

ADMINISTRATIVE PANEL DECISION

SLMP, LLC v. Cris Digamo, Diving World Travel
Case No. D2024-4719

1. The Parties

Complainant is SLMP, LLC, United States of America (“U.S.”), represented by Fredrikson & Byron, P.A., U.S.

Respondent is Cris Digamo, Diving World Travel, U.S.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 14, 2024. On November 15, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On November 15, 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 verified that the Complaint [together with the amendment to the Complaint/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 20, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 10, 2024. The Response was filed with the Center on December 3, 2024.

The Center appointed Christopher S. Gibson as the sole panelist in this matter on December 17, 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

Complainant is a company offering medical diagnostic equipment and supplies. It has used STATLAB formative marks since at least as early as 1976 in connection with its laboratory products and services in the U.S. and worldwide and currently uses the STATLAB mark on its website at “www.statlab.com”. Complainant is the owner of three U.S. registrations and two pending applications for marks containing the STATLAB and STAT LAB terms:

- U.S. Reg. No. 2,381,105, registered August 29, 2000, and with a date of first use in 1977, for the mark STATLAB MEDICAL PRODUCTS for “retail outlets, mail order catalog services; and computerized on-line ordering, all in the fields of cytology, histology and laboratory products” (incontestable).
- U.S. Reg. No. 1,612,609, registered September 11, 1990, and with a date of first use in 1977, for the mark STAT LAB MEDICAL PRODUCTS for a “full line of medical diagnostic chemicals and reagents for use in cytology and histology” and a “full line of medical diagnostic devices for use in cytology and histology” (incontestable).
- U.S. Reg. No. 5,909,086, registered November 12, 2019, and with a date of first use in 2018, for the mark STATLAB QUANTUM HDX for “medical diagnostic device system and analytical apparatus, namely, a medical apparatus staining system comprised of a slide chamber and motorized holder for performing automated histology, in situ hybridization, fluorescent and chromogenic in situ hybridization and immunohistochemistry for use in medical diagnostic laboratories”.
- U.S. App. No. 98654656, filed on July 18, 2024, for the mark STATLAB for “retail outlets, mail order catalog services; and computerized on-line ordering, all in the fields of cytology, histology and laboratory products; full line of medical diagnostic devices and equipment for use in cytology and histology; full line of medical diagnostic chemicals and reagents for use in cytology and histology”.
- U.S. App. No. 98784237, filed on October 3, 2024, for the mark STATLAB (stylized with design) for “retail outlets, mail order catalog services; and computerized on-line ordering, all in the fields of cytology, histology and laboratory products; full line of medical diagnostic devices and equipment for use in cytology and histology; full line of medical diagnostic chemicals and reagents for use in cytology and histology”.

The Domain Name was registered on April 4, 2015. It resolves to a website that purports to offer mobile laboratory services. However, Respondent’s site also lists Complainant’s email address for Respondent’s contact details (“info@statlab.com”); the site’s link for “explore our services” inexplicably resolves to a page about dentistry; other links on the site do not work; and the site’s terms and conditions generally refer to “Walk-in Lab”, not “Statlab”, and are nearly identical to the terms and conditions of a website at “www.walkinlab.com”.

5. Parties’ Contentions

A. Complainant

(i) Identical or confusingly similar

Complainant trademark rights in this case are based on its federal registrations and applications for marks (with the dominant STATLAB or STAT LAB portion) as well as its longstanding use of its marks in commerce. Further, Complainant contends that Respondent’s website at “www.statlabtest.com” establishes Complainant’s rights in its STATLAB marks because Respondent’s site falsely sets forth Complainant’s contact information, “info@statlab.com”, as Respondent’s contact information. Complainant contends the fact that Respondent is targeting Complainant’s mark shows the mark has achieved significance as a source identifier.

Complainant also contends the Domain Name is confusingly similar to its STATLAB marks. The dominant portion of Complainant's STATLAB marks is the term STATLAB. Here, the Domain Name incorporates the dominant portion in its entirety and adds the descriptive term "test". The difference between the Domain Name's use of the term "test" in place of Complainant's use of the terms "medical products" in Complainant's marks is insufficient to avoid confusing similarity. The merely descriptive term in the Domain Name suggests medical testing and therefore conveys the same meaning as Complainant's STATLAB marks. This is made even more apparent by Respondent's use of the Domain Name for a website promoting medical testing services. Based on the foregoing, Complainant submits that the Domain Name is confusingly similar to Complainant's STATLAB marks and therefore Complainant satisfies the first element of the Policy.

(ii) Rights or legitimate interests

Complainant contends Respondent has no rights or legitimate interests in the Domain Name. Complainant did not authorize Respondent to use the Domain Name or to hold itself out as associated with Complainant or to offer any goods or services on behalf of Complainant. There is no relationship between Complainant and Respondent. Respondent has not been commonly known by the Domain Name and owns no registered or unregistered trademarks related to the Domain Name. Based on the Whois information associated with the Domain Name, Respondent is known as Cris Digamo of Diving World Travel. Neither name establishes any rights associated with the term STATLAB.

