

ADMINISTRATIVE PANEL DECISION

Marcal Paper v. See PrivacyGuardian.org, Domain Administrator
Case No. D2023-3987

1. The Parties

Complainant is Marcal Paper, United States of America (“United States”), represented by Soteria LLC, United States.

Respondent is See PrivacyGuardian.org, Domain Administrator, United States.

2. The Domain Name and Registrar

The disputed domain name <marcalpapers.com> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 22, 2023. On September 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 25, 2023, the Registrar transmitted by email to the Center its verification response confirming that 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 Respondent of the Complaint, and the proceedings commenced on October 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 24, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 25, 2023.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on October 30, 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

Complainant is the owner of registration for the word trademark MARCAL on the Principal Register of the United States Patent and Trademark Office (USPTO), registration number 3,903,504, registration dated January 11, 2011, in international class 16, covering “paper products, namely, paper towels, bathroom tissues, facial tissues, facial napkins”. Complainant asserted first use and first use of its trademark in commerce in March 1938.

Complainant is a manufacturer of paper products, such as paper towels, paper tissues and paper napkins. It uses recycled paper products to protect the environment. Complainant primarily uses the identifier “MARCAL Paper” in commerce, and operates a commercial website at “www.marcaldpaper.com”.

According to the Registrar’s verification, Respondent is the registrant of the disputed domain name. The disputed domain name was registered on June 27, 2023. The Registrar did not disclose information regarding the identity of Respondent beyond the name of the name of the privacy service identified in its record of registration.

Respondent has used the disputed domain name as the email sender domain for messages transmitted to a third-party vendor of Complainant’s products, purportedly but falsely originating from Complainant, directing the vendor to make outstanding payments to a bank account that is not owned or controlled by Complainant (i.e., presumably controlled by Respondent). The fraudulent email transmitted by Respondent includes Complainant’s distinctive “MARCAL” logo and a link to Complainant’s commercial website. The only evidence on the record of this proceeding regarding Respondent’s use of the disputed domain name in connection with a website is a screenshot provided by the Center of a parking webpage that displays a seemingly random selection of German search terms.

5. Parties’ Contentions

A. Complainant

Complainant alleges that it owns rights in the trademark MARCAL and that the disputed domain name is confusingly similar to Complainant’s trademark.

Complainant contends that Respondent lacks rights or legitimate interests in the disputed domain name because: (1) Respondent is not affiliated with Complainant nor authorized to use Complainant’s trademark in the disputed domain name or otherwise; (2) Respondent has not been commonly known by the disputed domain name nor has it acquired trademark rights in MARCAL; (3) the disputed domain name is malicious and harmful to Complainant’s trademark.

Complainant argues that Respondent registered and is using the disputed domain name in bad faith because: (1) Complainant is one of the oldest tissue manufacturing companies in the United States, and by adopting the disputed domain name which is confusingly similar to Complainant’s trademark, Respondent demonstrates that it was aware of Complainant’s rights in its trademark; (2) the disputed domain name has been used by Respondent to engage in the transmission of deceptive emails intended to defraud a vendor of Complainant, and; (3) unless the disputed domain name is transferred, Complainant and its vendors will remain at substantial risk of further fraudulent activities by Respondent.

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

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

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)).

It is essential to Policy proceedings that fundamental due process requirements be met. Such requirements include that a respondent has 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 address provided in its record of registration. Courier delivery of the Written Notice to Respondent was not successfully completed because of inaccurate physical address information included in Respondent's record of registration. The record does not indicate the receipt status of email notifications. 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 the complainant has rights;
- (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.

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

A. Identical or Confusingly Similar

Complainant has provided evidence of rights in the trademark MARCAL through registration at the USPTO and through use in commerce. Respondent has not challenged Complainant's assertion of rights. The Panel determines that Complainant has established rights in the trademark MARCAL.

The disputed domain name directly and fully incorporates Complainant's distinctive MARCAL trademark. Such direct and full incorporation is sufficient to establish confusing similarity between Complainant's trademark and the disputed domain name for purposes of the Policy. Respondent's addition of the term "papers" to Complainant's trademark in the disputed domain name does not prevent a finding of confusing similarity. The Panel notes that Complainant typically adds the term "paper" to its MARCAL trademark.

The Panel determines that Complainant has established rights in the trademark MARCAL and that the disputed domain name 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, 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 replied to the Complaint and has not attempted to rebut Complainant's *prima facie* showing of lack of rights or legitimate interests.

Respondent has used the disputed domain name as the sender domain in email messages falsely purporting to originate from Complainant. Those email messages are an evident attempt by Respondent to fraudulently secure payments from Complainant's third-party vendor to accounts controlled by Respondent. Such use by Respondent does not constitute fair commercial use, or otherwise establish rights or legitimate interests on the part of Respondent.

Respondent's use of the disputed domain name in connection with a parking webpage that displays a few seemingly random German search terms does not establish rights or legitimate interests in favor of Respondent. This is effectively passive or "non-use" of the disputed domain name.

Respondent has not sought to challenge the evidence submitted by Complainant.

Respondent's actions do 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 registered and used the disputed domain name that is confusingly similar to Complainant's MARCAL trademark after Complainant acquired rights in its trademark, and after Complainant established a substantial online presence under its trademark. Respondent used Complainant's distinctive trademark and logo in its deceptive email scheme. This targeted use of Complainant's trademark indicates that Respondent knew or should have known of Complainant's trademark rights when it registered and used the disputed domain name.

Respondent has used the disputed domain name as the sender domain in emails falsely purporting to originate from Complainant. Such emails evidence a clear intent to defraud a third-party recipient and Complainant by providing banking information that is not associated with Complainant and its business, and requesting third-party payment to that account controlled by Respondent. Such activity by Respondent constitutes an intentional attempt to attract for commercial gain an Internet user to Respondent's online location by creating a likelihood of confusion with Complainant's mark as to Complainant's affiliation with Respondent's online location. Respondent's registration and use evidences bad faith within the meaning of paragraph 4(a)(iv) of the Policy.

The Panel determines that Complainant has established that Respondent registered and is using the disputed domain name in bad faith within the meaning 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, <marcalpapers.com>, be transferred to Complainant.

/Frederick M. Abbott/

Frederick M. Abbott

Sole Panelist

Date: November 13, 2023