

ADMINISTRATIVE PANEL DECISION

VIOOH Limited v. Adel Samir, VOIOH

Case No. D2023-1190

1. The Parties

Complainant is VIOOH Limited, United Kingdom, represented by Nameshield, France.

Respondent is Adel Samir, VOIOH, Egypt.

2. The Domain Name and Registrar

The disputed domain name <voioh.com> (the “Domain Name”) is registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 16, 2023. On March 16, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 17, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email to Complainant on March 22, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Respondent replied on March 22, 2023, requesting further information about the case. On March 24, 2023, Complainant requested a suspension of the proceedings to explore settlement options. The Center granted a suspension until April 23, 2023. Complainant filed an amended Complaint on April 14, 2023. On April 19, 2023, Complainant requested the reinstatement of the proceedings.

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 Respondent of the Complaint, and the proceedings commenced on April 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 10, 2023. The Response was filed with the Center on May 10, 2023.

The Center appointed Robert A. Badgley as the sole panelist in this matter on May 16, 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

Complainant is a marketing technology firm. According to the Complaint:

“Launched in 2018, VIOOH Limited is a leading premium global digital out of home marketplace, combining data and technology, connecting buyers and sellers, all with full transparency. VIOOH Limited is placed fourteenth in the MarTech 50 ranking for 2023.”

Complainant owns several registered trademarks for VIOOH, including: French Reg. No. 4404784, registered November 15, 2017 in Classes 9, 35, 36, 38, 40, and 41 in connection with, among other things, software and computer databases for measurement of media consumption, on line advertising on computer networks, financial estimates related to the sale of advertising space, and telecommunications services (electronic display services), publication of computer and electronic content; and International Reg. No. 1436571, registered on May 14, 2018 in connection with the same essential services indicated under the French registration.

Complainant owns several domain names containing the VIOOH mark, including <viooh.com> (registered on February 27, 2017) and <viooh.net> (registered on November 9, 2017). Complainant’s main website is located at <viooh.com>.

The Domain Name was registered on March 10, 2023. The Domain Name resolves to an error page. In addition, Complainant notes (and supports with screenshot evidence), mail exchanger records (MX records) have been configured for this Domain Name, thus enabling the use of the Domain Name for email purposes.

As noted below, Respondent alleges that he is a voice-over artist.

5. Parties’ Contentions

A. Complainant

Complainant contends that it has established each of the three elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent’s position is summarized in the following truncated version of his Response:

“...I am a voice-over artist, and I intended to use this domain name for my voice-over business...”

“While I acknowledge that my domain name, <voioh.com>, has a slight misspelling of the Complainant’s trademark VIOOH®, this misspelling is not intentional and does not constitute typosquatting. I offer two points to support this claim: (i) The misspelling completely alters the pronunciation; ‘VIOOH’ is pronounced as ‘VIEW’, where ‘VOIOH’ is pronounced as ‘Voi-Oh’. (ii) The term ‘voioh’ originates from the words ‘voice over’. The term ‘vo’ is a commonly used abbreviation for ‘voice over’, and ‘voioh’ comes from the first three letters of the word ‘voice’ and the pronunciation of the letter ‘O’ as ‘Oh’. This is a common and legitimate way to create a domain name that is descriptive of the business or service being offered.”

"I disagree with the allegation that I have no rights or legitimate interests in the disputed domain name. I purchased the domain name for my freelancing voice-over business, and I have a legitimate interest in the domain name. The following three points specifically address the Complainant's statements: (i) The registered address relates to my home recording studio where I offer my services as a voice-over artist. It does not relate to a business entity or organizational address. (ii) I have provided the Complainant with evidence of legitimate use of the domain name, as per our communication mail exchange. (iii) The domain name was planned to be used, and the draft 'coming soon' landing page was published on March 15, 2023. This was around one week before the reception of the first communication mail of the case filing on March 22, 2023. Accordingly, I believe that I have established a bona fide use of the domain name. I have attached evidence of a preparation to use the domain name, which includes a test email campaign with the Voioh brand dated September 2, 2021..."

"I disagree with the allegation that the disputed domain name was registered and is being used in bad faith. The domain name was going to be used to promote a legitimate business, and there is no evidence to suggest that I have registered or used the domain name in bad faith. The following four points specifically reply to the Complainant's statements: (i) I searched for the 'exact match' of the term 'voioh' in a simple Google search, and there was no mention of the Complainant's trademark in the search results. Additionally, the Complainant's trademark is neither known in my geographical region (Egypt, Middle-East), nor in my business industry, the 'voice-over' industry. (ii) The misspelling in the domain name was not intentional and relates to my business offering as a voice-over artist. (iii) The domain name resolves to an error page because the landing page was published on March 15, while the Complainant checked it on March 16 - typical DNS propagation takes up to 24 to 48 hours to reflect for all internet users - and the domain was locked later due to the filing of the UDRP case. (iv) The MX records are set up due to the 'Gmail' service provided by the registrar, 'Google Domains', from which I purchased the domain. I intended to use the email address "adelsamir@voioh.com" for my business communication."

"I have engaged with the client in good faith negotiations. I have shown interest in reaching a settlement agreement to transfer the domain to your client. I have not even tried to "sell" the domain, rather than get "compensated" for what I spent on it. [...] Lastly, please note that I am still open to negotiate the transfer of this domain to your client -if this is still on table-."

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element of the UDRP functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between Complainant's trademark and the Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds that Complainant has shown rights in respect of multiple registered trademarks for VIOOH.

The Panel also finds the VIOOH mark is recognizable, albeit in slightly altered form, within the Domain Name. Accordingly, the Domain Name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] 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 [Respondent] (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 [Respondent] 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 Panel need not address this element, given its holding below regarding the “bad faith” element.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation”, are evidence of the registration and use of the Domain Name in “bad faith”:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that 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 Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes, on a balance of probabilities and based on the record presented, that Complainant has failed to prove that Respondent registered the Domain Name in bad faith. A finding of bad faith registration of the Domain Name requires a finding that Respondent more likely than not had Complainant’s trademark in mind when registering the Domain Name. The Panel cannot make such a finding here. Rather, the Panel finds Respondent’s denial of knowledge of Complainant and its VIOOH mark is plausible.

First, the Domain Name and the mark are not identical, particularly in terms of their sound.

Second, Respondent is not engaged in the same area of commerce as Complainant.

Third, Complainant's area of commerce, which is a service for businesses, is not one that an ordinary individual would necessarily be expected to know. The record does not indicate the extent to which the VIOOH mark is known in Egypt, Respondent's country.

Fourth, Respondent's explanation of why he chose the Domain Name (as a sort of shorthand for "voice-over") strikes the Panel as plausible. Respondent states that he did a search for an exact match of "voioh" and that search did not yield Complainant's VIOOH mark. Further, Respondent provided one document showing that, on September 4, 2021, he had set up the beginning of an advertising page reflecting his work in the voice-over business; he also provided a test email for his proposed service.

The Panel also notes the expression by the Respondent of an offer to negotiate a settlement, which the Panel takes here to be different than a typical offer to sell to a trademark owner who has been targeted.

The UDRP is designed to address clear cases of cybersquatting. The record here does not indicate that this is such a case.

Complainant has not established Policy paragraph 4(a)(iii).

7. Decision

For the foregoing reasons, the Complaint is denied.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: May 21, 2023