

ADMINISTRATIVE PANEL DECISION

Ziip Inc v. Hagop Doumanian
Case No. D2023-5217

1. The Parties

The Complainant is Ziip Inc, United States of America (“United States”), represented by Justec Legal Advisory Services LLC, United States.

The Respondent is Hagop Doumanian, United States, represented by Cylaw Solutions, India.

2. The Domain Name and Registrar

The disputed domain name <ziip.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 December 14, 2023. On December 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 December 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 amended Complaint on December 21, 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 December 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 11, 2024. Upon request by the Respondent, the Response due date was extended to January 15, 2024. The Response was filed with the Center on January 15, 2024.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on January 22, 2024. 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, a Delaware corporation, markets app-connected electrical devices for esthetic facial treatments under the ZIIP mark. The Complainant is the proprietor of United States Trademark Registration No. 4791168 for ZIIP (word mark), registered on August 11, 2015, for goods in class 10, claiming a date of first use of April 29, 2015.

The Complainant operates its primary business website at the domain name <ziipbeauty.com>.

The disputed domain name was registered on April 1, 2000. The evidence in the record indicates that, as of 2003, the registrant was identified as “Jack Doumain” or “J.D. The Respondent in these proceedings is a party named “Hagop Doumanian”.

The record reflects that an update to the Whois information was recorded on March 1, 2023. The record does not identify any details about this update.

At the time of the Complaint, the disputed domain name resolved to a website featuring pay-per-click (“PPC”) links for “app software”, “open zip application”, and “roller banner”. On the same web page, the disputed domain name was offered for sale for USD 68,000. The Panel verified that this information was essentially unchanged at the time of the Decision.

The record shows that the Respondent is a professional domainer in the business of acquiring and selling short domain names.

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 its founders invented the world’s first app-connected facial toning device, which has been used by celebrities and featured in the press. The Complainant has invested USD 3,500,000 in the development and marketing of its ZIIP brand, which has acquired widespread recognition. The Complainant has 64,000 Instagram followers. The disputed domain name was registered on March 1, 2023, which is after the Complainant established its rights in the ZIIP mark. The disputed domain name is identical to the Complainant’s mark. The disputed domain name redirects to a website on which it is offered for sale for USD 68,000, an amount that significantly exceeds the costs of registering it. This website also features PPC links tangentially related to the Complainant’s business, thereby generating revenue for the Respondent based on the Complainant’s investment in its e-commerce brand. The Respondent is using unauthorized images on the Complainant’s website. The Respondent, which has shielded its identity using a privacy service, has registered the disputed domain name solely for the purpose of selling it and is not making any legitimate use of it. The value of the disputed domain name is directly related to the Complainant’s investment in the ZIIP brand.

The Complainant requests transfer of the disputed domain name.

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.

The Respondent challenges the Complainant's ownership of the ZIIP trademark registration, stating that the registration identifies the owner as Ziip, LLC, with an address in Wyoming, whereas the Complainant is identified as Ziip, Inc., with an address in California. The Respondent states that publicly available information indicates that Ziip, Inc., was incorporated in Delaware only in the year 2020. At this time, the Complainant knew or ought to have known that the disputed domain name was already registered by the Respondent. The Complainant provides no evidence of its existence between 2015 and 2020.

The Respondent states that it is in the business of registering generic, descriptive, misspelling of common words, and acronym domain names. This type of business has been recognized as legitimate by UDRP panels. The disputed domain name corresponds to a misspelling of the common word "zip." The Respondent had never heard of the Complainant prior to receiving the Complaint.

The Respondent states that historical records from November 2015 indicate that an organization called Netico, Inc., using the same email as the Respondent, was the registrant of the disputed domain name as of the year 2003. Netico, Inc. was a company established in 2000, dissolved in 2021 and re-established in 2022. The Respondent was the President of this company from its formation. The domain name records indicate that the registrant of the disputed domain name was "Jack Douman" identified by the initials "J.D." which is the same as the Respondent.

The disputed domain name has been used to redirect to third-party marketplace websites since 2012, when it was first listed for sale. Such websites do not permit displaying any images. This date precedes the establishment of the Complainant. The Respondent has never solicited the Complainant nor interfered with its business.

6. Discussion and Findings

Paragraph 4(a) of the UDRP requires the Complainant to make out all three of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the Respondent has registered and is using the disputed domain name in bad faith.

Under 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".

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.

