

ADMINISTRATIVE PANEL DECISION

Smartmockups s.r.o. v. 徐帅伟 (Xu Shuai Wei)
Case No. DCO2022-0043

1. The Parties

The Complainant is Smartmockups s.r.o., Czech Republic, represented by SafeNames Ltd., United Kingdom.

The Respondent is 徐帅伟 (Xu Shuai Wei), China.

2. The Domain Name and Registrar

The disputed domain name <smartmockups.co> is registered with Chengdu West Dimension Digital Technology Co., Ltd. (the "Registrar").

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on May 26, 2022. On May 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 30, 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 May 31, 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 in English on May 31, 2022.

On May 31, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On May 31, 2022, the Complainant submitted its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Chinese of the Complaint, and the proceedings commenced on June 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 28, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 30, 2022.

The Center appointed Joseph Simone as the sole panelist in this matter on July 11, 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, Smartmockups s.r.o. is a leading player among online graphic design platforms, operating from the website "www.smartmockups.com" which attracts over 550,000 users monthly.

The Complainant has an extensive global portfolio of trade marks containing the term "smartmockups", including the following:

- European Union Trade Mark Registration for SMARTMOCKUPS No. 018313306 in Class 45, registered on March 17, 2022;
- European Union Trade Mark Registration for SMARTMOCKUPS (stylized) No. 018313309 in Classes 9, 42, and 45, registered on February 27, 2021; and
- Australia Trade Mark Registration for SMARTMOCKUPS (stylized) No. 2123578 in Classes 9, 42, and 45, registered on September 25, 2020.

The disputed domain name was registered on July 5, 2021.

According to screenshots provided by the Complainant, at the time of filing the Complaint, the disputed domain name resolves to a pay-per-click website and is available for sale on Sedo.com for USD 1,580.

At the time of drafting of this Decision, the disputed domain name still resolves to a pay-per-click website and is still advertised as available for sale on Sedo.com for USD 1,580.

5. Parties' Contentions

A. Complainant

The Complainant asserts that it has prior rights in the SMARTMOCKUPS trade marks and that it is a leading player in its fields of business.

The Complainant further asserts that the disputed domain name is identical or confusingly similar to the Complainant's SMARTMOCKUPS trade marks.

The Complainant also asserts that it has not authorized the Respondent to use the SMARTMOCKUPS mark and there is no evidence to suggest that the Respondent has used, or undertaken any demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services.

The Complainant further asserts that there is no evidence suggesting that the Respondent has any connection to the SMARTMOCKUPS mark in any way, and that there is no plausible good faith reason for the Respondent to have registered the disputed domain name, especially after considering the relevant circumstances. The Complainant therefore concludes that the registration and any use of the disputed domain name whatsoever must be in bad faith.

B. Respondent

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

6. Discussion and Findings

A. Language of the Proceeding

In accordance with paragraph 11(a) of the Rules:

"[...] the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding."

In this case, the language of the Registration Agreement for the disputed domain name is Chinese. Hence, the default language of the proceeding should in principle be Chinese.

However, the Complainant filed the Complaint in English, and requested that English be the language of the proceeding, asserting *inter alia* that:

- The disputed domain name resolves to a website in English with a note inviting visitors to purchase the disputed domain name; and
- The Respondent has been involved in multiple UDRP proceedings in the past, and those were held in English.

The Respondent was notified in both Chinese and English of the language of the proceeding and the Complaint, and the Respondent did not comment on the language of the proceeding or submit any response.

After considering the relevant circumstances, the Panel determined that the language of the proceeding shall be English, and the Panel has issued this decision in English. The Panel further finds that such determination would not cause any prejudice to either Party and would ensure that the proceeding takes place with due expedition.

B. Identical or Confusingly Similar

The Panel acknowledges that the Complainant has established rights in the SMARTMOCKUPS trade marks in many jurisdictions around the world.

Section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)) makes clear that in cases where a domain name incorporates the entirety of a trade mark, the domain name will normally be considered confusingly similar to that mark for the purposes of UDRP standing.

