

ADMINISTRATIVE PANEL DECISION

Withings v. Host Master, EdenMedia
Case No. DCO2022-0047

1. The Parties

The Complainant is Withings, France, represented by Plasseraud IP, France.

The Respondent is Host Master, EdenMedia, Seychelles.

2. The Domain Name and Registrar

The disputed domain name <withings.co> is registered with Key-Systems GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 14, 2022. On June 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 15, 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 June 16, 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 June 16, 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 June 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 7, 2022. The Respondent sent informal communications to the Center on June 22, 2022, and June 23, 2022. On July 8, 2022, the Complainant submitted an unsolicited supplemental filing to the Center. The Center notified the Commencement of Panel Appointment Process to the Parties on July 8, 2022.

The Center appointed Steven A. Maier as the sole panelist in this matter on July 18, 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.

Having considered all the circumstances of the case, the Panel deems it unnecessary to consider the Complainant's unsolicited supplemental filing in this proceeding.

4. Factual Background

The Complainant is a company registered in France. It is a provider of connected devices in the health sector including Wi-Fi scales, blood pressure monitors, smart sleep systems, and automatic activity tracking watches.

The Complainant is the owner of various trademark registrations for the mark WITHINGS, including for example:

- France trademark registration number 4056955 for a combined mark WITHINGS, registered on December 24, 2013, in International Classes 9, 10, and 14, for goods and services including (in translation) "health control and monitoring devices" in International Class 10.
- International trademark number 1227495 for the word mark WITHINGS, registered on June 23, 2014, in International Classes 9, 10, and 14, for goods and services including "apparatus for checking and monitoring health" in International Class 10.

The Complainant operates a website at "www.withings.com".

The disputed domain name was registered on September 13, 2019.

The Complainant provides evidence that the disputed domain name has resolved to a website offering what appear to be sponsored pay-per-click ("PPC") links labelled "Device Management", "Health Tracking Software" and "Health Monitoring Device".

The Complainant also provides evidence that, on June 9, 2022, the disputed domain name was offered for sale on "sedo.com" for a stated price of USD 10,282.

5. Parties' Contentions

A. Complainant

The Complainant states that it was founded in 2008, and is renowned for its design and innovation in connected devices. It states that it was acquired by Nokia in 2016, and subsequently repurchased by its founder in 2018. The Complainant exhibits information concerning its history and business profile, including evidence of industry awards for innovation. It states that the Android version of its principal mobile application has been downloaded over one million times and it provides details of a substantial social media presence on platforms including Facebook, Instagram, and Twitter. The Complainant submits that as a result of these matters, its name and trademark WITHINGS is well-known in the fields of connected devices for health.

The Complainant submits that its trademark WITHINGS is a coined term.

The Complainant submits that the disputed domain name is identical to its trademark WITHINGS.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It says that it has never licensed or authorized the Respondent to use its WITHINGS trademark, that the Respondent has no independent trademark or other rights in respect of that name and that the Respondent is not making any *bona fide* commercial use of the disputed domain name. The Complainant submits that, instead, the Respondent is using the disputed domain name to redirect to a “parking” page which includes links to competitors of the Complainant, and/or that the Respondent registered the disputed domain name primarily for the purpose of selling to the Complainant at an exorbitant price.

The Complainant contends that the disputed domain name has been registered and is being used in bad faith. It states that, since its WITHING trademark is both a coined term and well-known, the Respondent cannot have registered the disputed domain name by coincidence. The Complainant also points to the close similarity between the disputed domain name and its own domain name <withings.com>.

The Complainant refers to the links on the Respondent’s website to “Device Management”, “Health Tracking Software”, and “Health Monitoring Device” and submits that such links redirect to competitors of the Complainant. The Complainant submits that the Respondent has therefore used the disputed domain name to take business away from the Complainant.

The Complainant adds that the Respondent has configured mail exchanger (“MX”) records on the disputed domain name enabling it to send emails from addresses “[...]@withings.co”. The Complainant submits that this presents a risk of the disputed domain name being used for the purpose of fraudulent emails, which represents a threat to the Complainant and its reputation.

The Complainant points also to the Respondent’s attempt to sell the disputed domain name for USD 10,282, which it contrasts with the one-year cost for a “.co” domain name, which it states to be USD 41.15.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

The Respondent did not file a formal Response in this proceeding. However, in its email to the Center dated June 22, 2022, the Respondent submits that it acquired the disputed domain name on October 15, 2021, as part of a “monetization domain portfolio” of 56,000 domain names, used exclusively to direct users to paid advertisements selected by various PPC or zero click advertising networks with which it partners.

