

ADMINISTRATIVE PANEL DECISION

VAL MAR S.R.L. v. Scott Cox

Case No. D2023-3037

1. The Parties

The Complainant is VAL MAR S.R.L., Italy, represented by AMSL Avvocati, Italy.

The Respondent is Scott Cox, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <ab1tackleusa.com> is registered with Automattic Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 14, 2023. On July 17, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 18, 2023, 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 (Private Whois, Knock Knock WHOIS Not There, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 20, 2023, 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 amendment to the Complaint on July 24, 2023.

The Center verified that the Complaint together with the amendment to 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 July 26, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 15, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 16, 2023.

The Center appointed Andrew F. Christie as the sole panelist in this matter on August 30, 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 an Italian company specializing in the manufacture of fishing equipment, including rods, rollers, and rockets. It manufactures and sells a line of products for deep-sea fishing under the brand “AB1”.

The Complainant is the owner of United States Trademark Registration No. 5694193 (registered on March 12, 2019) for the stylized trademark AB1 ADVANCED BIG GAME TECHNOLOGY in respect of fishing-related goods in classes 25 and 28, including fishing tackle. The registration certificate shows and describes the trademark as consisting of an imprint of the wording “AB1”, in fancy characters, below which there is the wording “ADVANCED BIG GAME TECHNOLOGY”, in smaller fancy characters.

The Complainant is the registrant of the domain name <ab1tackle.com> registered on January 28, 2017. On July 9, 2019, the Complainant and the Respondent entered a Marketing & Sales Agreement for the territory of the United States. This agreement identified the Respondent as the “Brand Manager, AB1 USA”, and the Respondent’s responsibilities as including the development of “US market specific AB1 support materials ... [which] may include AB1USA.com website”. On June 15, 2020, the Respondent invoiced the Complainant for the sum of USD 7,500 for services described as “AB1usa.com website – initial startup”, which was paid in full by the Complainant.

The disputed domain name was registered on December 19, 2019. At the time of this decision, the disputed domain name resolves to a website that prominently displays the characters “AB1” and purports to offer for sale fishing equipment branded as “AB1”.

Some time after registration of the disputed domain name, the Complainant found out that the registrant was not the Complainant, but the entity PRIVATE WHOIS – Knock Knock WHOIS Not There, LLC. The Complainant sent a cease and desist letter to the named registrant and to the Respondent on December 13, 2022, ordering them to cease using the website resolving from the disputed domain name, and to transfer the title of the disputed domain name to the Complainant. In that letter the Complainant also ceased all contractual and employment relationships with the Respondent from that date. There was no response from the Respondent to that letter.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that: (a) the disputed domain name wholly incorporates the Complainant’s registered trademark; (b) the addition of a geographic term in the disputed domain name creates confusing similarity; (c) the website resolving from the disputed domain name precludes the Complainant from controlling one of the most important areas of the global market; (d) the Respondent has not responded to the cease and desist letter; and (e) the Respondent is now sitting on the disputed domain name in order to prevent the Complainant from reflecting its trademark in a corresponding domain name, and his refusal to return the disputed domain name to the Complainant is being done out of malice or spite.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed 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 the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. This trademark consists of the characters "AB1", together with the words "Advanced Big Game Technology".

The characters "AB1" are the most dominant element of the Complainant's trademark. The disputed domain name consists of those dominant characters together with the terms "tackle" and "usa", and the generic Top-Level Domain ".com". The addition of the word "tackle", which is descriptive of the nature of the goods in respect of which the Complainant uses its trademark, and the term "usa", which is a reference to a geographical market in which the Complainant sells its goods under the trademark, does not avoid the finding of confusing similarity of the disputed domain name with the Complainant's trademark that results from the incorporation of its dominant characters "AB1".

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, 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. [WIPO Overview 3.0](#), section 2.1.

The evidence establishes that the Respondent was engaged by the Complainant to develop a website for the Complainant. The implication of the Complainant's assertions, which are unrebutted by the Respondent, is that the disputed domain name was registered for the purpose of that website. Nothing in the available record indicates that it was the parties' intention that the Respondent should acquire rights or legitimate interests in any domain name, including the disputed domain name, that was registered by the Respondent for the purpose of developing the website for the Complainant.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The evidence establishes that the Respondent registered the disputed domain name in furtherance of an agreement with the Complainant to develop a website for the Complainant. In the absence of any evidence indicating that the parties intended the disputed domain name to be registered in the name of the Respondent, it must be concluded that the parties intended the disputed domain name to be registered in the name of the Complainant. The Respondent's registration of the disputed domain name in his name is, in these circumstances, a registration in bad faith.

The evidence establishes that the Respondent has used the disputed domain name to resolve to a website that purports to offer for sale the Complainant's goods under the Complainant's trademark. The Respondent has continued to use the disputed domain name in this way following the termination of his services agreement with the Complainant, and in defiance of the Complainant's demand that he cease using the disputed domain name and that he transfer it to the Complainant. The Respondent's use of the disputed domain name in these circumstances is a bad faith use of it.

Based on the available record, the Panel finds the third element of the Policy has been established.

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, <ab1tackleusa.com>, be transferred to the Complainant.

/Andrew F. Christie/

Andrew F. Christie

Sole Panelist

Date: September 13, 2023