

ADMINISTRATIVE PANEL DECISION

DTTM Operations LLC v. Michael Gargiulo
Case No. D2023-4060

1. The Parties

The Complainant is DTTM Operations LLC, United States of America (“United States”), represented by 500law, United States.

The Respondent is Michael Gargiulo, United States, represented by Lewis & Lin, LLC, United States.

2. The Domain Name and Registrar

The disputed domain name <maralago.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 September 28, 2023. On September 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 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 (REGISTRATION PRIVATE) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 29, 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 amended Complaint on October 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 the Respondent of the Complaint, and the proceedings commenced on October 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 2, 2023. The Response was filed with the Center on November 2, 2023. On December 19, 2023, the Complainant submitted a Supplemental Filing, comprised largely of examples of use of its marks, and various online statements of the Respondent concerning strategies for registering and making money from domain name registrations. The Respondent responded to the Supplemental Filing on December 22, 2023, and the Complainant submitted a reply in support of its Supplemental Filing on January 4, 2024.

The Center appointed Gordon Arnold, Diane Cabell, and Evan D. Brown as panelists in this matter on December 27, 2023. The Panel finds that it was properly constituted. Each member of 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 owns the marks THE MAR-A-LAGO CLUB and MAR-A-LAGO (the “Marks”), for which it enjoys the benefits of registration in the United States (respectively, Registration No. 2056829, registered on April 29, 1997, and Registration No. 3719397, registered on December 1, 2009). The goods and services provided under the marks relate to the Mar-A-Lago Club – described as a “one of a kind luxury property located in the heart of Palm Beach, Florida between the Atlantic Ocean and Lake Worth.” The Complainant has submitted evidence – both with the Complaint and in its Supplemental Filing (which the Panel has considered) – of the extensive use of the Marks in connection with the Complainant’s business activities. The Respondent has not refuted the Complainant’s evidence of the existence of trademark rights.

The Respondent asserts that it is in the business of registering and developing inherently valuable domain names, all of which consist of one or more common use, generic and dictionary words and/or short letter domain names. Though the Whois information shows the disputed domain name was first registered on May 6, 1997, the Respondent asserts that it acquired the disputed domain name from its original registrant “on or around April 2021.” The Respondent asserts that the disputed domain name has legitimate use (*e.g.*, due to its meaning in Spanish and other languages (“sea to lake”) and its potential reference to the personal name “Mara Lago”). The Respondent submitted evidence that the previous owner of the disputed domain name used it to set up a website as a memorial for pets named Mar, A, & Lago and has submitted evidence that there are other uses of the term “maralago” in various unrelated businesses and properties across the United States, citing examples in Pennsylvania, Las Vegas, and near The Mar-a-Lago Club in Florida.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant’s trademark; that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

The Respondent contends that the Complainant has not satisfied all three of the elements required under the Policy for a transfer of the disputed domain name.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (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

This first element functions primarily as a standing requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7. 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. *Id.* This element requires the Panel to consider two issues: first, whether the Complainant has rights in a relevant mark; and second, whether the disputed domain name is identical or confusingly similar to that mark.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#). Particularly relevant to this element is the Complainant's MAR-A-LAGO mark of which it has demonstrated rights by providing evidence of its trademark registration for that mark.

The disputed domain name incorporates the MAR-A-LAGO mark in its entirety, except for the dashes between the words, which the Panel does not find to affect this analysis. This is sufficient for showing confusing similarity under the Policy.

Accordingly, the Panel finds that the Complainant has established this first element under the Policy.

B. Rights or Legitimate Interests

The burden of proof in UDRP proceedings is on a complainant; and, although panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name results in proving a negative, a complainant still must carry the burden, or, at least the conclusion of lack of rights or legitimate interests must be the only reasonable conclusion the panel can draw. See [WIPO Overview 3.0](#), Section 2.1.

