

ADMINISTRATIVE PANEL DECISION

Steinberg Media Technologies GmbH v. Privacy Service Provided by
Withheld for Privacy ehf / Ghulam Muhuddeen
Case No. D2022-0427

1. The Parties

Complainant is Steinberg Media Technologies GmbH, Germany, represented by Raffay & Fleck Patentanwälte, Germany.

Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Ghulam Muhuddeen, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <vstcrackweb.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 8, 2022. On February 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 8, 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 and contact information in the Complaint. The Center sent an email communication to Complainant on February 9, 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 February 9, 2022.

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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on February 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 16, 2022. Respondent sent informal communications to the Center on February 9, 2022, and on February 21, 2022. Respondent did not submit any formal response. Accordingly, the Center notified the Parties that it would proceed to panel appointment on March 17, 2022.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on March 28, 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 in various jurisdictions for the word trademark VST, including at the European Union Intellectual Property Office (“EUIPO”), registration number 000763367, registration dated March 16, 1999, in international classes (“ICs”) 9 and 42, covering computer programs on data carriers and computer programming; registration number 018015975, registration dated May 16, 2019, in IC’s 9, 15, and 42, covering, *inter alia*, software, data processing equipment and accessories, and music software, musical instruments and software creation, and; other related VST-formative word trademarks. Complainant owns registration for the word service mark VST on the principal register of the United States Patent and Trademark Office (“USPTO”), registration number 2499337, registration dated October 23, 2001, in IC 35 and 42, covering *inter alia* computer software design for others, and; trademark registration number 5993900, registration dated February 25, 2020, in IC 9, covering, *inter alia*, downloadable computer plug-in interface software and recorded computer plug-in interface software for audio processing, transmission, recording and playback. Complainant has registered the word trademark VST under the Madrid System, International Registration Number 946646, registration dated November 23, 2007, in ICs 9 and 42, covering, *inter alia*, computer programs on data carriers.

Complainant develops, markets and distributes computer software used for audio recording and editing, including the widely-used Cubase program. Part of Complainant’s software offering is VST (an acronym for Virtual Studio Technology), an audio plug-in software interface. VST is used not only in association with Complainant’s audio recording and editing software, but it also is licensed to third-party developers and marketers of music software programs.¹

According to the Registrars’ verification, Respondent is registrant of the disputed domain name. According to an ICANN Lookup report furnished by Complainant, the record of registration of the disputed domain name was created on March 10, 2021.

Respondent has used the disputed domain name to direct Internet users to a web platform that appears to offer “cracked” free downloadable versions of Complainant’s VST program, as well as other well-known branded audio-related software programs. The term “cracked” is commonly understood to refer to computer software programs whose security features have been disabled to allow copying and use without authorization from the relevant intellectual property owner.² As of the date of this decision, the disputed domain name is redirected to another domain name associated with what appears to be the same downloadable “cracked” content.

¹ See, e.g., Wikipedia entry for Virtual Studio Technology, https://en.wikipedia.org/wiki/Virtual_Studio_Technology, visited by Panel, April 2, 2022.

² See, e.g., Wikipedia entry for “Software Cracking”, https://en.wikipedia.org/wiki/Software_cracking, visited by Panel, April 2, 2022.

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 an approved dispute resolution service provider, one of which is the Center, regarding allegations of abusive domain name registration and use (Policy, paragraph 4(a)).

5. Parties' Contentions

A. Complainant

Complainant asserts that it owns rights in the trademark VST and in other VST-formative trademarks.

Complainant argues that the disputed domain name is confusingly similar to its VST and VST-formative trademarks.

Complainant contends that Respondent lacks rights or legitimate interests in the disputed domain name because: (1) Respondent has not made use or preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services; (2) Respondent has not been commonly known by the disputed domain name; (3) Respondent is not making a legitimate noncommercial or fair use of the disputed domain name; (4) Respondent has not made any other legitimate use of the disputed domain name.

