

ADMINISTRATIVE PANEL DECISION

Datafield, Inc. v. Domains By Proxy, LLC / Itoro Etuks,
ETK Financial Corporation
Case No. D2022-0028

1. The Parties

Complainant is Datafield, Inc., United States of America (“United States”), represented by Porter Wright Morris & Arthur, LLP, United States

Respondent is Domains By Proxy, LLC / Itoro Etuks, ETK Financial Corporation, United States.

2. The Domain Name and Registrar

The disputed domain name <datafieldtechnology.com> (the “Domain Name”) is 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 5, 2022. On January 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 6, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email to Complainant on January 10, 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 January 11, 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 January 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 8, 2022. Respondent sent an informal email on February 14, 2022.

The Center appointed Robert A. Badgley as the sole panelist in this matter on February 21, 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.

On February 23, 2022, the Panel issued Procedural Order No. 1, stating in part as follows:

“In view of the arguments raised by the Respondent in the informal email received on February 14, 2022, the Panel affords Respondent until March 2, 2022, to submit a Response.

Complainant is afforded five (5) calendar days after receipt by the Center of Respondent’s response, to respond thereto.”

Respondent filed nothing in response to Procedural Order No. 1.

4. Factual Background

According to the Complaint:

“Complainant was founded in 1989 in Worthington, Ohio, and started as a staffing company, with the sole purpose of providing local businesses with highly-skilled technical professionals. Complainant ultimately expanded to surrounding states and in 1996 began focusing on telecommunications design and engineering services. Currently, Complainant serves the United States’ largest telecommunications service providers, with over 180 professionals based at the corporate headquarters in Worthington, Ohio, in Complainant’s satellite office in Charlotte, North Carolina, and remotely throughout the United States.”

Complainant asserts that it provides services in all 50 states and has revenues of USD 20 million.

Complainant holds a registered trademark with the United States Patent and Trademark Office (“USPTO”) for the trademark DATAFIELD, USPTO Reg. No. 4,986,906, registered on June 28, 2016 in connection with telecommunications services, business auditing services, business consulting services, and related services, with a December 31, 1996 date of first use in commerce.

Complainant operates a commercial website at “www.datafieldusa.com”. At the website, Complainant extensively uses its registered trademark DATAFIELD, as well as DATAFIELD TECHNOLOGY SERVICES as an unregistered mark.

The Domain Name was registered on April 14, 2019. The Domain Name does not currently resolve to an active website. For a time, however, the Domain Name resolved to an active commercial website where Respondent advertised its purported services, including information technology (IT) project management, networking implementation, and business analysis. Respondent’s website used the terms DataField, DataFields, and DataField Technology interchangeably. The website contained claims that Respondent had business partnerships with many major IT companies, including Cisco, IBM, Dell, and HP.

On May 6, 2021, Complainant’s counsel sent a cease-and-desist letter to Respondent, asserting Complainant’s trademark rights and demanding that Respondent cease using the DATAFIELD and DATAFIELD TECHNOLOGY SERVICES marks on Respondent’s website. Complainant also demanded a transfer of the Domain Name. According to Complainant, Respondent did not reply to this cease-and-desist letter.

Respondent has not disputed any of the foregoing facts and allegations.

5. Parties' Contentions

A. Complainant

Complainant contends that it has proven all three elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent has not replied to Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the 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 Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the trademark DATAFIELD, through registration and use demonstrated in the record. The Panel finds the Domain Name to be confusingly similar to that mark. The DATAFIELD mark is entirely reproduced in the Domain Name, and the additional word "technology" does little or nothing to reduce the confusing similarity between the mark and the Domain Name. (The word "technology" is closely associated with many of the services that Complainant offers under its DATAFIELD mark.) The Panel need not make a finding on the claimed unregistered DATAFIELD TECHNOLOGY SERVICES mark.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

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

The Panel concludes that Respondent lacks rights or legitimate interests in the Domain Name. Respondent has not come forward to articulate or prove a *bona fide* reason for registering the Domain Name. It is undisputed that Respondent has no authority from Complainant to register the Domain Name. It is also undisputed that, for a time, Respondent used the Domain Name for a website which offered services which overlap with Complainant's trademarked services. The Panel finds that such use of Complainant's trademark does not invest Respondent with a legitimate interest in the Domain Name.

Complainant has established Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation”, are evidence of the registration and use of the Domain Name in “bad faith”:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith. Based on the undisputed record here and the nature of the services purportedly offered at Respondent’s website, the Panel finds it more likely than not that Respondent had Complainant’s DATAFIELD trademark in mind when registering the Domain Name.

With respect to bad faith use, the undisputed record here indicates that Respondent has used the Domain Name for commercial gain by offering services which, to some extent, overlap with and thereby compete with Complainant’s trademarked services. This conduct constitutes bad faith within the meaning of the above-quoted Policy paragraphs 4(b)(iii) and 4(b)(iv).

Complainant has established Policy paragraph 4(a)(iii).

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 Domain Name <datafieldtechnology.com> be transferred to Complainant.

/Robert A. Badgley/
Robert A. Badgley
Sole Panelist
Date: March 7, 2022