

COMPLAINT TRANSMITTAL COVERSHEET

You are hereby informed that a Complaint has been filed against you with the World Intellectual Property Organization (**WIPO**) Arbitration and Mediation Center (the **Center**) pursuant to the Uniform Domain Name Dispute Resolution Policy (the **Policy**) as approved by the Internet Corporation for Assigned Names and Numbers (**ICANN**) on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the **Rules**) as approved by ICANN on October 30, 2009, and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the **Supplemental Rules**) in effect as of December 14, 2009.

The Policy is incorporated by reference into your Registration Agreement with the Registrar(s) of your domain name(s), in accordance with which you are required to submit to a mandatory administrative proceeding in the event that a third party (a **Complainant**) submits a complaint to a dispute resolution service provider, such as the Center, concerning a domain name that you have registered. Pursuant to Paragraph 4 of the Rules and Paragraph 4(d) of Supplemental Rules, upon Notification of the Complaint and Commencement of Administrative Proceedings, you will be forwarded an electronic copy of the Complaint (including any annexes) and Written Notice of the dispute in hard copy by post and/or facsimile, where applicable. For these purposes, please advise the Center as soon as possible of any preferred and functioning email address.

Once the Center has checked the Complaint to determine that it satisfies the formal requirements of the Policy, the Rules and the Supplemental Rules, it will forward an official copy of the Complaint to you. You will then have 20 calendar days within which to submit a Response to the Complaint in accordance with the Rules and Supplemental Rules to the Center and the Complainant. You may represent yourself or seek the assistance of legal counsel to represent you in the administrative proceeding.

The **Policy** can be found at <http://www.icann.org/en/dndr/udrp/policy.htm>

The **Rules** can be found at <http://www.icann.org/en/dndr/udrp/uniform-rules.htm>

The **Supplemental Rules**, as well as other information concerning the resolution of domain name disputes can be found at <http://www.wipo.int/amc/en/domains/supplemental/eudrp/>.

A **model Response** can be found at <http://www.wipo.int/amc/en/domains/respondent/index.html>.

Alternatively, you may contact the Center to obtain any of the above documents. The Center can be contacted in Geneva, Switzerland by telephone at +41 22 338 8247, by fax at +41 22 740 3700 or by e-mail at domain.disputes@wipo.int.

You are kindly requested to contact the Center to provide the contact details to which you would like (a) the official version of the Complaint and (b) other communications in the administrative proceeding to be sent.

A copy of this Complaint has also been sent to the Registrar(s) with which the domain name(s) that is/are the subject of the Complaint is/are registered.

By submitting this Complaint to the Center the Complainant hereby agrees to abide and be bound by the provisions of the Policy, Rules and Supplemental Rules.

Before the:

**WORLD INTELLECTUAL PROPERTY ORGANIZATION
ARBITRATION AND MEDIATION CENTER**

Qwalify, Inc.
645 Westmount Road East
Unit 11 (2nd Floor)
Kitchener (ON)
N2E 3S3

(Complainant)

-v-

Domain Administrator
Fundacion Private Whois

(Respondent)

Disputed Domain Name(s):

www.qualify.com

COMPLAINT

I. Introduction

1. This Complaint is hereby submitted for decision in accordance with the Uniform Domain Name Dispute Resolution Policy (the **Policy**), approved by the Internet Corporation for Assigned Names and Numbers (**ICANN**) on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the **Rules**), approved by ICANN on October 30, 2009, and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the **Supplemental Rules**).

II. The Parties

A. The Complainant

2. The Complainant in this administrative proceeding is Qwalify, Inc., a Canadian corporation.
3. The Complainant's contact details are:

Address: 645 Westmount Road East, Unit 11 (2nd Floor)
Kitchener (ON)
N2E 3S3

Telephone: 1-800-535-5043

Fax: None.

E-mail: info@qwalify.com

4. The Complainant's authorized representative in this administrative proceeding is:

Name: Sarah M. Matz, Esq.

Firm: Adelman Matz P.C.

Postal Address: 1173A Second Avenue, Suite 153
New York, New York 10065

Telephone: (646) 650-2213

Fax: (646) 650-2108

E-mail: sarah@adelmanmatz.com

Name: Gary Adelman, Esq.

Firm: Adelman Matz P.C.

Postal Address: 1173A Second Avenue, Suite 153
New York, New York 10065

Telephone: (646) 650-2198

Fax: (646) 650-2108

E-mail: g@adelmanmatz.com

5. The Complainant's preferred method of communications directed to the Complainant in this administrative proceeding is:

Electronic-only material

Method: e-mail

Address: sarah@adelmanmatz.com

Contact: Sarah M. Matz, Esq.

Material including hardcopy (where applicable)

Method: Post/Courier
Adelman Matz P.C.
Address: 1173A Second Avenue, Suite 153
New York, New York 10065
Fax: (646) 650-2108
Contact: Sarah M. Matz, Esq.

