

ADMINISTRATIVE PANEL DECISION

Microban Products Company v. Domain Sales - (Expired domain caught by auction winner) c/o Dynadot
Case No. D2022-2930

1. The Parties

Complainant is Microban Products Company, United States of America (“United States”), represented by Nelson Mullins Riley & Scarborough, L.L.P., United States.

Respondent is Domain Sales- (Expired domain caught by auction winner) c/o Dynadot, United States.

2. The Domain Name and Registrar

The disputed domain name <duratechbymicroban.com> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 8, 2022. On August 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 10, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

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 Respondent of the Complaint, and the proceedings commenced on August 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 5, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on September 12, 2022.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on September 23, 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

Complainant is the owner of registrations for the word, and word and design, trademark and service mark MICROBAN on the Principal Register of the United States Patent and Trademark Office (USPTO), including (but not limited to) word registration No. 1141006, registration dated November 4, 1980, in International Class (IC) 1, covering additive to impart antibacterial, antifungal and antimicrobial properties to plastic resins; word registration No. 1464213, registration dated November 10, 1987, in IC 5, covering liquid/spray disinfectants as further specified; word registration No. 2220264, registration dated January 26, 1999, in IC 40, covering, *inter alia*, antimicrobial treatments for plastic resins. Complainant also owns trademark registrations for MICROBAN in a substantial number of countries outside the United States.

Complainant has submitted "intent to use" applications for the word trademark and service mark DURATECH BY MICROBAN to the USPTO, serial Nos. 97420551 and 97420553, both applications filed May 20, 2022, covering antimicrobial preparations and services, respectively.

Complainant manufactures and sells antimicrobial, disinfectant and odor control products in more than 30 countries. It operates a commercial website at "www.microban.com".

According to the Registrar's verification, Respondent is registrant of the disputed domain name. According to a Whois record furnished by Complainant, the record of registration for the disputed domain name was created on May 24, 2022. There is no evidence on the record of this proceeding that any party other than Respondent has owned or controlled the disputed domain name since the creation date of the record of registration.

Respondent initially offered the disputed domain name for sale through sedo.com for USD 995, and Respondent more recently redirects the disputed domain name to GoDaddy's Broker Service webpage. Complainant transmitted a cease-and-desist and transfer demand by email to Respondent dated June 8, 2022, to which Respondent did not reply. Complainant asserts that Respondent associated the disputed domain name with a mail exchange ("MX") record.

5. Parties' Contentions

A. Complainant

Complainant asserts that it has rights in the trademarks MICROBAN and DURATECH BY MICROBAN, and that the disputed domain name is identical or confusingly similar to those trademarks.

Complainant argues that Respondent lacks rights or legitimate interests in the disputed domain name because: (1) Complainant has not authorized or licensed Respondent to use its trademarks; (2) Respondent is not commonly known by Complainant's trademarks or the disputed domain name; (3) Respondent's offer to sell the disputed domain name does not constitute a *bona fide* offering of goods or services; (4) Respondent's association of the disputed domain name with an MX record suggests that it may intend to use the disputed domain name for a phishing or business email compromise scheme, and; (5) Respondent's opportunistic registration of the disputed domain name suggests an intent to capitalize on the goodwill of Complainant.

Complainant contends that Respondent registered and is using the disputed domain name in bad faith because: (1) Respondent registered the disputed domain name long after Complainant established rights in its MICROBAN trademark, and very shortly following Complainant's applications to register its DURATECH BY MICROBAN trademark; (2) Respondent's use of the disputed domain name to direct Internet users to an offer for sale is evidence of bad faith; (3) Respondent's association of the disputed domain name with an email server suggests that Respondent's intent may be to use the disputed domain name as part of a phishing or business email compromise attack, and; (4) Respondent's failure to reply to a cease-and-desist letter is evidence of bad faith.

Complainant requests the Panel to direct the Registrar to transfer the disputed domain name to Complainant.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

The registration agreement between Respondent and the Registrar subjects Respondent to dispute settlement under the Policy. The Policy requires that domain name registrants submit to a mandatory administrative proceeding conducted by an approved dispute resolution service provider, one of which is the Center, regarding allegations of abusive domain name registration and use (Policy, paragraph 4(a)).

It is essential to Policy proceedings that fundamental due process requirements be met. Such requirements include that a respondent have notice of proceedings that may substantially affect its rights. The Policy and the Rules establish procedures intended to ensure that respondents are given adequate notice of proceedings commenced against them and a reasonable opportunity to respond (see, e.g., Rules, paragraph 2(a)).

The Center formally notified the Complaint to Respondent at the email and physical address provided in its record of registration. Courier delivery of the Written Notice to Respondent was successfully completed. There is some indication of a problem with transmission of email to Respondent at the email address incorporating the disputed domain name. The Center took those steps prescribed by the Policy and the Rules to provide notice to Respondent, and those steps are presumed to satisfy notice requirements.

