

## **ADMINISTRATIVE PANEL DECISION**

PrideStaff, Inc. v. Adam Smith  
Case No. D2022-3505

### **1. The Parties**

The Complainant is PrideStaff, Inc., United States of America (“USA” or “United States”), represented by Frost Brown Todd LLC, USA.

The Respondent is Adam Smith, Canada.

### **2. The Domain Name and Registrar(s)**

The disputed domain name <pridestaffing.info> is registered with Google LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 21, 2022. On September 22, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on September 26, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On September 26, 2022, the Center sent a request for clarification of the Complaint to the Complainant. The Complainant filed an amended Complaint and an amendment to the Complaint on October 6, 2022.

The Center verified that the Complaint together with the amendment to the Complaint and 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 October 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 2, 2022.

The Center appointed Dr. Clive N.A. Trotman as the sole panelist in this matter on November 14, 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, founded in 1978, is a USA company that provides staffing services both to employers requiring professional staff and to individuals looking for such employment. The Complainant has over 85 offices nationwide.

The Complainant has received recognition and awards including the “Best of Staffing” industry award annually since 2010 and the “Best of Staffing Talent Diamond Award” 2017-2022.

The Complainant has registered the following trademarks or service marks (“trademarks”):

PRIDESTAFF, United States Patent and Trademark Office, principal register, registered November 25, 1997, registration number 2116589, in class 35. The trademark has achieved incontestable status;

PRIDESTAFF, Canadian Intellectual Property Office, registered June 4, 1998, registration number TMA495653, in class 35. The trademark is currently owned by the Complainant’s Canadian subsidiary.

The Complainant has also owned and used the domain name <pridestaff.com> since 1996 for business purposes including the provision of information about the Complainant to potential clients, and as a platform through which potential employees may peruse and apply for posted available positions.

The Respondent has not provided any background information except for the contact details provided in order to register the disputed domain name, which is held through a privacy service. The disputed domain name was registered according to the WhoIs on August 19, 2022, and does not resolve to an active website.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain name incorporates the Complainant’s trademark in its entirety and is confusingly similar. The changing of the word “staff” in the trademark to “staffing” in the disputed domain name does not change the commercial impression and the result is virtually the same as the Complainant’s trademark. The generic Top-Level Domain (“gTLD”) “.info” does not prevent confusion.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant says the Respondent is not a franchisee or otherwise affiliated with the Complainant and does not conduct any business on the Complainant’s behalf. According to the Complainant’s research, the Respondent’s address is residential and Google Maps does not show any business associated with the address.

The Complainant contends that the Respondent registered and is using the disputed domain name in bad faith.

The Complainant says that upon investigation it became apparent that the Respondent’s email address, commencing with “purestafing”, is similar to that of a Canadian staffing company named Pure Staffing Solutions Inc., which uses the website “www.purestaffing.com”.

The Complainant says the disputed domain name is passively held by the Respondent, in consequence of which the Complainant is prevented from registering the same domain name. The Complainant says that irrespective of the disputed domain name being passively held, and taking note of the previous findings in the decision in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) ("*Telstra*"), there can be no plausible good faith use to which the disputed domain name could be put by the Respondent. The disputed domain name is so obviously connected with the Complainant that its registration and use by the Respondent, who has no connection with the Complainant, suggests opportunistic bad faith.

The Complainant says the Respondent registered the disputed domain name in order to trade off the Complainant's goodwill and to represent its employment services as being those of the Complainant.

The Complainant also says that in this instance, having regard to all the evidence, the Respondent's use of a privacy service to conceal its identity is a further indication of bad faith.

The Complainant has cited certain previous decisions under the Policy that it considers to be relevant.

The Complainant requests the transfer of the disputed domain name.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy states that the Respondent is required to submit to a mandatory administrative proceeding in the event that the Complainant asserts to the applicable dispute-resolution provider, in compliance with the Rules, that:

"(i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) you have no rights or legitimate interests in respect of the domain name; and

(iii) your domain name has been registered and is being used in bad faith".

The Complainant has made the relevant assertions as required by the Policy. The dispute is properly within the scope of the Policy and the Panel has jurisdiction to decide the dispute.