B. The Respondent

6. According to Internet.BS Corp.'s WhoIs database, the Respondent in this administrative proceeding is Domain Administrator / Fundacion Private Whois. Copies of the printout of the database search(es) conducted on February 24, 2014 and the historical records showing prior owners of the www.qualify.com URL from DomainTools.com are provided as **Annex 1**.

7. All information known to the Complainant regarding how to contact the Respondent is as follows:

Registrant
Name: Domain Administrator
Registrant
Organization: Fundacion Private Whois
Street: Attn: qualify.com, Aptds. 0850-00056
City: Panama
Postal Code: Zona 15
Country: PA
Telephone: +507.65995877
Fax: Unknown
E-mail: 522738792khq5w1v@5225b4d0pi3627q9.privatewhois.net

III. The Domain Name(s) and Registrar(s)

8. This dispute concerns the domain name(s) identified below:

www.qualify.com: The Respondent acquired the domain name sometime between March 1, 2012 and May 15, 2012.

9. The registrar(s) with which the domain name(s) is/are registered is/are:

Name:	Internet.bs Corp. Sea Beach Boulevard,
Postal	Sea Beach Estates
Address:	N-4892 Nassau The Bahamas
Fax:	München Fax: +49-89-2444-3-2838 London Fax: +44-(0)207-113-2165 Madrid Fax: +34 (0)91 788 98 25 Milano Fax: +39 02 30 41 2039 Paris Fax: +33 (0)1 70 99 44 15 Brussel Fax: +32(0)2789 8545
E-mail:	abuse@internet.bs Email English: contact-en@internet.bs Email Italiano: contact-it@internet.bs Email Français: contact-fr@internet.bs Email Español: contact-es@internet.bs Email Deutsch: contact-de@internet.bs
Website:	www.internetbs.net

IV. Language of Proceedings

10. To the best of the Complainant's knowledge, the language of the Registration Agreement is English, a copy of which is provided as **Annex 2** to this Complaint. The Complaint has been submitted in English.

V. Jurisdictional Basis for the Administrative Proceeding

11. This dispute is properly within the scope of the Policy and the Administrative Panel has jurisdiction to decide the dispute. The registration agreement, pursuant to which the domain name that is the subject of this Complaint is registered, incorporates the

Policy by reference in the preamble and again in Paragraph 1(d). A true and correct copy of the domain name dispute policy that applies to the domain name(s) in question is provided as **Annex 2** to this Complaint and can be found at <http://www.internetbs.net/legal/Internet.bs-RegistrationAgreement.pdf>. The domain name was originally registered on September 27, 1999, however based upon the historical WhoIs Records for www.qualify.com, Respondent acquired the domain name by transfer of ownership sometime between March 1, 2012-May 15, 2012. On March 1, 2012 the Registrant of www.qualify.com domain name was “Private Whois qualify.com”. As of May 15, 2012 and currently the WhoIs Records indicate that Fundacion Private Whois is the Registrant for www.qualify.com.¹ A true and correct copy of the printout of the database search(es) conducted on February 24, 2014, as well as the historical WhoIs Records from DomainTools.com as printed on February 24, 2014 are submitted herewith as **Annex 1**.

VI. Factual and Legal Grounds

12. This Complaint is based on the following grounds:

A. The domain name(s) is(are) identical or confusingly similar to a trademark or service mark in which the Complainant has rights

i. The Qwalify Trademark.

Complainant has rights in and to the Qwalify Trademark. It is well settled that trademark registrations constitute “prima facie evidence of the validity of the trademark.” *Wachovia Corporation v. Peter Carrington*, WIPO Case No.D2002-0775 § 6A (citing *Backstreet Prods., v. Zuccarini*, WIPO Case No. D2001-0654, § 8A). *See also Humana Inc. v. Cayman Trademark Trust*, WIPO Case No.D2006-0073, §6A (“[i]n this case, presentation of certified true and correct copies of US . . . registrations satisfies the threshold requirement of having rights in the mark”).

“QWALIFY” is a registered trademark in the United States Patent and Trademark Office US Reg. No. 4319882, owned by Complainant, for services in International Class 042 for *inter alia*:

¹ “[A] transfer of a domain name is held to be a new ‘registration.’” *Octogen Pharmacal Company, Inc. v. Domains By Proxy, Inc. / Rich Sanders and Octogen e-Solutions*, Case No. D2009-0786, §6(D).

Providing a website featuring technology that enables users to such as recruiters and hiring managers to manage the entire candidate attraction and selection process, including administration of background checks, assessments and skills tests . . .

(the “Qwalify Trademark”). A true and correct copy of the Certificate of Registration for “QWALIFY”, including the complete description of goods and services is provided as **Annex 3**.

