

ADMINISTRATIVE PANEL DECISION

DataMotion, Inc. v. Emi Roberti, Data Motion
Case No. DAI2024-0035

1. The Parties

The Complainant is DataMotion, Inc., United States of America (“United States”), represented internally.

The Respondent is Emi Roberti, Data Motion, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <datamotion.ai> is registered with 1API GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 25, 2024. On April 26 and April 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 29 and 30, 2024, 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 1, 2024, 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 amendment to the Complaint on May 2, 2024, inserting the name of the registrant as identified by the Registrar as the Respondent.

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 the Respondent of the Complaint, and the proceedings commenced on May 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 28, 2024. The Response was filed with the Center on May 28, 2024. Prior to this, the Respondent had sent email communications to the Center on April 26, May 2, and May 24, 2024.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on June 14, 2024. 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 is an American company which provides a platform providing “secure, intelligent data exchange solutions”. According to its website at “www.datamotion.com”, the Complainant has some 2,000 customers with some 10 million active users.

According to the Complaint, the Complainant has been operating for over two decades. It has been the holder of the domain name <datamotion.com> since 1995. The website receives approximately 18,000 visits per month. The Complainant’s LinkedIn account has some two thousand followers. The Complainant has been rated by DirectTrust, HiTrust and TrustRadius as one of the most highly rated Health Information Service Providers and secure data exchange companies in healthcare and financial markets.

In addition to its operations in the United States, the Complaint also states that the Complainant has operations in Canada, the United Kingdom, and “Europe” through business relationships with major industry players in these countries.

The Complainant is the owner of United States Registered Trademark No. 3,991,552, DATAMOTION, which has been registered in the Principal Register since July 12, 2011 in respect of computer software for managing, tracking, filtering, auditing, securing and moving data over the internet; computer software for secure transmission, delivery and receipt of electronic data in International Class 9 and 42. The registration details claim a first use in commerce in October 2008.

The disputed domain name was registered on October 14, 2023.

The Respondent is the sole officer of a company incorporated in the United Kingdom, Data Motion Ltd, Company Number 12532421.¹ The Companies’ House details show that the company was incorporated and operated under the name EQB Group Limited from March 24, 2020 to October 20, 2023, when its name was changed to its current name. The Companies House details also record the Respondent’s occupation as “professional coach”.

The disputed domain name resolves to a website which appears to offer software development services related to security video cameras and management services. The website also offers, or appears to offer, “customized SaaS solutions”.

Before filing the Complaint, the Complainant had made a number of complaints about trademark infringement by the Respondent’s website to various service providers used by the Respondent including the Registrar and the webhosting service. At least one of these complaints led to the (as it turned out) temporary suspension of the Respondent’s website. When it was subsequently reinstated, the website had been modified to include a “support” email address and a LinkedIn account.

The Complainant’s attempts to press its allegations through communications to the contacts provided by the Respondent on the modified website have not elicited any response.

As is pointed out in the Response, a company apparently unrelated to both parties, Resonate Group Limited, owns United Kingdom Registered Trademark No. UK00003228729, DATAMOTION, in respect of a range of

¹ The Response includes a print-out from the Companies’ House registration for this company which shows only the overview. The overview provides that the address of the company’s registered office is the same as the Respondent’s address. The details of the company’s officers are available at “<https://find-and-update.company-information.service.gov.uk/company/1253242>”.

goods and services in International Classes 9, 35, 37, 39, and 42. These include computers and computer software for transport signalling control; design, installation, commissioning maintenance and repair for computer hardware and information systems for transport and associated activities. This trademark has been registered in the United Kingdom with effect from its filing date on May 3, 2017.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of a disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

In the present case, the Complainant has proven ownership of a registered trademark in the United States for DATAMOTION.

While the Respondent contends that the Complainant does not hold any registered rights in the United Kingdom, that misunderstands the nature of the inquiry at this stage under the Policy. It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties, the date they were acquired and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. All that is required at this stage, therefore, is simply a visual and aural comparison of the disputed domain name to the proven trademarks.

