

ADMINISTRATIVE PANEL DECISION

Zapier, Inc. v. Filip De Clerck, Fillter

Case No. DEU2022-0003

1. The Parties

The Complainant is Zapier, Inc., United States of America ("United States"), represented by Cobalt LLP, United States.

The Respondent is Filip De Clerck, Fillter, Belgium.

2. The Domain Name, Registry and Registrar

The Registry of the disputed domain name <zapier.eu> is the European Registry for Internet Domains ("EURid" or the "Registry"). The Registrar of the disputed domain name is GoDaddy.com, LLC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 31, 2022. On February 1, 2022, the Center transmitted by email to the Registry a request for registrar verification in connection with the disputed domain name. On February 4, 2022, the Registry transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .eu Alternative Dispute Resolution Rules (the "ADR Rules") and the World Intellectual Property Organization Supplemental Rules for .eu Alternative Dispute Resolution Rules (the "Supplemental Rules").

In accordance with the ADR Rules, Paragraph B(2), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 7, 2022.

On February 7, 2022, the Respondent sent a non-compliant Response. In accordance with the ADR Rules, Paragraph B(3), the due date for Response was March 21, 2022. On March 24, 2022, the Center informed the Respondent that the Response was not compliant. The Respondent did not submit a compliant Response. Accordingly, the Center notified the Respondent's default on April 1, 2022.

The Center appointed Luca Barbero as the sole panelist in this matter on April 5, 2022. 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 ADR Rules, Paragraph B(5).

4. Factual Background

The Complainant is a company active in the automated workflow and app connectivity industry. Founded in 2011, it specializes in online automation tools that connect and integrate third-party internet applications and application services. It currently has employees in the United States and 23 other countries around the world.

The Complainant is the owner of several trademark registrations for ZAPIER, including the following:

- International trademark registration No. 1183779, for ZAPIER (word mark), registered on October 25, 2013, in class 42, designating in particular the European Union.

The Complainant operates a website at the domain name <zapier.com>, registered on October 30, 2011, which is used by the Complainant to promote its services under the trademark ZAPIER.

The disputed domain name <zapier.eu> was registered on February 16, 2020 and is pointed to a registrar parking page with pay-per-click links.

5. Parties' Contentions

A. Complainant

The Complainant contends that disputed domain name <zapier.eu> is identical to its trademark ZAPIER.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant asserts that the Respondent registered the disputed domain name long after its trademark ZAPIER had been registered and that a simple online search at the time of registering the disputed domain name, would have revealed the existence of the Complainant. Consequently, it is unlikely that the Respondent couldn't have known about the Complainant's existence and probably registered the disputed domain name with the Complainant in mind.

The Complainant further contends that the Respondent is not commonly known by the disputed domain name and has not been licensed or granted permission in any way to use the Complainant's trademark.

The Complainant points out that the disputed domain name is redirected to a website displaying pay-per-click advertising, which also proves the Respondent has in no way made preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services, nor does it apparently intend to make a legitimate noncommercial or fair use of the disputed domain name.

With reference to the circumstances evidencing bad faith, the Complainant indicates that, considering i) the Respondent appears to have been well aware of the Complainant's trademark ZAPIER at the time of registering the disputed domain name, ii) the Complainant has been operating its main website at "www.zapier.com" since 2011 and iii) that ZAPIER is a coined term with no particular meaning, the Respondent undoubtedly acted in bad faith, also in light of the fact that it is also a business competitor of the Complainant and initially made use of the disputed domain name to redirect users to its own website.

The Complainant also states that, in view of the above, the Respondent clearly registered the disputed domain name with the intention of attracting, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademark.

The Complainant underlines that it sent a cease-and-desist demand letter to the Respondent regarding its registration and use of the disputed domain name, following which the Respondent redirected the same to a pay-per-click website, thus still obtaining revenues from the use of the disputed domain name.

In view of the above, the Complainant requests that the disputed domain name be revoked.

B. Respondent

The Respondent did not submit a compliant Response.

On February 7, 2022, the Respondent mentioned that he was happy to "comply with their request to transfer the ownership of the Zapier.eu domain".

The Complainant did not request the suspension of the proceeding.

6. Discussion and Findings

According to Article 22(1)(a) of the Commission Regulation (EC) No. 874/2004 (hereinafter, the "Regulation"), an ADR procedure may be initiated by any party where the registration is speculative or abusive within the meaning of Article 21. Article 21(1) of the Regulation, provides that a registered domain name shall be subject to revocation where it is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or European Union law and where it:

(a) has been registered by its holder without rights or legitimate interests in the name; or

(b) has been registered or is being used in bad faith.

Article 22(11) of the Regulation states that "the ADR panel shall decide that the domain name shall be revoked, if it finds that the registration is speculative or abusive as defined in Article 21. The domain name shall be transferred to the complainant if the complainant applies for this domain name and satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No. 733/2002". The general eligibility criteria have been amended by Regulation (EU) 2019/517 of the European Parliament and of the Council, of March 19, 2019.

This provision is reflected in paragraph B(11)(b) of the ADR Rules, stating that the sole remedies available pursuant to an ADR proceeding where the respondent is the domain name holder in respect of which domain name the complaint was initiated shall be limited to revocation or to the transfer of the domain name to the complainant provided that it satisfies the eligibility criteria established for the registration of ".eu" domain names.

A. Identical or Confusingly Similar to a name in respect of which a right or rights are recognized or established by national law of a Member State and/or European Union law

Article 10(1) of the Regulation contains a list of rights which may fulfill the definition of "name in respect of which a right is recognized or established" provided in Article 21(1) of the Regulation. Said list includes, *inter alia*: "registered national and community trademarks, geographical indications or designations of origin, and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works."

