

ADMINISTRATIVE PANEL DECISION

Automation Anywhere, Inc. v. Michael Nava, Domain Nerdz LLC
Case No. DIO2022-0050

1. The Parties

Complainant is Automation Anywhere, Inc., United States of America (“United States”), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States.

Respondent is Michael Nava, Domain Nerdz LLC, United States.

2. The Domain Name and Registrar

The disputed domain name <automationanywhere.io> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 19, 2022. On October 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 19, 2022, 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 (Privacy Protection) and contact information in the Complaint. The Center sent an email communication to Complainant on October 28, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on November 1, 2022.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the .IO Domain Name Dispute Resolution Policy (the “Policy”), the Rules for .IO Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .IO 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 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 22, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on November 23, 2022.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on December 2, 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 Rules, paragraph 7.

4. Factual Background

Complainant is owner of registrations for the word trademark AUTOMATION ANYWHERE on the Principal Register of the United States Patent and Trademark Office (“USPTO”), including registration number 3913711, registration dated February 1, 2011, in international class (“IC”) 9, covering computer software and firmware, as further specified, and; registration number 5566006, registration dated September 18, 2018, in IC 42, covering consulting services in the field of software automation and hosting services for software automation. Complainant owns registration for the word trademark AUTOMATION ANYWHERE as an International Trademark under the Madrid System, registration number 1532722, registration dated April 17, 2020, in IC 41, covering, *inter alia*, educational services, namely, providing training and educational courses on computer automation. The referenced Madrid System registration includes a range of country designations.

Complainant develops and supports robotic process automation (“RPA”), automating end-to-end business processes. Complainant offers a cloud-native platform combining RPA, artificial intelligence, machine learning, and analytics to automate repetitive tasks and build deeper customer relationships. Complainant has more than 2,200 business partners and more than 4,000 customers globally, with approximately 1,800 employees. Complainant operates its primary commercial website at the domain name <automationanywhere.com>, with that domain name created on February 15, 2006.

According to the Registrar’s verification, Respondent is registrant of the disputed domain name. According to the Registrar’s verification, the record of registration of the disputed domain name was created by Respondent on December 11, 2021. There is no indication on the record of this proceeding that any party other than Respondent has been registrant of or has controlled the disputed domain name since its creation date.

Respondent has offered the disputed domain name for sale for USD 6,998 on dan.com.¹

Respondent has been found to have engaged in abusive domain name registration and use in at least nine prior administrative panel proceedings. These include: *TEVA Pharmaceuticals International GmbH v. Privacy Protection/Michael Nava /or Domain Nerdz LLC*, WIPO Case No. [D2022-2266](#) (transfer of <qvar.net>); *Swedbank AB v. Privacy Protection, Privacy Protection / Michael Nava /or Domain Nerdz LLC*, WIPO Case No. [D2022-2109](#) (transfer of <swedbank.xyz>); *LIDL Stiftung & Co. KG v. Michael Nava, Domain Nerdz LLC*, WIPO Case No. [DCO2022-0080](#); *Panavision International, L.P., Panavision Inc. v. Michael Nava /or Domain Nerdz, LLC*, WIPO Case No. [DCO2022-0042](#) (transfer of <panavision.co>); *Fedrigoni S.P.A v. Michael Nava, Domain Nerdz LLC*, WIPO Case No. [DCO2021-0094](#) (transfer of <fabriano.co>); *Actavis Group PTC ehf, Actavis Holdco US, INC. v. Michael Nava, Domain Nerdz LLC*, WIPO Case No. [DCO2021-0045](#) (transfer of <actavis.co>); and *Flowbird SAS (Parkeon) v. Michael Nava, Domain Nerdz LLC*, WIPO Case No. [DCO2020-0088](#).

5. Parties’ Contentions

A. Complainant

Complainant contends that it owns rights in the trademark AUTOMATION ANYWHERE and that the disputed domain name is identical or confusingly similar to that trademark.

Complainant argues that Respondent lacks rights or legitimate interests in the disputed domain name because: (1) Complainant has never licensed or otherwise authorized Respondent to use its trademark in the disputed domain name or otherwise; (2) offering the disputed domain name for sale on a website does not constitute a *bona fide* offering of goods or services; (3) Respondent has not been commonly known by the disputed domain name and has not acquired any trademark or service mark rights in the disputed

¹ This is according to a screenshot provided by Complainant dated October 18, 2022.

domain name; (4) offering the disputed domain name for sale on a website does not constitute legitimate noncommercial or fair use of Complainant's trademark in the disputed domain name.

Complainant alleges that Respondent registered and is using the disputed domain name in bad faith because: (1) the mere registration of a domain name that is identical or confusingly similar to a famous or widely known trademark can itself create a presumption of bad faith; (2) Respondent must have known of Complainant's trademark when it registered the disputed domain name; (3) Respondent's actions suggest opportunistic bad faith; (4) by using the disputed domain name in connection with a website offering it for sale for USD 6,998, Respondent has clearly registered it "primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name"; (5) Complainant acquired rights in its trademark long before Respondent registered and used the disputed domain name, and; (6) Respondent has "engaged in a pattern of such conduct" pursuant to paragraph 4(b)(ii) of the Policy by registering not only the disputed domain name but also the domain names found to have been registered and used in bad faith in a number of prior administrative panel proceedings.

