

ADMINISTRATIVE PANEL DECISION

Xactware Solutions, Inc. v. Charles Christmas Case No. D2023-0376

1. The Parties

The Complainant is Xactware Solutions, Inc., United States of America (“United States”), represented by McCarter & English, LLP, United States.

The Respondent is Charles Christmas, United States.

2. The Domain Names and Registrar

The disputed domain names <xactamates.com>, <xactestimate.com>, and <xactmates.com> are all registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 27, 2023. On January 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 30, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 31, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on February 5, 2023.

The Center verified that the Complaint together with the amended 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 February 7, 2023. In accordance with the Rules, paragraph 5, the initial due date for Response was February 27, 2023. The Respondent did not submit any formal response, however sent informal communication emails on February 3, and 7, 2023. The proceedings then were suspended on February 10, 2023. However, upon the request of the Complainant, they were

re-instituted afterwards on March 4, 2023. Accordingly, the Center notified the commencement of panel appointment process on March 24, 2023.

The Center appointed Evan D. Brown as the sole panelist in this matter on March 29, 2023. 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 provides computer software solutions for professionals involved in estimating and managing phases of building, restoration and repair. The Complainant owns the mark XACTIMATE which it uses in connection with computer programs. The mark is registered in several countries, including the United States (e.g., Reg. No. 1,816,735, registered on January 18, 1994).

According to the Whois information, the three disputed domain names were registered on October 15, 2022. The Complainant asserts that at the time of the registration of the disputed domain names, the Respondent was a licensee well-trained in and authorized to use the Complainant's software. The Respondent used the disputed domain names to resolve to pay-per-click sites providing sponsored links along with an option for a user to attempt to acquire the disputed domain names.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain names are identical or confusingly similar to the Complainant's trademark; that the Respondent has no rights or legitimate interests in respect of the disputed domain names; and that the disputed domain names were registered and are being used in bad faith.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions, however in his informal communication dated February 7, 2023, he shared his settlement intention.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights, (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names, and (iii) the disputed domain names have been registered and are being used in bad faith. The Panel finds that all three of these elements have been met in this case.

A. Identical or Confusingly Similar

This element requires the Panel to consider two issues: first, whether the Complainant has rights in a relevant mark; and second, whether the disputed domain names are identical or confusingly similar to that mark. This element under the Policy functions primarily as a standing requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde*

Nast S.A. v. Voguechen, WIPO Case No. [D2014-06657](#). The Complainant has demonstrated its rights in the XACTIMATE mark by providing evidence of its trademark registrations.

The disputed domain names are confusingly similar to the XACTIMATE mark. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. [WIPO Overview 3.0](#), section 1.7. In some cases, such assessment may also entail a more holistic aural or phonetic comparison of the complainant's trademark and the disputed domain name to ascertain confusing similarity. *Id.* The disputed domain names meet this test. The sound, appearance and connotation of each the disputed domain names – particularly in how they play on the notions of being “exact” in the process of generating an “estimate,” demonstrate a confusing similarity.

The Complainant has established this first element under the Policy.

B. Rights or Legitimate Interests

The Panel evaluates this element of the Policy by first looking to see whether the Complainant has made a *prima facie* showing that the Respondents lack rights or legitimate interests in respect of the disputed domain names. If the Complainant makes that showing, the burden of production of demonstrating rights or legitimate interests shifts to the Respondents (with the burden of proof always remaining with the Complainant).

On this point, the Complainant asserts, among other things, that (1) there is no evidence of the Respondent's use of, or demonstrable preparations to use, the disputed domain names in connection with a *bona fide* offering of goods or services, (2) to the best of the Complainant's knowledge, the Respondent has never been known by the disputed domain names, (3) the Respondent is not making a legitimate noncommercial or fair use of the disputed domain names, and (4) the end user license agreement the Respondent entered into with the Complainant at the time he registered the disputed domain names prohibited the registration of any designation, name or mark which is the same or similar to the Complainant's mark

The Panel finds that the Complainant has made the required *prima facie* showing. The Respondent has not presented evidence to overcome this *prima facie* showing. And nothing in the record otherwise tilts the balance in the Respondent's favor.

Accordingly, the Panel finds that the Complainant has established this second element under the Policy.

C. Registered and Used in Bad Faith

As discussed above, it is clear that the Respondent knew of the Complainant and its marks when it registered the disputed domain names. The Respondent did not provide any reason for the registration of the disputed domain names. Particularly when paired with how the Respondent used the disputed domain names to attract visitors to revenue-generating advertisements, and to seek to sell the disputed domain names, it appears that the Respondent registered the disputed domain names in bad faith. Bad faith use is shown from those activities of using the disputed domain name to present pay-per-click links for commercial gain. The fact that the Registrar or a third party may generate such content on the website at the disputed domain name (e.g. the pay-per-click links), or that the Respondent itself may not have directly profited, does not prevent a finding of bad faith.

For these reasons, the Panel finds that the Complainant has successfully met this third element.

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 names, <xactamates.com>, <xactestimate.com> and <xactmates.com>, be transferred to the Complainant.

/Evan D. Brown/

Evan D. Brown

Sole Panelist

Date: April 13, 2023