Complainant provides technology services, namely a hiring platform that enables employers to approach the recruitment of prospective employees in a more effective way. Qwalify provides specialized tools so that employers can evaluate employment candidates quickly and efficiently to find the best person for each position, environment and employment culture. Complainant operates under, and provides its services, in Canada, the United States and to companies all over the world under the “QWALIFY” trademark. By virtue of Complainant’s use of the Qwalify Trademark, since at least the August of 2010 Complainant has acquired rights in and to the Qwalify Trademark. True and correct copies of screenshots of the Complainant’s website, screenshots of the Qwalify platform in use, and marketing materials demonstrating use of the Qwalify Trademark are provided as **Annex 4** to this Complaint. True and correct copies of screenshots of Complainant’s various online properties that it uses to advertise its services are annexed hereto as **Annex 11**.

In addition to Complainant’s own advertising, Complainant’s services have been the subject of numerous news articles, interviews and other media coverage. True and correct copies of examples of media coverage of Complainant are attached as **Annex 9**. Based upon the foregoing Complainant has acquired rights in and to the Qwalify Trademark, and as such is the proper Complainant in this proceeding.

ii. The Domain Name is Confusingly Similar:

The domain name www.qualify.com is confusingly similar to the Qwalify Trademark and to Complainant’s domain name www.qwalify.com. Here the domain name is almost identical to the Qwalify Trademark and Complainant’s official domain name as it incorporates almost the entire Qwalify Trademark, and as such is confusingly similar.

“[C]onfusing similarity is a low threshold test the purpose of which is effectively to assess whether a complainant has sufficient rights so as to give it standing to bring a complaint . . . It involves a simple comparison of the mark relied

upon with the domain name in issue.” *See rapidShare AG and Christian Schmid v. majeed randi*, WIPO Case No. D2010-1089 (citing *Aubert International SAS and Aubert France SA v. Tucows.com Co.*, WIPO Case No. D2008-1986)).

“The test of confusion in comparing the words or marks at issue is from the standpoint of the average unwary consumer, looking at the marks in their totality, having an imperfect recollection of the former . . . Confusing similarity turns on the similarity in sound, appearance and idea suggested by the mark and the domain name among other factors.” *Sharman License Holdings, Limited v. Gregg Smitherman*, Case No. D2004-0375, §6A. The “Policy requires only that the domain name be identical or confusingly similar to a mark . . . quite independently from whether or not any actual confusion or likelihood of confusion is present.” *Motorola, Inc. vs NewGate Internet, Inc.*, Case No. D2000-0079, §6. “The test of confusing similarity under the Policy is confined to a comparison of the disputed domain name and the trademark alone.” *Lyonnaise de Banque v. Richard J.*, Case No. D2006-0142, §6A.

The domain name www.qualify.com is identical and confusingly similar to the Qwalify Trademark and the Complainant’s registered domain name www.qwalify.com, as it identical in sound and idea. The only differences between Respondent’s www.qualify.com domain name and Complainant’s Qwalify Trademark and corresponding URL, do not differentiate the sites and still result in a confusingly similar use. *See Sharman License Holdings, Limited v. Gregg Smitherman*, Case No. D2004-0375, §6A (domain name shazaa.com was held to be confusingly similar to the KaZaa Mark based on phonetic similarity); *CPP, Inc. v. Virtual Sky*, Case No. D2006-0201, §6A (the domain name in dispute <skills1.com> is identical to Complainant’s registered trademark SKILLSONE in sound and idea suggested by the trademark, but differs in appearance by the substitution of the numeral “1” for the word “one”, which is the suffix found in Complainant’s registered trademark. The replacement of the word “one” with the numeral “1”, found in the domain name in dispute, results in a confusingly similar use of the Complainant’s trademark SKILLSONE.”).

Like the above cited panel decisions, the only differences between the domain name www.qualify.com and Complainant’s Qwalify Trademark and corresponding URL, namely the use of “u” instead of “w” and the “.com” suffix, are legally irrelevant as they do nothing to avoid the a finding of confusing similarity.

It is commonly held that a domain will be found to be confusingly similar to a trademark where the domain name spelling differs from a trademark by merely interchanging one letter for another. *See e.g.* WIPO Overview 2.0, 1.10 (“A domain name which contains a common or obvious misspelling of a trademark normally will be found to be confusingly similar to such trademark, where the misspelled trademark remains the dominant or principal component of the domain name.”). *See also e.g. America Online, Inc. v. Johuanthan Invs., Inc.*, WIPO Case No. D2001-0918 (September 14, 2001) § 6 (finding “aollnews.com” to be confusingly similar with “AOL” trademark); *Humana Inc. v. Cayman Trademark Trust*, WIPO Case No. D2006-0073, §6A (where different or repeated character “does not significantly affect the appearance or pronunciation of the domain name” the domain name is considered to be “virtually identical and/or confusingly similar mark to the Complainant’s trade-mark”).

