

ADMINISTRATIVE PANEL DECISION

PrideStaff, Inc. v. Domain /or Administrator
Case No. D2022-3486

1. The Parties

The Complainant is PrideStaff, Inc., United States of America (“United States”), represented by Frost Brown Todd LLC, United States.

The Respondent is Domain /or Administrator, Nigeria.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 20, 2022. On September 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 21, 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 (Privacy Protection) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 22, 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 September 28, 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 September 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 21, 2022.

The Center appointed Cherise Valles as the sole panelist in this matter on October 27, 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 PrideStaff, Inc. is a corporation organized under the laws of the State of California (the "Complainant"). It was founded in 1978 and is a well-known staffing firm in the United States. It provides professional staffing services for both employers and potential employees.

The Complainant owns the trademark PRIDESTAFF, which was registered in the United States (Registration No. 2,116,589, Registered November 25, 1997). In connection with "employment agency services; personnel relocation services; personnel placement and recruitment services; temporary personnel placement and recruitment services; contract staffing services; personnel management consulting services; and personnel outplacement services" in Class 35, with a first use date of March 1, 1995.

The Complainant has owned and used the <pridestaff.com> domain name since 1996.

The Complainant states that customers learn about the company, request staffing services, and apply for posted positions through the <pridestaff.com> website (Annex C of the Complaint). The Complainant submits that <pridestaff.com> has become an important asset and a key means of communicating with its customers and the public.

The disputed domain name <pridestaffcompanies.com> was registered by the Respondent on July 19, 2022.

The disputed domain name previously resolved to a page displaying pay-per-click links and currently does not resolve to any content (Annex E of the Complaint).

5. Parties' Contentions

A. Complainant

The Complainant asserts that each of the elements enumerated in paragraph 4(a) of the Policy and the corresponding provisions in the Rules have been satisfied. In particular, the Complainant asserts that:

- The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.
- The disputed domain name is confusingly similar to the Complainant's registered PRIDESTAFF trademark, in light of the fact that it wholly incorporates the Complainant's mark.
- The Respondent lacks rights or legitimate interests in the disputed domain name.
- The Complainant states that the Respondent should be considered as having no rights or legitimate interests in the disputed domain name. The Complainant has never licensed or otherwise permitted the Respondent to use its trademarks or to register any domain name that included its trademarks.
- The Complainant asserts that the disputed domain name was registered and is being used in bad faith. The mere fact of registration of a domain name that is confusingly similar or identical to a famous trademark by an entity that has no relationship to that mark is itself evidence of bad faith registration and use.

The Complainant requests the Panel to issue a decision finding that the disputed domain name be transferred to the Complainant, in accordance with paragraph 4(i) of the Policy.

B. Respondent

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

6. Discussion and Findings

In terms of paragraph 4(a) of the Policy, for a Complaint to succeed, the Complainant must prove each of the following elements:

- (i) the disputed domain name is identical 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; and,
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Respondent has failed to file a Response in this proceeding. The Panel may draw appropriate inferences from the available evidence submitted by the Complainant.

A. Identical or Confusingly Similar

To prove this element, the Complainant must have relevant rights in a trademark and the disputed domain name must be identical or confusingly similar to such trademark.

The Complainant submits that the disputed domain name is confusingly similar to the trademark in which it has rights. The disputed domain name incorporates the PRIDESTAFF trademark in its entirety with the addition of the term "companies". Given the Complainant's trademark registration as detailed above, the Panel finds that the Complainant has established its trade mark rights in PRIDESTAFF for the purposes of paragraph 4(a)(i) of the Policy.

The Complainant asserts that the disputed domain name is confusingly similar to such mark. It argues that the disputed domain name is confusingly similar to the PRIDESTAFF trademark, as it incorporates the trademark in its entirety.

The disputed domain name incorporates said trademark in its entirety with the addition of the mis-spelled word "companies". As stated in section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") "[w]here 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". Thus, the inclusion of the word "companies" in the disputed domain name does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's PRIDESTAFF trademark.

It is standard practice when comparing a disputed domain name to a complainant's trademark not to take the Top Level Domain ("TLD") into account. See section 1.11.1 of the [WIPO Overview 3.0](#), which states that the "applicable [TLD] in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and, as such, is disregarded under the first element of the confusing similarity test". In the present case, the TLD ".com" is disregarded under the first element of the confusing similarity test.

In the light of the foregoing, the Panel finds that the disputed domain name is confusingly similar to the Complainant's registered trademark and that the Complainant has met its burden with respect to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out a non-exhaustive set of circumstances, any of which, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate a respondent's

rights or legitimate interests to a domain name for the purposes of paragraph 4(a)(ii) of the Policy, namely:

“[a]ny of the following circumstances, in particular but without limitation, if found by the panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (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.”

The Respondent did not submit a Response or attempt to demonstrate any rights or legitimate interests in the disputed domain name, whether on the basis of the non-exhaustive examples set out in paragraph 4(c) of the Policy or on any other basis, and the Panel draws inferences from this failure, where appropriate, in accordance with paragraph 14(b) of the Rules.

