

ADMINISTRATIVE PANEL DECISION

NURO Corp. v. Domain admin, Cybertonic

Case No. D2021-2166

1. The Parties

The Complainant is NURO Corp., Canada, internally represented.

The Respondent is Domain admin, Cybertonic, France, represented by John Berryhill, Ph.d., Esq., United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <nuro.com> is registered with TurnCommerce, Inc. DBA NameBright.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 2, 2021. On July 6, 2021, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 6, 2021, 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 and contact information in the Complaint. In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amendment to the Complaint on July 8, 2021.

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”).

On July 9, 2021, the Respondent’s representative sent an email to the Center (copied to the Complainant) noting that the Complaint identified a particular person as the Complainant’s authorized representative in the proceeding, and stating that he had been informed by that person that he had not been engaged in the matter and does not represent the Complainant in the matter. On the same day, in response to the email of the Respondent’s representative, the Complainant’s founder and CEO, Francois Gand, replied that he was the person to whom all communications in the matter should be addressed, stated “we reserve the right to keep [the named person] as an observer and side counsel to the matter”, and requested the Center to cc that person on all communications.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 15, 2021. In accordance with the Rules, paragraph 5, the due date for Response was August 4, 2021. The Response was filed with the Center July 16, 2021. On July 17, 2021, the Complainant filed a supplemental filing.

The Center appointed Daniel R. Bereskin QC, Andrew F. Christie, and Martin Schwimmer as panelists in this matter on August 31, 2021. The Panel finds that it was properly constituted. Each member of 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 August 31, 2021, the Respondent emailed the Center requesting that, should the Panel admit and consider the Complainant's Supplemental Filing, the Respondent be provided with a deadline by which to provide responsive comments on the matters raised therein.

4. Factual Background

The Complainant is a corporation formed under the laws of Ontario, Canada, on April 24, 2017. The Complaint asserts that the Complainant operates in the healthcare sector providing several products, including hardware and software, under regulatory clearances granted by Health Canada and the United States Food and Drug Administration.

The Complainant is the owner of Canada Trademark No. 1009315 (registered on November 20, 2018; asserted to be used in Canada since September 29, 2016) and United States Trademark No. 6248255 (registered on January 19, 2021; claiming priority from the aforementioned Canada application) for the stylized mark **NURO**.

The Respondent is a French corporation (société à responsabilité à associé unique) registered on July 29, 2004. The principal of the Respondent, Francois Carillo, is the proprietor of Domaining.com, a domain name news aggregator and resource directory, and a known dealer in short domain names. The Respondent is the proprietor of Catchy.com, at which the Respondent advertises its interest in buying pronounceable four-letter domain names.

The Respondent registered the disputed domain name on February 19, 2015. The Complainant provided screenshots of the web pages resolving from the disputed domain name at various times in the past, obtained from Archive.org. On April 26, 2015, the disputed domain name resolved to a page at Catchy.com containing the text: "nuro Do you like this domain? Make an offer!". On September 2, 2019, the disputed domain name resolved to a page at which it was offered for lease for USD 4,500/month. On July 2, 2021, the disputed domain name resolved to a page containing the text: "The problem with not having the .com of your name is that it signals weakness. Fix it now ...", with link to the LinkedIn profile of Mr. Carillo.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to a trademark in which it has rights because it is the owner of the trademark NURO which is federally-registered both in Canada and in the United States.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name because: (i) the Respondent has been the registrant of the disputed domain name for at least six years during which time the Respondent has made no *bona fide* offering of goods or services using the disputed domain name and has held no federal registration in either Canada or the United States for the trademark for NURO; and (ii) as such, the Respondent has been in direct violation of the Complainant's

intellectual property rights in both Canada and the United States, and of the Complainant's rights to use the disputed domain name under its officially-granted trademarks.

The Complainant contends that the disputed domain name was registered and is being used in bad faith because: (i) it is clear that the Respondent acquired the disputed domain name for the sole purpose of cybersquatting on it and ultimately selling it for valuable consideration in excess of the Respondent's out-of-pocket costs related to it; (ii) the disputed domain name has been advertised both for sale and for lease to third parties for up to USD 4,500 per month (promotionally) and up to USD 9,000 per month (non-promotionally) with no intention of using it whatsoever in any shape or form; (iii) currently the disputed domain name resolves to a page with no relevant content besides a link to the LinkedIn profile of the Respondent's principal, which is not a legitimate use of the disputed domain name, is cybersquatting, and is a demonstrated intention to attract unfair commercial gain via the use of the Complainant's federally-registered trademark NURO.

