

ADMINISTRATIVE PANEL DECISION

Xactware Solutions, Inc. v. Joseph Legg

Case No. D2023-0575

1. The Parties

Complainant is Xactware Solutions, Inc., United States of America (“United States”), represented by McCarter & English, LLP, United States.

Respondent is Joseph Legg, United States.

2. The Domain Name and Registrar

The disputed domain name <xactestimates.com> (the “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 February 8, 2023. On February 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 9, 2023, 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 February 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 8, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on March 9, 2023.

The Center appointed Robert A. Badgley as the sole panelist in this matter on March 17, 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 describes itself as “a leading provider of computer software solutions for professionals involved in estimating and managing all phases of building, restoration and repair”. One of Complainant’s products is XACTIMATE, which Complainant describes as “the insurance industry’s most powerful and comprehensive solution for property claims estimation”. According to Complainant, the XACTIMATE software is widely used by property insurance claim adjusters to estimate the costs of repairing damaged commercial or residential property.

Complainant holds several registrations in various jurisdictions worldwide for the mark XACTIMATE, including the registered trademark XACTIMATE registered with the United States Patent and Trademark Office, Reg. No. 1,816,735, registered on January 18, 1994 in connection with “computer programs for use in building construction cost estimating”.

Complainant operates a commercial website at the domain name <xactimate.com>.

According to a screenshot of a LinkedIn profile annexed to the Complaint, Respondent is a commercial roofer in Tennessee, United States. Complainant also alleges, and supports with documentary evidence, that Respondent was and is a licensee of Complainant who used the XACTIMATE system in connection with his own business. Under section 13.2 of the license agreement (an end user license agreement) between Complainant and Respondent, the latter had contractually agreed to refrain from using any designation, name, or trademark beginning with “Xact”.

The Domain Name was registered on October 12, 2022. The Domain Name resolves to a parking page set up by the Registrar which contains hyperlinks including “Roofing Construction Companies”, “Construction Contractors”, etc. The parking page also indicates that the Domain Name may be acquired. According to Complainant, Respondent derives pay-per-click revenue from this parking page.

Respondent does not dispute any of the foregoing allegations and evidence.

5. Parties’ Contentions

A. Complainant

Complainant contends that it has established all three elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (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 has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the trademark XACTIMATE through registration and use demonstrated in the record. The Panel also concludes that the Domain Name is confusingly similar to that mark. The Domain Name incorporates the entire fanciful XACTIMATE trademark and adds the letters “est” after the “c” and before the first “t”, and the letter “s” at the end of the XACTIMATE trademark. Despite these additional letters, the XACTIMATE mark remains recognizable within the Domain Name.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] 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 [Respondent] (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 [Respondent] 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.

The Panel concludes that Respondent lacks rights or legitimate interests in connection with the Domain Name. Respondent has not come forward in this proceeding to articulate or prove any *bona fide* basis for registering the Domain Name.

It is undisputed that Respondent was aware of the XACTIMATE mark when he registered the Domain Name, and that Complainant never authorized Respondent to use XACTIMATE in a domain name or otherwise. Indeed, Respondent had contractually agreed not to use or attempt to register any designation, name, or mark which is the same as or similar to any of the Complainant’s trademarks (which includes the XACTIMATE trademark) nor any designation, name, or trademark beginning with “Xact”.

The undisputed record also shows that Respondent has used the Domain Name for a website which contains pay-per-click hyperlinks, and which offers the Domain Name for sale. Such a use of the Domain Name, registered in contravention of Respondent’s contractual promise to Complainant, cannot give rise to a right or legitimate interest in connection with the Domain Name.

Complainant has established Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation”, are evidence of the registration and use of the Domain Name in “bad faith”:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or

- (ii) that Respondent has 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 Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that Respondent registered and used the Domain Name in bad faith under the Policy. The Panel incorporates its discussion above in the "Rights or Legitimate Interests" section.

Respondent clearly had Complainant's mark in mind when registering the Domain Name, since Respondent was one of Complainant's customers at the time he registered the Domain Name. Respondent's use of the Domain Name constitutes bad faith within the meaning of the above-quoted Policy paragraph 4(b)(iv).

Complainant has established Policy paragraph 4(a)(iii).

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 <xactestimates.com> be transferred to Complainant.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: March 31, 2023