It is recognised in cases under the Policy that it is sufficient for a complainant to make a *prima facie* case under the second element of the Policy, not rebutted by the respondent, that the respondent has no rights or legitimate interests in the domain name concerned (see section 2.1 of the [WIPO Overview 3.0](#)). If a respondent fails to rebut such a *prima facie* case by demonstrating rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy, or on any other basis, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

On the evidence before the Panel, it appears that there has never been any relationship between the Complainant and the Respondent. The Respondent does not seem to be licensed, or otherwise authorized, be it directly or indirectly, to register or use the Complainant’s PRIDESTAFF trademark in any manner, including in, or as part of, the disputed domain name. The Complainant has stated that the Respondent is neither a franchisee nor otherwise affiliated with the Complainant.

In this case, it appears that the Complainant has established the requisite *prima facie* case under the second element of the Policy.

The Complainant asserts that the Respondent is unable to invoke any of the circumstances set out in paragraph 4(c) of the Policy in order to demonstrate rights or legitimate interests in the disputed domain name. In particular, the Respondent cannot assert that, prior to any notice of this dispute, it was using, or had made demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy.

The registration of the PRIDESTAFF trademark preceded the registration of the disputed domain name by many years. It is clear, therefore, that the Respondent would have been aware of the Complainant’s PRIDESTAFF trademark when registering the disputed domain name.

Furthermore, the nature of the disputed domain name, consisting of the Complainant’s PRIDESTAFF trademark and the additional term “companies”, carries a risk of implied affiliation and cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. The Panel finds that the subtle misspelling of the word “companies” does not prevent the disputes domain name from being inherently misleading, as there is a risk that Internet users will not notice the misspelling. See section 2.5.1 of the [WIPO Overview 3.0](#).

In light of the foregoing, the Panel finds that the Complainant has established an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and concludes that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

For this element, the Complainant is required to prove that the disputed domain name was registered and that it was used in bad faith. The term “bad faith” is “broadly understood to occur where a respondent takes unfair advantage of, or otherwise abuses, a complainant’s mark”. See section 3.1 of the [WIPO Overview 3.0](#). Paragraph 4(b) of the Policy sets out four non-exhaustive examples of circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, namely:

- (i) circumstances indicating that the respondent 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 service mark or to a competitor of that complainant, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the respondent’s website or location or of a product or service on its website or location.

In the present case, the Complainant’s submissions relate to paragraph 4(b)(iv) of the Policy.

Previous UDRP panels have found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typographical errors or 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 section 3.1.4 of the [WIPO Overview 3.0](#).

1) Registration in bad faith

Given the well-known nature of the Complainant’s PRIDESTAFF trademark, it is implausible that the Respondent was unaware of the Complainant’s trademark when it registered the disputed domain name.

Bad faith can be found where a respondent “knew or should have known” of a complainant’s trademark rights but nevertheless registered a particular domain name in which it had no rights or legitimate interest (See *Research In Motion Limited v. Privacy Locked LLC/Nat Collicot*, WIPO Case No. [D2009-0320](#); *The Gap, Inc. v. Deng Youqian*, WIPO Case No. [D2009-0113](#)).

Prior panels have held that bad faith can be found where a domain name is so obviously connected with a well-known trademark that its very use by someone with no connection to the trademarks suggests opportunistic bad faith (see *LEGO Juris A/S v. store24hour*, WIPO Case No. [D2013-0091](#)). Given the strong reputation of the Complainant’s trademark, registration in bad faith can be inferred in the circumstances of this case.

As noted above, the Complainant’s trademark rights predate the registration date of the disputed domain name. Knowledge of a corresponding trademark at the time of the registration of the domain name suggests bad faith (see *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#)).

2) Use in bad faith

The disputed domain name currently resolves to an inactive page. The Complainant contends that the disputed domain name was being used as a placeholder, with a category of pay-per-click links titled "Related Searches," that contains a link to "Employment Recruiting" which then directs viewers/customers to third party sites offering competitive services to those of the Complainant (Annex E to the Complaint). In these circumstances, the Panel finds that the Respondent was using the disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademark, as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

The Complainant argues that the Respondent is holding the disputed domain name and is preventing the Complainant from obtaining its rightful ownership and control of the disputed domain name.

Prior WIPO UDRP panels have held that the incorporation of a famous mark in a domain name, coupled with an inactive website, may be evidence of bad faith registration and use. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *CBS Broadcasting, Inc. v. Dennis Toeppen*, WIPO Case No. [D2000-0400](#).

The Complainant has also indicated that the Respondent has set up MX-records for the disputed domain name (Annex F of the Complaint). This allows the Respondent to send and receive emails from the disputed domain name, which the Complainant argues may be used for fraudulent email communications.

These circumstances and the fact that the Respondent has decided not to provide any legitimate explanation or to assert any alleged good faith motivation in respect of the registration and use of the disputed domain name in the face of the Complainant's contentions can be regarded as an indicator of bad faith.

The fact that the disputed domain name currently resolves to an inactive page does not prevent a finding of bad faith.

Accordingly, the Panel concludes that the Complainant has satisfied its burden of showing bad faith registration and use of the disputed domain name under 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 <pridestaffcompanies.com> be transferred to the Complainant.

/Cherise Valles/

Cherise Valles

Sole Panelist

Date: November 11, 2022