

## **ADMINISTRATIVE PANEL DECISION**

Erase Technologies, LLC v. Web Presence LLC, NetReputation.com  
Case No. D2022-3797

### **1. The Parties**

Complainant is Erase Technologies, LLC, United States of America (“United States”), represented by Gibney, Anthony & Flaherty, LLP, United States.

Respondent is Web Presence LLC, NetReputation.com, United States, represented by Cylaw Solutions, India.

### **2. The Domain Name and Registrar**

The disputed domain name <guaranteedremoval.com> (hereinafter 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 October 11, 2022. On October 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 13, 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 October 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 10, 2022, was extended to November 14, 2022. The Response was filed with the Center on November 14, 2022.

The Center appointed Lawrence K. Nodine, John C. McElwaine, and Gerald M. Levine as panelists in this matter on December 15, 2022. The Panel finds that it was properly constituted. Each member of 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 a content removal company that specializes in the permanent deletion of negative material on websites and search engines. Complainant has owned the domain name <www.guaranteedremovals.com> since November 2013. Additionally, Complainant owns a New York State service mark registration for GUARANTEED REMOVALS (Reg. No. S25506; Registered April 26, 2022), a pending Florida State trademark application (Application No. W22000088220; filed on July 1, 2022), and one active pending U.S. federal trademark application (Application No. 97593365; filed on September 15, 2022) (the “GUARANTEED REMOVALS mark”).

Respondent provides web-design, web development, and SEO optimization services. Respondent registered the Disputed Domain Name on December 16, 2016, and used the website associated therewith to provide these reputation management services starting at the end of 2017.

Complainant contacted Respondent regarding its use of the Disputed Domain Name on March 21, 2022. Currently, the Disputed Domain Name resolves to an inactive webpage.

#### 5. Parties' Contentions

##### A. Complainant

Complainant alleges that it has offered its services under the “www.guaranteedremovals.com” website since at least 2014, and now has 23,000 clients in the United States, as well hundreds of clients in 57 other countries. Complainant offers no evidence to support its allegations of use.

Complainant contends that its New York State service mark registration in conjunction with its years of use of the GUARANTEED REMOVALS mark establish that it has rights in the GUARANTEED REMOVALS trademark and that the Disputed Domain Name is confusingly similar thereto. Complainant further alleges that the singularizing of the GUARANTEED REMOVALS mark to GUARANTEED REMOVAL does not overcome a likelihood of confusion between the two marks. Complainant contends that through its use of its mark since 2014, it has established GUARANTEED REMOVALS as a global identifier for its services.

Complainant claims that Respondent is not making a *bona fide* or fair use of the Disputed Domain Name because the website associated with the Disputed Domain Name is currently inactive. Complainant charges Respondent with passive holding.

Complainant contends that Respondent registered and continues to use the Disputed Domain Name in bad faith. Specifically, Complainant states that Respondent knew about the use of the GUARANTEED REMOVALS mark years prior to any direct contact with Complainant. Complainant further claims that Respondent’s USD 75,000 counteroffer to Complainant’s offer to purchase the Disputed Domain Name is evidence of bad faith under the Policy.

##### B. Respondent

Respondent replies that Complainant has no standing to bring this Complaint because Complainant does not have a federal trademark registration and Complainant has failed to prove secondary meaning in the GUARANTEED REMOVALS mark.

Respondent asserts that it has rights and a legitimate interest in the Disputed Domain Name because the Disputed Domain Name is composed of two common English dictionary words that have a descriptive and well known meaning that is wholly separate and that is related to Respondent’s service offerings.

Since 2014, it also has provided services in relation to reputation management, including the removal of negative online content, in the name of “NetReputation.com”.

Respondent contends (and supplies evidence) that it has made uninterrupted and continuous use of the Disputed Domain Name in relation to its dictionary meaning from 2017 until 2022.