This is especially true where the change does not avoid phonetic and visual similarities, as is the case here. *See e.g. Kühne + Nagel International AG v. Donald Cross*, Case No. D2006-1103, § 6A (finding that “a” instead of “e” in “nagel”, the transcription of “ü” in “ue” is common and phonetically irrelevant and does not avoid a confusing similarity of the signs, neither in an optical nor a phonetical respect); *Sharman License Holdings, Limited v. Gregg Smitherman*, Case No. D2004-0375, §6A (finding confusion based on phonetic similarity).

Here, replacement of the “w” in Complainant’s Qwalify Trademark with a “u” in the www.qualify.com domain name still results in a confusingly similar use as the two words are phonetically identical. Moreover, the domain name exploits the likelihood that users who are looking for Complainant’s website, or third parties who are writing about or describing Complainant’s website, will spell “QWALIFY” with a “u”, thus pointing to Respondent’s website instead of Complainant’s. This type of confusion is more than likely, it is already happening. By way of example, in a recent profile on Complainant, the writer mistakenly pointed readers to the Respondent’s URL when it mis-spelled Complainant’s website as “www.qualify.com.” A true and correct copy the profile on Complainant, which mis-spelled Complainant’s URL as **Annex 10** is annexed hereto.

Additionally “[t]he addition of .com is not a distinguishing difference.” *Oxygen Media, LLC v. Primary Source*, WIPO Case No. D2000-0362 (June 19, 2000) § 6A; *Pandora Jewelry, LLC v. Whois Privacy Protection Service, Inc. / naiyang ren*

Case No. D2010-1841, §6A (“it is well-established in previous UDRP decisions that the generic top level domains such as “.com”, “.org”, “.net”, etc., are to be disregarded”).

The Qwalify Trademark and Respondent’s domain name www.qualify.com still look and sound alike. *Lilly ICOS LLC v. Jason Kleiner*, Case No. D2006-0563, §6A (differences are immaterial to confusingly similar standard where domain name and trademark still look and sound alike). As such the domain name is confusingly similar to the Qwalify Trademark, and Complainant’s legitimate URL, in which Complainant has rights.

B. The Respondent has no rights or legitimate interests in respect of the domain name.

Respondent has no rights or legitimate interests in the domain name. The facts here demonstrate that Respondent is not using, or planning to use, the domain name in connection with a *bona fide* offering of goods and services. To the contrary, Respondent has parked the domain name www.qualify.com, to reap the financial benefits of pay per click advertising until the domain name can be sold. True and correct copies of screenshots of the parked domain name www.qualify.com are annexed hereto as **Annex 5** (with “For Sale” banner on the upper right hand corner).

So far as “domain name parking is concerned”, it is now well-known how these sorts of services operate. A domain name owner “parks” the domain name with a domain name parking service provider. The service provider then generates a page that incorporates sponsored links or links to sponsored links. When an Internet user clicks on these sponsored links, the entity sponsoring that link will make a payment. This “click through revenue” is then ordinarily split between the domain name parking service provider and the owner of the domain name. *See Paris Hilton v. Deepak Kumar*, Case No. D2010-1364, §6.11 (citing *Owens Corning v. NA*, WIPO Case No. D2007-1143). Previous panels have held that where a respondent is merely parking a domain name until it can be sold and gives the parking company free reign over the content, that this weighs in favor of a finding that the Respondent has no legitimate rights or interests in the domain name. *See e.g. Express Scripts, Inc. v. Windgather Investments Ltd. / Mr. Cartwright*, Case No. D2007-0267, §6.15-1.16.

Here, the only content on the website to which the disputed domain name points are pay per click links that re-direct users to other online locations. Respondent is utilizing the services of a company by the name of DomainSponsor.com to park the

domain name until it can be sold and is allowing the parking company free reign over the content. Typically such a use does not support a finding of a *bona fide* offering of goods or services and is not a fair use of the disputed domain name. A true and correct copy of the Domain Sponsor Legal Policies, which appears when you click on the “Privacy Policy Legal Policies” link at the bottom of the page www.qualify.com, is annexed hereto as **Annex 6**. Additionally true and correct copies of screenshots from the domainsponsor.com website, including the page advertising the same page landing that Respondent is using, are annexed hereto as **Annex 7**.

In responding to this Complaint, any argument that since “qualify” is a dictionary word, use of the domain name www.qualify.com as a parking page has given Respondent a legitimate interest in the domain name, is without legal or factual support. While there are limited instances where it would be possible for a parking page to constitute a permissible use i.e. where a domain name consisting of a common word support posted pay-per click links genuinely related to the common meaning of the domain name at issue, Respondent’s page here does not contain any such links. *See* WIPO Overview 2.6 (where PPC links are genuinely related to meaning of domain name, it may be permissible use). Unlike those examples, Respondent’s links are wholly unrelated to the common meaning of the word “qualify” instead the posted links redirect users to online games, wrestling classes, kids games and even Chuck E Cheese’s website. *See Annex 5*.

