

ADMINISTRATIVE PANEL DECISION

Xtermite, Inc., XT 2000, Inc. v. vincent chargualaf, XTTERMITE CONTROL
Case No. D2024-3383

1. The Parties

Complainants are Xtermite, Inc., United States of America (“United States” or “U.S.”), and XT 2000, Inc., United States (Complainants may be referred to collectively as the “Complainant” or the “Complainants” as needed), represented by ARC IP Law, P.C, United States.

Respondent is vincent chargualaf, XTTERMITE CONTROL, United States, represented by Clear Sky Law Group, P.C., United States.

2. The Domain Names and Registrar

The disputed domain names <xtermitecontrol.com> and <xtermite.net> (the “Domain Names”) are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 17, 2024. On August 19, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On August 19, 2024, 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 notified the deficiency in the Complaint on August 21, 2024. Complainant filed an amendment to the Complaint on August 21, 2024. Respondent sent several emails to the Center on August 22 and 30, 2024.

The Center verified that the Complaint together with the amendment to 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 August 22, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 11, 2024. On September 3, 2024, Respondent sent an email to the Center requesting an extension to the Response due date. On September 6, 2024, the Center confirmed that the due date for Response was extended to September 15, 2024, in accordance with paragraph 5(b) of

the Rules. On September 12, 2024, Complainant requested suspension of the proceeding. The Center confirmed on September 13, 2024, that the proceeding was suspended until October 13, 2024, for purposes of settlement discussions. On October 11, 2024, Complainant requested an extension to the suspension period. On October 15, 2024, the Center confirmed that the proceeding was further suspended until November 13, 2024. On November 13, 2024, Complainant requested an extension to the suspension period. On November 14, 2024, the Center confirmed that the proceeding was further suspended until December 13, 2024. On December 13, 2024, Complainant requested reinstitution of the proceeding. The Response was filed with the Center on December 13, 2024.

The Center appointed Christopher S. Gibson as the sole panelist in this matter on December 20, 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.

On December 13, 2024, Complainant notified the Center that it had filed a case concerning the Domain Names against Respondent in the United States District Court for the Southern District of California. Even so, Complainant requests that the Panel render a decision in this case before further steps take place in the litigation. Rule 18(a) provides that “[i]n the event of any legal proceedings initiated prior to or during an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, the Panel shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or to proceed to a decision.” Respondent has not provided a submission on this point. The Panel decides to proceed to a decision in this case.

4. Factual Background

Complainant is a pest control company and owner of the trademarks XTERMITE and XT-2000:

- XTERMITE, U.S. Regis. No. 7,302,834, in connection with various pest control services in International Classes 37 and 42, registered on February 13, 2024, with a date of first use in commerce of November 4, 1998.

- XT-2000, U.S. Regis. No. 7,015,397, in connection with pesticides in International Class 5, registered on April 4, 2023, with a date of first use in commerce of November 24, 2003.

Respondent Chargaualaf was an employee of Complainant Xtermite, Inc. for a period of approximately one month in May 2023. On July 8, 2024, Complainants became aware of Respondent’s business, XT Termite Control. Complainants’ employee visited a pesticide vendor for a routine transaction, but the vendor mistakenly presented Complainants’ employee with paperwork related to a pesticide order placed by Respondent XT Termite Control, apparently because the vendor had confused Complainants’ XTERMITE mark with Respondent’s name.

On further investigation by Complainants, it was discovered that Respondent Chargaualaf had begun operating a pest control business under the name “XT Termite Control,” with a fictitious business name (“FBN”) registration in San Diego County, California, and a California Structural Pest Control Board registration. Complainants further discovered via online advertising related to Respondent XT Termite Control that an unknown registrant had registered the Domain Name <xttermite.net> on May 13, 2024, and was using it for a website to advertise services under the name XT Termite. Based on this information, Complainants concluded the Domain Name <xttermite.net> was registered by Respondent Chargaualaf. On July 17, 2024, Complainants sent a cease-and-desist letter to Respondent Chargaualaf, alleging he was the registrant of the Domain Name <xttermite.net> and demanding that he arrange for its immediate transfer to Complainants. The cease-and-desist letter set a deadline of July 24, 2024.

On July 25, 2024, Complainants’ counsel noted a lack of response from Respondent Chargaualaf and proceeded to conduct further due diligence. On visiting the Domain Name <xttermite.net>, Complainants’

counsel discovered that the previous site had been replaced with a “404 Error Page,” which has continued through the filing date of the Complaint. Complainants believe Respondent Chargaualaf is still using this Domain Name to host the “@xttermite.net” email server. On July 25, 2024, Complainants’ counsel also discovered the Domain Name <xttermitecontrol.com> had been registered on July 24, 2024, the same date as the deadline for the cease-and-desist letter, and that it was linked to another website advertising Respondent XT Termite Control, including the same contact information associated with Respondent Chargaualaf.

