

ADMINISTRATIVE PANEL DECISION

Accuity, Inc. v. Kenneth Hunter

Case No. D2022-0397

1. The Parties

The Complainant is Accuity, Inc., United States of America (“United States”), represented by Nelson Mullins Riley & Scarborough, LLP, United States.

The Respondent is Kenneth Hunter, United States.

2. The Domain Name and Registrar

The disputed domain name <safe-banking.com> (the “Disputed Domain Name”) 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 February 4, 2022. On February 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 7, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on February 10, 2022, 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 February 11, 2022.

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 February 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 8, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 17, 2022.

The Center appointed Lynda M. Braun as the sole panelist in this matter on March 22, 2022. 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 provider of online subscription-based data solutions for the financial services industry, which enables customers to maximize the accuracy of their banking and payment transactions, and to minimize the risk of non-compliance with government regulations during these transactions. Specifically, the Complainant provides specialized anti-money laundering and compliance solutions that enable organizations to uncover fraud, terrorist financing, and money laundering under the SAFE BANKING SYSTEMS trademark.

The Complainant merged with Safe Banking Systems Software, LLC in January 2019, and acquired the SAFE BANKING SYSTEMS trademarks. The Complainant owns the following trademarks, registered with the United States Patent and Trademark Office (“USPTO”):

SBS SAFE BANKING SYSTEMS, United States Registration No. 3,383,753, registered on February 19, 2008, with a first use and first use in commerce of March 1, 1999, in international class 42; and SBS SAFE BANKING SYSTEMS, United States Registration No. 5,741,220, registered on April 30, 2019, in international class 42 (hereinafter collectively referred to as the “SAFE BANKING Mark”). The SAFE BANKING Mark has come to embody goodwill in the marketplace and to serve as a source identifier for the Complainant.

The Complainant owned the domain name <safe-banking.com> but inadvertently allowed it to lapse. The Complainant’s domain name originally resolved to the Complainant’s official website at “www.safe-banking.com”, which the Complainant used to establish its online presence and to advertise, market, and render the Complainant’s services to customers. The Complainant’s domain name was also utilized to host email addresses associated with the Complainant and the Complainant’s predecessor in the operation of its business.

The Disputed Domain Name was registered by the Respondent on March 24, 2021, and resolved to a mirrored website, identical to that of the Complainant’s website prior to the lapse of the domain name. The Respondent impersonated the Complainant to trade on the Complainant’s SAFE BANKING Mark and also activated mail exchanger (MX) records associated with the Disputed Domain Name, indicating that it was being used for email correspondence, and even potentially part of a phishing scheme. The Respondent has subsequently removed the mirrored website; the Disputed Domain Name currently resolves to a landing page with no substantive content that states: “Safe Banking Systems. We’re working hard to improve our website and we’ll ready to launch after __days, __hours, __minutes, __seconds.”

The Complainant provided the Panel with screenshots of its original website, the Disputed Domain Name’s resolving mirrored, identical website, and the current landing page in several annexes to the Complaint.

5. Parties’ Contentions

A. Complainant

The following are the Complainant’s contentions:

- the Disputed Domain Name is confusingly similar to the Complainant’s SAFE BANKING Mark;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;
- the Disputed Domain Name was registered and is being used in bad faith; and

- the Complainant seeks the transfer of the Disputed Domain Name from the Respondent to the Complainant in accordance with paragraph 4(i) of the Policy.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

(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 Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry: a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the SAFE BANKING Mark.

It is uncontroverted that the Complainant has established rights in the SAFE BANKING Mark based on its years of use as well as its registered trademarks for the SAFE BANKING Mark with the USPTO in the United States. The general rule is that "registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive". See *CWI, Inc. v. Domain Administrator c/o Dynadot*, WIPO Case No. [D2015-1734](#). The Respondent has not rebutted this presumption, and therefore the Panel finds that the Complainant has rights in the SAFE BANKING Mark.

The Disputed Domain Name is comprised of the dominant portion of the SAFE BANKING Mark, which is "safe banking", with the only difference being the addition of a hyphen between the terms "safe" and "banking", followed by the generic Top-Level Domain ("gTLD") ".com". It is well established that a domain name that wholly incorporates a trademark – or incorporates at least a dominant feature of the relevant mark -- may be deemed confusingly similar to that trademark for purposes of the Policy despite the addition – or omission – of other terms. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8. Thus, it is well recognized that a disputed domain name that incorporates a trademark may be confusingly similar to that trademark for purposes of the Policy despite the addition of a hyphen. The presence or absence of punctuation marks such as hyphens cannot on their own avoid a finding of confusing similarity. See *Six Continents Hotels, Inc. v. Helen Siew*, WIPO Case No. [D2004-0656](#).

