

ADMINISTRATIVE PANEL DECISION

Sleeptopia, Inc. v. Gregory Perez
Case No. D2023-1317

1. The Parties

Complainant is Sleeptopia, Inc., United States of America (“United States”), represented by Hovey Williams LLP, United States.

Respondent is Gregory Perez, United States.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 27, 2023. On March 29, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 30, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on March 30, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on April 4, 2023.

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 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 25, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 2, 2023.

The Center appointed Christopher S. Gibson as the sole panelist in this matter on May 19, 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

Since at least as early as January 1, 2013, Complainant has advertised, promoted, and offered its products and services in the field of sleep apnea using its business name and trademark, SLEEPTOPIA.

Complainant is a health provider in the field of sleep apnea that provides sleep testing and diagnostic services, supplies continuous positive airway pressure (“CPAP”) machines and masks for sleep apnea therapy, employs a number of licensed doctors who specialize in sleep disorders and sleep therapy, and provides its patients with educational awareness and resources regarding sleep disorders, such as sleep apnea, and the most effective treatment available.

Complainant owns an incontestable United States trademark for SLEEPTOPIA in standard characters. The trademark is registration no. 5983977, registered February 11, 2020, with a date of first use in commerce of January 1, 2013, for “[h]ealth assessment services, namely, providing a database in the field of sleep apnea and home sleep testing diagnostic information based on collected data and information all for treatment and diagnostic purposes”. Complainant’s products and services are provided and sold under the SLEEPTOPIA mark in physical office locations and through Complainant’s website at “www.sleepiainc.com”, a website owned and operated by Complainant since February 14, 2013.

The Domain Name was registered on July 30, 2006. The registration was subsequently updated on September 4, 2022. The Domain Name resolves to pay-per-click (“PPC”) links offering products and services that compete with those offered by Complainant.

5. Parties’ Contentions

A. Complainant

(i) Identical or confusingly similar

Complainant states its products and services are of the highest quality and are actively promoted, provided, offered, and sold through the use of and in connection with its SLEEPTOPIA trademark. The SLEEPTOPIA mark in its entirety and when used with Complainant’s products and services is an inherently distinctive and made-up phrase, created, and owned by Complainant. Complainant has expended substantial time, money, and effort to actively and continuously use the SLEEPTOPIA mark for an extensive amount of time, and has acquired significant goodwill through such use of the mark in connection with Complainant’s products and services.

Complainant contends the Domain Name is identical to, nearly identical to, confusingly similar with, and/or a near-exact reproduction of the SLEEPTOPIA mark, without any changes or additional wording before the generic Top-Level Domain (“gTLD”), and therefore the SLEEPTOPIA mark comprises the Domain Name’s predominantly featured element. A comparison of the Domain Name to the SLEEPTOPIA mark is all that is necessary to establish the identity or near identity between the Domain Name and Complainant’s trademark and incontestable United States trademark registration.

Complainant states the gTLD “.com” is disregarded when comparing the Domain Name to Complainant’s SLEEPTOPIA mark, since it is a technical registration requirement. Thus, the inclusion or use of “.com” with the Domain Name does not provide any distinguishing element when considering the identity and/or confusing similarity between the Domain Name and Complainant’s SLEEPTOPIA mark.

(ii) Rights or legitimate interests

Complainant states that its first use of the SLEEPTOPIA mark dates back over ten years, to January 1, 2013. Since at least as early as 2013, Complainant has continuously used the mark in connection with Complainant’s products and services. On July 29, 2019, Complainant applied for registration of the SLEEPTOPIA mark with the United States Patent and Trademark Office (“USPTO”), which was subsequently registered on February 11, 2020.

According to the Whois database information, the Domain Name was registered on July 30, 2006; however, Complainant contends that according to the archives at “www.web.archive.org”, the site was first used in 2011, at which time it was parked for free, courtesy of GoDaddy.com. Between 2006 and December 22, 2021, the only content displayed or available through the archives shows the Domain Name resolved to nothing more than a parked site.

However, Complainant submits that as of at least January 2023 and through the date the Complaint was filed, the Domain Name actively resolves to a generic pay-per-click (“PPC”) website offering links to products in the sleep therapy industry that are directly competitive with those offered by Complainant under the SLEEPTOPIA mark – namely, CPAP supplies, pillow, and mattresses business – resulting in cybersquatting.

Complainant has not licensed nor authorized the use of its trademark to Respondent, and Respondent is not commonly known by the Domain Name through any use, whether it be through the parked site or the cybersquatting site. Further, Complainant argues that past Panels have established that generally, parking webpages for a respondent’s commercial gain does not provide a legitimate interest in the domain name under the Policy. Moreover, because the SLEEPTOPIA mark is not a dictionary word, colloquial term, or otherwise descriptive in nature, Complainant claims it has made the above *prima facie* case that paragraph 4(a)(ii) has been satisfied, and therefore Respondent bears the burden of proof to show that it has rights or legitimate interests in the Domain Name, without Respondent palming off the goodwill of Complainant’s rights in the SLEEPTOPIA mark. Complainant argues that Respondent cannot meet its burden of proof, and therefore, has no rights or legitimate interests in the Domain Name, as Respondent is merely engaging in cybersquatting activity that uses Complainant’s SLEEPTOPIA mark to host sponsored PPC links associated with, and directly competing with, Complainant’s products and services.