Complainant requests the Panel to direct the Registrar to transfer the disputed domain name to Complainant.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

The registration agreement between Respondent and the Registrar subjects Respondent to dispute settlement under the Policy. The Policy requires that domain name registrants submit to a mandatory administrative proceeding conducted by the Center, regarding allegations of abusive domain name registration and use (Policy, paragraph 4(a)).

It is essential to Policy proceedings that fundamental due process requirements be met. Such requirements include that a respondent have notice of proceedings that may substantially affect its rights. The Policy and the Rules establish procedures intended to ensure that respondents are given adequate notice of proceedings commenced against them and a reasonable opportunity to respond (see, e.g., Rules, paragraph 2(a)).

The Center formally notified the Complaint to Respondent at the email and physical address provided in its record of registration. Courier delivery was unsuccessful because of inaccurate contact data in Respondent's record of registration. There is no indication of problems with the transmission of email to Respondent. The Center took those steps prescribed by the Policy and the Rules to provide notice to Respondent, and those steps are presumed to satisfy notice requirements.

Paragraph 4(a) of the Policy sets forth three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration and use and to obtain relief. These elements are that:

- (i) the disputed domain name 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 disputed domain name; and
- (iii) the disputed domain name has been registered or is being used in bad faith.

Each of the aforesaid three elements must be proved by a complainant to warrant relief.

A. Identical or Confusingly Similar

Complainant has provided evidence of rights in the trademark AUTOMATION ANYWHERE, including by registration at the USPTO, by registration as an International Trademark under the Madrid System, and by use in commerce. Respondent has not challenged Complainant's assertion of rights. The Panel determines that Complainant owns rights in the trademark AUTOMATION ANYWHERE.

The disputed domain name directly and fully incorporates Complainant's AUTOMATION ANYWHERE trademark. This is sufficient to establish identity under the Policy. The addition of the Top-Level Domain ("TLD") ".io" to Complainant's trademark in the disputed domain name does not prevent a finding of confusing similarity. The Panel determines that the disputed domain name is identical to Complainant's AUTOMATION ANYWHERE trademark.

Complainant has established that it owns rights in the trademark AUTOMATION ANYWHERE, and that the disputed domain name is identical to that trademark.

B. Rights or Legitimate Interests

Complainant's allegations to support Respondent's lack of rights or legitimate interests in the disputed domain name are outlined above, and the Panel finds that Complainant has made a *prima facie* showing that Respondent lacks rights or legitimate interests in the disputed domain name.

Respondent has not replied to the Complaint and has not attempted to rebut Complainant's *prima facie* showing of lack of rights or legitimate interests.

Respondent has used the disputed domain name to direct Internet users to a website offering the disputed domain name for sale at a price that is substantially above the ordinary cost of domain name registration. There is no indication that Respondent made additional justifiable expenditures in connection with the disputed domain name. This conduct does not constitute a *bona fide* offering of goods or services by Respondent as it is seeking to exploit the goodwill value of Complainant's trademark without Complainant's authorization. Moreover, such use by Respondent of Complainant's trademark in the disputed domain name does not constitute a legitimate noncommercial or fair use.

There is no evidence that Respondent has been commonly known by the disputed domain name, or that it has established any trademark rights in AUTOMATION ANYWHERE.

Respondent has not attempted to justify registration and use of the disputed domain name for some legitimate purpose.

The Panel determines that Complainant has established that Respondent lacks rights or legitimate interests in the disputed domain name.

C. Registered or Used in Bad Faith

In order to prevail under the Policy, Complainant must demonstrate that the disputed domain name "has been registered or is being used in bad faith" (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy states that "for the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith". These include, (i) circumstances indicating that [the respondent has] registered or [has] acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the respondent's] documented out-of-pocket costs directly related to the domain name; or (ii) [the respondent has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct [...]"

Respondent registered the disputed domain name identical to Complainant's trademark long after Complainant registered that trademark. The disputed domain name is also identical to Complainant's domain name <automationanywhere.com>. Respondent offered the disputed domain name for sale at a price substantially above the ordinary cost of registration indicating that Respondent sought to take advantage of the goodwill associated with Complainant's trademark. Respondent knew or should have known of Complainant's rights in its trademark. Searching Complainant's trademark in Google or another search engine would have prominently identified Complainant.

Respondent's offering of the disputed domain name for sale at a price likely in excess of its out-of-pocket costs of registration is evidence of Respondent's registration with the intention to sell the disputed domain name to Complainant or another party. Even if Respondent had not registered the disputed domain name with the intent to offer it for sale, Respondent did offer it for sale, contravening the Policy.² Respondent has not attempted to justify its registration and offering for sale of the disputed domain name.

Respondent has repeatedly been found to have engaged in abusive domain name registration and use, evidencing a pattern of conduct to prevent the owners of trademarks or service marks from reflecting their marks in corresponding domain names. Registration of the disputed domain name identical to Complainant's trademark continues that pattern of conduct, contravening paragraph 4(b)(ii) of the Policy.

The Panel determines that Respondent registered and/or used the disputed domain name in bad faith.

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, <automationanywhere.io>, be transferred to Complainant.

/Frederick M. Abbott/

Frederick M. Abbott

Sole Panelist

Date: December 16, 2022

² The Policy provides for a finding of bad faith in circumstances where the disputed domain name is registered "or" is being used in bad faith.