Where posted links on a parking page are not related to the meaning of the domain name, pay per click links cannot satisfy the requirement for legitimate use. To the contrary, such use generally supports the inference that Respondent has no legitimate interest. *See Compart AG v. Compart.com / Vertical Axis, Inc.*, Case No. D2009-0462 §6B (holding that “the mere fact that a word identical to the Domain Name exists as a defined dictionary term does not give rise to any rights or legitimate interests in the name on the part of a respondent who uses it in ways like this that are not tied to the meaning of that word” finding that respondent had not shown rights or legitimate interests in the domain name where advertisements is not related to the meaning of common word); *Express Scripts, Inc. v. Windgather Investments Ltd. / Mr. Cartwright*, Case No. D2007-0267, §6.15-1.16.

Moreover, given that Respondent is diverting consumers to the parked website for commercial gain through pay-per click advertisement, the use cannot be considered fair or non-commercial. *Lardi Ltd v. Belize Domain WHOIS Service Lt.*, Case No. D2010-1437, §6A (holding that parking page was not *bona fide* offering of goods and services and use was not fair use of domain name).

Complainant has not given Respondent any right or license to utilize its Qwalify Trademark. In addition to the above Respondent is not commonly known by the name “QUALIFY”, nor has Respondent utilized the name “QUALIFY” in a matter to otherwise acquire any trademark rights therein.

As set forth above, the circumstances here very clearly support the finding that Respondent has no right or legitimate interest in the domain name.

C. The domain name(s) was/were registered and is/are being used in bad faith.

All of the evidence available here further leads to the conclusion that the domain name www.qualify.com was registered in and is being used in bad faith by the Respondent.

First, there are numerous facts that indicate that the domain name was recently registered or acquired by Respondent primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to either the Complainant or to a competitor of the Complainant, for valuable consideration far in excess of any out of pocket costs directly related to the domain name. Respondent acquired ownership of the domain name sometime between March and May of 2012,² which is after Complainant first acquired rights in and to the Qwalify Trademark through its use. **See Annex 1.**

Respondent was clearly aware of Complainant at the time it registered the domain name. Complainant has been using the Qwalify Trademark since at least August of 2010. Complainant filed its application for registration of Qwalify Trademark with the USPTO in March of 2012, around the exact same time that Respondent applied for registration of the URL www.qualify.com. *See e.g. American Funds Distributors, Inc. v. Domain Administration Limited*, Case No. D2007-0950 (even if Respondent did not have actual notice it had constructive

² As noted above the last updated information indicates that the domain was transferred sometime between March-May of 2012. “[A] transfer of a domain name is held to be a new ‘registration’ such that the good faith of the registration must be evaluated as of the date of the transfer.” *Octogen*, Case No. D2009-0786, §6(D).

notice based the extensive prior use of name and the fact that it comprises the dominant part of registered trademark).

Additionally, when Respondent registered the domain name it knew or should have known about Complainant through basic inquiries in a search engine or trademark database.

At the time the domain name www.qualify.com was registered the Qwalify Trademark was in wide use on the internet. As noted in numerous decisions and the Policy itself, when a person registers a domain name they are required to “represent and warrant . . . that . . .(b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party . . . It is your responsibility to determine whether your domain name registration infringes or violates someone else’s rights.” See Policy, §2. This imposes that the registrant make some good faith effort to avoid registering and using domain names that correspond to trademarks in violation of the Policy. See *Aspen Holdings Inc. v. Rick Natsch, Potrero Media Corporation*, Case No. D2009-0776 (“The Panel notes that paragraph 2 of the Policy implicitly requires a registrant to make some good faith effort to avoid registering and using domain names corresponding to trademarks in violation of the Policy”); *BzzAgent, Inc. v. bzzaget.com c/o Nameview Inc. Whois IDentity Shield and Vertical Axis*, Case No. D2010-1187 (“the onus is on the respondent to make the appropriate enquiries to ensure that the registration of the domain name does not infringe or violate third party rights.”). Here there can be no doubt that had Respondent made such an effort, as is its obligation, that it would have found Complainant’s Qwalify Trademark.

Here, as set forth in further detail below, the Respondent is targeting US buyers for its URL. See **Annex 8** requesting bids in US dollars; **Annex 5** using English ads for US companies such as ChuckE Cheese. The fact that Respondent acquired the domain name for sale between March and May of 2012, the same time that Complainant filed its trademark application for “QWALIFY”, raises the inference that Respondent did a search and knew about Complainant, but registered the domain name anyway for the purposes of selling it to Complainant for sums of money above and beyond its out of pocket costs.

Complainant’s use of “Qwalify” would have been known had Respondent done a simple search engine search. Complainant has expended significant time and resources on widespread internet advertising. Among other things Complainant

maintains a variety of online properties including, a website, a blog, a Twitter feed, a Facebook page, a Youtube Channel and others. *See Annex 11* (true and correct copies of various online properties maintained by Complainant for the purposes of advertising and promoting its services).

