

## **ADMINISTRATIVE PANEL DECISION**

Cathleen Trigg-Jones v. Witold Stawarz  
Case No. D2023-3258

### **1. The Parties**

The Complainant is Cathleen Trigg-Jones, United States of America (“United States”), represented by The Vanel Law Firm, P.C., United States.

The Respondent is Witold Stawarz, Poland.

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

The disputed domain name <iwoman.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 18, 2023. On July 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 28, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 31, 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 31, 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 August 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 5, 2023. The Response was filed with the Center on August 28, 2023.

The Center appointed Assen Alexiev as the sole panelist in this matter on September 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**

The Complainant is a social entrepreneur with a background in journalism, multi-media production, public relations, marketing, public speaking, and executive coaching. She is the owner of the United States trademark registrations for the trademark IWOMAN™ with registration Nos. 6504370 and 6504371 (the “IWOMAN trademark”), both registered on September 28, 2021 in the United States Patent and Trademark Office (“USPTO”) Supplemental Register for services in International Class 41. The claimed date of first use of the IWOMAN trademark is January 1, 2019.

The disputed domain name was registered on October 17, 1997. The Respondent claims to have acquired it in 2009. It currently resolves to a parked webpage. According to the archives available at the Wayback Machine, in 2014 the disputed domain name resolved to a website that contained information about pregnancy in women.

#### **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.

The Complainant states that the disputed domain name is identical to its IWOMAN trademark.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because there is no evidence of the Respondent’s use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services. The Complainant maintains that the Respondent has never been commonly known by the disputed domain name and that it has not acquired any trademark rights. The Complainant states that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant’s trademark. According to the Complainant, the Respondent is illegally cybersquatting and offering the disputed domain name for sale.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. According to it, the disputed domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring its registration to the Complainant or to a competitor of the Complainant for valuable consideration in excess of the Respondent’s out-of-pocket costs directly related to the disputed domain name.

##### **B. Respondent**

The Respondent requests that the Complaint be denied, and submits that the Complainant has not shown evidence sufficient to prove any of the elements of its claim for transfer of the disputed domain name.

The Respondent states that the disputed domain name was registered by him in 2009, and maintains that he developed a blog website at the disputed domain name in 2014. The Respondent notes that its website is currently down for further development and upgrades.

The Respondent points out that the disputed domain name consists of “common dictionary words ‘i woman’,” which he has used to create a website addressed to women. The Respondent maintains that he has legitimate interests in respect of the disputed domain name and that it was not registered and is not being used in bad faith. The Respondent maintains that the Complainant’s IWOMAN trademark is not as old as his ownership of the disputed domain name, and although the Complainant may be able to show rights sufficient to establish the first element of a claim under the Policy, the bad faith registration and use requirements of paragraph 4(a)(iii) of the Policy are fatal to its claim.

The Respondent further points out that the Complainant's IWOMAN trademark is listed on the USPTO Supplemental Register, which means that it is descriptive and has not acquired distinctive status. The Respondent cites McCarthy on Trademarks and Unfair Competition, according to which the registration on the Supplemental Register "confers no substantive trademark rights beyond those under common law", and "does not entitle the registrant to any statutory presumption that the term is a trademark and not a generic name".

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

As pointed out by the Respondent, the Complainant's IWOMAN trademark is registered in the USPTO Supplemental Register. According to the official website of the USPTO, the Supplemental Register is a listing of non-mark designations (such as descriptive words) that are "capable" of eventually becoming a "mark."

The status of trademarks registered in the USPTO Supplemental Register is discussed in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)). According to its section 1.2.2, complainants relying on trademark registrations listed solely on the USPTO Supplemental Register are expected to show secondary meaning in order to establish trademark rights under the Policy, because under United States law a supplemental registration does not by itself provide evidence of distinctiveness to support trademark rights.

The Complainant has not put forward any evidence that its IWOMAN trademark has acquired secondary meaning or that it has become a "mark" that the relevant public associates with the Complainant. In the absence of such evidence, the Panel is unable to reach a conclusion that the Complainant has established rights in a trademark as required by paragraph 4(a)(i) of the Policy.

Based on the available record, the Panel therefore finds the first element of the Policy has not been established, and the Complaint must fail.

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

Since the Complainant has failed to establish trademark rights for the purposes of the Policy, it is not necessary to make a finding on the issue of rights and legitimate interests in the disputed domain name.