Paragraph 4(a) of the Policy sets forth three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration and use and to obtain relief. These elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- (ii) 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.

Each of the aforesaid three elements must be proved by a complainant to warrant relief.

A. Identical or Confusingly Similar

Complainant has provided evidence of rights in the trademark MICROBAN, including by registration at the USPTO and through use in commerce. See Factual Background, *supra*. Respondent has not challenged Complainant's assertion of rights in MICROBAN. The Panel determines that Complainant owns rights in the trademark MICROBAN.

Complainant has alleged rights in the trademark DURATECH BY MICROBAN based on filing of two applications for registration at the USPTO. Those two applications are in the form of "intent to use" applications, and the documentation from the USPTO furnished by Complainant makes no assertion of actual use in commerce. As such, the aforesaid applications standing alone are insufficient to establish common law or other rights in the DURATECH BY MICROBAN trademark. This does not preclude the two applications from being considered by the Panel as evidence of Respondent's intent in registering the disputed domain name, nor does it constitute an assessment of whether Complainant will ultimately establish rights in the DURATECH BY MICROBAN trademark. It merely has not done so for purposes of this proceeding.

The disputed domain name directly and fully incorporates Complainant's MICROBAN trademark. This is sufficient to establish confusing similarity between the trademark and the disputed domain name from the standpoint of the Policy. The addition by Respondent of the terms "duratech by" to Complainant's trademark does not prevent a finding of confusing similarity.

The Panel determines that Complainant has established rights in the trademark MICROBAN, and that the disputed domain name is confusingly similar to that trademark.

B. Rights or Legitimate Interests

Complainant's allegations to support Respondent's lack of rights or legitimate interests in the disputed domain name are outlined above, and the Panel finds that Complainant has made a *prima facie* showing that Respondent lacks rights or legitimate interests in the disputed domain name.

Respondent has not replied to the Complaint and has not attempted to rebut Complainant's *prima facie* showing of lack of rights or legitimate interests.

Respondent has offered the disputed domain name, confusingly similar to Complainant's trademark, for sale. Respondent was not authorized to use Complainant's trademark in the disputed domain name, nor was it authorized by Complainant to offer, sell and/or transfer the disputed domain name. Respondent has not provided any potentially legitimizing explanation for its decision to register (and offer for sale) the disputed domain name.

Respondent's actions do not establish rights or legitimate interests in the disputed domain name. They do not constitute a *bona fide* offering of goods or services, nor do they represent a legitimate noncommercial or fair use of the disputed domain name.

Respondent's registration and use of the disputed domain name does not otherwise manifest rights or legitimate interests.

The Panel determines that Complainant has established that Respondent lacks rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

In order to prevail under the Policy, Complainant must demonstrate that the disputed domain name "has been registered and is being used in bad faith" (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy states that "for the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith". These include, "(i) circumstances indicating that [the respondent has] registered or [the respondent has] acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the respondent's] documented out-of-pocket costs directly related to the domain name; ... or (iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location".

Respondent registered the disputed domain name which is confusingly similar to Complainant's distinctive MICROBAN trademark almost immediately following Complainant's submission to the USPTO of two intent-to-use trademark applications with trademark terms identical to the disputed domain name. The registration by Respondent of the disputed domain name was not plausibly coincidental or serendipitous. Respondent was targeting Complainant's MICROBAN trademark and its associated goodwill.

Respondent offered to sell the disputed domain name for a price presumably in excess of its out-of-pocket expenses associated with the disputed domain name. There is no evidence of any expenditure by Respondent in connection with the disputed domain name other than its cost of registration. It is a long-standing matter of jurisprudence under the Policy that while the express terms of paragraph 4(b)(i) refer to the sale of a domain name to the trademark owner or its competitor, this is not a requirement for establishing bad faith registration and use based on an offer to sell. See, e.g. *Educational Testing Service v. TOEFL*, WIPO Case No. [D2000-0044](#). The Panel need not review that long jurisprudential history here.

Respondent has not furnished any explanation that might rebut the evidence of bad faith registration and use.

It is sufficient in the circumstances of this proceeding for the Panel to determine that Respondent registered the disputed domain name primarily for the purpose of selling the disputed domain name for a price in excess of its out-of-pocket expenses.

Complainant has argued that Respondent associated the disputed domain name with an MX record suggesting an intent to undertake some act of fraud through use of deceptive email. The Panel does not consider the specific evidence furnished by Complainant regarding an MX record sufficient to establish the fact alleged without further support or clarification. As assessment of this element by the Panel is not necessary to its determination, the Panel does not further address here.

The Panel determines that Complainant registered and is using the disputed domain name in bad faith within the meaning of paragraph 4(b)(i) of the Policy.

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, <duratechbymicroban.com>, be transferred to Complainant.

Frederick M. Abbott

Frederick M. Abbott

Sole Panelist

Date: October 7, 2022