

## **ADMINISTRATIVE PANEL DECISION**

Droga5, LLC v. SC Public Relation Inc.

Case No. D2022-4334

### **1. The Parties**

Complainant is Droga5, LLC, United States of America (“United States”), represented by McDermott Will & Emery LLP, United States.

Respondent is SC Public Relation Inc., United States.

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

The disputed domain name <droga5llc.com> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 15, 2022. On November 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with The Domain Name. On November 15, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for The Domain Name which differed from the named Respondent (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to Complainant on November 17, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed amended Complaint on November 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 Respondent of the Complaint, and the proceedings commenced on November 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 13, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on December 19, 2022.

The Center appointed Nobles, Kimberley Chen as the sole panelist in this matter on January 4, 2023. 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, founded in 2006, is a creative and advertising agency headquartered in New York with offices in London, Tokyo, São Paulo, and Dublin. Complainant provides creative strategy, business design, brand experience, integrated campaigns, and performance marketing services under the name DROGA5.

Complainant owns several registered trademarks for DROGA5 in various jurisdictions, including:

- United States registered trademark registration number 3,586,467 for DROGA5 word mark, registered on March 10, 2009;
- European Union registered trademark number 012405247 for DROGA5 word and design mark, registered on May 2, 2014.

Complainant also owns and operates its official website at <droga5.com>, which Complainant registered on November 14, 2005.

The Domain Name was registered on October 10, 2022, and reverted to Complainant's website <droga5.com> at the time of filing of the Complaint. At the time of the Decision, the Domain Name reverts to an error page.

#### **5. Parties' Contentions**

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

Complainant contends that (i) the Domain Name is identical and confusingly similar to Complainant's trademarks; (ii) Respondent has no rights or legitimate interests in the Domain Name; and (iii) Respondent registered and is using the Domain Name in bad faith.

In particular, Complainant contends that it has trademark registrations for DROGA5 and owns a domain name incorporating the DROGA5 trademarks. Complainant contends that Respondent registered and is using the Domain Name to confuse Internet users looking for *bona fide* and well-known DROGA5 products and services.

Complainant notes that it has no affiliation with Respondent, nor authorized Respondent to register or use a domain name, which includes Complainant's trademarks, and that Respondent has no rights or legitimate interests in the registration and use of the Domain Name. Rather, Complainant contends that Respondent has acted in bad faith in acquiring and setting up the Domain Name for redirecting the Domain Name to Complainant's website, when Respondent clearly knew of Complainant's rights. The Domain Name is also very similar to one of Complainant's trade names, and there is a risk for possible illegal phishing attempts. Moreover, Complainant contends that the Domain Name was actually used in furtherance of a fraudulent employment scheme, discovered when an individual visited Complainant's corporate office to investigate an alleged position with Complainant.

##### **B. Respondent**

Respondent did not reply to Complainant's contentions.

## 6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy to the Panel that:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name was registered and is being used in bad faith.

Section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) states that failure to respond to the complainant’s contentions would not by itself mean that the complainant is deemed to have prevailed; a respondent’s default is not necessarily an admission that the complainant’s claims are true.

Thus, although in this case Respondent has failed to formally respond to the Complaint, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See, e.g., *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#).

### A. Identical or Confusingly Similar

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. Complainant provided evidence of its rights in the DROGA5 trademarks, as noted above. Complainant has therefore proven that it has the requisite rights in the DROGA5 trademarks.

With Complainant’s rights in the DROGA5 trademarks established, the remaining question under the first element of the Policy is whether the Domain Name, typically disregarding the Top-Level Domain (“TLD”) in which it is registered (in this case, “.com”), is identical or confusingly similar to Complainant’s trademark. See, e.g., *B & H Foto & Electronics Corp. v. Domains by Proxy, Inc. / Joseph Gross*, WIPO Case No. [D2010-0842](#).

Here, the Domain Name is confusingly similar to Complainant’s DROGA5 trademarks. These trademarks are recognizable in the Domain Name. The addition of the term “llc”, which is a company designation of “limited liability company” in the business field, does not prevent a finding of confusing similarity between Complainant’s trademarks and the Domain Name.

Thus, the Panel finds that Complainant has satisfied the first element of the Policy.

### B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

From the record in this case, it is evident that Respondent was, and is, aware of Complainant and the DROGA5 trademarks, and does not have any rights or legitimate interests in the Domain Name.

Complainant has confirmed that Respondent is not affiliated with Complainant, or otherwise authorized or licensed to use the DROGA5 trademarks or to seek registration of any domain name incorporating the

trademarks. Moreover, there is no evidence showing that Respondent has been commonly known by the Domain Name.

In addition, Respondent has not used the Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Rather, Complainant asserts that the Domain Name previously redirect to Complainant's website which has not been rebutted by Respondent, and at the time of this Decision, it resolves to an error page. Such use does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Name. See, e.g., *Intesa Sanpaolo S.p.A. v. Charles Duke / Oneandone Private Registration*, WIPO Case No. [D2013-0875](#). See also *DROGA5 v. WhoisGuard, Inc., WhoisGuard Protected / Robert Jurek, Katrin Kafut, Purchasing clerk, Starship Tapes & Records*, WIPO Case No. [D2017-2533](#) ("The apparent lack of rights or legitimate interests in respect of the disputed domain name is supported by the invisible redirection to the Complainant's official website, indicating there is very likely no connection with a *bona fide* offering of goods and services").