Nevertheless, the Panel notes that the Complaint would have failed on this ground also. The Respondent has submitted evidence that in 2014 the disputed domain name resolved to a website that featured content related to the pregnancy in women. Such content indicates that, on the balance of probabilities, the Respondent is likely to have used the disputed domain name in relation to its common meaning for a *bona fide* purpose years before any notice of the dispute and before the Complainant started using the IWOMAN trademark in 2019. This would have led the Panel to the conclusion that the Complainant has failed to establish that the Respondent does not have rights or legitimate interests in the disputed domain name.

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

Since the Complainant has failed to establish trademark rights for the purposes of the Policy, it is not necessary to make a finding on the issue of bad faith.

However, the Complaint would have failed on this element as well. Even if, for the sake of argument, it is accepted that the Complainant has established trademark rights for the purposes of the Policy, as discussed in section 3.8.1 of the [WIPO Overview 3.0](#), where a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent. This general position is subject to the scenarios described in section 3.8.2 of the [WIPO Overview 3.0](#), *i.e.*, the registration of a domain name: (i) shortly before or after announcement of a corporate merger, (ii) further

to the respondent's insider knowledge (*e.g.*, a former employee), (iii) further to significant media attention (*e.g.*, in connection with a product launch or prominent event), or (iv) following the complainant's filing of a trademark application.

The Complainant has not put forward any argument why any of the above scenarios should be regarded as present in this dispute, and indeed there is no reason for such a finding, since, as evident from the trademark certificates for the registration of the IWOMAN trademark, its claimed date of first use is January 1, 2019, which is almost five years after the date in 2014 for which the Respondent has shown use of the disputed domain name in relation to a website containing information about pregnancy in women, and almost ten years after the date in 2009 when the Respondent renewed the registration of the disputed domain name (which suggests that it had first acquired it even earlier). There is no reason to accept that the Respondent may have anticipated that the Complainant would eventually start to use an IWOMAN trademark years later, and that the Respondent's intent in acquiring and using the disputed domain name was to unfairly capitalize on the Complainant's reputation. That would have led the Panel to the conclusion that the Complainant has failed to establish that the disputed domain name was registered and is being used in bad faith.

## 7. Reverse Domain Name Hijacking (“RDNH”)

Paragraph 15(e) of the UDRP Rules provides that, if “after considering the submissions the panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding”.

RDNH is furthermore defined under the UDRP Rules as “using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name.” Panels have also referred to paragraphs 3(b)(xiii) and (xiv) of the UDRP Rules in addressing possible RDNH scenarios.

As discussed in section 4.16 of the [WIPO Overview 3.0](#), reasons articulated by panels for finding RDNH include: (i) facts which demonstrate that the complainant knew it could not succeed as to any of the required three elements – such as the complainant's lack of relevant trademark rights, clear knowledge of respondent rights or legitimate interests, or clear knowledge of a lack of respondent bad faith (see generally section 3.8) such as registration of the disputed domain name well before the complainant acquired trademark rights, (ii) facts which demonstrate that the complainant clearly ought to have known it could not succeed under any fair interpretation of facts reasonably available prior to the filing of the complaint, including relevant facts on the website at the disputed domain name or readily available public sources such as the WhoIs database, (iii) unreasonably ignoring established Policy precedent notably as captured in this WIPO Overview – except in limited circumstances which *prima facie* justify advancing an alternative legal argument, (iv) the provision of false evidence, or otherwise attempting to mislead the panel, (v) the provision of intentionally incomplete material evidence – often clarified by the respondent, (vi) the complainant's failure to disclose that a case is a UDRP refiling, (vii) filing the complaint after an unsuccessful attempt to acquire the disputed domain name from the respondent without a plausible legal basis, (viii) basing a complaint on only the barest of allegations without any supporting evidence.

Given the undertakings in paragraphs 3(b)(xiii) and (xiv) of the UDRP Rules, some panels have held that a represented complainant should be held to a higher standard.

Panels have more recently clarified that, for an RDNH finding to be made, it is not necessary for a respondent to seek an RDNH finding or prove the presence of conduct constituting RDNH.

The present case is notable in that the relevant circumstances do not support any of the three elements of the Policy. The Complainant is represented by counsel who should have appreciated that the Complaint could not succeed as to each of these three elements, given the Complainant's lack of relevant trademark rights and the registration and use of the disputed domain name years before the Complainant started using its IWOMAN trademark. In this situation, the Complainant must have known that it could not succeed, but nevertheless filed the Complaint. This supports a finding that the Complaint was brought in bad faith.

## **8. Decision**

For the foregoing reasons, the Complaint is denied. The Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

*/Assen Alexiev/*

**Assen Alexiev**

Sole Panelist

Date: October 3, 2023