(iii) Registered and used in bad faith

Prior to the registration of Complainant’s SLEEPTOPIA mark on February 11, 2020, Complainant’s first use of its business and brand name dates back to January 1, 2013, and Complainant has since continuously used the SLEEPTOPIA mark in connection with Complainant’s products and services, provided and sold in physical office locations and through Complainant’s website.

Complainant states that according to the Whois database information, the Domain Name was originally registered on July 30, 2006, was set to expire on July 30, 2023, but was “last updated” on September 4, 2022. Complainant understands the general rules regarding this aspect of the Policy, whereby a complainant would not typically prevail where its trademark rights postdate the creation date of the disputed domain name; however, Complainant claims this case lies within the exception of that rule because, based on all currently known facts, Complainant believes that the Domain Name was likely transferred to Respondent after Complainant acquired trademark rights in the SLEEPTOPIA mark. Complainant’s belief is based on the limited facts and knowledge currently available to Complainant, such as (i) the “last update” occurring in September 2022, when the renewal or expiration date of the Domain Name was set for July 2023; and (ii) all archived images between 2006 and 2021 show the Domain Name resolving to a website parked for free by GoDaddy.com, whereas images captured by Complainant between January and March 2023 (after the last update and after Complainant owned rights in SLEEPTOPIA), show the Domain Name resolving to a generic PPC website advertising products and services directly competitive with Complainant’s products and services and squarely positioned within Complainant’s sleep therapy industry.

Moreover, Complainant states that shortly before or around the “last update” date of September 4, 2022, Complainant filed a request through GoDaddy seeking to contact the then-registrant of the Domain Name to discuss Complainant’s desire to purchase the Domain Name. No response was received; However, the registrant’s information was removed from publicly accessible Whois information, presumably as a result of a transfer in ownership or employment of a proxy service, which further allows the Panel to infer bad faith.

Complainant urges that it is not unreasonable to infer the transfer in possession of the Domain Name around September 4, 2022, and therefore the Policy’s registration in bad faith requirement should be assessed from this date, as the date the current Respondent likely acquired the Domain Name, and as the relevant date of bad faith registration by Respondent, which postdates Complainant’s trademark rights in and ownership of

the SLEEPTOPIA mark. Since Complainant alleges a relevant change in registration of the Domain Name has occurred, and was intentionally masked by Respondent through use of a proxy service, it is now incumbent on Respondent to provide satisfactory evidence of an unbroken chain of registration to rebut a presumption of bad faith registration.

Complainant claims that based on Complainant's established, long-term use of SLEEPTOPIA in connection with Complainant's products and services and Complainant's reputable business and goodwill, Respondent had knowledge of Complainant's trademark before the September 4, 2022, transfer date, acquiring and using the Domain Name in bad faith to target Complainant's unsuspecting customers using the SLEEPTOPIA mark for non-legitimate commercial gain and to deceive or create confusion among the relevant market and purchasers. Complainant submits that in using the Domain Name for no purpose beyond cybersquatting through a PPC website with links to products that directly compete with Complainant's business, products and services, Respondent creates a likelihood of confusion with Complainant's SLEEPTOPIA mark and seeks to obtain revenue from this deceptive activity and practice.

Accordingly, Complainant concludes Respondent is intentionally attempting to palm off the goodwill of Complainant and Complainant's SLEEPTOPIA mark to traffic Internet users through Respondent's website at the Domain Name, for commercial gain, in bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

In order to succeed on its Complaint, Complainant must demonstrate that the three elements set forth in paragraph 4(a) of the Policy have been satisfied. These elements are that:

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

A. Identical or Confusingly Similar

Complainant has demonstrated that it has rights in its SLEEPTOPIA trademark, both through its USPTO registration and continuous use since 2013. The Panel finds that the Domain Name incorporates the SLEEPTOPIA mark in its entirety, without variation. See, e.g., *Beachbody, LLC v. Contact Privacy, Inc. Customer 1244448913, Contact Privacy, Inc. / Thomas Medley*, WIPO Case No. [D2019-1157](#) (finding confusing similarity where a disputed domain name incorporated the complainant's mark in its entirety).

Accordingly, the Panel finds that the Domain Name is identical or confusingly similar to a trademark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Regarding the second element of the Policy, section 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), states, "where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element".