### **A. Identical or Confusingly Similar**

The Complainant has produced copies of registration documents in respect of the trademark PRIDESTAFF registered in the USA and Canada and the Panel is satisfied that the Complainant has the requisite rights in the trademark under the Policy.

The disputed domain name <pridestaffing.info>, neglecting the gTLD ".info", incorporates the entirety of the Complainant's trademark, and to that extent may be considered to be confusingly similar to the trademark. The word "staff" in the Complainant's trademark has been modified to form the word "staffing" in the disputed domain name. The Panel does not find that this modification of the Complainant's trademark to form the disputed domain name prevents a finding of confusing similarity.

Accordingly the Panel finds for the Complainant under paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

The Complainant is required to present a *prima facie* case to the effect that the Respondent does not have rights or legitimate interests in the disputed domain name. The Complainant has stated that the Respondent is not a franchisee or otherwise affiliated with the Complainant, and is not authorised to conduct business on behalf of the Complainant.

It is for the Respondent to produce any evidence demonstrating rights or legitimate interests in the disputed domain name, as provided for under paragraph 4(a)(ii) of the Policy by demonstrating, without limitation:

“(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue”.

Whilst it remains for the Complainant to prove its case, paragraph 4(a)(ii) of the Policy is usually deemed to have been satisfied if the Respondent does not contest the Complainant's *prima facie* case.

The Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name and finds for the Complainant under paragraph 4(a)(ii) of the Policy.

## **C. Registered and Used in Bad Faith**

The Complainant must prove under paragraph 4(a)(iii) of the Policy that the disputed domain name has been registered and is being used in bad faith. Paragraph 4(b) of the Policy lists examples of circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

“(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location”.

The provisions of paragraph 4(b) of the Policy are without limitation and bad faith may be found alternatively by the panel.

The Complainant has advanced a number of grounds, some under the heading of rights and legitimate interests, that may be considered in the determination of registration and use of the disputed domain name in bad faith.

The Complainant investigated the nature of the Respondent's contact email address, as disclosed by the Registrar in revealing the Respondent's contact details, the definitive part of which is "purestafing" (with a single letter "f"). The Complainant has produced screen capture evidence of the website of a company unrelated to the Complainant, Pure Staffing Solutions Inc., which trades through the website "www.purestaffing.com" (with a double "f"). The Pure Staffing Solutions Inc., website has content including the statement "Canada's leading employment agency for quickly sourcing top-level skilled-trades, engineering and operations candidates", and "View Latest Job Openings". The relevance of this discovery to the present case is to suggest that the contact information provided by the Respondent to the Registrar was intentionally deceptive by creating at least a superficial impression that the Respondent was connected to an actual authentic employment agency, notwithstanding the misspelling.

The disputed domain name is passively held, resolving only to a notice that the page cannot be reached. The panel in *Telstra* took into consideration a number of criteria, which have been widely cited since, in deciding that passive holding of the relevant domain name without positive action or active use did not preclude a finding of bad faith use in that particular case. In the present case it is noted that the Complainant's trademark has incontestable status and has had long-standing use since its first registration on November 25, 1997 (with first use stated to be March 1, 1995); the Respondent cannot reasonably make any plausible use of the disputed domain name that would not conflict with the Complainant's rights and has not advanced any such use; the disputed domain name clearly reflects and indicates more probably than not a prior knowledge of the Complainant's trademark; and the disputed domain name in itself implies that it belongs to an employment agency with essentially the same trademark as the Complainant and therefore could be used to misrepresent the Complainant through either a website or an email address.

Furthermore the registrant details of the disputed domain name have been placed behind a privacy service by the Respondent. Generally, use of a privacy service may not in itself be an indication of bad faith and is a choice for which there can be benign reasons. When, however, the intention appears most probably to be, as here, primarily to frustrate contact or to delay any potential proceedings under the Policy or otherwise, that can be taken as an indication a bad faith intent.

Having regard to the totality of the evidence, and on the balance of probabilities, the Panel finds the disputed domain name to have been registered and used in bad faith by the Respondent in the terms of paragraph 4(a)(iii) 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 <pridestaffing.info> be transferred to the Complainant.

*/Clive N.A. Trotman/*

**Dr. Clive N.A. Trotman**

Sole Panelist

Date: November 28, 2022