ARBITRATION
AND
MEDIATION CENTER

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

ADMINISTRATIVE PANEL DECISION

Bytedance Ltd. v. Muhammad Haroon
Case No. D2022-2946

1. The Parties

The Complainant is Bytedance Ltd., Cayman Islands, represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is Muhammad Haroon, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <capcutapks.com> is registered with NameCheap, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 10, 2022. On August 10, 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 disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent (Privacy service provided by Withheld for Privacy ehf, Iceland) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 11, 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 September 21, 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 September 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 11, 2022. The Respondent sent informal communications to the Center on August 11 and 19, 2022 and October 1, 2022, which are summarised below. The Respondent did not submit any formal Response. Accordingly, the Center notified the Parties with the Commencement of Panel Appointment Process on October 17, 2022.

The Center appointed Mihaela Maravela as the sole panelist in this matter on October 25, 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.

Following the email from the Respondent of August 11, 2022, asking "[h]ow to settle this issue", the Center has sent on August 15, 2022 an email informing the Parties about the procedure to be followed if they wish to explore settlement options. The Complainant has submitted a request for the proceedings to be suspended on August 19, 2022, that the Respondent confirmed to having received on the same day. The proceedings were suspended on August 19, 2022. On August 29, 2022, the Complainant sent a communication with a standard settlement form, to which the Respondent did not respond. The proceedings were reinstituted on September 20, 2022.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

4. Factual Background

The Complainant is an Internet technology company that owns a series of content platforms that enable people to connect with consuming and creating content through machine learning technology, including TikTok and Helo. In April 2020 the Complainant launched the CapCut application, which is a video editing app that allows users to add a trove of stickers, filters and effects, and also has a simple-to-use green screen function, a zooming feature and many more. The CapCut app saw downloads to reach 140 million globally in the first half of 2021.

The Complainant is the owner of various CAPCUT trademarks, including the European Union trademark No. 018255581 registered on May 15, 2021. The Complainant operates its main website at "www.capcut.com".

The disputed domain name was registered on November 23, 2021 and resolves to a website that features the Complainant's logo and/or images from the Complainant's official website, while offering downloadable Capcut mobile application files.

On August 11, 2022, following the Notice of Registrant Information communication from the Center, the personal-named Respondent sent informal emails to the Center saying that: "I didn't understand what you trying to say" and asking "How to settle this issue". On August 19, 2022, the Respondent sent an informal email to the Center saying that "[t]he disputer pay me the money and i will give him the domain with all content. My demanding price is $10k for domain and Content." On October 1, 2022, the Respondent sent an informal email to the Center stating that "I have read written notice and i want to communicate with the complaining person as I'm agree to transfer domain to him as i did not want to waste the efforts i put on this domain and im return i am demanding $4000 for capcutapks.com The reason for it is that as i did hard work to rank the upper site and i wan not aware of the trade mark policy. So that's why i am demanding this much amount and we will settle the issue by transferring domain when the complaining person pay me $4000."

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name is confusingly similar to its CAPCUT trademark, to which only the generic, descriptive term "apks" was added. According to the Complainant, "apk" or "apks" is a common short form used to refer to Android Package Kit, a file format that Android uses to distribute and install apps, therefore, the term "apks" describes the Complainant's product for download on an Android device. This addition serves to underscore and increase the confusing similarity between the disputed domain name and the Complainant's trademark CAPCUT.

As regards the second element, the Complainant argues that the Respondent is not sponsored by or affiliated with the Complainant in any way, nor has the Complainant given the Respondent a license, authorization or permission to use the Complainant's trademarks in any manner, including in domain names. Also, the Respondent is not commonly known by the disputed domain name. The Complainant also argues that the Respondent is using the disputed domain name to resolve to a website that features the Complainant's logo and/or images from the Complainant's official website, while offering downloadable CAPCUT mobile application files. The inclusion of the Complainant's CAPCUT trademark and logo creates the appearance that the disputed domain name and its website is somehow affiliated with the Complainant, which is not true. Moreover, the Respondent's use of the disputed domain name cannot constitute a legitimate fair use, because the disputed domain name appears to be resolving to a blog-style website, which publishes information and guides on the Complainant's Capcut app, but also sponsored advertisements, which do not support a claim of fair use.