Seeking to establish facts to satisfy this Policy element, the Complainant asserts that:

- There is no active website at the disputed domain name, and the content at the disputed domain name does not relate to the compound word "mar-a-lago", nor does it relate to the Marks.
- To the Complainant's knowledge, the Respondent has never been known by or legitimately used in commerce any trademark including the word "mar-a-lago."
- The Complainant has not authorized the Respondent to register or use the disputed domain name.
- The Respondent is not making a legitimate noncommercial or fair use of the disputed domain without intent for commercial gain, but is using the disputed domain name to mislead and divert consumers or tarnish the Marks.
- There is no doubt that the website located at the disputed domain name aims to create a false impression of affiliation with the Complainant in order for the Respondent to generate and divert traffic from those interested in Complainant's goods and services.
- The Respondent is not making "nominative fair use" of the disputed domain name so as to absolve it of violating the Policy.
- The Respondent is not only depriving the Complainant of the ability to utilize the Marks as a domain name, but the Respondent is actually causing confusion by creating an affiliation with the Complainant that does not exist.

The Respondent asserts the following:

- The wording "maralago" is descriptive, being comprised of dictionary terms that translate into "sea to lake" in several languages. The Complainant's property earned its name because it is located between the Atlantic Ocean and Lake Worth.
- Being in the business of registering and developing inherently valuable domain names, the Respondent seeks to extract value from the fact that the disputed domain name is a pronounceable eight-letter dot com domain name comprised of descriptive words.
- The words "Mara Lago" could also be a personal name.
- Panels have accepted that aggregating and holding domain names (usually for resale) demonstrates rights and a legitimate interest in such domain name.
- Knowledge of a complainant's trademark, alone, does not equate to a respondent's lack of rights or legitimate interests in a dictionary word or phrase.

- There are no factors present that demonstrate that the Respondent registered the disputed domain name to target the Complainant's trademark, and at no point since the disputed domain name was registered some 26 years ago was it used to target the Complainant or any third party mark.
- Though the Respondent has not used the disputed domain name in connection with an active website, it has legitimate rights in the disputed domain name because of its descriptive, dictionary word connotation and may be later used for bona fide purposes.

Although the Complainant submitted further arguments on these points, the Complainant was unable to provide persuasive specific evidence to overcome the Respondent's arguments. The Policy is not designed to adjudicate all types of disputes that relate in any way to domain names. *Boku, Inc. v. Phuc To*, WIPO Case No. [D2023-1338](#). The Panel does not have the benefit of cross-examination of witnesses, disclosure of documents held by the parties, or the other instruments that are typically available to assist a court to resolve certain kinds of disputes. *Id.* Many of the Complainant's assertions, through no fault of the Complainant, are conclusory. That is the nature of this proceeding, as already noted above. Further, it is noted that the Complainant's arguments and evidence that are directed to the *third* element (bad faith) do not carry the Complainant's burden as to the *second* element (whether the Respondent has no rights or legitimate interests in respect of the disputed domain name). See also [WIPO Overview 3.0](#) section 2.15.

C. Registered and Used in Bad Faith

Because of its determination under the second element, the Panel need not address the element of bad faith registration and use.

7. Decision

Given the colorable dispute between the parties as to the rights the Respondent may have, the Panel concludes it would be overstepping the Policy's scope to order a transfer of the disputed domain name on this record. The panel does *not* criticize the Complainant in the attempt to use this focused and cost-effective forum to seek to obtain the domain name and has no opinion on what the outcome might be if the relief were pursued in a forum where full information exchange and examination of witnesses could occur. The Panel makes no specific finding other than that the record has insufficient proof of a lack of rights or legitimate interests in the disputed domain name.

For the foregoing reasons, the Complaint is denied.

/Evan D. Brown/
Evan D. Brown
Presiding Panelist

/Gordon Arnold/
Gordon Arnold
Panelist

/Diane Cabell/
Diane Cabell
Panelist
Date: January 25, 2024