

ADMINISTRATIVE PANEL DECISION

Tytex A/S v. William Coam, Germanium World LLC

Case No. D2021-3051

1. The Parties

The Complainant is Tytex A/S, Denmark, represented by DAHL Lawfirm, Denmark.

The Respondent is William Coam, Germanium World LLC, United States of America (“United States”), represented by Cylaw Solutions, India

2. The Domain Name and Registrar

The disputed domain name <carefix.com> is registered with Moniker Online Services, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 16, 2021. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 17, 2021, the Registrar 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 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 the Respondent of the Complaint, and the proceedings commenced on September 21, 2021. In accordance with the Rules, paragraph 5, the due date for Response was October 11, 2021. The Response was filed on October 7, 2021.

The Center appointed Matthew Kennedy as the sole panelist in this matter on October 17, 2021. 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 provider of medical textiles, including post-surgery garments. Previously, it held the following trademark registrations for CAREFIX:

- Danish trademark registration number VR 1994 01620, registered on March 11, 1994. This registration expired in 2004;
- German trademark registration number DE39541734, registered on May 14, 1996. This registration was cancelled on November 1, 2005;
- United Kingdom trademark registration number UK00002040833, registered on October 11, 1996. This registration expired and was removed from the register on October 10, 2006; and
- United States trademark registration number 2080079, registered on July 15, 1997. This registration was cancelled on October 17, 2004.

Currently, the Complainant holds multiple trademark registrations for CAREFIX in multiple jurisdictions, including the following:

- European Union trademark registration number 008537045, registered on March 8, 2010 (applied for on September 9, 2009), specifying goods in classes 5, 10, and 25. This registration remains in force; and
- International trademark registration number 1031211, registered on December 9, 2009, designating multiple jurisdictions, including the United States, and specifying goods in classes 5, 10, and 25. This registration also remains in force.

The Respondent is William Nah, alias "Coam", and his company is called Germanium World LLC, formerly named "Germanium Inc". The Respondent is a domain name reseller and has operated a domain name marketplace since 2003. He currently holds a portfolio of approximately 5,500 domain names, including <care4me.com>, <caremedia.com>, <fixtec.com>, <fixw.com>, and <caresalon.com>, registered in 2003, 2004, 2007, 2009, and 2013, respectively. According to evidence provided by the Complainant, the Respondent or businesses in which he participated have been found in at least four prior proceedings under the Policy to have registered domain names in bad faith, including *NHN Corporation v. NHN Corp.*, *National Health Network*, WIPO Case No. D2003-0939; and *Aperam Alloys Imphy v. Germanium Inc.*, WIPO Case No. D2012-0773. According to a notarized declaration made by the Respondent annexed to the Response, he appealed three of those four decisions to courts in the United States and subsequently transferred the relevant domain names pursuant to mutually agreed settlements.

The disputed domain name was registered on June 19, 2008. It resolves to a landing page on the Respondent's website where it is offered for sale at the price of USD 24,500. Below the price, the page displays buttons labelled "Make an offer" and "Buy now".

5. Parties' Contentions

A. Complainant

The disputed domain name is identical to the Complainant's CAREFIX trademark. The trademark has been continuously used internationally since its registration in 1994-96.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent only appears to be reselling the disputed domain name. The Respondent is not affiliated with, nor authorized by, the Complainant in any way and is not related in any way to the Complainant's business.

The disputed domain name was registered and is being used in bad faith. The Respondent should have known of the existence of the Complainant when he registered the disputed domain name. The Respondent offers the disputed domain name for sale. He has been found in prior proceedings under the Policy to have registered domain names in bad faith. The Respondent is a professional domain name registrant and should reasonably be expected to have made suitable searches to support his warranty under paragraph 2 of the Policy that the registration of the disputed domain name would not infringe upon the rights of any third party. The Respondent could through a simple search on Google or in a publicly available trademark register, including their local United States Patent and Trademark Office ("USPTO") database have ascertained the Complainant's rights to the CAREFIX trademark. The Respondent is intentionally attempting to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademark.

B. Respondent

The Respondent acknowledges that the Complainant registered the trademarks in 2010 that are active as of the current date, and further acknowledges that they are identical to the disputed domain name for the purposes of the Policy. However, the Complainant had no valid trademark rights in the year 2008 in any part of the world.

The Respondent registered the disputed domain name due to its generic nature at a time when it was not subject to any valid trademark rights by the Complainant in any jurisdiction. The disputed domain name is offered for sale for USD 24,500 but no reference has been included to the Complainant. The Respondent has registered numerous generic domain names and also holds similar domain names containing either the word "care" or "fix". His business is reselling domain names containing generic terms, which amounts to a *bona fide* offering of goods and services. "Care Fix" is a combination of very common dictionary words and otherwise derived from the common phrase "Care to Fix". At present, there is wide third party use of the term "Care Fix".

No bad faith can be held against the Respondent either at the time of registration or based on the current use of the disputed domain name. There is simply no evidence whatsoever to support the Complainant's limited contention that the disputed domain was registered because of the Complainant. The evidence convincingly demonstrates that "Care Fix" / "Care to Fix" is widely used for its descriptive value and there has been no evidence provided (except for the Complainant's expired / dead trademark registrations) which even purports to show that the Respondent actually was aware or ought to have been aware of the Complainant's mark in 2008. The Complainant did not even own a "carefix" domain name at that time; it only registered its domain name <carefix.dk> in 2009. "Care Fix" is a descriptive / combination of generic words and, given the absence of registered trademark rights in 2008, it is necessary for the Complainant to provide evidence as to the nature of use, the amount of sales, the extent of advertising, actual public recognition and consumer surveys, in order to establish secondary meaning of the mark in the United States. If the Complainant fails to produce evidence of its reputation as it existed at the time the Respondent registered the disputed domain name, the inference must be that it had none.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that a complainant must prove each of the following elements:

- (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 above elements apply cumulatively, which means that the Complainant must prevail on all of them in order for the Complaint to succeed.