With respect to the third element, the Complainant argues that by registering the disputed domain name that fully incorporates the Complainant's CAPCUT trademark along with the generic, descriptive term "apks", the Respondent has created a domain name that is confusingly similar to the Complainant's trademark. By doing so, the Respondent has demonstrated a knowledge of and familiarity with the Complainant's brand and business. Furthermore, given that the disputed domain name resolves to a website displaying the Complainant's logo and offering the downloads of the Capcut app, it is "not possible to conceive of a plausible situation in which the Respondent would have been unaware of" the Complainant's brand at the time the disputed domain names was registered. Moreover, the Respondent creates a likelihood of confusion with the Complainant and its trademark by resolving to a website which display or displayed the Complainant's CAPCUT trademark and logo in a brand-like manner and purports to be blog-style website that allow users to download the Capcut app, with the Respondent then attempting to profit from such confusion by including sponsored advertisements.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions. The Respondent sent informal communications to the Center on August 11 and 19, 2022 and October 1, 2022.

6. Discussion and Findings

In the informal submissions made by the Respondent it appears to have consented to the transfer of the disputed domain name. However, given the circumstances of the case, particularly the fact that the Respondent asked for a consideration in exchange of the transfer, as well as the fact that the Respondent denied bad faith in registration of the disputed domain name, and that the disputed domain name still resolves to an active website, the Panel will proceed to a decision on the merits. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 4.10.

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following elements:

(i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) that the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has proved rights over the CAPCUT trademark.

The disputed domain name incorporates the trademark CAPCUT in its entirety. The addition of the letters "apks" does not in the view of the Panel prevent the Complainant's trademark from being recognizable within the disputed domain name. Many UDRP panels have found that a disputed domain name is confusingly similar where the relevant trademark is recognizable within the disputed domain name. See section 1.7 of the WIPO Overview 3.0.

It is well accepted by UDRP panels that a generic Top-Level Domain ("gTLD"), such as ".com", is typically ignored when assessing whether a domain name is identical or confusing similar to a trademark. See section 1.11 of the WIPO Overview 3.0.

This Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademarks and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* case demonstrating that the Respondent has no rights or legitimate interests in the disputed domain name in order to place the burden of production on the Respondent (see section 2.1 of the WIPO Overview 3.0).

In the present case, the Complainant has established a *prima facie* case that it holds rights over the trademark CAPCUT and claims that the Respondent has no legitimate reason to acquire and use the disputed domain name. There is no evidence that the Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services. Rather, according to the unrebutted evidence of the Complainant, the website at the disputed domain name is used to resolve to a website that features the Complainant's logo and/or images from the Complainant's official website, while offering downloadable Capcut mobile application files, likely generating revenue from clickthrough advertising. Such use could incorrectly suggest that the website is operated by an affiliate of the Complainant. Such use does not amount to a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name. Furthermore, the nature of the disputed domain name carries a risk of implied affiliation and cannot constitute a fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the WIPO Overview 3.0.

Also, there is no evidence that the Respondent is commonly known by the disputed domain name.

The Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent failed to rebut that *prima facie* case because the Respondent did not formally respond to the Complainant's contentions.

With the evidence on file, the Panel finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith.

The Complainant's registration and use of the relevant trademarks predate the date at which the Respondent registered the disputed domain name. The disputed domain name resolves to a website reproducing the Complainant's trademark and logo. Given the distinctiveness of the Complainant's trademark, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks, and to target those trademarks.

As regards the use, the disputed domain name resolved to a website where the Complainant's trademark and logo were displayed, while offering downloadable Capcut mobile application files. The Panel is of the view that in light of the Respondent's use of the disputed domain name, paragraph 4(b)(iv) of the Policy applies, in that bad faith registration and use can be found in respect of a disputed domain name, where a 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 a complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

Moreover, in the informal communications to the Center, the Respondent offered to sell the disputed domain name for various amounts, varying between USD 4,000 to USD 10,000. Consequently, the Panel finds that the circumstances listed under paragraph 4(b)(i) of the Policy providing that the Respondent has registered the disputed domain name primarily for the purpose of selling or otherwise transferring the domain name registration to the Complainant or its competitors for an amount likely in excess of the documented out-of-pockets costs are applicable in this case.

The Respondent has not formally participated in these proceedings and has failed to rebut the Complainant's contentions and to provide any evidence of actual or contemplated good-faith use and indeed none would seem plausible.

In the Panel's view, the circumstances of the case represent evidence of registration and use in bad faith of the disputed domain name. Consequently, the Panel concludes that the condition of paragraph 4(a)(iii) of the Policy is fulfilled.

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, <capcutapks.com> be transferred to the Complainant.

/Mihaela Maravela/
Mihaela Maravela
Sole Panelist
Date: November 8, 2022