

ADMINISTRATIVE PANEL DECISION

All-Tag Corporation v. Miguel Ribeiro
Case No. D2024-1097

1. The Parties

The Complainant is All-Tag Corporation, United States of America (“United States”), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States.

The Respondent is Miguel Ribeiro, Portugal. ¹

2. The Domain Name and Registrar

The disputed domain name <all-tags.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 13, 2024. On March 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 14, 2024, 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 (GDPR Masked / GDPR Masked) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 14, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on March 15, 2024.

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”).

¹The Panel notes that an email communication was received from a legal representative associated with the Respondent’s reply to the Complainant’s cease-and-desist letters prior to the filing of the Complaint in this proceeding. The email communication indicated that the Respondent would represent himself and as such, the Panel will not treat such email communication as indicating external legal representation for the Respondent.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 20, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 9, 2024. On March 20 and April 5, 2024, the Center received two email communications from the email address associated with the Technical and Billing Contacts for the disputed domain name as disclosed by the Registrar. Also on March 20, 2024, the Center received an email communication from a third party using the same “[...]@sensorpoint.pt” email provider as the Respondent. On April 4, 2024, the Center received the email communication as described in Footnote 1 above.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on April 18, 2024. 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 is a manufacturer and supplier of electronic article surveillance (“EAS”) products and services designed to help retailers protect their merchandise from shoplifting under the ALL-TAG trademark, which has been used by the Complainant and its predecessors in commerce since at least 1992.

In addition to the domain name <all-tag.com>, created on March 12, 2001, where the Complainant’s official website is available, the Complainant is the owner of the following trademark registrations:

- United States Trademark Registration No. 3,647,345 for the ALL-TAG mark, in class 9, filed on December 12, 2008, registered on June 30, 2009, subsequently renewed; and
- European Union Trademark Registration No. 018115254 for ALL-TAG, in class 9, filed on August 27, 2019, registered on May 22, 2020.

The Complainant’s counsel sent warning letters to the Respondent on September 4, 2019, October 15, 2019, November 5, 2020, August 22, 2023, and October 25, 2023. (Annex 8 to the Complaint).

On November 6, 2023, the Respondent’s counsel at that time replied to the Complainant’s counsel stating that “Responding to your letter addressed to my Client Miguel Ribeiro, I must inform that it is considered that there is no noncompliance or infringement of the brand mentioned by you. My client purchased the domain in question, as it was for sale and this was done on January 5, 2018. Your European registration, based on the information you sent us, is dated later, so my Client understands that he does not have to refrain from any conduct with regard to the domain he uses in a legitimate and legal way”.

In reply to said message, the Complainant’s counsel replied on November 20, 2023, reiterating the prior requests, to which the Respondent’s counsel lastly replied on November 28, 2023, stating that “In response to the letter received, by email, my client informs that has nothing more to say about the subject, other than what has already been conveyed.”

The disputed domain name was registered on January 14, 2016, and presently resolves to an online webpage selling EAS products targeting the Portuguese market.

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 the Respondent is using the disputed domain name in connection with a website that falsely appears to be a website for, or associated with, the Complainant, using the ALL-TAG trademark in connection with the same goods and services associated with the Complainant's trademark. In addition to that the Complainant asserts that the Respondent has served since 2011 as managing partner at Sensorpoint in Portugal, having worked from 1994 to 2010 as sales manager at Sensormatic, both companies working in the same industry as the Complainant and being well known to each other. In this regard, the Complainant notes that it was involved in various business relationships with Sensormatic during the Respondent's employment there until 2010 and that once Respondent joined Sensorpoint in 2011, said company was involved in a lawsuit involving both Complainant and Sensormatic from 2001 until 2019.

According to the Complainant, the disputed domain name contains the ALL-TAG trademark in its entirety, simply adding the letter "s" at the end to make it plural, thus being confusingly similar therewith and, as past UDRP panels have already found that the difference of a single letter does nothing to alleviate confusing similarity.

Furthermore, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name given that:

- (i) the Complainant has never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use the ALL-TAG trademark in any manner;
- (ii) by using the disputed domain name that is confusingly similar to the ALL-TAG trademark in connection with a website that falsely purports to be the Complainant or associated with it, the Respondent has failed to create a bona fide offering of goods or services under the Policy; and
- (iii) the Respondent has never been commonly known by the disputed domain name and has never acquired any trademark or service mark rights in the disputed domain name.

Furthermore, the Complainant points out that given that the Respondent worked in the same industry he was well-aware of the Complainant when registering the disputed domain name and using it in connection with a website that falsely purports to be a website for, or otherwise associated with, the Complainant, constituting bad faith pursuant to paragraph 4(b)(iv) of the Policy.

B. Respondent

The Respondent did not reply to the Complainant's contentions. On March 20, 2024, an email communication was received from a third party using an email address similar to that of the Respondent, namely being provided by their apparent employer, Sensorpoint. In this email, the third party stated that "We have received your email, but we cannot understand the terms and contents of the attachments, since it is a very technical language. Please send the documents in Portuguese so that we can respond properly".

On April 4, 2024, an email communication was received by the Respondent's former counsel at the time of the Complainant's transmission of its various above-referenced cease-and-desist letters, reiterating the request for any legal documents to be translated into Portuguese so that the Respondent can "defend himself properly".