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. The Complainant has provided a trademark registration certificate for the ZIIP mark. The Panel notes that the public record confirms that the Complainant had established trademark rights as of the date of the Complaint. [WIPO Overview 3.0](#), section 1.1.3.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the Complainant's ZIIP mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The issue of whether the trademark registration preceded or succeeded the registration of the disputed domain name will be discussed under the second and third elements below.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

In view of the Panel's conclusions under the third element below, the Panel does not make a finding under the second element.

C. Registered and Used in Bad Faith

Under the third element, the Complainant must prove that the Respondent registered and is using the disputed domain name 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.

Except for limited circumstances involving registration of a domain name to capitalize on nascent trademark rights, panels will not normally find bad faith on the part of the respondent where a respondent registers a domain name before the complainant's trademark rights accrue. [WIPO Overview 3.0](#), Section 3.8.1.

In this case, the Complainant's trademark rights have been established as of August 11, 2015, the date of registration of the trademark. The disputed domain name was registered on April 1, 2000. The Complainant has not provided evidence of its use of the ZIIP mark as of that date. Rather, the Complainant asserts that the actual registration of the disputed domain name took place on March 1, 2023, when the Whois record for the disputed domain name was updated. The Complainant implies that the update indicates that a change of ownership has occurred and a new registration, post-dating its establishment of trademark rights, has been effected.

The Panel notes that the evidence in the record on this point is unsatisfactory. The Panel notes the Complainant, which bears the burden of proof in an UDRP proceeding, has failed to provide any evidence, such as any entries from historic Whois records for the disputed domain name that might have pointed to a registrant transfer in 2023, or any evidence that the Respondent at any point targeted the Complainant. The Panel notes that an updated Whois entry does not, by itself, prove that a change of ownership has taken place, since such an update may have been triggered by other changes. See *Patrick Schur v. Devin Day*, WIPO Case No. [D2023-4104](#). In this case, moreover, there is no evidence that there was any change in the use of the disputed domain name before or after the alleged date of the transfer of ownership.

The Respondent argues it has registered the disputed domain name in 2000 as part of its longstanding business of registering short domain names, and provides examples from its portfolio. The Panel notes that these reference domain names appear to have little in common with the disputed domain name. All contain two symbols and feature the top-level domains ".org" or ".net". None are similar to common words or contain the top-level domain ".com".

The Panel finds that the evidence provided by the Respondent itself indicates that, on balance of probabilities, the disputed domain name has at all time been controlled by it, albeit under different corporate identities. The available evidence, however, presents an incomplete picture. The Panel notes that the registrant “Jack Douman” visible in historical Whois records from 2003 and stated by the Respondent as the registrant in 2015, bears some rough similarity to but does not correspond to the name of the Respondent Hagop Doumanian (which is not Douman). The Respondent claims that it controlled Netico, Inc., which was listed as the “Organization” affiliated with the disputed domain name at least from 2003. However, the record indicates that this company was dissolved in 2020, and Netico, Inc. is no longer associated with the disputed domain name today.

At the same time, however, the Respondent does provide evidence that the disputed domain name was made available for sale in 2012 and 2013, predating the Complainant’s establishment of trademark rights. Moreover, there is no evidence that the Respondent at any time attempted to sell the disputed domain name to the Complainant. The use of the disputed domain name for PPC links, under the circumstances, does not support a finding that the Respondent is attempting to capitalize on the value of the Complainant’s mark.

Generally speaking, panels have found that the practice as such of registering a domain name for subsequent resale (including for a profit) would not by itself support a claim that the respondent registered the domain name in bad faith with the primary purpose of selling it to a trademark owner (or its competitor). [WIPO Overview 3.0](#), section 3.1.1.

The evidence in the case file as presented does not indicate that the Respondent’s aim in registering the disputed domain name was to profit from or exploit the Complainant’s trademark. Rather, on balance, the evidence indicates that the Respondent acquired the disputed domain name for its value as a short domain name related to a common English word. The Respondent or his corporate aliases have made the disputed domain name available for sale over a period of time that precedes the Complainant’s accrual of trademark rights.

While overall the evidence presented by both Parties is incomplete, it is on the Complainant to make out its case and the Panel does not find sufficient evidence that the Respondent registered the disputed domain name in bad faith targeting of the Complainant or its trademark rights. [WIPO Overview 3.0](#), section 3.8.1.

The Panel finds the third element of the Policy has not been established.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Ingrīda Kariņa-Bērziņa/

Ingrīda Kariņa-Bērziņa

Sole Panelist

Date: February 5, 2024