Moreover, the nature of the Domain Name, comprising Complainant's fanciful and inherently distinctive trademarks with a common business designation, carries a risk of implied affiliation and cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by Complainant. See [WIPO Overview 3.0](#), section 2.5.1.

Accordingly, Complainants have provided evidence supporting its *prima facie* claim that Respondent lacks any rights or legitimate interests in the Domain Name. Respondent has failed to produce countervailing evidence of any rights or legitimate interests in the Domain Name. Thus, the Panel concludes that Respondent does not have any rights or legitimate interests in the Domain Name and Complainant has met their burden under paragraph 4(a)(ii) of the Policy.

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

The Panel finds that Respondent's actions indicate that Respondent registered and is using the Domain Name in bad faith.

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, 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 online 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 Panel finds that Complainant has provided ample evidence to show that registration and use of the DROGA5 trademarks long predate the registration of the Domain Name. Complainant is also well established and known. Indeed, the record shows that Complainant's DROGA5 trademarks and related services are widely known and recognized. Therefore, and also noting the composition of the Domain Name

itself, Respondent was likely aware of the DROGA5 trademarks when he registered the Domain Name, or knew or should have known that the Domain Name was confusingly similar to Complainant's trademarks. See [WIPO Overview 3.0](#), section 3.2.2; see also *TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited*, WIPO Case No. [D2016-1973](#).

The Panel therefore finds that Respondent's awareness of Complainants' trademark rights at the time of registration suggests bad faith. See *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. [D2001-1070](#); *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#).

Further, the registration of the Domain Name incorporating Complainant's DROGA5 trademark with the addition of the term "llc" which is a designation of "limited liability company" in the field of business, suggests Respondent's actual knowledge of Complainant's rights in the DROGA5 trademark at the time of registration of the Domain Name and his effort to opportunistically capitalize on the registration and use of the Domain Name.

In addition, Respondent has not used the Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Rather, Complainants assert that the Domain Name previously redirected to Complainant's website at the domain name <droga5.com> (which is almost identical to the Domain Name), which has not been rebutted by Respondent. It is more likely than not that Respondent seeks to create likelihood of confusion with Complainant and/or its trademarks. In the circumstances of this case, such use is indicative of bad faith. See [WIPO Overview 3.0](#), section 3.1.4. Although the Domain Name currently resolves to an error page, from the inception of the UDRP, panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. See section 3.3 of the [WIPO Overview 3.0](#), describes the circumstances under which the passive holding of a domain will be considered to be a bad faith registration: "While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put." See *Andrey Ternovskiy dba Chatroulette v. WhoisGuard Protected, WhoisGuard, Inc. / Armando Machado*, WIPO Case No. [D2018-0082](#).

Finally, and even more problematic, Complainant contends that Respondent has used the Domain Name for a corresponding email address to create a false association with Complainant and to perpetrate a phishing scam under the guise of an offer of employment with Complainant. Specifically, Complainant's legal team claims to have received notice from Complainant's security operations center reporting that an unknown individual appeared at Complainant's business office indicating that he was concerned with the legitimacy of a position he had been offered by Complainant. The individual showed an employee of Complainant the email communications and the contacts he received from an email address associated with the Domain Name, noting that he has spoken with someone who was purported to be in Complainant's human resources department, and that his communications with the purported human resources professional was through email or Zoom, but the purported human resources professional was always off camera.

Use of a domain name for fraudulent purposes, such as a fraudulent employment scam, is manifestly evidence of bad faith. See [WIPO Overview 3.0](#), section 3.4. In this case, Complainant has not provided any direct evidence of the alleged employment fraud, and while the Panel has no reason to doubt Complainant's allegations of fraud, the Panel need not make a determination on this matter as other evidence and circumstances are more than sufficient to support a finding of bad faith. In this regard, the Panel considers that Respondent's activities appear to be calculated to obtain an illegitimate benefit from Complainant's goodwill. This is inferred from both the email servers configured on the disputed domain name, and the invisible redirection from the disputed domain name to Complainant's website. As Complainant pointed out, this presents a risk that Respondents are engaged in a phishing scheme. The consequences of such a

scheme can be detrimental not only to the company whose goodwill has been taken advantage of, but to third party staff and customers who may entrust what appears to be Complainant with sensitive information.

Moreover, the Panel notes the distinctiveness and reputation of the DROGA5 trademarks, the failure of Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, the use of a privacy service, and the implausibility of any good faith use to which the Domain Name may be put, further support a finding of bad faith.

Accordingly, the Panel finds that Respondent has registered and is using the Domain Name in bad faith and Complainants succeed under the third element of paragraph 4(a) 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 Domain Name <droga5llc.com> be transferred to Complainant.

*/Nobles, Kimberley Chen/*

**Nobles, Kimberley Chen**

Sole Panelist

Date: January 18, 2023