Complainant asserts that Respondent registered and is using the disputed domain name in bad faith because: (1) Complainant's VST trademark is well-known by computer software developers and users; (2) distribution of "cracked" computer software constitutes bad faith, particularly as in this case where other unauthorized versions of well-known branded audio software are made available, and; (3) there is no discernible good faith aspect to Respondent's use of the disputed domain name.

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

B. Respondent

Respondent transmitted the following to the Center: "Hi Sir Please Send me You Softwares name i will Delete all Post my Site" [sic] on February 9, 2022, and "Please tell me Your Issue i will Solve Your all issue" on February 21, 2022. Respondent did not otherwise reply to Complainant's contentions.

6. Discussion and Findings

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 addresses provided in its record of registration. Courier delivery to the privacy service engaged by Respondent was successfully completed. It is not clear whether express courier delivery of the Complaint to Respondent was successfully completed. Respondent sent two email communications to the Center that indicates it received notice of the Complaint. 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; and
- (ii) 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.

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

A. Identical or Confusingly Similar

Complainant has provided substantial evidence of rights in the trademark VST, including by registration at the EUIPO, by registration at the USPTO, by registration as an International Trademark under the Madrid System, and by wide use in commerce, including electronic commerce (see Factual Background, *supra*). Respondent has not challenged Complainant's assertion of trademark rights. The Panel determines that Complainant owns rights in the trademark VST.

Complainant's VST trademark is incorporated in full as the initial term in the disputed domain name. This is sufficient to establish confusing similarity between the disputed domain name and Complainant's trademark within the meaning of the Policy. Respondent's addition of the terms "cracked" and "web" in the disputed domain name does not prevent a finding of confusing similarity. The Panel determines that the disputed domain name is confusingly similar to Complainant's VST trademark.

Complainant has established that it owns rights in the trademark VST and that the disputed domain names is confusingly similar 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 in section 5A, 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 substantively replied to the Complaint, and has not attempted to rebut Complainant's *prima facie* showing of lack of rights or legitimate interests.

Respondent's use of the disputed domain name to direct Internet users to a website that offers unauthorized downloading of well-known third-party computer programs, including Complainant's, from which security protections have been removed (*i.e.* "cracked" versions) does not establish rights or legitimate interests in favor of Respondent. It is neither a *bona fide* offering of goods or services nor a fair use of the disputed domain name or Complainant's trademark.

Respondent's use of the disputed domain names does not otherwise manifest rights or legitimate interests in the disputed domain name.

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

C. Registered and Used in Bad Faith

In order to prevail under the Policy, Complainant must demonstrate that the disputed domain name “has been registered and 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 that, “(iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent’s] website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the respondent’s] website or location or of a product or service on [the respondent’s] website or location”.

Respondent manifestly had actual notice of Complainant’s trademark rights when it registered and used the disputed domain name. The composition of the disputed domain name indicates Respondent registered the disputed domain name with Complainant’s trademark in mind. Unauthorized versions of Complainant’s software appear on Respondent’s website. Complainant’s VST trademark was used as the initial term in the header of Respondent’s website associated with the disputed domain name.

The specific mechanism by which Respondent may have profited from use of the disputed domain name is not clear from the record in this proceeding. Nonetheless, the express elements of paragraph 4(b) of the Policy are illustrative, not exhaustive, and the commercial harm done to Complainant and other software developers from Respondent’s making available of unauthorized versions of their products is sufficient to constitute bad faith use of Complainant’s trademark whether Respondent was and is acting for direct financial benefit or to promote visits to its website for some other purpose.

Respondent’s action constitutes intentionally using Complainant’s trademark in the disputed domain name for purposes of attracting Internet users to Respondent’s website by creating a likelihood of confusion as to Complainant’s affiliation with Respondent’s website. Such action by Respondent constitutes registration and use of the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

The Panel will direct the Registrar to transfer the disputed domain name to Complainant.

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, <vstcrackweb.com>, be transferred to Complainant.

/Frederick M. Abbott/

Frederick M. Abbott

Sole Panelist

Date: April 3, 2022