Respondent states that it registered the Disputed Domain Name in good faith purely because it comprised a common phrase that is descriptive of its services. Respondent asserts that it only became aware of Complainant's website in February 2018 when an individual employed by Complainant outsourced reputation management work to Respondent. According to Respondent, in June 2022 it deactivated the website associated with the Disputed Domain Name out of its respect for Complainant. Respondent also denies it provided a monetary demand to Complainant in exchange for the sale of the Disputed Domain Name.

## 6. Discussion and Finding

### A. Identical or Confusingly Similar

The Panel finds that Complainant's New York State service mark registration establishes that it has rights in the GUARANTEED REMOVALS mark. However, state trademark registrations are not always granted the same deference as national trademark registrations because they are sometimes issued automatically. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.2. This does not appear to be the case in New York where the New York State trademark registration statute and related regulations provide on their face for substantive review, including consideration of descriptiveness. See NY Gen Bus L § 360-A-C (2014) and regulations at <https://dos.ny.gov/state-records-rules-and-regulations>. Accordingly, "the exception in the Overview does not apply". *Paul McMann v. J McEachern*, WIPO Case No. [D2007-1597](#) (Massachusetts state registrations not issued "automatically"; Secretary of the Commonwealth exercises some scrutiny); *Teresa Christie, d/b/a The Mackinac Island Florist v. James Porcaro, d/b/a Weber's Mackinac Island Florist*, WIPO Case No. [D2001-0653](#) (Panel has no power to nullify Michigan state registration). Even though Complainant's New York registration recites a design element, it is not dominant and Complainant was not required to disclaim the textual elements. [WIPO Overview 3.0](#) section 1.10.

Accordingly, the Panel finds that Complainant has satisfied Policy paragraph 4(a)(1).

### B. Rights or Legitimate Interests

The Panel finds that Respondent has legitimate interests in the Disputed Domain Name as prior to any notice of the dispute, Respondent was using the Disputed Domain Name in connection with a *bona fide* offering of services. See WIPO Overview, section 2.10.1. Respondent has submitted evidence of press releases and an archived webpage of the Disputed Domain Name from 2018 confirming Respondent's use of the Disputed Domain Name in association with *bona fide* offering of negative content removal services. See *Dollar Bank, Federal Savings Bank v. Host Master / Jason Duke*, WIPO Case No. [D2016-0701](#). Publicly available archive webpages also confirm that the Disputed Domain Name was actively offering reputation management services until June 2022, shortly after Complainant contacted Respondent and demanded that it cease use of the Disputed Domain Name, thereby supporting Respondent's claim that it deactivated the website in light of the dispute, and refuting Complainant's allegation of passive holding.

Respondent has also offered substantial evidence of third party use of "guaranteed removal" descriptively. The Panel finds that preponderance of evidence supports Respondent's claim that it registered the Disputed Domain Name to exploit its descriptive connotations and not to exploit any alleged trademark rights of Complainant.

Therefore, Complainant has not satisfied paragraph 4(a)(ii) of the Policy.

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

The Panel also finds that Complainant has failed to prove by a preponderance of the evidence that Respondent registered the Disputed Domain Name in bad faith. Respondent registered the Disputed Domain Name in 2016, more than five years before Complainant applied for its New York State trademark registration in 2022. Although Complainant alleged widespread use since 2014, it did not submit any evidence to support the allegation, other than the declaration of its General Counsel that the “Company has been using the mark Guaranteed Removals in connection with their services since at least as early as 2014”. It is important to note that the Panel holds that there was insufficient evidence that Complainant would have acquired distinctiveness in the descriptive GUARANTEED REMOVALS mark prior to registration of the Disputed Domain Name by Respondent. There is no basis, therefore, for the Panel to infer that Respondent was more likely than not aware of Complainant’s trademark rights when it registered the Disputed Domain Name in 2016. The Panel finds that Complainant has failed to provide evidence of its purported extensive use of the GUARANTEED REMOVALS mark in 2016 when Respondent registered the Disputed Domain Name.