In addition, since 2010 Complainant has been the subject of many news articles, television interviews, magazine articles, press releases, conference panelists etc, including but not limited to the Wall Street Journal, the Huffington Post, Metro, CTV News interview, the Verge, TechVibes, itBusiness, Business News Network, The Globe and Mail, CBC Interview on the Lang and O’Leary Exchange, Exchange Magazine, BYOB Book.com, and the Record’s Technology Spotlight, just to name a few. Complainant has also received press attention for its attendance at various conferences as well as its partnerships and investors. Attached hereto as **Annex 9** are copies of evidence of various press clippings, news coverage, news articles, interviews, blog postings and other documents evidencing media coverage of Complainant.

Given the widespread media coverage and advertising efforts beginning in 2010, there can be no doubt that had Respondent done any inquiry it would have been aware of Complainant’s trademark rights in QWALIFY prior to its registration of the domain name. In fact, when you do a google search for “qualify.com,” the domain name Respondent should have looked into, Google asks if you meant “qwalify.com” (Complainant’s website). *See Annex 12* (a copy of the Google results for the search “qualify.com” asking “Did you mean: qwalify.com”). Respondent was, or should have been aware, by virtue of doing basic research, such as search engine or trademark database searches, that it was infringing on Complainant’s rights.³

Despite the fact that Respondent was aware, it registered the domain name and is now trying to sell the domain name for far more than any out of pocket costs it could have incurred. Previously, the www.qualify.com website landing page indicated that it was for sale and stated that the owner was not accepting bids below two hundred thousand US Dollars (\$200,000.00). Now there is a banner across the

³ Alternatively, Respondent’s failure to engage in any good faith inquiry, such as search engine or trademark searches, also supports a finding of bad faith here. *See BzzAgent, Inc.*, Case No. D2010-1187 (“lack of any good faith attempt to ascertain whether or not the Disputed Domain Name was infringing someone else’s trademark, such as by conducting trademarks searches or search engine searches, supports a finding of bad faith” (citing *Mobile Communication Service Inc. v. WebReg*, RN, WIPO Case No. D2005-1304)).

parking page indicating that the web site is “For Sale”. *See Annex 5* (“For Sale” advertisement across the upper right hand corner of the web page). When the banner is clicked on, the visitor is re-directed a page on perfectname.com offering qualify.com for sale (<http://www.perfectname.com/domains/index.php?domain=qualify.com>) and encouraging the visitor to use the below form to make an offer in US Dollars.⁴

Through its attorneys, Complainant attempted to ascertain the current price for the www.qualify.com domain name by utilizing Respondent’s bidding page. Initially, Complainant entered \$20.00. A true and correct copy of the screenshots evidencing this process are annexed hereto as **Annex 8**. The first entry was immediately rejected with a message that “the owner has already turned down an offer for qualify.com higher than your \$20.00 offer. Your offer will not be submitted to the owner.” *See Annex 8*. Complainant then entered \$100.00. Again this entry was immediately rejected with a message instructing the visitor to:

make one offer of what Qualify.com is worth to you. Then if Qualify.com is worth more to you than it is worth to the owner, you will be successful. Making multiple incremental offers makes you appear not to be serious.

See id. Complainant then entered \$1,000, which was also summarily rejected with a message saying “you can make one more offer. Give it your best shot.” *See id.* Complainant then entered \$5,000, which was summarily rejected and then the visitor is immediately taken to a page listing the top domain sales chart highlighting alleged recent sales of other domain names for hundreds of thousands of dollars. There is no way Respondent incurred out of pocket costs in the amounts of hundreds of thousands of dollars. It is clear that Respondent acquired the domain name www.qualify.com for the purpose of selling, renting or transferring it to Complainant or one of its competitors in the United States, the only persons who would pay such excessive monetary sums.

Second, the facts here also demonstrate that Respondent likely registered the domain name to prevent Complainant from having it. The date Respondent acquired the domain name www.qualify.com is years after Complainant acquired common law rights in and to its Qwalify Mark through its use in August of 2010 and is around the

⁴ The links on the landing page and the fact that Respondent is requesting bids in “USD” is evidence that Respondent is targeting US trademark rights holders and companies.

same time that Complainant filed its trademark application. These facts support the conclusion that Respondent registered the domain name to prevent Complainant from having the domain name.

Third, there is further evidence that Respondent is currently using the domain name in an attempt to attract users to its website for its own commercial gain by creating a likelihood of confusion with Complainant's Qwalify Trademark. Respondent's domain name is virtually identical to Complainant's Qwalify Trademark. Respondent has parked the page as a landing site for paid advertising in the hopes that third parties will misspell the Qwalify Trademark when they are looking for Complainant, and land on Respondent's page. The more people that navigate to Respondent's page and click on any of the links contained thereon, the more revenue Respondent can generate through the pay per click advertising. There is no question that Respondent is intentionally trying to attract internet users to its site for its own commercial gain by exploiting the likelihood of confusion with the Qwalify Trademark. Such confusion is already taking place, and Respondent is commercially benefiting from it. *See e.g. Annex 10* (copies of a profile of Complainant's company that accidentally mis-spelled the URL for Complainant's website and pointed interested third parties to www.qualify.com).

