

ADMINISTRATIVE PANEL DECISION

MMDSmart Ltd. v. Kate Milenskaya
Case No. D2023-4185

1. The Parties

The Complainant is MMDSmart Ltd., Israel, represented by Elbert Nazaretsky Rakov & Co Law Office, Israel.

The Respondent is Kate Milenskaya, Ukraine.

2. The Domain Name and Registrar

The disputed domain name <mmdsmart.info> 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 October 9, 2023. On October 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 10, 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 11, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint.

The Center verified that 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 November 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 4, 2023. The Response was filed with the Center on December 1, 2023. On December 25, 2023, the Complainant filed an unsolicited supplemental filing headed “Additional Statement”.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on December 15, 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 states that it is an Israeli company. It is described in the Complaint as “active in the area of international telecommunications services, owner of domain <mmdsmart.com> and MMDSmart service mark”. According to the Complaint, the Complainant was founded in 2007 and is “a leading global supplier of innovative communications products in more than 100 countries around the world”.

The Complainant claims that its said service mark is a valuable business asset which is designed by means of an original logo in the form of a waterdrop colored with side sunlight to which the words “mmd smart” have been added in lowercase and superscript style. The Complainant states, but does not evidence that “over the years” the Complainant has labeled all electronic and paper materials related to the advertising and delivery of its services with “MMDSmart”.

The Complainant produces a single page screenshot of the homepage of its website. Although it asserts that it is the owner of the related domain name <mmdsmart.com>, the Whois entry which it produces shows a registrant that is a privacy service. According to the Whois entry, said domain name was registered on October 2, 2007. No history has been produced of the use of this domain name.

The disputed domain name was registered on June 29, 2023. A single page screenshot of the homepage of the website associated with the disputed domain name produced by the Complainant shows the use of the logo claimed by the Complainant to be its logo as described above together with the words “MMD Smart. Connect. Engage. Smile. / Real stories from the life of the company Reviews from employees, former and current clients and failed business partners”. These words are superimposed upon the image of two men whom the Complainant states are founders of the Complainant. The Complainant asserts, but does not evidence, that the words “Connect. Engage. Smile.” are the Complainant’s “corporate watchwords”. These words are not shown on the screenshot of the Complainant’s website.

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 the “MMDSmart” service mark is distinctive and specific, is used by the Complainant in its ordinary course of trade, and is protected by law from infringement and unauthorized use by third parties. The Complainant also submits that the disputed domain name is practically the same as its said mark and that the associated website repeats verbal and graphic elements thereof. The Complainant notes that it has not granted permission to the Respondent or any third party to use the said mark, and that the Respondent thereby has no rights or legitimate interests in the disputed domain name. Finally, the Complainant contends that the disputed domain name has been registered for the purpose of engaging in illicit interference with the Complainant’s business, and that the use of said mark, the images of the Complainant’s founders, and the Complainant’s corporate watchword “undeniably witness about targeted efforts to misrepresent [the disputed domain name] as related to the Complainant for the purpose of disrupting the Complainant’s business”.

B. Respondent

The Respondent contends that the Complainant has not satisfied the elements required under the Policy for a transfer of the disputed domain name. Notably, the Respondent asserts that the website associated with the disputed domain name is noncommercial in nature and was established on the initiative of former and current employees of a company named MMD Smart Ukraine LLC to discuss the issue of workplace bullying from the company's management and owners, and to mediate the resolution of existing disputes. The Respondent asserts that the Complainant has failed to meet the burden of proving that it has rights to the term "MMD Smart" or the domain name <mmdsmart.info>, noting that the Complainant's arguments are not supported by any evidence and are unsubstantiated statements. The Respondent expresses its desire for amicable dispute resolution by mediation, noting that the Complainant has not directly communicated with it. The Respondent adds that despite the fact that the Complainant has not proven any rights to "MMDSmart", or the similarity of the photographs on the Respondent's website to someone else, as a gesture of goodwill, it has removed the relevant graphic elements and images from the front page of the website associated with the disputed domain name. The Respondent submits that it is making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain misleadingly to divert consumers or to tarnish the trademark at issue. Finally, the Complainant asserts that none of the circumstances described in the Policy, paragraph 4(b), are applicable to the present case.

6. Discussion and Findings

A. Preliminary Matter: The Complainant's Supplemental Filing

As noted above, on December 25, 2023, the Complainant filed an unsolicited supplemental filing headed "Additional Statement".

Paragraph 12 of the Rules expressly provides that it is for the Panel to request, in its sole discretion, any further statements or documents from the Parties it may deem necessary to decide the case. Unsolicited supplemental filings are generally discouraged, unless specifically requested by the Panel. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.6.

In this particular case, the Panel determines that the Complainant's unsolicited supplemental filing shall not be admitted. As further discussed in section 6B below, the Complaint is rejected on the threshold issue of proving rights in a trademark, a matter that should have been addressed in the Complaint, and which is in any event neither revisited nor expanded upon in the supplemental filing.

The Complainant provides no evidence to support its allegations of unregistered trademark rights, and its submissions on this topic are conclusory in nature. The requirement to provide evidence of rights in a trademark, rather than mere assertion, is fundamental to Policy jurisprudence, and is a matter that predates not just the [WIPO Overview 3.0](#) but also its predecessor guidance ("the Second Edition") which was cited in the Response. While the supplemental filing seeks to address certain other matters raised in the Response, it would serve no good purpose to admit this as it cannot correct the determinative issue.