Paragraph B(11)(d)(1)(i) of the ADR Rules determines that the Panel shall issue a decision granting the remedies requested in the event that the Complainant proves “The domain name is identical or confusingly similar to a name in respect of which a right is recognized by the national law of a Member State and/or European Union law”.

In the case at hand, as highlighted above, the Complainant provided evidence of a trademark registration for ZAPIER valid in the European Union.

The Panel notes that the trademark ZAPIER is entirely reproduced in the disputed domain name, with the mere addition of the “.eu” ccTLD which, as stated in several prior cases, can be disregarded, being a mere technical requirement for registration.

Therefore, the disputed domain name is clearly identical to a trademark in which the Complainant has established rights for the purposes of the ADR Rules.

Accordingly, the Panel finds that the Complainant has proven that the disputed domain name is identical to a name in respect of which it has rights, according to the first requirement of Article 21(1) of the Regulation and Paragraph B(11)(d)(1)(i) of the ADR Rules.

B. Rights or Legitimate Interests

According to Article 21(2) of the Regulation and Paragraph B(11)(e) of the ADR Rules, any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate a respondent’s rights or legitimate interests in a domain name:

- (1) prior to any notice of the dispute, the respondent has used the domain name or a name corresponding to it in connection with the offering of goods or services or has made demonstrable preparations to do so;
- (2) the respondent, being an undertaking, organization or natural person, has been commonly known by the domain name, even in the absence of a right recognized or established by national and/or European Union law;
- (3) the respondent is making a legitimate and noncommercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name in which a right is recognized or established by national and/or European Union law.

A complainant is required to make a *prima facie* case that the respondent lacks rights or legitimate interests and, once such *prima facie* case is made, the burden of production shifts to the respondent to submit appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

In the present case, the Panel finds that the Complainant has made out a *prima facie* case and that the Respondent has failed to provide any elements to establish rights or legitimate interests in the disputed domain name.

It is clear that the Complainant has no relation with the Respondent and that the Complainant has not authorized the Respondent to use the trademark ZAPIER or to register and use the disputed domain name. In addition, there is no indication before the Panel that the Respondent might be commonly known by the disputed domain name.

Moreover, the Panel finds that, in light of the Respondent’s redirection of the disputed domain name, identical to the Complainant’s trademark, to a pay-per-click website with links also referred to the client’s business sector (as shown by the screenshots submitted by the Complainant and confirmed by the Panel’s review of the website), the Respondent has not used, or made preparations to use, the disputed domain

name in connection with the offering of goods or services in good faith prior to any notice of the dispute and has not made a legitimate and non-commercial or fair use of the disputed domain name, without intent to mislead consumers or harm the reputation of the Complainant's distinctive signs.

In light of the foregoing and in absence of a Response, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain name according to the second requirement of Article 21(1) of the Regulation and Paragraph B(11)(d)(1)(ii) of the ADR Rules.

C. Registered or Used in Bad Faith

According to Article 21(1)(b) of the Regulation, a complainant is required to demonstrate that a domain name has been registered or used in bad faith.

Article 21(3) of the Regulation and Paragraph B(11)(f) of the ADR Rules provide a non-exhaustive list of circumstances which, if found by the Panel to be present, may be evidence of the registration or use of a domain name in bad faith:

(1) circumstances indicating that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name to the holder of a name in respect of which a right is recognized or established by national and/or European Union law, or to a public body; or

(2) the domain name has been registered in order to prevent the holder of such a name in respect of which a right is recognized or established by national and/or European Union law, or a public body, from reflecting this name in a corresponding domain name, provided that:

(i) the Respondent has engaged in a pattern of such conduct; or

(ii) the domain name has not been used in a relevant way for at least two years from the date of registration; or

(iii) there are circumstances where, at the time the ADR Proceeding was initiated, the Respondent has declared its intention to use the domain name, in respect of which a right is recognized or established by national and/or European Union law or which corresponds to the name of a public body, in a relevant way but failed to do so within six months of the day on which the ADR Proceeding was initiated;

(3) the domain name was registered primarily for the purpose of disrupting the professional activities of a competitor; or

(4) the domain name was intentionally used to attract Internet users, for commercial gain to the Respondent's website or other online location, by creating a likelihood of confusion with a name on which a right is recognized or established, by national and/or European Union law, or it is a name of a public body, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the Respondent; or

(5) the domain name is a personal name for which no demonstrable link exists between the Respondent and the domain name registered.

The Panel notes that, in light of the prior registration and use of the trademark ZAPIER in connection with the Complainant's services also online via the Complainant's website "www.zapier.com" and considering that ZAPIER is a coined mark which appears to have no meaning in any language, the Respondent was more likely than not aware of the Complainant and its trademark when it registered the disputed domain name, with which it is identical.

The Panel also finds that, considering the use the Respondent has made of the disputed domain name in connection with a webpage with pay-per-click links also related to the Complainant's business, the Respondent intentionally attempted to attract Internet users, for commercial gain, to its website, by creating a likelihood of confusion with the Complainant's trademark, as to the source, sponsorship, affiliation or endorsement of its website.

In view of the above, the Panel finds that the disputed domain name was registered and is being held in bad faith and thus, the Complainant has also met the requirement of Article 21(1) of the Regulation and Paragraph B(11)(d)(1)(ii) of the ADR Rules.

7. Decision

For the foregoing reasons, in accordance with Paragraph B(11) of the ADR Rules, the Panel orders that the disputed domain name <zapier.eu> be revoked.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: May 2, 2022