B. Respondent

The Respondent agrees that the Complainant satisfies the requirement that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

In relation to whether the Respondent has rights or legitimate interests in respect of the disputed domain name, the Respondent contends that: (i) the relevant rights and interests are not required to be trade or service mark rights, but include a range of equitable interests such as the continued use of the domain name for a *bona fide* purpose and "the right of seniority"; (ii) the Respondent's registration of the disputed domain name predates any evidence of a trade or service mark right belonging to the Complainant; (iii) as a short, four-letter, pronounceable domain name, corresponding to a common term, the disputed domain name is inherently valuable for those characteristics alone; (iv) the Respondent was unaware of the Complainant when it acquired the disputed domain name; (v) the Complainant does not state any facts under which the Respondent's use of the disputed domain name infringes or capitalizes on the Complainant's alleged junior mark; and (vi) because the letters "nuro" are the sole textual component of more than 42 pending and registered trademarks in offices around the world by dozens of different registrants, it cannot be said that the Complainant is notably or famously associated with the letters "nuro" or that the Respondent's registration and offer for sale of the disputed domain name comprising these four letters was inspired by the Complainant.

In relation to whether the disputed domain name has been registered and is being used in bad faith, the Respondent contends that: (i) bad faith registration cannot be found where a domain name was registered prior to the establishment of the trade or service mark at issue; (ii) the Complainant has long known that the Respondent has senior registration status of the disputed domain name, and has chosen not to disclose to the Panel its prior attempts to purchase the disputed domain name directly or through agents; (iii) the Complainant has insisted on having communications directed to its external counsel as "observer and side counsel", demonstrating that the Complainant has the means and ability to engage counsel in the filing and prosecution of its trademark registration matters, from which it may be inferred that the Complainant has consulted with such counsel in this matter; (iv) there are no facts of record on which the Respondent could conceivably be considered to have registered the disputed domain name in bad faith; and (v) the Complainant's registered stylized mark uses a font that is strikingly similar to the font in which the Respondent represented the letters "nuro" on its website in August 2016, more than one month before the Complainant's claimed first use of its mark, raising the possibility that the similarity is not merely coincidental.

C. Complainant's Supplemental Filing

The Complainant's unsolicited Supplemental Filing made a range of assertions, of which only the following statement arguably was not raised in the Complaint either expressly or by implication: "if necessary, it can be legally established and proven that, under Common Law, NURO's operations were first and officially introduced to representatives of the Federal Government of Canada in the last quarter of the Year 2014."

6. Discussion and Findings

A. Supplemental Filing

As explained in section 4.6 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), panels have repeatedly affirmed that the party submitting or requesting to submit an unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response (e.g., owing to some “exceptional” circumstance). In the Panel’s view, the Complainant did not establish any exceptional circumstance for admission of its Supplemental Filing. In particular, the Supplemental Filing did not address any issue that either was not already addressed in the Complaint or could not reasonably be expected to have been addressed by the Respondent in its Response. Moreover, the only assertion in the Supplemental Filing that might be considered not to have been already made in the Complaint has no probative value. Even if the Complainant’s operations were “first and officially introduced to representatives of the Federal Government of Canada” in 2014, that does not assist the Complainant’s case. The Complainant did not exist as a legal entity at that time (by the Complainant’s own admission, it was incorporated in 2017), and whatever was the actual nature of being “introduced” it did not constitute relevant use of its trademark (by the Complainant’s own admission, its first use of the trademark was in 2016). Furthermore, no evidence has been disclosed to support this bare allegation.

Because the Panel is able to determine the outcome of this matter in favor of the Respondent on the facts and assertions contained in the case file currently before it, there is no need for the Panel to provide the Respondent with the opportunity to reply to the Complainant’s Supplemental Filing.