For completeness, the Panel will also make note of the emails received from the email address disclosed by the Registrar for the Administrative and Technical Contacts for the disputed domain name. In essence, such emails clarified that, "[we do] not own the domain name in question. The domain is registered by one of our customers, and as such, we do not have any legal responsibility or direct involvement in the management or use of this domain name" and, "we have forwarded your notification to the contact information we have on file for the domain registrant".

6. Discussion and Findings

6.1. Procedural Matter – Language of the proceedings

Emails were received from two persons seemingly connected to the Respondent wherein they have asked that the Complaint be translated into Portuguese.

WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 4.5.1 states that:

“Pursuant to paragraph 11 of the UDRP Rules, unless otherwise agreed by the parties, the default language of the proceeding is the language of the registration agreement, subject to the authority of the panel to determine otherwise.”

Noting the aim of conducting the proceedings with due expedition, paragraph 10 of the UDRP Rules vests a panel with authority to conduct the proceedings in a manner it considers appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case.

Against this background, panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. Such scenarios include (i) evidence showing that the respondent can understand the language of the complaint, (ii) the language/script of the domain name particularly where the same as that of the complainant’s mark, (iii) any content on the webpage under the disputed domain name, (iv) prior cases involving the respondent in a particular language, (v) prior correspondence between the parties, (vi) potential unfairness or unwarranted delay in ordering the complainant to translate the complaint, (vii) evidence of other respondent-controlled domain names registered, used, or corresponding to a particular language, (viii) in cases involving multiple domain names, the use of a particular language agreement for some (but not all) of the disputed domain names, (ix) currencies accepted on the webpage under the disputed domain name, or (x) other indicia tending to show that it would not be unfair to proceed in a language other than that of the registration agreement. The credibility of any submissions by the parties and in particular those of the respondent (or lack of reaction after having been given a fair chance to comment) are particularly relevant.”

In the present case the language of the registration agreement is English, a commonly spoken language and one that both persons emailing the Center have shown capability of understanding and using in their communications with the Center. In addition to that, the disputed domain name is composed of two words from the English language which also indicates that the Respondent himself is also familiar with the language used in both the registration agreement and the Complaint.

The Panel thus finds that ordering the translation of the Complaint and its annexes into Portuguese would unnecessarily cause delays and costs. Lastly, given the vast array of electronically translations tools that are freely available on the Internet indicate that the Respondent or his counsel could have been in a position to use such tools to fully understand the case and submit a defence.

6.2. Substantive Matter

Paragraph 4(a) of the Policy sets forth the following three requirements which have to be met for this Panel to order the transfer of the disputed domain name to the Complainant:

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

The Complainant must prove in this administrative proceeding that each of the aforesaid three elements is present in order to obtain the transfer of the disputed domain name.

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 3.0](#), section 1.7.

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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. Although the addition of a letter "s" may bear on assessment of the second and third elements, the Panel finds the addition of such term 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.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that indicate a respondent's rights to or legitimate interests in a disputed domain name. These circumstances are:

- (i) before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name, in spite of not having acquired trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent, in not formally responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights to or legitimate interests in the disputed domain name. This entitles the Panel to draw any such inferences from such default as it considers appropriate pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden of proof is still on the Complainant to make a prima facie case against the Respondent.

In that sense, and according to the evidence submitted, the Complainant has made a prima facie case against the Respondent that the Respondent has not been commonly known by the disputed domain name, and neither has the Complainant ever assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use the ALL-TAG trademark in any manner. Based on the available record, by the time of the registration of the disputed domain name in 2016, the Respondent was no longer employed at Sensormatic with which the Complainant had entered into various business relationships regarding the resale of its products. Moreover, there is no evidence to suggest that Respondent was allowed to register the disputed domain name in 2016 following its departure from Sensormatic in 2010.

The composition of the disputed domain name, namely a typographical variation of the Complainant's Trademark which the Respondent, for working in the same industry was evidently aware and which reflects the Respondent's illicit intent to mislead unsuspecting Internet users expecting to find the Complainant and unaware of the misspelled disputed domain name, which cannot confer upon the Respondent rights or legitimate interests.

Another element to consider is the use of the disputed domain name in connection with an active website selling the similar products as those of the Complainant, without any disclaimer as to its lack of relationship with the Complainant, which makes it even more difficult to conceive which rights or legitimate interests the Respondent would have in a domain name that is clearly confusingly similar to the Complainant's trademark.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

C. Registered and Used in Bad Faith

The Policy indicates in paragraph 4(b)(iv) that bad faith registration and use can be found in respect of a domain name, where, by using the domain name, a respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

In this case, both the registration and use of the disputed domain name in bad faith can be found in view of the competing use of the disputed domain name in connection with a webpage that purportedly offers the same products as those of the Complainant.

The Respondent's registration and use of the typosquatting disputed domain name not only clearly indicates full knowledge of the Complainant's trademark but also an attempt of misleadingly diverting consumers for his own commercial gain. Moreover, given the Respondent's employment history for a direct competitor of the Complainant at the time of registering the disputed domain name, such registration and use falls squarely within the meaning of bad faith in Policy paragraph 4(b)(iii), "you have registered the domain name primarily for the purpose of disrupting the business of a competitor".

For the reasons above, the Respondent's conduct has to be considered, in this Panel's view, as bad faith registration and use of the disputed domain name.

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 <all-tags.com> be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: May 1, 2024