

ADMINISTRATIVE PANEL DECISION

Sunrise Senior Living, LLC v. Orfilio Valdesuso, tech-accounting.com
Case No. D2023-3071

1. The Parties

The Complainant is Sunrise Senior Living, LLC, United States of America ("United States"), represented by Snell & Wilmer, LLP, United States.

The Respondent is Orfilio Valdesuso, tech-accounting.com, United States.

2. The Domain Name and Registrar

The disputed domain name <seniorcaresunrise.com> is registered with Tucows Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 18, 2023. On July 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 19, 2023, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 24, 2023 providing the registrant and contact information disclosed by the amended Complaint on July 24, 2023.

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").

The Respondent filed a Response on July 29, 2023, before the commencement of the proceedings. In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 27, 2023. The Center notified the Commencement of Panel Appointment Process on August 28, 2023.

The Center appointed Ingrida Kariņa-Bērziņa as the sole panelist in this matter on September 6, 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.

On September 6, 2023, the Complainant submitted a request to file a supplemental filing to provide a response to the Respondent's Response. On September 29, 2023, the Panel issued Procedural Order No. 1, which stated as follows:

In view of the arguments raised by the Respondent in the Response submitted, the Panel affords Complainant five (5) calendar days from the date of this Administrative Panel Order to comment on Respondent's assertions included in the Response and to submit such comments to the Center.

Respondent is afforded five (5) calendar days after receipt by the Center of Complainant's comments, to respond thereto. Further, Respondent is requested to submit information, supported by evidence, on its selection of the term "sunrise" for the name of its business, and for the disputed domain name.

On October 2, 2023, the Complainant submitted a request for an extension to reply to the Procedural Order. The Respondent submitted its objection to an extension of time on October 3, 2023. The Parties were subsequently notified that the Panel had granted the Parties extensions of time.

On October 13, 2023, the Complainant submitted its additional filing. The Respondent provided its response thereto on October 19, 2023.

4. Factual Background

The Complainant, an American company established in 1981, operates a chain of hundreds of senior care facilities in the United States under the SUNRISE and SUNRISE SENIOR LIVING marks, for which it has registered trademarks including the following:

- United States Trademark Registration No. 2313763 for SUNRISE (word mark), registered on February 1, 2000 for services in class 42, claiming a date of first use in 1981;
- United States Trademark Registration No. 2850729 for SUNRISE SENIOR LIVING (word mark), registered on June 8, 2004 for services in classes 35, 43, 44, and 45.

The Complainant has operated a website at the domain name <sunriseseniorliving.com> since 2000.

The record reflects that the Complainant sent a cease-and-desist letter to the Respondent on October 4, 2022 and an additional email on January 6, 2023. In its supplemental filing, the Respondent states that it was aware of these letters but did not reply due to the breakdown of negotiations between the Parties.

The disputed domain name was registered on October 27, 2021. The record reflects that, at the time of filing of the Complaint, it resolved to the Respondent's website operated by Sunrise Senior Care with the tagline "body.mind.social" and the headline "Total Senior Care Approach!!!!" The website contained pictograms, but minimal text, for the sections entitled "Adult Day Care," "Caregiver Support," and "Home Care". The website further had links for "social workers," "case management" and "health care providers." The copyright notice stated that it was held by "Sunrise Adult Daycare" and the website offers a street address, email address and telephone numbers on the "Contact" page under the heading "A Better Care Starts Now! Give us the chance to show you how we can help."

At the time of this Decision, the Panel verified that the Respondent's website contains substantially the same type of information, but appears to be more detailed.

The Respondent was incorporated in the State of Florida on October 22, 2021. It operates a single "Sunset Senior Care" facility located on Sunset Boulevard in Fort Lauderdale, Florida, United States. The Panel viewed Google Maps images that correspond to images provided by the Respondent, confirming that the Respondent's location is as stated in the case materials, and the images available indicate that the Respondent appears to actually offer the services stated, namely, "Adult Day Care" services for senior citizens.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that it is one of the largest providers of senior living services in the United States, and that it has continuously used and marketed the SUNRISE mark in connection with these services since at least 1981. The Respondent's domain name incorporates the entirety of the Complainant's SUNRISE mark and is virtually identical to its SUNRISE SENIOR LIVING mark. The Complainant's SUNRISE marks are "arbitrary" for senior living services and the Complainant has not authorized the Respondent to use these marks. The Respondent's website purports to offer senior care services, which cannot be *bone fide* use when the Respondent intentionally traded off the goodwill of the Complainant's registered mark. Upon receiving the Complainant's cease-and-desist letter, the Respondent agreed to stop using the SUNRISE mark yet refused to transfer the disputed domain name.

B. Respondent

The Respondent's Response may be summarized as follows: it operates an Adult Day Care licensed by the State of Florida that offers services that differ from those offered by the Complainant, namely, the Respondent's services are used by senior citizens on a non-resident basis. The Complainant, by contrast, offers residential services. Each entity is licensed for different types of services. The Respondent has a physical location with prominent placement of the business name.