In undertaking that comparison, it is permissible in the present circumstances to disregard the country code Top-Level Domain ("ccTLD") component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the ".ai" ccTLD, the disputed domain name consists of the Complainant's registered trademark. Accordingly, the Panel finds that the Complainant has established that the disputed domain name is identical with the Complainant's trademark and the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

The Respondent registered the disputed domain name after the Complainant began using its trademark and also after the Complainant had registered its trademark.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

While the disputed domain name is not derived from the Respondent's name, it is the same as the name of the company which the Respondent adopted in October 2023 around the same time as the Respondent registered the disputed domain name. That, however, does not automatically confer rights or legitimate interests in the disputed domain name as the company's name was adopted after the Complainant began using its trademark and so could potentially have been adopted with knowledge of the Complainant's trademark and to take advantage of that fact.

Based on the limited information presented on the Respondent's website,² the Complainant contends that the Respondent is not engaged in a good faith offering of goods and services. For example, the Complainant contends:

“the Respondent presents little evidence of a bona fide offering, as the associated Website fails to showcase tangible products or services. Rather, it vaguely outlines potential offerings and lacks substantive proof of actual products. For instance, the Website does not provide details to its VMS Plug-in or AI solution service under its Services tab. The Website only states that these are the services provided. When a consumer visits the Website and clicks on the services, only a find out more button is presented that leads to a messenger window. On the other hand, the Complainant's website decisively states its various solutions, including financial services, healthcare, public sector, and mobile app with detailed descriptions of each solution and blogs containing information about these services.”

² Formally the Respondent and the company he incorporated are different legal persons but, as the Respondent either registered the disputed domain name on behalf of the company or permits it to use the disputed domain name, nothing turns on that distinction in this case.

and:

“It is imperative to include the LinkedIn page as part of this argument because it serves as a significant digital extension of the Respondent’s professional identity and business presence, being directly linked to the Website. Since there is a lack of legitimate business offerings on the Website, the Complainant believes it has established a lack of bona fide offering.”

It must be acknowledged that the Respondent’s website is comparatively rudimentary compared to the detailed and sophisticated information made available on the Complainant’s website. However, it does not necessarily follow from this that the Respondent is not making a good faith offering of goods or services. On the contrary, the Respondent has provided some evidence of some business associations with third parties.

The Complainant relies on a trademark registered in the United States only but does refer to providing services through business relationships with major industry players in the United Kingdom and Europe. It is possible that those activities have given rise to the Complainant having rights in DATAMOTION as an unregistered trademark in the United Kingdom and that those rights take precedence over any rights the Respondent and his company may have developed from their use. It is not possible to assess the extent to which that is the case on the evidence in this proceeding.

To an extent, it is arguable that the words “data” and “motion” in combination may have descriptive connotations in some contexts.

Moreover, the existing registered trademark held by Resonance Group Limited in the United Kingdom shows that the Complainant does not hold exclusive rights in “Data Motion” in the United Kingdom for all purposes.

While there is arguably an overlap, or potential overlap, between the services of the respective parties, it is not clearly apparent that is necessarily the case. For example, the Respondent’s security video camera management solutions do not at least on their face appear to conflict with the Complainant’s data services. On the other hand, the Respondent’s website also refers to the Respondent providing customised Software as a Service (SaaS) solutions which may conflict.

All of these factors lead the Panel to conclude that the Complainant has not established that the Respondent has no rights or legitimate interests in the disputed domain name. The dispute between the parties, at least on the record presented in this case, appears to be more properly characterised as a trademark dispute, or a trademark priorities dispute, rather than the kind of cybersquatting conduct the Policy is directed against.

Accordingly, the Panel finds the second element of the Policy has not been established.

C. Registered and Used in Bad Faith

As the Complaint must fail in any event, no good purpose would be served by addressing the third requirement under the Policy.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: June 26, 2024