B. Identical or Confusingly Similar

The first element analysis under the Policy typically proceeds in two steps. First, the Panel must assess whether the Complainant possesses UDRP-relevant rights in a trademark. These rights may be registered or unregistered in nature. Where it is established that the Complainant possesses such rights, the Panel will proceed to compare the mark concerned with the disputed domain name in order to assess identity or confusing similarity.

In the present case, there is no registered trademark to consider. Instead, the Complainant effectively asserts that it possesses unregistered trademark rights in the term "MMDSmart". To establish unregistered trademark rights for UDRP purposes, the Complainant must show that its mark has become a distinctive

identifier which consumers associate with the Complainant's goods or services. Relevant evidence can include a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys. Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning. [WIPO Overview 3.0](#), section 1.3. As noted above, the [WIPO Overview 3.0](#) represents an updated version of the Second Edition which is cited by the Respondent in the Response, although the jurisprudence relating to this particular topic has not changed in material respects.

Here, as the Respondent points out, the Complainant has failed to produce any supporting evidence for its assertion of unregistered rights. The only evidence on the record which the Panel has to go on is the domain name <mmdsmart.com> which was registered in 2007, and the undated single page screenshot of the associated website. However, as the Respondent points out, the Whois record for this particular domain name shows that it is registered to a privacy service and the Complainant does nothing to demonstrate that the Complainant is the underlying registrant despite making an assertion that it is the holder. Even if the Complainant had provided suitable corresponding evidence, the registration date of this particular domain name would not on its own be evidence of the extent of the use of the mark or even the duration of its use in commerce, given that the Panel is not in a position to assume when and in what manner any commercial use of the domain name commenced.

The Panel notes that the Complaint effectively asserts that the Respondent is targeting the Complainant's alleged unregistered mark. The fact that a respondent is shown to have been targeting a complainant's mark (e.g., based on the manner in which the related website is used) may support the complainant's assertion that its mark has achieved significance as a source identifier. [WIPO Overview 3.0](#), *ibid*. Here, if the Panel were to accept the Complainant's assertions that the logo on the website associated with the disputed domain name is the Complainant's logo and that the people portrayed there are the Complainant's founders, it might be possible to infer that this constitutes some form of targeting of the Complainant's rights. However, there is no evidence provided to support either of those assertions. The only relevant evidence available is that the same logo appears to be represented on the single page screenshot of the website associated with <mmdsmart.com>, the domain name which the Complainant asserts (without suitable evidence) that it owns.

The Panel adopts the view expressed by the panel in *CEMEX UK Operations Ltd. v. Privacy Service Provided by Withheld for Privacy ehf / Cargo Logistics Transportation Services, Cargo Logistics Transportation Services; South Coast Shipping Company, South Coast Shipping Company; and Cargo Logistics, Cargo Logistics Transportation Services*, WIPO Case No. [D2022-1445](#) ("CEMEX") on this particular topic. That panel noted that the manner in which a related website is used may support unregistered trademark rights "where there is other evidence which is of a doubtful or marginal nature, but normally it would not constitute the sole evidence of unregistered rights". The panel went on to reason that if that was not the case then the test would be entirely circular and any term used in a domain name could be said to support a finding of unregistered trademark rights – which is clearly not the intention of the Policy.

In these circumstances, the Panel rejects the Complainant's assertion of an unregistered trademark in the term "MMDSmart" for want of evidence. In the particular circumstances of this case, the anonymized Whois record of a domain name registered in 2007, coupled with the single page screenshot of the website associated with such domain name, would not in the Panel's view be capable of amounting to even the kind of doubtful or marginal evidence that could be bolstered by the alleged use of the website associated with the disputed domain name to target the asserted rights.

There is no need for the Panel to go on to compare the mark asserted by the Complainant with the disputed domain name as the position is moot.

Based on the available record, the Panel finds the first element of the Policy has not been established.

C. Rights or Legitimate Interests and Registered and Used in Bad Faith

The requirements of paragraph 4(a) of the Policy are conjunctive. A consequence of this is that failure on the part of a complainant to demonstrate one element of the Policy will result in failure of the complaint in its entirety. Accordingly, in light of the Panel's findings in connection with the first and element under the Policy, no good purpose would be served by addressing the issue of the Respondent's rights or legitimate interests in the disputed domain name or whether the disputed domain name has been registered and is being used in bad faith.

7. Further Complaint

The Panel notes that this Decision effectively determines the Complaint on the threshold issue, without examination of the wider merits. If the Complainant were able to overcome its present inability to establish unregistered trademark rights, it does appear to the Panel *prima facie* that there may be an issue to be determined under the Policy relating to the disputed domain name. That issue would be whether the Respondent is carrying out some form of unfair targeting of the Complainant's rights via the disputed domain name or is engaging in fair use thereof, for example, by making legitimate noncommercial criticism or referential use. Given that this issue remains outstanding, the present Panel considers that the Complainant should not be barred by the present Decision from filing a further complaint under the Policy if it is in a position to evidence its unregistered trademark rights according to Policy jurisprudence, i.e., along the lines discussed in the [WIPO Overview 3.0](#), section 1.3. The Panel notes that a similar approach was adopted in CEMEX, *supra*.

8. Decision

For the foregoing reasons, the Complaint is denied.

/Andrew D. S. Lothian/

Andrew D. S. Lothian

Sole Panelist

Date: December 29, 2023