In responding to this Complaint, Respondent may try to present evidence that its state of mind at the time of the registration was not "in bad faith." But this argument would not change the outcome here. As set forth above, had Respondent conducted a basic search of a search engine or the USPTO trademark database, the market Respondent is targeting, it would have been aware of Complainant's Qwalify Trademark. Its knowledge of this fact or failure to make basic inquiries in good faith is evidence of registration in bad faith.

In addition, Complainant has presented ample evidence of Respondent's ongoing use of the domain name in bad faith, and as such no matter what its state of mind was, Respondent's registration should be deemed to have occurred "in bad faith".

Under paragraph 4(b)(iv) of the Policy a respondent that uses the domain name to attract Internet users to its website or online location by creating a likelihood of confusion with the complainant's mark and its sponsorship of the website is acting in bad faith, without reference to the respondent's state of mind at the time that the registrant registered the domain name. *Octogen*, Case No. D2009-0786, §6(D).

Where Complainant demonstrates bad faith passive use and use that is intended to attract internet users to Respondent's website by creating a likelihood of confusion with Complainant's Qualify Trademark, the registration can be deemed to have occurred in bad faith. *See Octogen*, Case No. D2009-0786, §6(D) ("bad faith registration can be deemed to have occurred even without regard to the state of mind of the registrant at the time of registration, if the domain name is subsequently used to trade on the goodwill of the mark holder, just as bad faith use can occur without regard to the fact that the domain name at issue has not been (or has been 'passively') used.").

Under the above precedent, regardless of Respondent's actual state of mind at the time of registration, the registration should be deemed to have occurred in bad faith. Respondent is utilizing the domain name to trade on the goodwill of the legal mark holder, Complainant, by exploiting the likelihood that users will spell Qualify with a "u" instead of a "w" (a common and identical phonetic spelling) for its own commercial gain. Respondent is currently using the domain name in bad faith and as such, its registration is deemed to have occurred in bad faith.

Additionally, Respondent's use in violation of Complainant's trademark rights violates Respondent's representations and warranties and as such voids its right to maintain the domain name registration for www.qualify.com. As noted in *Octagen*, Section 2 of the Policy requires ongoing representations, namely that

by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that . . . (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights.

In *Octagen*, the Panel held that:

this provision not only imposes a duty on the part of the registrant to conduct an investigation at the time of registration, but also includes a representation and warranty by the registrant that it will not now or in the future use the domain name in violation of any laws or regulations. This effectively imposes on the registrant a continuing duty to ensure that the domain name is not used in violation of another's rights and clearly covers intellectual property rights and the laws protecting them, including copyright and trademark. This representation and warranty is not limited to the moment at which the registrant registers the domain name; rather, it extends to any use of the domain name in the future. This obligation is an integral part of the Policy, and it cannot be ignored. A party can register or acquire a

domain name in good faith, yet use the domain name in the future in such a way that the representations and warranties that the registrant made as of the time of registration are violated. If a party uses the domain name in the future so as to call into question the party's compliance with the party's representations and warranties, this may be deemed to be retroactive bad faith registration.

See id. §6(D). Here, as set forth above, Respondent is violating this ongoing obligation, which voids its right to maintain ownership of the domain name at issue.

Respondent has a history of bad faith registrations which reinforces the same inference here. In a recent decision against this Respondent, *Hoffmann-La Roche Inc. v. Fundacion Private Whois*, Case No. D2012-0909, the panel held that:

[T]he fact the Respondent was involved in a various other UDRP proceedings (F. Hoffmann-La Roche AG v. Fundacion Private Whois, WIPO Case No. D2012-0754; BJ Acquisition, LLC v. Fundacion Private Whois, WIPO Case No. D2012-0755; Belstaff S.R.L. v. Fundacion Private Whois, WIPO Case No. D2012-0796; Seiko Holdings Kabushiki Kaisha (trading as Seiko Holdings Corporation) v. Fundacion Private Whois, Domain Administrator, WIPO Case No. D2012-0810; F. Hoffmann-La Roche AG v. Fundacion Private Whois, Domain Administrator, WIPO Case No. D2012-0822; Red Bull GmbH v. Fundacion Private Whois, WIPO Case No. D2012-0842; LEGO Juris A/S v. Howtogetrealmoneyonline.com, WIPO Case No. D2012-0832; Hoffmann-La Roche Inc. v. Fundacion Private Whois, Domain Administrator, WIPO Case No. D2012-0967, Hoffmann-La Roche Inc. v. Fundacion Private Whois, Domain Administrator, WIPO Case No. D2012-0981; Inter-Continental Hotels Corporation v. Fundacion Private Whois Domain Administrator and PPA Media Services; Inter-Continental Hotels Corporation v. Fundacion Private Whois Domain Administrator and PPA Media Services, WIPO Case No. D2012-1095; and Canadian Tire Corporation, Limited v. Private Whois Service / Fundacion Private Whois, WIPO Case No. D2012-1026), in which panels found that the Respondent had registered and used domain names in bad faith, reinforces an inference of bad faith.