The Domain Name <xttermite.net> was registered on May 13, 2024, and the Domain Name <xttermitecontrol.com> was registered on July 24, 2024. Respondent states the Domain Names are owned by XT Termite Control, a California corporation, which Chargaualaf owns. The Domain Names resolved to websites that have been used by XT Termite Control.

5. Parties’ Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Names.

(i) Identical or confusingly similar

As discussed above, Complainants have provided evidence of ownership of the trademarks XTERMITE and XT-2000.

Complainants state both Domain Names, <xttermite.net> and <xttermitecontrol.com>, include the term “xttermite,” which has a strikingly similar appearance to both the XTERMITE and XT-2000 marks, as it contains the “XT” portion of the XT-2000 mark and the entirety of the characters within the XTERMITE mark. Complainants claim these similarities between the Domain Names and Complainants’ marks are exacerbated in view of Respondent’s use of the Domain Names in connection with pest control services, which overlaps with Complainants’ goods and services, namely pest control and pesticide.

(ii) Rights or legitimate interests

Complainants assert Respondent Chargaualaf is a former employee of Complainant Xtermite. Following his employment, Respondent Chargaualaf registered the name “XT Termite Control,” both as an FBN with San Diego County and as a pest control service provider with the California Structural Pest Control Board. Respondent Chargaualaf has never had any ownership interest in Complainants’ marks or otherwise been permitted to use them and is not otherwise permitted to use them under the law. Furthermore, Respondent Chargaualaf is no longer associated with Complainants.

(iii) Registered and used in bad faith

Complainants contend that the registration and use of the Domain Names is an overt effort by Respondent Chargaualaf, whether under his own name or under the name XT Termite, to profit from Complainants’ XTERMITE and XT 2000 marks by creating a likelihood of confusion. Complainants allege that Respondent registered the Domain Names with the intention of deceiving Complainants’ customers, vendors, and the public. Respondent Chargaualaf combined components of the XTERMITE and XT-2000 marks to create the term, “XT Termite”, which is incorporated into both Domain Names. Respondent Chargaualaf crafted the term XT Termite with the intention to cause confusion with Complainants’ marks, as evidenced by Respondent Chargaualaf prior experiences with Complainants and the clear resemblance between the phrase XT Termite and Complainants’ XTERMITE and XT-2000 marks. Complainants argue the similarity between the phrase “XT Termite” and the XTERMITE and XT-2000 marks, when used in connection with overlapping goods and services related to pesticide and pest control, demonstrates a deliberate and willful

attempt by Respondent Chargaualaf to attract, for commercial gain, Internet users to websites and an email server owned by Respondent Chargaualaf, by confusing customers, vendors, and the public as to the source, sponsorship, affiliation, or endorsement of goods and services offered by Respondent.

Complainants are aware of at least one instance of actual confusion. Complainants further believe that an untold number of their potential customers have been misled by Respondent Chargaualaf's registration and use of the Domain Names. Respondent Chargaualaf is currently using the Domain Name <xtermite.net> to host the "@xtermite.net" email server, which he can use to confuse customers, vendors, and the public into believing that an incoming email is originating from Complainant Xtermite, Inc. or that an outgoing email will be received by Complainant Xtermite, Inc.

Respondent Chargaualaf initially registered the Domain Name <xtermite.net> for the website of his pest control company. Only after Complainants sent a cease-and-desist letter on July 17, 2024, did Respondent Chargaualaf cease using that Domain Name and register the Domain Name <xtermitecontrol.com> on July 24, 2024. Complainants contend it is clear to any reasonable person that, by taking down his previous site and establishing a new one linked to the Domain Name <xtermitecontrol.com>, Respondent Chargaualaf was attempting to conceal his continued infringement upon the XTERMITE and XT-2000 marks by making it appear that he was no longer using the Domain Name <xtermite.net>.

B. Respondent

Respondent contends that Complainant has not satisfied all three of the elements required under the Policy for a transfer of the Domain Names.

(i) Identical or confusingly similar

Respondent contends the Domain Names are not identical or confusing with Complainants' trademarks, emphasizing the name of Respondent's company is XT Termite Control, not Xtermite, and that the "XT" is separate from terms "Termite Control."

(ii) Rights or legitimate interests

Respondent states its corporation briefly used the Domain Names in good faith for pest control services.

