

ADMINISTRATIVE PANEL DECISION

Patrick Schur v. Stephen Brewer
Case No. D2023-4098

1. The Parties

The Complainant is Patrick Schur, Switzerland, represented by Gearhart Law, United States of America (“United States”).

The Respondent is Stephen Brewer, United States, represented by John Berryhill, Ph.d. Esq, United States.

2. The Domain Name and Registrar

The disputed domain name <demoji.com> 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 September 28, 2023. On October 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 2, 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 (Domains by Proxy LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 3, 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 8, 2023. The Respondent’s representative sent two email communications to the Center on October 9, 2023, and October 10, 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 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 1, 2023. The Response was filed with the Center on October 13, 2023.

The Center appointed Luca Barbero as the sole panelist in this matter on November 3, 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 has provided evidence of ownership of the following trademark registrations for DEMOJI (Annexes 3 and 4 to the Complaint), among other things for software for use in automating and managing business processes:

- Swiss trademark registration No. 727577 for DEMOJI (word mark), filed on February 15, 2019, and registered on February 22, 2019, in classes 09, 35, 36, 38, 39, 41, 42, 44, and 45;

- United States trademark registration No. 6213418 for DEMOJI (word mark), filed on April 23, 2019, and registered on December 08, 2020, in international classes 09, 35, 36, 38, 39, 41, 42, 44, and 45.

The disputed domain name was registered on November 14, 2012, and is pointed to a parking page displaying the indication: "Demoji.com Coming Soon'ish - Tasty like a raindrop."

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 states that the disputed domain name is identical to its trademark DEMOJI as it reproduces the trademark in its entirety with the mere addition of the generic Top-Level Domain ("gTLD") ".com".

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that the Respondent has no trademark rights in DEMOJI and submits that he also does not appear to use DEMOJI at all in connection with his activity. The Complainant submits that the Respondent is not using the disputed domain name for any purpose and has been holding it passively for the last 10 years, thus showing no intent to use the disputed domain name for any *bona fide* purpose.

With reference to the circumstances evidencing bad faith, the Complainant indicates that the Respondent unlawfully registered the disputed domain name for the purpose of depriving the Complainant of his use and to benefit from the sale of services similar to those of the Complainant using the Complainant's trademark.

The Complainant further asserts that considering the "updated on" status in the Whois records shows the date of September 12, 2022, the Respondent may have become the owner of the disputed domain name through its transfer between unrelated registrants after its creation date, postdating the accrual of Complainant's trademark rights.

The Complainant further underlines that since (i) the disputed domain name currently resolves to a "coming soon" page, (ii) the Respondent has never made use of the disputed domain name, and (iii) the Respondent has not been commonly known by the disputed domain name prior to the accrual of the Complainant's trademark rights, the Respondent has not carried out any legitimate business at the disputed domain name, nor is there any reasonable evidence that such online presence may be upcoming, as the same landing page has been in place for nearly a decade.

The Complainant further submits that, given the Complainant's numerous and internationally registered trademarks, it is not plausible to conceive of a circumstance in which the Respondent could legitimately use the disputed domain name without violating trademark law. The Complainant also states that the Respondent has taken active steps to conceal his identity by using a privacy shield, which combined with the Respondent's lack of rights or legitimate interests and the fact that the Respondent has been holding the disputed domain name passively for the purpose of confusing Internet users who would seek the services of the Complainant, would amount to bad faith use.

Lastly, the Complainant contends that the Respondent's use of the disputed domain name is an attempt to prevent the Complainant from reflecting his trademark in the disputed domain and from benefiting from the good will and notoriety that the Complainant has built into his trademark in the form of business intended for Complainant.

B. Respondent

On October 9, 2023, the Respondent sent an informal email communication to the Center stating that the Complainant's counsel had been informed of the identity of the Respondent's counsel in correspondence sent before the filing of the Amendment to the Complaint, providing also copy of the letter sent to Complainant's counsel on October 5, 2023. In such letter the Respondent highlighted that the disputed domain name was registered since as early as 2012 by the Respondent, enclosing a historical Whois report for the disputed domain name and a purchase receipt dated 2012, and requested the withdrawal of the Complaint, explaining that given the circumstances of the case the Complainant would not have been able to demonstrate the Respondent's bad faith.

On October 13, 2023, the Respondent submitted a formal Response rebutting the Complainant's contentions, stating that the Complainant has failed to provide any information on the actual use of the alleged Complainant's trademark and asserting that the reason for such omission is likely that the Complainant conducts no commercial activities whatsoever in relation to the claimed mark.

The Respondent contends that he has rights and legitimate interests in the disputed domain name since 2012 indicating that, in his role as a web developer and together with a friend, he conceived a hobby project involving a play on the popular "emoji" graphics, which they would have called "demoji" or "demonic emoji" and has maintained the disputed domain name since then, in the event he and his friend may someday get around to working on their project.

With reference to the Complainant's contentions as to the Respondent's bad faith, the Respondent claims that bad faith registration cannot be found where a domain name was registered prior to the establishment of the trade or service mark at issue.

The Respondent further highlights that the Complainant, considering the similarity between the present proceeding and other prior proceedings in which the complaints were rejected on the same grounds, appears to be pursuing a deceptive and misleading pattern of abusive behavior.

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed 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 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. Indeed, the Complainant has provided evidence of trademark registrations for DEMOJI in Switzerland and the United States.

The Panel finds that the disputed domain name is identical to the trademark DEMOJI as it reproduces the trademark in its entirety with the mere addition of the gTLD ".com", which can be disregarded when comparing the similarities between a domain name and a trademark. [WIPO Overview 3.0](#), section 1.11.1.

Therefore, based on the available record, the Panel finds the first element of the Policy has been established by the Complainant.

B. Rights or Legitimate Interests

In light of the Panel's findings on the third element, it is not necessary to address the issue of whether the Respondent has rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The Panel notes that there is no evidence on record that the Respondent registered and used the disputed domain name with the intention to target the Complainant and its trademark.

Indeed, the Respondent registered the disputed domain name in 2012 (as confirmed by the historical Whois records and the purchase receipt submitted as Annexes A and B to the Response), before the Complainant's first registration of the trademark DEMOJI in 2019. Moreover, the Complainant has failed to provide any evidence of use of the trademark DEMOJI at any time, before or after the registration of his trademark. Therefore, the Complainant has failed to demonstrate that the Respondent was or could have been aware of the Complainant's trademark at the time of registration of the disputed domain name.

Therefore, based on the available record, the Panel finds the third element of the Policy has not been established.

D. Reverse Domain Name Hijacking

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.

As stated 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 3.0](#) – 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”.

The Panel concludes that the Complainant’s actions constitute Reverse Domain Name Hijacking. The Panel notes that the Complainant’s case is based on the arguments that registering a domain name using the “demoji” name corresponding to the Complainant’s registered trademark, independently of any awareness of the Complainant or its mark, is of itself evidence of bad faith. The Panel finds that the Complainant, which is represented by counsel, should have contemplated that it could not succeed with such an argument in light of the prior registration of the disputed domain name.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: November 16, 2023