Here there is clear evidence that the domain name was registered and is currently being used in bad faith and as such should be transferred to Complainant.

VII. Remedies Requested

13. In accordance with Paragraph 4(i) of the Policy, for the reasons described in Section VI. above, the Complainant requests the Administrative Panel appointed in

this administrative proceeding that www.qualify.com be transferred to the Complainant.

VIII. Administrative Panel

14. The Complainant elects to have the dispute decided by a single-member Administrative Panel.

IX. Mutual Jurisdiction

15. In accordance with Paragraph 3(b)(xiii) of the Rules, the Complainant will submit, with respect to any challenges that may be made by the Respondent to a decision by the Administrative Panel to transfer or cancel the domain name(s) that is/are the subject of this Complaint, to the jurisdiction of the courts at the location of the principal office of the concerned registrar.

X. Other Legal Proceedings

16. To the Complainant's knowledge, no other legal proceedings have been commenced or terminated in connection with or relating to the domain name that is the subject of the Complaint.

XI. Communications

17. A copy of this Complaint, together with the cover sheet as prescribed by the Supplemental Rules, has been sent or transmitted to the Respondent on February 28, 2014 by electronic mail to 522738792khq5w1v@5225b4d0pi3627q9.privatewhois.net, the email address on file with the Registrar's WhoIs Database, in accordance with paragraph 2(b) of the Rules.
18. A copy of this Complaint has been sent or transmitted to the concerned registrar on February 28, 2014 by electronic mail to abuse@internet.bs, contact-en@internet.bs, Italiano: contact-it@internet.bs, contact-fr@internet.bs, contact-es@internet.bs, and contact-de@internet.bs.

19. This Complaint is submitted to the Center in electronic form, including annexes, in the appropriate format.

XII. Payment

20. As required by the Rules and Supplemental Rules, payment in the amount of USD \$1,500 has been made by credit card.

XIII. Certification

21. The Complainant agrees that its claims and remedies concerning the registration of the domain name, the dispute, or the dispute's resolution shall be solely against the domain name holder and waives all such claims and remedies against (a) the WIPO Arbitration and Mediation Center and Panelists, except in the case of deliberate wrongdoing, (b) the concerned registrar(s), (c) the registry administrator, (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents.

22. The Complainant certifies that the information contained in this Complaint is to the best of the Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under the Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Dated: New York, New York
February 28, 2014

ADELMAN MATZ P.C.

By: :
Sarah M. Matz, Esq.
1173A Second Avenue, Suite 153
New York, New York 10065
Tel: (646) 650-2207
Email: sarah@adelmanmatz.com
Attorneys for Complainant

XIV. List of Annexes

- Annex 1 – True and correct copies of printout of 2/24/14 Whois search for www.qualify.com and printout of historical Whois Records from DomainTools.com for ownership of www.qualify.com on March 1, 2012 and May 15, 2012.
- Annex 2 – A true and correct copy of the Registration Agreement for www. Internet.bs.net.
- Annex 3 – A true and correct copy of the Certificate of Registration for “QWALIFY” from the United States Patent and Trademark Office.
- Annex 4 – True and correct copies of screenshots from Complainant’s website, samples of marketing material, and screenshots of Complainant’s services, depicting use of the Qwalify Trademark.
- Annex 5 – True and correct copies of screenshots of landing page for www.qualify.com as taken on 2/2/14 and 2/9/14 depicting Respondent’s use of the parked domain name.
- Annex 6 – A true and correct copy of the DomainSponsor Legal Policies that is linked to Respondent’s page www.qualify.com under the heading “Privacy Policy Legal Policies”.
- Annex 7 – True and correct copies of screenshots from www.domainsponsor.com.
- Annex 8 – True and correct copies of screenshots evidencing the bidding process for www.qualify.com as taken on February 8, 2014.
- Annex 9 – True and correct copies of news articles, press releases and other media concerning Complainant.
- Annex 10 – A true and correct copy of an article from Technology Directory 2013 concerning Complainant pointing readers to www.qualify.com.
- Annex 11 – True and correct copies of screenshots from Complainant’s online properties including its blog located at www.qwalify.org/blog, its Twitter page and its Facebook page.
- Annex 12 – A true and correct copy of a screenshot of a Google search for www.qualify.com asking “Did you mean: qwalify.com”.