The Respondent states that, upon the acquisition of the portfolio, it performed a scan of the entire portfolio for potential infringed trademarks using “Estibot.com”. It states that the disputed domain name was not flagged in the scan and that it was entirely unaware of the trademark WITHINGS or the Complainant itself at the time it acquired the disputed domain name. The Respondent exhibits a page from “Estibot.com” headed “Domain Trademark Checker” which specifies the disputed domain name and includes the figure “0” under a column headed “Risk”.

The Respondent submits that the actual use of the domain names it controls is determined by the advertising networks with which it partners and that it has no direct control over the advertisements chosen for delivery to the visitor by those advertising networks. It states that it does, however, alert those advertisers to any “malicious” advertising campaigns such as that identified by the Complainant, but had received no complaints regarding the disputed domain name until its receipt of the Complaint in this proceeding.

The Respondent submits that it therefore has a legitimate interest in the disputed domain name which, as part of the above-mentioned portfolio, generates advertising revenues in a manner that, to the Respondent’s knowledge, does not infringe upon the classes of the Complainant’s trademarks.

The Respondent denies in the circumstances that the disputed domain name was registered or has been used in bad faith.

The Panel determines that the Respondent's submissions summarized above shall stand as its response in this proceeding. The Respondent's further email to the Center, dated June 23, 2022, contains nothing of relevance to the issues in the proceeding.

6. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are that:

- (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.

A. Identical or Confusingly Similar

The Complainant has established that it has registered trademark rights in the mark WITHINGS. The disputed domain name is identical to that trademark, ignoring the country code Top-Level Domain ("ccTLD") ".co" which is typically to be disregarded for the purposes of comparison. The Panel therefore finds that the disputed domain name is identical to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

In the view of the Panel, the Complainant has established a strong *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Panel makes this finding on the basis of the following factors in particular:

1. The Panel finds the Complainant's WITHINGS trademark to be a distinctive, coined, term which is widely known in the field of connected devices in the health sector.
2. The disputed domain name is identical to the Complainant's trademark for the purposes of paragraph 4(a)(i) of the Policy.
3. Furthermore, the disputed domain name including the TLD ".co" is highly similar to the Complainant's domain <withings.com>, from which it operates its principal website, differing from that domain name only by the omission of the final letter "m" in the TLD.
4. The disputed domain name has been used to redirect to sponsored links which include "Device Management", "Health Tracking Software", and "Health Monitoring Device", all of which reflect the commercial activities for which the Complainant is renowned.

Against these factors, the Respondent submits that it acquired the disputed domain name as part of a large portfolio of domain names, that it screened the whole portfolio for relevant trademarks but did not find the Complainant's WITHINGS trademark, that it had not otherwise heard of the Complainant or its trademark, and that it does not control the type of advertisement chosen by the advertising networks with which it partners.

Commentary on the approach adopted by panels under the UDRP in cases of this nature can be found in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). While section 3 of [WIPO Overview 3.0](#) is addressed primarily to the issue of bad faith, the considerations in that section are of equal application to the issue of rights and legitimate interests as claimed by the Respondent in this case.

In particular, section 3.2.2 of [WIPO Overview 3.0](#), “Knew or should have known”, states:

“Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant’s mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant’s mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent’s claim not to have been aware of the complainant’s mark.”

Section 3.3.3 of [WIPO Overview 3.0](#), “Willful blindness and the duty to search for and avoid trademark-abusive registrations”, states:

“Panels have held that especially domainers undertaking bulk purchases or automated registrations have an affirmative obligation to avoid the registration of trademark-abusive domain names. Panelists will look to the facts of the case to determine whether such respondent has undertaken good faith efforts to screen such registrations against readily-available online databases to avoid the registration of trademark-abusive domain names.”

In this case, the Panel finds that the Respondent has failed to discharge the obligation to avoid registering a domain name that was abusive of the Complainant’s trademark.

The Respondent has, in the first place, failed to file any formal Response in the proceeding or to exhibit any evidence in support of its submissions, with the exception of the single “Estibot.com” page which refers to the disputed domain name. Therefore, there is no evidence to support the Respondent’s claim that it acquired the disputed domain name as part of a portfolio of 56,000 domain names (although the Panel is willing to take this at face value), no information about the other names in that portfolio, and no evidence (other than the single “Estibot.com” page) of the full scanning exercise which the Respondent claims to have carried out.