A. Identical or Confusingly Similar

Based on the evidence submitted, the Panel finds that the Complainant has rights in the CAREFIX mark at the time of this proceeding.

The disputed domain name wholly incorporates the CAREFIX mark as its operational element. The only additional element is the generic Top-Level Domain (“gTLD”) suffix (“.com”). As a mere technical requirement of registration, a gTLD suffix is generally disregarded in the comparison between a domain name and a trademark for the purposes of the first element of paragraph 4(a) of the Policy. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 1.11.

Therefore, the Panel finds that the disputed domain name is identical to a trademark in which the Complainant has rights. The Complainant has satisfied the first element in paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Given the Panel’s findings in Section 6.C. below, it is unnecessary to consider the second element of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires the Complainant to prove that the disputed domain name has been registered and is being used in bad faith. A finding in a complainant’s favour on this element normally requires a finding that the respondent targeted a complainant’s mark.

In the present dispute, the disputed domain name was registered in 2008, after the expiry of the Complainant’s original 1994-97 trademark registrations, which occurred during the period 2004-06, but before the grant of the Complainant’s current trademark registrations, which occurred from 2009 onwards. At the time when the disputed domain name was registered, the Complainant had no registered trademark rights anywhere in the world. Although the Complainant asserts that the CAREFIX mark has been used continuously since its original registrations in 1994-96 up until the present, it provides no evidence in support of that assertion. While it provides evidence in the form of a Google search for “carefix” in 2021, it provides no evidence of prior reputation or use of its CAREFIX mark that might have established that it held unregistered rights in that mark when the disputed domain name was registered 13 years ago. Accordingly, the Panel is unable to find that the Respondent targeted the Complainant’s mark when he registered the disputed domain name because there is no evidence that the Complainant held any rights in the CAREFIX mark at that time.

The Panel has considered the possibility that there may be exceptional circumstances indicating that the Respondent registered the disputed domain name in anticipation of nascent trademark rights – noting here that the prior registrations were in effect revived. See WIPO Overview, section 3.8.2. However, the Complainant did not file an application for any of its existing trademark registrations until a year later. It does not appear that the Complainant even registered a domain name incorporating “carefix” until a year later either. Although the Complainant had previously held trademark registrations, these had all expired or been cancelled and nothing in the record indicates that the Respondent should have, or even could have, been aware that the Complainant would subsequently seek new trademark registrations for the same mark. The Complainant fails to offer any explanation as to the circumstances surrounding the expiry and cancellation of its prior registrations and the filing of new applications if, indeed, it was continuously using the mark in the interim as it claims to have been doing. The Complainant had apparently – at least as far as the public trademark registration records would have shown – abandoned the CAREFIX mark before the Respondent

registered the disputed domain name.

Moreover, the Respondent has provided an explanation for his registration of the disputed domain name that has some credibility. The Respondent submits that he registered the disputed domain name as a combination of the dictionary words “care” and “fix”. This is borne out, to some extent, by the evidence showing that he has registered many other domain names containing combinations of dictionary words, several of which actually incorporate the words “care” or “fix”. On the other hand, the evidence presented is not convincing that “carefix”, “care fix” or “care to fix” is a common phrase or widely used in a descriptive sense .

It is not disputed that the Respondent or a business in which he participated was found to have registered and used other domain names in bad faith in previous proceedings under the Policy, although the Respondent declares that appeals were filed in three of those proceedings and subsequently settled out of court. Nevertheless, the facts of those proceedings can be distinguished from the present dispute because the evidence on record does not show that any relevant trademark rights existed at the time when the disputed domain name was registered.

In view of all the above circumstances, the Panel is unable to find that the Respondent registered the disputed domain name in bad faith. Accordingly, the Complainant has failed to establish the third element in paragraph 4(a) of the Policy.

D. Reverse Domain Name Hijacking

Paragraph 15(e) of the Rules provides that if “after considering the submissions the panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding”. “Reverse Domain Name Hijacking” is defined in paragraph 1 of the Rules as “using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name.”

The Respondent submits that the Complainant was intent on Reverse Domain Name Hijacking the disputed domain name.

The Panel notes that the Complainant has legal representation in this proceeding. A crucial requirement for the Complaint was a showing that the Respondent targeted the Complainant’s trademark at the time when he registered the disputed domain name in 2008. The Complainant provided details of its 1994-97 national trademark registrations and asserted that these “are replaced” by its 2009 international registration, without disclosing that it held no registered trademark rights in CAREFIX in any jurisdiction during a period leading up to and including 2008, when the Respondent registered the disputed domain name. An annex to the Complaint showed that three earlier registrations were inactive in 2021 only and another annex (in Danish) showed that one trademark registration had been cancelled in 2004. The Complainant may have impliedly acknowledged the temporal gap in its registered rights when it asserted that the Respondent should have known of the existence of “the Complainant” (rather than the Complainant’s mark) when he registered the disputed domain name, but later the Complaint expressly alleged that the Respondent could have ascertained the Complainant’s trademark rights through a trademark search when, at the time he registered the disputed domain name, the Complainant held no valid trademark registration for CAREFIX anywhere.

Therefore, the Panel declares that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: October 31, 2021