(iii) Registered and used in bad faith

Respondent contends the Domain Names were not registered in an intentional attempt 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.

6. Discussion and Findings

To succeed on its Complaint, Complainant must demonstrate that the three elements set forth in paragraph 4(a) of the Policy have been satisfied. These elements are that:

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

A. Identical or Confusingly Similar

The Panel finds that Complainants have demonstrated rights in their XTERMITE and XT-2000 marks through registration and longstanding use in commerce dating from the late 1990s and early 2000s, respectively. The Panel further finds that the Domain Names <xttermite.net> and <xttermitecontrol.com> incorporate the XTERMITE mark in its entirety while adding an additional “t” in both cases, and the term “control” in the Domain Name <xttermitecontrol.com>. Both Domain Names also incorporate the “XT” from the XT-2000 mark. This combination in the Domain Names creates a confusing similarity with Complainant’s XTERMITE and XT-2000 marks (affirmed by the fact that Complainants and Respondents operate in the same industry and geographic area). Numerous UDRP decisions have found that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”); see also section 1.7 of the [WIPO Overview 3.0](#), which states, “where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.”

Accordingly, the Panel finds that the Domain Names are confusingly similar to trademarks in which Complainants have rights and the first element of the Policy has been established.

B. Rights or Legitimate Interests

Although the overall burden of proof in UDRP proceedings is on a complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult 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 (although the burden of proof always remains on the complainant). 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.

Having reviewed the available record, the Panel finds Complainants have established a prima facie case that Respondent lacks rights or legitimate interests in the Domain Names. Complainants did not authorize Respondent to use Complainant’s marks in the Domain Names or to hold themselves out as associated with Complainants or to offer any goods or services on behalf of Complainants. Respondent owns no registered or unregistered trademarks related to the Domain Names. In the circumstances of this case – where Respondent Chargaulaf was a former employee of Complainant Xtermite, Inc. and targeted Complainants and their marks when registering the Domain Names – the fact that Respondent registered “XT Termite Control” as a FBN in San Diego County, California, and with the California Structural Pest Control Board registration, gives rise to no rights or legitimate interests in the Domain Names.

Respondent has not rebutted the factual contentions asserted by Complainants that Respondent Chargaulaf was a former employee of Complainant Xtermite Inc. Respondent did not formally respond to any of Complainant’s allegations concerning targeting of Complainants and their marks, other than to claim the Domain Names were registered in good faith. Moreover, there is no evidence of Respondent making a legitimate noncommercial or fair use of the Domain Names. Therefore, the Panel finds that Respondent has not rebutted Complainants’ prima facie case that Respondent lacks rights or legitimate interests in the Domain Names. Accordingly, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires that Complainants demonstrate that Respondent registered and is using the Domain Name in bad faith. [WIPO Overview 3.0](#), section 3.1, states, “bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark.”

Here, the Panel determines that the Domain Names were registered and have been used in bad faith. Although Respondent claims they registered the Domain Names in good faith and they were not registered in an intentional attempt to attract for commercial gain, Internet users to Respondent's website, the Panel rejects this contention. The evidence shows that Respondent Chargaualaf was aware of Complainants and their trademarks and targeted those marks when registering the Domain Names. The second Domain Name was registered on the deadline date set by Complainants' cease-and-desist letter, in an apparent attempt to avoid compliance with that letter's demands. Respondent has not tried to provide any independent justification for they chose to register the Domain Names <xttermite.net> and <xttermitecontrol.com>, which are confusingly similar to Complainants' XTERMITE and XT-2000 marks.

Thus, given not only the distinctiveness of Complainant's XTERMITE and XT-2000 marks, but also the timing of the registration of the Domain Names after Complainant had establish rights in its marks, and after Respondent Chargaualaf has been employed by Complainant Xtermite, Inc., and for the Domain Name <xttermitecontrol.com>, after Respondent had received Complainants' cease-and-desist letter, the Panel considers that the only logical conclusion is that Respondent targeted Complainants and their marks when registering the Domain Names. This point is further confirmed by Respondent's use of the Domain Names to provide competing services in the same geographic area, as discussed above. The Panel determines that Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's sites by creating a likelihood of confusion with Complainants' marks.

In conclusion, the Panel determines that, for all the above reasons, the Domain Names were registered and have been used in bad faith. Accordingly, Complainants have satisfied the third element 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 Names <xttermitecontrol.com> and <xttermite.net> be transferred to Complainant Xtermite, Inc.

/Christopher S. Gibson/

Christopher S. Gibson

Sole Panelist

Date: January 21, 2025