Respondent candidly acknowledges that it learned of Complainant’s predecessor in 2018, when Complainant outsourced some work to Respondent. However, this knowledge was acquired well after the registration of the Disputed Domain Name in 2016 and, in any event, there is no evidence that Complainant objected at that time or made Respondent aware of a claim of trademark rights. Complainant offers no argument or evidence to rebut Respondent’s plausible contention that both parties used “guaranteed removal” as a descriptive term.

Because Complainant has failed to carry its burden to prove bad faith registration, the Panel will not address the bad faith use contentions.

### **D. Reverse Domain Name Hijacking**

Paragraph 15(e) of the UDRP Rules provides that, if “after considering the submissions the panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding”. [WIPO Overview 3.0](#), section 4.16. That section of the Overview further provides a number of non-exclusive factors which, in appropriate circumstances, support a finding of RDNH. Such factors as may be relevant to the instant proceeding include: “the provision of false evidence, or otherwise attempting to mislead the panel”; and “the provision of intentionally incomplete material evidence--often clarified by the respondent”.

The Panel finds Reverse Domain Name Hijacking because Complainant factually misleading allegations and key arguments that lacked a plausible legal basis.

First, Complainant relied in part on two federal trademark applications, representing that “[b]oth applications are currently pending”. Complaint p. 7. This argument was factually misleading because Complainant did not disclose that it filed an “Express Abandonment” of the standard character application on the very same day that it filed the UDRP Complaint with the Center. The email submitting the Complaint was received by the Center on October 11, 2022 at 12:28 PM Eastern Time USA. Complainant filed the Express Abandonment of its application for the GUARANTEED REMOVALS word mark (Serial Number 97312285) in the United States Patent and Trademark Office (“USPTO”) about six hours later at “18:51:29 ET 2022” (USPTO time stamp).

The Panel finds that, even though the allegation that the application was “pending” was technically correct when the UDRP complaint was filed, the Panel finds that the Express Abandonment was doubtless being prepared before it was filed. And, in any event, Complainant could have and should have amended its complaint to avoid misleading the Panel. It is immaterial that Complainant did not abandon both of its federal applications. Indeed, neither of the applications advanced Complainant’s case as applications confer no rights. Policy paragraph 4(a)(i), [WIPO Overview 3.0](#) section 1.1.4. It is Complainant’s effort to mislead the Panel

that supports the finding of RDNH. It is not an excuse to say that the entire allegation was not misleading or that the misleading allegations pertain to an argument that would not have succeeded.

Second, and similarly, Complainant alleged that “[a] Florida state registration currently pending,” but the exhibit to which it points recites “Rejected Filing”. Here again, the misleading allegation, which Complainant’s counsel certified under Rule 3(b)(xiii) as “accurate,” is not excused because the annexed evidence reveals the allegation’s falsity on its face.

Third, Complainant’s only contention with respect to Policy paragraph 4(a)(ii) is that Respondent was making no use of the Disputed Domain Name as of the filing of the complaint,<sup>1</sup> even though it well knew (and had alleged) that Respondent had been using the Disputed Domain Name to provide services for several years. In essence, Complainant would penalize Respondent for taking down the site as it had insisted in its cease and desist letter, and then labeling this “passive holding”. This contention lacked any “plausible legal basis.” [WIPO Overview 3.0](#), section 4.16.

## 7. Decision

For the foregoing reasons, the Complaint is denied.

*/Lawrence K. Nodine/*  
**Lawrence K. Nodine**  
Presiding Panelist

*/John C McElwaine/*  
**John C McElwaine**  
Panelist

*/Gerald M. Levine/*  
**Gerald M. Levine**  
Panelist  
Date: January 5, 2023

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<sup>1</sup> The Complaint alleges that: “As of the filing of this Complaint, the Infringing Domain Name is not active in connection with any bona fide offering of goods or services. The inactivity of the website indicates that the Respondent does not have any rights or legitimate interests in the domain name . . . Since the Infringing Domain currently has no content, there is essentially no use of the domain name.”