Moreover, Complainant claims there is no evidence of Respondent's use of, or demonstrable preparations to use, the Domain Name or a name corresponding to it in connection with a bona fide offering of goods or services. While the Domain Name resolves to a website, Complainant contends it is not associated with a bona fide offering of goods or services. The site's contact information refers to "info@statlab.com", which is Complainant's email address for inquiries to Complainant's site. Moreover, while purporting to provide "mobile laboratory services", the link to "explore our services" inexplicably resolves to a page entirely about dentistry. Other links on the site simply do not work. Further, Respondent site's terms and conditions in all but one instance refer to "Walk-in Lab", not "Statlab" and are nearly identical to the terms and conditions of "www.walkinlab.com". In addition, based on Complainant's investigation, Respondent's address listed on its website is the address of a UPS store. In sum, the information on Respondent's site is confusing and nonsensical, and therefore does not evidence any use or preparations to use the Domain Name in connection with any bona fide offering of goods or services. Finally, Complainant contends Respondent is not making a legitimate noncommercial or fair use of the Domain Name.

Complainant argues Respondent's use of the Domain Name is an illegitimate use that seeks commercial gain by misleadingly diverting consumers and tarnishing Complainant's STATLAB marks by using Complainant's identical STATLAB mark not only in the Domain Name, but also prominently on Respondent's confusing and nonsensical website. Based on the foregoing, Complainant submits that Respondent has no rights or legitimate interests in the Domain Name and Complainant satisfies the second element of the Policy.

(iii) Registered and used in bad faith

Complainant contends that Respondent registered and is using the Domain Name in bad faith. Respondent registered the Domain Name well after Complainant established rights in the STATLAB marks. Complainant has been using its STATLAB marks since at least 1976 and registered the marks STAT LAB MEDICAL PRODUCTS and STATLAB MEDICAL PRODUCTS in September 1990 and August 2000, respectively, with both marks being considered incontestable long before Respondent registered the Domain Name in April 2015. Complainant claims Respondent was on notice of Complainant's rights for years prior to registering and using the Domain Name.

Complainant further claims Respondent registered the Domain Name to intentionally attract, for commercial gain, Internet users to Respondent's site by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's site. Complainant's use of the term STATLAB in all its marks has created a family of STATLAB marks all distinguished by the dominant,

distinctive term STATLAB. Moreover, Complainant's branding of its family of STATLAB marks has been unified across its website, product packaging, and marketing while adding over 750 new products over seven years. Complainant states its family of STATLAB marks is widely known. Complainant urges it is appropriate for the Panel to give weight to Complainant's family of marks based on the dominant, distinctive term STATLAB.

Here, Respondent's registration of the Domain Name merely adds the term "test" to Complainant's STATLAB mark, which should create a presumption of bad faith. The Domain Name creates a likelihood of confusion with Complainant's family of STATLAB marks. The minor differences between the additional, terms "test" in the Domain Name and "medical products" in Complainant's marks are insufficient to avoid confusion caused by the otherwise identical, dominant, and distinctive STATLAB portion, particularly when both the Domain Name and Complainant's marks are associated with the same medical testing category of products and services and would be encountered by the same consumers and end users. Complainant indicates that Respondent brands its website at "www.statlabtest.com" with Complainant's STATLAB mark, and the content of Respondent's site is related to medical testing, which is the identical field of Complainant's products. In addition, Respondent seeks to create a likelihood of confusion by using Complainant's contact email "info@statlab.com".

Complainant argues the absence of Respondent's rights or legitimate interests in the Domain Name also indicates bad faith. Of all the domain names Respondent could have chosen to register and use, Respondent chose one in which it has no rights even when Respondent was on at least constructive notice of Complainant's registered rights in the STATLAB marks and had actual knowledge of Complainant's rights in the marks as shown by Respondent's use of email address "info@statlab.com" as Respondent's contact information on its site. A single Internet search would have revealed Complainant's confusingly similar STATLAB marks to Respondent. Even if Respondent chose not to search, proceeding with willful blindness like this indicates bad faith. Given Complainant's rights as to which Respondent was on notice, the absence of Respondent's rights, and Respondent's choice to proceed with a confusingly similar Domain Name, there is a complete absence of any conceivable good faith use, which indicates Respondent sought to create a likelihood of confusion for commercial gain. The confusing and nonsensical content of Respondent's website further exacerbates likely confusion, tarnishes Complainant's STATLAB marks, and creates a negative impression of Complainant to confused users who are likely to access it, showing further evidence of Respondent's bad faith. Based on the foregoing, Complainant submits Respondent registered and used the Domain Name in bad faith under Policy, paragraphs 4(a)(iii) and 4(b).

