that have no meaning outside their use to identify the Complainant as a source of certain products and services, having thus the Respondent sought to divert Internet traffic from the Complainant's website to a website offering adult entertainment content in direct competition with the Complainant's website presumably to profit from and exploit the Complainant's trademarks.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy sets forth the following three requirements which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

- (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.

The Complainant must prove in this administrative proceeding that each of the aforesaid three elements is present so as to have the disputed domain name transferred to it, according to paragraph 4(a) of the Policy.

Before turning to these issues, however, the Panel needs to address the question of the language of the proceedings.

### **A. Language of Proceedings**

In accordance with paragraph 11 of the Rules, the Panel has the authority to determine the language of proceedings. Considering the circumstances of this case and the fact that the Respondent did not formally reply to any of the communications sent by the Center, both in English and in Czech, this Panel does not consider it prejudicial to the Respondent if English were adopted as the language of the proceeding, especially in view of the choice of the disputed domain name that incorporates terms in the English language and that the website to which the disputed domain name redirected Internet users was also in the English language. The proceeding would be unduly delayed if the Complaint had to be translated into Czech. Accordingly, the Panel accepts the Complainant's request for English to be the language of this proceeding.

### **B. Identical or Confusingly Similar**

The Complainant has established rights in the CLIPS4SALE.COM and CLIPS4SALE trademarks.

The Panel finds that the disputed domain name reproduces the Complainant's mark in its entirety. The addition of the letter "s" does not prevent a finding of confusing similarity. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 1.7.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark. The first element of the Policy has been established.

### **C. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that may indicate the Respondent's rights to or legitimate interests in the disputed domain name. These circumstances are:

- (i) before any notice 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, in spite of not having acquired 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.

The Respondent, in not formally responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name. This entitles the Panel to draw any inferences from such default as it considers appropriate, pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden of proof is still on the Complainant to make at least a *prima facie* case against the Respondent under the second UDRP element.

In that sense, and according to the evidence submitted, the Complainant has made a *prima facie* case against the Respondent that the Respondent has not been commonly known by the disputed domain name, and there is no connection or affiliation between the Complainant and the Respondent. Also, the Complainant indeed states that the Respondent is not a licensee of the Complainant, nor is the Respondent otherwise authorized to use the Complainant's trademarks for any purpose.

Also, the absence of any indication that the Respondent has rights in a term corresponding to the disputed domain name, or any possible link between the Respondent and the disputed domain name that could be inferred from the details known of the Respondent or from a webpage relating to the disputed domain name, corroborate with the Panel's finding of the absence of rights or legitimate interests.

In view of these circumstances, the inactive use of the disputed domain name and the past use to redirect Internet users to third-party websites that offer adult entertainment services in direct competition with the Complainant's services cannot be considered a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use of the disputed domain name.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

The second element of the Policy has therefore been established.

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

This case presents the following circumstances which indicate bad faith registration and use of the disputed domain name:

- a) the Complainant's trademark is registered;
- b) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by him of the disputed domain name; and
- c) the nature of the disputed domain name (reproducing the entirety of the Complainant's trademark plus the letter "s"), and the implausibility of any good faith use to which the disputed domain name may be put.

Further, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

For the reasons above, the Respondent's conduct has to be considered, in this Panel's view, as bad faith registration and use of the disputed domain name.

## **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 <sclips4sale.com> be transferred to the Complainant.

*/Wilson Pinheiro Jabur/*

**Wilson Pinheiro Jabur**

Sole Panelist

Date: October 11, 2022