Here, the Panel determines that Complainant has made out a *prima facie* case, while Respondent has failed to respond to Complainant's contentions. The Panel finds that Complainant has not authorized Respondent

to use Complainant's SLEEPTOPIA mark; that Respondent is not commonly known by the Domain Name; that Respondent has not used the Domain Name for a legitimate noncommercial or fair use, nor used it in connection with a *bona fide* offering of goods or services. Instead, the Domain Name links to a PPC site with links to products in the sleep therapy industry that are directly competitive with those offered by Complainant under the SLEEPTOPIA mark, including CPAP supplies, pillow, and mattresses. Additionally, past UDRP panels have established that parking webpages for a respondent's commercial gain does not provide a legitimate interest in the domain name under the Policy. See, e.g., *Merck Sharp & Dohme Corp. v. Domain Administrator, PrivacyGuardian.org / George Ring, DN Capital Inc.*, WIPO Case No. [D2017-0302](#) (finding a *prima facie* case established under paragraph 4(a)(ii) where complainant owned the registered trademark GARDASIL for pharmaceutical preparations and HPV vaccines, and respondent used <gardasilvaccine.com> linked to a PPC website with links relating to vaccines, cancer, and HPV); *Eastman Sporto Group LLC v. Jim and Kenny*, WIPO Case No. [D2009-1688](#) (finding pre-2008 use of domain name within Policy's safe harbor, but respondent's use since 2008 to be illegitimate cybersquatting via a standard PPC page with hyperlinks based upon complainant's industry, directing users to sites that purportedly sell directly competitive products).

Accordingly, the Panel finds that Complainant has made a *prima facie* showing of Respondent's lack of rights or legitimate interests in respect of the Domain Name, which has not been rebutted by Respondent. The Panel therefore finds that Complainant has established the second element of the Policy in accordance with paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires that Complainant demonstrate that Respondent registered and is using the Domain Name in bad faith. [WIPO Overview 3.0](#), section 3.1, states, "bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark".

Here, the Panel determines that the Domain Name was registered and is being used in bad faith. First, it is clear that the Domain Name is being used in bad faith, as it resolves to a webpage with PPC links purporting to offer goods and services competitive with those offered by Complainant. Respondent has made no attempt to respond to Complainant's allegation on this point, or to otherwise justify its use of the Domain Name.

That noted, the key question in this case is whether the Domain Name was registered in bad faith. Complainant has presented evidence that the Whois database information for the Domain Name indicates it was originally registered on July 30, 2006, prior to Complainant's acquisition of trademark rights, but that the Domain Name's Whois registration record was later updated on September 4, 2022, after Complainant had acquired its trademark rights. The update date in the Whois record for a domain name indicates the last time a change is made to the domain name's registration information. In this case, the change was made (as pointed out by Complainant) before the next regularly scheduled renewal date for the Domain Name. Complainant claims the Domain Name was likely transferred to Respondent after Complainant acquired trademark rights in the SLEEPTOPIA mark because of two factors: (i) shortly before the September 4, 2022, update to the Domain Name's Whois record, Complainant filed a request (through GoDaddy) seeking to contact the then-registrant of the Domain Name to discuss Complainant's desire to purchase it. Following this contact, the September 2022 update to the Domain Name's Whois record took place and the registrant's information was removed from publicly accessible Whois information, presumably as a result of a transfer in ownership or employment of a proxy service; and (ii) the change in use of the Domain Name, with archived images between 2006 to 2021 showing it resolving to a website parked by GoDaddy.com, while images captured between January and March 2023 show the Domain Name resolving to a PPC website advertising products and services directly competitive with Complainant's products and services. Based on these facts, Complainant argues it is reasonable to infer the transfer in possession of the Domain Name around September 4, 2022, and therefore the Policy's registration in bad faith requirement should be assessed from this date as the date the current Respondent likely acquired the Domain Name, which postdates Complainant's trademark rights in the SLEEPTOPIA mark.

Faced with these allegations, Respondent has made no response with no attempt at all to explain or justify its registration of the Domain Name, or its subsequent use of the Domain Name, as noted above. *Angelica Fuentes Téllez v. Domains by Proxy, LLC / Angela Brink*, WIPO Case No. [D2014-1860](#) (inferring respondent's attempt to conceal its identity in bad faith based on respondent's failure to provide evidence of an unbroken chain of registration). Further, Respondent has not responded to Complainant's allegation that, based on Complainant's established, long-term use of SLEEPTOPIA in connection with Complainant's products and services and Complainant's reputable business and goodwill, Respondent likely had knowledge of Complainant's trademark before the relevant September 4, 2022, date, and therefore acquired the Domain Name in bad faith to target Complainant's SLEEPTOPIA mark and use it for the PPC website with links to products that directly compete with Complainant's products and services. See *Pinterest, Inc. v. Pinerest.com, et al.*, WIPO Case No. [D2015-1873](#) (notwithstanding the original date of creation and prior unrelated purposes of the disputed domain name, the panel found bad faith registration when balancing probabilities that the transfer of possession took place as of the "last updated" date with the intent to target complainant's trademark); see also [WIPO Overview 3.0](#), section 3.6 (stating "[...] where the respondent does not avail itself of the opportunity to respond to claims based on the timing of the registration of the disputed domain name (such as a materially relevant change in underlying registrant), panels have been prepared to infer that the use of a privacy or proxy service may seek to mask the timing of the respondent's acquisition of the domain name").

The Panel determines that, on the balance of the probabilities and for all of the above reasons, the Domain Name was registered and is being used in bad faith. Accordingly, Complainant has satisfied the third element 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 Domain Name, <sleeptopia.com>, be transferred to Complainant.

/Christopher S. Gibson/

Christopher S. Gibson

Sole Panelist

Date: June 20, 2023