B. Respondent

Respondent submitted a very brief Response with several points in defense of ownership of the Domain Name. Respondent claims that as owner and operation chief of Stat Lab LLC, a limited liability corporation active since 2015, Respondent has legitimate rights and interests in the Domain Name "for clinical laboratories real sick and disabled patients' use of tests resulting in blood draws appointments and Business marketing for Hospital, Nursing Homes and Rehab". Respondent submitted a copy of articles of formation for this LLC filed with the state of Virginia on March 30, 2015. Respondent contends that it registered the Domain Name in 2015 for a genuine business purpose and has been using it in good faith, reflecting the integrity of Stat Lab LLC and its impact on the medical community.

Respondent claims the Domain Name "was not registered or used in bad faith and currently has multiple clinical laboratory contracts with Skilled Nursing Facilities and Clinical Laboratories serving sick patients in our community". Respondent claims Stat Lab LLC "is a community base Lab Services business servicing the Northern Virginia and Washington dc [sic] and Maryland United States of America". Respondent also submitted a copy of a purported contract from November 2023 that was unexecuted. Respondent also submitted evidence of a letter from the Embassy of Morocco that references Cris Digamo as president and CEO of Stat Lab LLC but otherwise is personal in nature, intended to express condolences on the passing of Digamo's father. Finally, Respondent submitted what purports to be a business proposal for Stat Lab LLC. Respondent requests that the Panel reject Complainant's claim and allow the Respondent to retain ownership of the Domain Name.

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 Name registered by Respondent is 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 Name; and
- (iii) Respondent has registered and is using the Domain Name in bad faith.

A. Identical or Confusingly Similar

The Panel finds that Complainant has demonstrated rights in its STATLAB and STAT LAB marks through registration and widespread use in commerce dating from the mid-1970s. The Panel further finds that the Domain Name incorporates Complainant's marks in their entirety (and as to the STAT LAB mark, omits the space between the two terms), while merely adding the term "test". This combination in the Domain Name creates a confusing similarity with Complainant's STATLAB and STAT LAB marks and the Domain Name. 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 Name is confusingly similar to a trademark in which Complainant has 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 Complainant has established a *prima facie* case that Respondent lacks rights or legitimate interests in the Domain Name. Complainant did not authorize Respondent to use Complainant's marks in the Domain Name or to hold itself out as associated with Complainant or to offer any goods or services on behalf of Complainant. Respondent owns no registered or unregistered trademarks related to the Domain Name. Based on the Whois information associated with the Domain Name, Respondent is known as Cris Digamo of Diving World Travel. Neither name establishes any rights associated with the term STATLAB.

Respondent has submitted evidence that it established a limited liability company ("LLC") in 2015 in the state of Virginia. However, to the extent this evidence might begin to support a legitimate interest in the Domain Name, this interest is undermined by Respondent's use of the Domain Name as reflected on Respondent's website, where the evidence indicates Respondent misleadingly copied Complainant's email address for purposes of Respondent's contact details (thereby demonstrating a targeting of Complainant), and also misleadingly copied content from multiple other third-party sites (including information about dental services,

which content is completely unrelated to Respondent's purported services), apparently without authorization. Respondent has not rebutted these factual contentions. Respondent did not respond to any of Complainant's allegations concerning targeting of Complainant and its marks, or copying from other third-party sites, nor did Respondent provide any evidence of an ongoing business other than an unexecuted contract. Moreover, there is no evidence of Respondent making a legitimate noncommercial or fair use of the Domain Name. Therefore, the Panel finds that Respondent has not rebutted Complainant's *prima facie* that the Respondent lacks rights or legitimate interests in the Domain Name. Finally, the Panel confirms that Respondent has no right or legitimate interest in the Domain Name as it appears to be used misleadingly to confuse source or sponsorship with Complainant, including gaining or seeking reputation. See e.g., [WIPO Overview 3.0](#), section 2.5.3.

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 Complainant 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 Name was registered and is being used in bad faith. Although Respondent claims he registered the Domain Name in 2015 for a genuine business purpose and has been using it in good faith, the evidence indicates otherwise. Respondent failed to respond to Complainant's evidence of misleading content on Respondent's website, some of which (i.e., using Complainant's email address) demonstrates an awareness of and targeting of Complainant and its marks. Complainant's earliest trademark registration predates registration of the Domain Name by 25 years, and Complainant's marks have been used widely in the same field (medical diagnostic products and services) where Respondent purports to operate. See [WIPO Overview 3.0](#), section 3.1.4 ("Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith."). Thus, given the distinctiveness of Complainant's STATLAB and STAT LAB family of marks, the timing of the registration of the Domain Name many years after Complainant had established rights in its marks, and the fact that the Domain Name is so obviously connected with Complainant's marks, the Panel considers that the only logical conclusion is that Respondent targeted Complainant and its marks when registering the Domain Name. This point is further confirmed by Respondent's use of the Domain Name – not to mention the use of the Complainant's email address, as discussed above. The Panel determines that Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with Complainant's mark.

In conclusion, the Panel determines that, for all the above reasons, the Domain Name was registered and is being used in bad faith. Accordingly, Complainant has 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 Name <statlabtest.com> be transferred to Complainant.

/Christopher S. Gibson/
Christopher S. Gibson
Sole Panelist
Date: January 7, 2025