Moreover, based on the Panel’s independent review of the operation of the “Domain Trademark Checker” offered on “Estibot.com”, the service states that: “Domains are parsed into words and checked with the USPTO.” Since this service appears to check only the United States Patent and Trademark Office database, the Respondent appears wholly to have ignored the possibility of trademark registrations in territories other than the United States of America. Not only that, but a basic search by the Panel of the USPTO database shows a number of live trademark registrations for marks comprising or including WITHINGS, dated years earlier than the acquisition of the disputed domain name. A search for WITHINGS against the WIPO Global Brand Database, moreover, produces numerous results in various territories referable to the Complainant. Furthermore, a Google search against the term WITHINGS produces numerous pages of results which appear to refer exclusively to the Complainant and its products. In the view of the Panel, these matters amply demonstrates the inadequacy of the “scan” that the Respondent claims to have carried out. The Panel furthermore notes that the Respondent’s “scan” seems not to have included an enquiry as basic as reviewing the “.com” version of the disputed domain name which, like the USPTO results, would have immediately alerted the Respondent the Complainant’s rights.

In conclusion, while the Respondent appears to base its claim to rights and legitimate interests upon having carried out a scan for any conflicting trademark rights, the Panel finds that scan to have been manifestly inadequate for its stated purpose. The Respondent failed to discharge the obligation to avoid the registration of trademark-abusive domain names and is unable therefore to establish rights or legitimate interests in respect of the disputed domain name. The Panel finds therefore that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

Similar considerations as set out above apply to the question of registration of the disputed domain name in bad faith. For that element to be established, the Complainant must demonstrate that the Respondent knew or ought to have known of the Complainant's trademark and registered the disputed domain name with a view to targeting that trademark. For the reasons set out above, the Panel finds on balance that the Respondent knew or should have known that the disputed domain name was identical or confusingly similar to the Complainant's trademark. Moreover, in view of the fact that the WITHINGS trademark is a distinctive, coined term and the near identity of the disputed domain name to the Complainant's own domain name, <withings.com>, from which its principal website is operated, the Panel can only reasonably conclude that the Respondent culpably targeted the Complainant's trademark.

Concerning the Respondent's use of the disputed domain name, the Panel finds the Respondent's adoption of the disputed domain name to be inherently misleading, as inevitably suggesting to Internet users that the disputed domain name is owned or operated by, or otherwise commercially affiliated with, the Complainant. Furthermore, on visiting the Respondent's website, Internet users have been met with links which the Panel finds directly to reflect the goods and services for which the Complainant is known. The Panel accepts in this regard the Complainant's submission that such links have redirected to destinations including competitors of the Complainant and are therefore detrimental to the Complainant's business.

With regard to the Respondent's claim that the advertising links connected with the disputed domain name were automatically generated and outside its control, paragraph 3.5 of [WIPO Overview 3.0](#) states:

"Particularly with respect to 'automatically' generated pay-per-click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests)."

While circumstances such as the use of 'negative keywords' may be a mitigating factor in such cases, there is no evidence in this case of any such precautions having been taken by the Respondent in this case. The Panel finds therefore that the Respondent cannot credibly disclaim responsibility for the advertisements in question.

The Panel therefore finds that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service on its website (paragraph 4(b)(iv) of the Policy).

The Panel notes further that the Respondent has not denied, nor made any attempt to explain, its configuration of MX records upon the disputed domain name. Such activity does not appear to be consistent with a "passive" holding of a domain name for the purpose only of generating linked advertising revenue and the Panel therefore considers the Complainant's stated concerns about this activity to be reasonably founded.

In the light of the distinctive nature of the Complainant's trademark (and website URL) and the use which the Respondent has made of the disputed domain name as described above, the Panel also finds it reasonable to infer that the Respondent registered the disputed domain name with a view to selling it to the Complainant (or a competitor of the Complainant) for the sum of USD 10,282, being a sum significantly in excess of its likely out-of-pocket costs directly associated with the disputed domain name (paragraph 3(b)(i) of the Policy). The Panel notes in this regard that there is no evidence in this proceeding of any party other than the Complainant that could make use of the disputed domain name that would not be likely to conflict with the Complainant's rights.

The Panel concludes 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, <withings.co>, be transferred to the Complainant.

/Steven A. Maier/

Steven A. Maier

Sole Panelist

Date: August 1, 2022