Finally, the addition of a gTLD such as ".com" in a domain name is technically required. Thus, it is well established that such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11. Thus, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's SAFE BANKING Mark.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainant.

B. Rights or Legitimate Interests

Under the Policy, a complainant has to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent carries the burden of production of evidence that demonstrates rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

In this case, given the facts as set out above, the Panel finds that the Complainant has made out a *prima facie* case. The Respondent has not submitted any arguments or evidence to rebut the Complainant's *prima facie* case. Furthermore, the Complainant has not authorized, licensed or otherwise permitted the Respondent to use its SAFE BANKING Mark. Nor does the Complainant have any type of business relationship with the Respondent. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any name similar to it, nor any evidence that the Respondent was using or making demonstrable preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services. See Policy, paragraph 4(c).

Based on the Respondent's use made of the Disputed Domain Name to impersonate the Complainant, create and host a website identical to the Complainant's original website, to configure emails using MX records to potentially perpetuate a phishing scheme does not confer rights or legitimate interests on the Respondent. See [WIPO Overview 3.0](#), section 2.13.1 ("Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent."). Thus, the Panel concludes that nothing on the record before it would support a finding that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name. Rather, the Panel finds that the Respondent is using the Disputed Domain Name for commercial gain with the intent to mislead by defrauding the Complainant's customers. Moreover, such use cannot conceivably constitute a *bona fide* offering of a product/service within the meaning of paragraph 4(c)(i) of the Policy.

In this case, the Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent has not submitted any substantive arguments or evidence to rebut the Complainant's *prima facie* case. As such, the Panel determines that the Respondent does not have rights or legitimate interests in the Disputed Domain Name.

Accordingly, the Panel finds that the second element of paragraph 4(a) of the Policy has been met by the Complainant.

C. Registered and Used in Bad Faith

The Panel finds that based on the record, the Complainant has demonstrated the existence of the Respondent's bad faith pursuant to paragraph 4(b) of the Policy.

First, based on the circumstances here, the Panel concludes that the Respondent registered and is using the Disputed Domain Name in bad faith in an attempt to attract Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's SAFE BANKING Mark as to the source, sponsorship, affiliation or endorsement of the Disputed Domain Name. The Respondent's registration and use of the Disputed Domain Name to impersonate the Complainant and create a mirrored, identical website indicate that such registration and use had been done for the specific purpose of trading on the name and reputation of the Complainant and its SAFE BANKING Mark. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#) ("[t]he only plausible explanation for Respondent's actions appears to be an intentional effort to trade upon the fame of Complainant's name and mark for commercial gain").

Second, the Disputed Domain Name was registered more than a decade after the Complainant first began

using its SAFE BANKING Mark. The Panel finds that the Respondent had the Complainant's SAFE BANKING Mark in mind when registering the Disputed Domain Name.

Finally, Panel finds that the Respondent knew that the Complainant had rights in the Mark when registering the Disputed Domain Name. The Respondent used the Disputed Domain Name to resolve to a website identical to that of the Complainant's original website, making clear that the Respondent was well aware of the Complainant and its SAFE BANKING Mark (having registered it after the Complainant inadvertently allowed it to lapse), thus demonstrating bad faith. Thus, it strains credulity to believe that the Respondent had not known of the Complainant or its SAFE BANKING Mark when registering the Disputed Domain Name. See *Myer Stores Limited v. Mr. David John Singh*, WIPO Case No. [D2001-0763](#) (respondent's knowledge of the registration and use of a trademark prior to registering the domain name constitutes bad faith). The Panel concludes that the Respondent's use of the Disputed Domain Name to incorporate the dominant portion of the SAFE BANKING Mark and impersonate the Complainant, create a mirrored website identical to the Complainant's original website, and activate MX records was emblematic of bad faith registration and use. In sum, the Panel finds that the Respondent had actual knowledge of the Complainant's SAFE BANKING Mark when registering the Disputed Domain Name, and that Respondent registered and used the Disputed Domain Name to take unfair advantage of the Complainant's SAFE BANKING Mark.

Accordingly, the Panel finds that the third element of paragraph 4(a) of the Policy has been met by the Complainant.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Name <safe-banking.com> be transferred to the Complainant.

/Lynda M. Braun/

Lynda M. Braun

Sole Panelist

Date: April 5, 2022