B. Identical or Confusingly Similar

The Complainant has based this Complaint on its registered stylized trademark. As explained in section 1.10 of the WIPO Overview 3.0, to the extent that the stylized elements of a trademark are incapable of representation in a domain name, those elements are largely disregarded for the purposes of assessing identity or confusing similarity under the first element, and the assessment involves comparing the disputed domain name with the textual components of the relevant mark.

Once the generic Top-Level Domain “.com” is ignored (which is appropriate in this case), the disputed domain name consists solely of the string of letters, in order, that make up the Complainant’s registered stylized trademark. Accordingly, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

C. Rights or Legitimate Interests

The Respondent claims it has rights or legitimate interests in the disputed domain name by virtue of the fact that its registration predates the Complainant’s trademark rights and that it is a short, four-letter, pronounceable word that corresponds to a common term. As explained in section 2.10 of the WIPO Overview 3.0, mere registration of a domain name comprised of a dictionary word or phrase does not, of itself, confer rights or legitimate interests on the respondent. In order to find rights or legitimate interests in such a domain name, it should be used (or at least demonstrably be intended for use) in connection with its meaning.

The Respondent is not a licensee of the Complainant, is not an authorized distributor of the Complainant’s products, and has not been authorized by the Complainant to use its trademark. The Respondent has not provided any evidence that it has been commonly known by, or has made a *bona fide* use of, the disputed domain name, or that it has, for any other reason, rights or legitimate interests in the disputed domain name. The Respondent has not used the disputed domain name in any way other than to offer it for lease or sale. The Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, and the Respondent has not rebutted this.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

D. Registered and Used in Bad Faith

The Respondent registered the disputed domain name nearly four years before the Complainant's first registration of its trademark, and over one and one-half years before the Complainant's asserted first use of its trademark. In these circumstances, it is clear that the Respondent did not register the disputed domain name for the purpose of selling or renting the disputed domain name to the Complainant, preventing the Complainant from reflecting its trademark in the disputed domain name, or disrupting the business of the Complainant.

The Respondent's use of the disputed domain name since registration of it has been consistent – namely, to offer it for lease or sale. This is not a case in which the Respondent, subsequent to the Complainant obtaining trademark rights, has changed its use of the disputed domain name and sought to take unfair advantage of a reputation developed by the Complainant in its trademark. There is, therefore, no evidence currently before the Panel of any bad faith use of the disputed domain name by the Respondent.

Accordingly, the Panel finds that the Respondent did not register and has not used the disputed domain name in bad faith.

E. Reverse Domain Name Hijacking

Paragraph 15(e) of the Rules provides that, if 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. Paragraph 1 of the Rules defines "Reverse Domain Name Hijacking" to be "using the Policy in bad faith to attempt to deprive a registered domain name holder of a domain name".

Section 4.16 of the WIPO Overview 3.0, lists, non-exhaustively, circumstances which previous panels have considered to be indicative of a complaint having been brought in bad faith, including that the facts demonstrate the complainant knew it could not succeed as to one or more of the required three elements, and that the complainant unreasonably ignored established Policy precedent notably as captured in the WIPO Overview 3.0. The Panel considers that those circumstances are present in this case.

Moreover, the Panel takes note of the fact that the Complainant identified a particular partner of a major Canadian law firm as the Complainant's authorized representative in the proceeding and then, when this was queried by the Respondent, requested all communications to be addressed to the Complainant's founder and CEO, stated that it reserved the right to keep the named partner "as an observer and side counsel" to the matter, and asked the Center to cc that person on all communications. While it is not for the Panel to speculate as to why the Complainant chose to prosecute the Complaint in this manner, these facts do establish that legal advice was available to the Complainant, whether or not it was taken. In the Panel's opinion, that exacerbates the Complainant's culpability for bringing the Complaint in the circumstances identified above.

Accordingly, the Panel finds that the Complaint was brought in bad faith, in an attempt at Reverse Domain Name Hijacking, and therefore constituted an abuse of the administrative proceeding.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Andrew F. Christie/

Andrew F. Christie

Presiding Panelist

/Daniel R. Bereskin QC/

Daniel R. Bereskin QC

Panelist

/Martin Schwimmer/

Martin Schwimmer

Panelist

Date: September 14, 2021