

## **ADMINISTRATIVE PANEL DECISION**

Century 21 Real Estate, LLC v. José Rojas, Century 21 Norte  
Case No. D2023-0394

### **1. The Parties**

The Complainant is Century 21 Real Estate, LLC, United States of America (“United States”), represented by Castillo y Castillo, Dominican Republic.

The Respondent is José Rojas, Century 21 Norte, Dominican Republic.

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

The disputed domain name <century21norte.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 31, 2023. On February 1, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 2, 2023, 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 February 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2023. The Center received an email communication from the Respondent on February 17, 2023. The Respondent did not file a formal Response.

The Center appointed Steven A. Maier as the sole panelist in this matter on March 15, 2023. 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 is a corporation organized under the laws of Delaware, United States. It is a franchisor of real estate services in numerous countries around the world under the brand and trademark CENTURY 21.

The Complainant is the owner of registrations for the trademark CENTURY 21 in various territories, including for example:

- United States trademark registration number 1063488 for the word mark CENTURY 21, registered on April 12, 1977 in International Class 34; and
- Dominican Republic trademark registration number 41405 for the word mark CENTURY 21, registered on October 15, 1986 in International Class 35.

The disputed domain name was registered on November 15, 2006.

It is common ground that an entity controlled by the Respondent (and others) has been an authorized franchisee of the Complainant. The Complainant states that the relevant franchise commenced on May 22, 2007. Further references to the Respondent in this Decision include the trading entity.

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

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

The Complainant submits that it has traded under the CENTURY 21 trademark for over 36 years and that it currently has approximately 7,250 franchisees in 71 countries. It contends that its CENTURY 21 trademark is distinctive, incontestable and famous.

The Complainant submits that the disputed domain name contains, and is therefore confusingly similar to, its CENTURY 21 trademark.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It contends that the Respondent was in default of its relevant franchise agreement and exhibits correspondence with the Respondent and other documentation commencing in January 2011 and relating principally to monies allegedly due. These exhibits include:

- a letter from the Complainant to the Respondent dated March 29, 2012, in which the Complainant asserts that the franchise agreement will terminate on May 31, 2012;
- a money judgment obtained by the Complainant against the Respondent in the Dominican Republic in July 2014;
- a letter from the Complainant to the Respondent dated June 3, 2016, offering the Respondent settlement terms under which it could obtain a new franchise agreement and stating: "As a pre-condition to the preceding, we are requiring that you immediately transfer the ownership of your website century21norte.com and any other website that uses the name Century 21 as any part of the url to us or as we assign."; and
- a letter from the Complainant to the Respondent dated July 6, 2016, stating: "In light of the fact that we have tried many times to come to an agreement with you, without success. We hereby deny you and your business the right the use of the brand CENTURY 21®."

The Complainant submits that the Respondent was not in any event authorized by the franchise agreement to register any domain name under the CENTURY 21 trademark. It exhibits a copy of its franchise

agreement with the Respondent. The Complainant further submits that: "... efforts were made without result, to comply with payment and to turn over the domain <century21norte.com> following the termination of the franchise agreement which confirms that the Respondent lacks right and legitimate interest in the disputed domain name..."

The Complainant submits that the disputed domain name was registered and has been used in bad faith. It states that the Respondent has continued to use the disputed domain name despite having been in default of the now terminated franchise agreement for over 10 years, and despite the Complainant's demand that it cease to use the CENTURY 21 trademark. The Complainant repeats that the Respondent was never authorized to registered the disputed domain name, even while it was a franchisee of the Complainant, and that it is now using the disputed domain name to divert Internet users from the Complainant's website to its own by misrepresenting a continuing connection with the Complainant.

The Complainant requests the transfer of the disputed domain name.

## **B. Respondent**

The Respondent did not file a formal Response in the proceeding. In its email to the Center dated February 17, 2023, the Respondent stated that it "previously had a relationship with the brand in the Dominican Republic, which will no longer continue". It stated that it was undergoing a name change and was in the process of removing everything related to the CENTURY 21 brand. It stated, however, that it did not wish to lose its personal email accounts associated with the disputed domain name as it had important information stored within those accounts.

## **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 respect of the mark CENTURY 21. The disputed domain name incorporates that trademark, which is therefore clearly recognizable within the disputed domain name. The Panel therefore finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

### **B. Rights or Legitimate Interests**

The Panel finds that the Complainant has established a good arguable case that the Respondent has no subsisting rights or legitimate interests in respect of the disputed domain name. While the Respondent was previously an authorized franchisee of the Complainant, it does not appear to be seriously disputed that that franchise relationship has now ended and that the Respondent has no ongoing licence to use the Complainant's CENTURY 21 trademark in commerce. However, in view of the Panel 's findings on the question of bad faith, below, it is not necessary for the Panel to reach a firm conclusion on this element.

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

The requirement that the disputed domain name “has been registered and is being used in bad faith” is a conjunctive requirement, meaning that both of these elements must be proven by the Complainant. That requirement is strictly observed by panels under the UDRP. While attempts have historically been made to imply retroactive bad faith in certain cases, current UDRP jurisprudence is clear that no such approach is permissible and that the respondent must be shown to have known of, and to have unfairly targeted, the complainant’s trademark at the date of registration of the disputed domain name (see e.g. [WIPO Overview 3.0](#), section 3.2.1).

In this case, the Complainant has not persuaded the Panel that the disputed domain name was originally registered by the Respondent in bad faith. The Respondent registered the disputed domain name some months before its appointment as a franchisee of the Complainant, being apparently entitled as a franchisee to use the Complainant’s CENTURY 21 trademark in commerce. While the Complainant states that the Respondent was not authorized under the relevant franchise agreement to register the disputed domain name, the Complainant has not provided clear evidence to the satisfaction of the Panel that such registration was expressly prohibited. Furthermore, even if unauthorized, that would not automatically render the Respondent’s registration in bad faith under the Policy, unless the Respondent intended at that time to divert business away from the Complainant (or its authorized franchisees) or otherwise to take unfair advantage of the Complainant goodwill in the CENTURY 21 trademark. The Panel has seen no evidence to that effect. In the Panel’s opinion, it seems reasonable in the circumstances of the case to infer that the Respondent registered the disputed domain name with a view to becoming a franchisee of the Complainant, which took place a few months after the registration, with a relationship lasting for several years.

Furthermore, it is clear from the correspondence exhibited by the Complainant that it was aware of the Respondent’s use of the disputed domain name and indeed corresponded with the Respondent for several years at an email address linked to the disputed domain name. There is nothing in the correspondence exhibited by the Complainant that claims the Respondent registered the disputed domain name improperly, and indeed the Complainant sought the transfer of the disputed domain name in June 2016 as one of the terms of a new commercial arrangement.

Since the Complainant cannot establish to the satisfaction of the Panel that the disputed domain name was originally registered by the Respondent in bad faith, the Complaint must inevitably fail and it is unnecessary for the Panel to consider the Respondent’s subsequent use of the disputed domain name.

The Panel also observes that, while it may be open to the Complainant to pursue its claims in respect of the disputed domain name in an appropriate court of law, the present case is not one of “cybersquatting” or a similar mischief to which the UDRP is directed: see e.g. section 4.14.6 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

The Complainant has failed to establish, therefore, that the disputed domain name has been registered and is being used in bad faith.

### **7. Decision**

For the foregoing reasons, the Complaint is denied.

*/Steven A. Maier/*

**Steven A. Maier**

Sole Panelist

Date: March 29, 2023