The Complainant does not own a trademark for the term "senior care", nor does it own the domain name <sunriseseniorcare.com>. Persons seeking senior care would not associate "senior living" with "senior care," specifically "independent living" which is the primary business model offered by the Complainant. The disputed domain name was freely available for the price of USD 11.95. Considering the investment made by the Complainant in its brand, its failure to acquire the disputed domain name is likely due to the fact that it did not consider it a threat for confusion or misuse of the brand.

The Respondent selected the disputed domain name because it was similar to its business name but significantly less expensive than the alternative domain name <sunriseseniorcare.com>, which was also available for purchase. Contrary to the statements made by the Complainant, the Respondent did not agree to cease offering senior care services. The Respondent agreed to remove "home care business" from its website as it does not yet offer those services. Also, the Respondent offered to add a disclaimer to the website explaining that the entities are not related. The Parties are not direct competitors as they offer different services to different groups of senior citizens.

C. The Parties' Responses to the First Panel Order

The Complainant restates its arguments under the first element. Under the second element, the Respondent has failed to prove it has rights or legitimate interest in the disputed domain name, which infringes upon the Complainant's longstanding nationwide rights in its SUNRISE marks. The Respondent cannot prove rights or legitimate interests in the disputed domain name because of the Respondent's location on Sunrise Boulevard. The types of services offered by the Parties are similar and related, as both offer senior care services. Direct competition is not necessary to show bad faith. The Complainant's SUNRISE marks are well-known and it cannot be a coincidence that the Respondent selected this domain name. The Respondent's failure to respond to the Complainant's cease-and-desist letters demonstrates bad faith.

The Respondent states that the Complainant has failed to prove that it has exclusive rights to use the mark SUNRISE and SUNRISE SENIOR LIVING related to adult day care services. Numerous other providers of senior care services in the state of Florida incorporate the term “Sunrise” in their names. The two Parties are engaged in different businesses and target a different group of customers. The Respondent is operating a legitimate licensed adult day care business. Its failure to respond to the Complainant's letter is not evidence of bad faith but in response to the fact that the Complainant was not engaging in a negotiation. The Respondent selected the name “Sunrise Senior Care” due to its location on Sunrise Boulevard, which is a prominent street in Broward County. This is a common name for businesses in the area. When selecting the disputed domain name, the Respondent verified that there were no registered trademarks for the type of activity or service offered by the Respondent. The Respondent was not aware of the Complainant as they are not within the same business type within senior care.

6. Discussion and Findings

Paragraph 4(a) of the UDRP requires Complainant to make out all three of the following:

- (i) the disputed 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 disputed domain name; and
- (iii) Respondent has registered and is using the disputed domain name in bad faith.

Under paragraph 15(a) of the Rules, “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the Complainant's SUNRISE mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms (here, “senior care”) may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests / Registered and Used in Bad Faith

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name, by demonstrating any of the following:

(i) before any notice to it of the dispute, the respondent's 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) that the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent is 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.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

In this case, it is not disputed that the Complainant holds registered trademark rights in the SUNRISE and SUNRISE SENIOR LIVING marks, and that such rights predate by 20 years the registration of the disputed domain name.

However, there is also no dispute that the Respondent has registered and is operating a business called "Sunrise Senior Care" for which the disputed domain name has been registered and is being used. As such, the Panel finds that the evidence supports a finding that, prior to notice of the dispute, the Respondent's 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. See [WIPO Overview 3.0](#), section 2.2.

The Respondent's company, Sunrise Senior Care LLC, was registered in October 2021, a few days before the registration of the disputed domain name. The evidence available indicates that the Respondent operates a business and that the disputed domain name resolves to a website connected to that business. The Panel finds that, on balance, for purposes of the Policy, Respondent has provided a *prima facie* plausible explanation for the choice of its business name due to its location on Sunrise Boulevard. Further, the Panel finds that the Respondent has provided a *prima facie* plausible explanation for its choice to register the disputed domain name <seniorcaresunrise.com>, which is not identical to its business name, rather than <sunriseseniorcare.com>, which is—namely, a lower price.

The record indicates that the Complainant is a sophisticated national business and the Respondent is a single-facility business serving a local clientele. While the similarity of the disputed domain name to the Complainant's trademarks is evident, the case before the Panel seems to present more complicated elements of trademark law than the Policy is suited to address – it may very well be that the Respondent was aware of the Complaint and its considerable reputation; it may be the case that the Respondent sought to unfairly play off that renown (and used a street name to "hide" this fact); at the same time it is hard to overlook the fact that the Respondent's business name corresponds to the street name of its location; the Panel also notes the corrective actions of the Respondent.

The Complainant relies on the argument that the Respondent is infringing its SUNRISE and SUNRISE SENIOR LIVING marks in the name of its business, and the use of the disputed domain name therefore cannot constitute a *bona fide* offering of goods or services. Again, a determination of the potential existence of trademark infringement – which is fundamentally what this claim invokes – falls outside the scope of the Policy.

Based on the available record, the Panel finds the second element of the Policy has not been established.

Based on the finding under the second element, the Panel need not come to a determination that the Complainant has established the third element under paragraph 4(a) of the Policy.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Ingrīda Kariņa-Bērziņa/

Ingrīda Kariņa-Bērziņa

Sole Panelist

Date: November 3, 2023