The disputed domain name incorporates the Complainant's SMARTMOCKUPS mark in its entirety with the Top-Level Domain ("TLD") ".co". Section 1.11.1 of the [WIPO Overview 3.0](#) states that the applicable TLD in a domain name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

The Panel therefore finds that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its rights in the SMARTMOCKUPS trade marks and in demonstrating that the disputed domain name is identical to its marks.

C. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, the complainant is required to establish a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made out, the respondent bears the burden of producing evidence in support of its rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

The Complainant asserts that it has not authorized the Respondent to use its trade marks and there is no evidence to suggest that the Respondent has used, or undertaken any demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services.

Thus, the Complainant has established its *prima facie* case with satisfactory evidence.

The Respondent did not file a response and has therefore failed to assert factors or put forth evidence to establish that it enjoys rights or legitimate interests in the disputed domain name. As such, the Panel concludes that the Respondent has failed to rebut the Complainant's *prima facie* showing of the Respondent's lack of rights or legitimate interests in the disputed domain name, and that none of the circumstances of paragraph 4(c) of the Policy is applicable in this case.

At the time of filing of the Complaint and at the time of drafting of this Decision, the disputed domain name resolved to a parking page with pay-per-click links.

As such, there is no evidence adduced to show that the Respondent, prior to the notice of the dispute, has used or has demonstrated preparation to use the disputed domain name in connection with a *bona fide* offering of goods or services. There is also no evidence adduced to show that the Respondent has been commonly known by the disputed domain name or the Respondent is making a legitimate noncommercial or fair use of the disputed domain name.

The Panel further finds that the disputed domain name is misleading and carries a high risk of implied affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

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

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered as evidence of the registration and use of a domain name in bad faith:

- (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 (the owner of the trade mark or service mark) or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the respondent registered the domain name in order to prevent the owner of the trade mark 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) circumstances indicating that the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent is using the domain name to intentionally attempt 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.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances in which bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant seeks to profit from and exploit the trade mark of another party. See *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. [D2004-0230](#).

For reasons discussed under this and the preceding heading, the Panel believes that the Respondent's conduct in this case constitutes bad faith registration and use of the disputed domain name.

When the Respondent registered the disputed domain name, the SMARTMOCKUPS trade marks were already widely known and directly associated with the Complainant's activities. UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely known trade mark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

Given the extensive prior use and fame of the Complainant's marks, in the Panel's view, the Respondent should have been aware of the Complainant's marks when registering the disputed domain name, and that it is no coincidence that the Respondent has registered the disputed domain name incorporating the exact same SMARTMOCKUPS trade mark.

The Respondent has also provided no evidence to justify its choice of the term "smartmockups" in the disputed domain name. In light of the foregoing, it would be unreasonable to conclude that the Respondent – at the time of the registration of the disputed domain name – was unaware of the Complainant and its trade marks.

The Complainant's registered trade mark rights in SMARTMOCKUPS for its products and services predate the registration date of the disputed domain name. A simple online search (e.g., via Google or Baidu) for the term "smartmockups" would have revealed that it is a design platform.

The Panel finds the trade mark SMARTMOCKUPS to be distinctive of the Complainant and has seen no evidence that the term has any meaning in commerce other than to identify the Complainant and its business. In the absence of any explanation from the Respondent of its choice of the disputed domain name, the Panel infers on balance that it was aware of the Complainant's trade mark SMARTMOCKUPS at the time it registered the disputed domain name and did so with the intention of taking unfair advantage of the Complainant's goodwill in that trade mark.

Absent any evidence from the Respondent to the contrary, the Panel finds that the Respondent registered the disputed domain name primarily for the purpose of selling it to the Complainant (or a competitor of the Complainant) for valuable consideration likely in excess of its out-of-pocket costs directly related to the disputed domain name. This conclusion is supported from the fact that the disputed domain name resolves to a parking page with a note that overtly seeks to sell the disputed domain name. Moreover, the parking page also contains pay-per-click links (paragraph 4(b)(iv) of the Policy).

The Panel finds in the circumstances that the disputed domain name has been registered and is being used in bad faith.

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, <smartmockups.co>, be transferred to the Complainant.

/Joseph Simone/

Joseph Simone

Sole Panelist

Date: July 22, 2022