

ADMINISTRATIVE PANEL DECISION

Skillful Communications, Inc. v. Redacted for Privacy, Aquent / Aquent
Aquent, Aquent
Case No. D2022-0910

1. The Parties

Complainant is Skillful Communications, Inc., United States of America (“United States”), represented by Chipperson Law Group, P.C., United States.

Respondent is Redacted for Privacy, Aquent, France / Aquent Aquent, Aquent, United States, represented by Wolf, Greenfield & Sacks, P.C., United States.

2. The Domain Name and Registrar

The disputed domain name <skill.com> is registered with Gandi SAS (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 15, 2022. On March 16, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 17, 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 March 18, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on March 23, 2022.

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 Respondent of the Complaint, and the proceedings commenced on March 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 18, 2022. The Response was filed with the Center April 18, 2022.

The Center appointed Georges Nahitchevansky, Gregory N. Albright, and Richard G. Lyon as panelists in this matter on May 12, 2022. The Panel finds that it was properly constituted. Each member of 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, Skillful Communications, Inc., is a provider of interview and career-related training for both individuals and companies. Complainant has used the mark SKILLFUL in connection with its services since at least 2010, and perhaps as early as 2007, and the mark SKILL since April 2020. Complainant owns trademark registrations in the United States for its (i) SKILLFUL mark (Registration No. 5,035,949, which issued to registration on September 6, 2016 with a claimed first use date of January 1, 2010) and (ii) SKILL mark (Registration No. 6,312,168, which issued to registration on April 6, 2021 with a claimed first use date April 1, 2020). Complainant also owns the domain names <skillfullydone.com> and <skill.net>, among others, which it uses in connection with websites providing information concerning Complainant and its services.

Respondent is a staffing company and provider of temporary employees. Respondent's parent company is TRI Ventures, Inc, which was known as Laser Designs, Corp from 1986 to 1992, MacTemps, Inc. from 1992 to 1999, and Aquent, Inc. from 1999 to 2009. Respondent was founded in 2001 as a 99.8 per cent owned subsidiary of Aquent, Inc.

The disputed domain was originally registered on May 1, 1995, under the name of MacTemps, Inc.. When Mactemps, Inc. changed its name to Aquent, Inc. in 1999, the disputed domain became listed as owned by Aquent, Inc. At some point between October 22, 2007 and February 11, 2008, the disputed domain name was transferred from Aquent, Inc. to Respondent Aquent, LLC. In early 2021, the disputed domain name started to resolve to a website promoting a service called SKILL that provides a network of recruiters, boutique agencies and global search firms operated by a company called Scout Exchange LLC, a company under common ownership with Respondent.

Complainant through its counsel sent Respondent a demand letter on July 16, 2021 concerning its use of SKILL and the disputed domain name. Respondent, through counsel, responded to Complainant's letter on August 27, 2021. Respondent rejected Complainant's demands. The parties had further communication in the fall of 2021, but Respondent continued to reject Complainant's demands. The disputed domain name continues to resolve to a website promoting the services of Scout Exchange LLC.

5. Parties' Contentions

A. Complainant

Complainant contends that it has rights in the SKILL and SKILLFUL marks by virtue of its use and registration of those marks in connection with its services. Complainant argues that its rights arose in its SKILL and SKILLFUL marks "prior to the current user's use and/or acquisition" of the disputed domain name.

Complainant maintains that the disputed domain name is identical to its SKILL mark and confusingly similar to its SKILLFUL mark as the disputed domain name fully reproduces "SKILL" and omits the suffix "FUL."

Complainant asserts that Respondent has no rights or legitimate interests in the disputed domain name as any trademark rights Respondent could claim in "SKILL.COM" as a trademark were abandoned at least twenty years ago. Complainant notes that from 2000 through 2009, there was no active website at the disputed domain, but simply "a message stating that 'SKILL.COM has changed its name to Aquent,'" and that from 2009 through November 20, 2020, Respondent or its predecessor in interest, Aquent, Inc., merely used the disputed domain name as a redirect to a website at "www.aquent.com" (and for brief period of time

to "www.aquent.us"). Complainant further asserts that the disputed domain name was recently transferred to Scout Exchange, LLC, although the "Registrant information still appearing as Aquent," and that since then the disputed domain name has been used with a website that "mimics the color scheme of Complainant's website" and contains design and messaging elements that overlap with those of Complainant's website at <skillfullydone.com>. Complainant maintains that Respondent is using the disputed domain to misleadingly attract web users to a website operated by Respondent or its affiliates.

Lastly, Complainant argues that Respondent has registered and used the disputed domain name in bad faith. Complainant notes that the disputed domain was transferred by Aquent, Inc. to Aquent, LLC, a different corporate entity, at some point between October 22, 2007 and February 11, 2008. Such transfer according to Complainant created a new registration that occurred after Complainant developed trademark rights in the SKILLFUL mark. Complainant further argues that a second transfer, and new registration, of the disputed domain name occurred between November 29, 2020 and January 22, 2021, as between Aquent, LLC and Scout Exchange, LLC, although Respondent remains the listed registrant of the disputed domain name. Complainant also contends that Respondent, which also operates in the employment and recruitment industry, has used the disputed domain name in bad faith to misleadingly attract web users to its "strikingly similar" website and in violation of Complainant's rights in its SKILL trademark which arose in April 2020.

B. Respondent

Respondent rejects Complainant's contentions. Respondent maintains that Respondent, its parent company TRI Ventures, Inc. and its sister company Scout Exchange, LLC have each been in the business of matching employers and recruiters with job candidates since the 1980s and that this business predates Complainant's earliest trademark registrations or other alleged rights.

Respondent contends that the disputed domain name was registered in 1995 and that its subsequent transfer by TRI Ventures, Inc., then known as Aquent, Inc., to its subsidiary Respondent Aquent, LLC does not constitute a new registration as it was done in good faith in furtherance of a legitimate business purpose, namely, the matching of employers and recruiters with skilled employees. Respondent also contends that Respondent and its related companies have legitimately owned and used the disputed domain name since its initial registration in 1995 as part of their business. In that regard, Respondent notes that since early 2021 it has licensed the disputed domain name to its affiliated company Scout Exchange, LLC, which is also owned by their common parent company, TRI Ventures, Inc. Respondent denies that the disputed domain name was transferred to Scout Exchange, LLC, as Complainant contends, given that Aquent, LLC has remained the listed registrant for the disputed domain name since 2007.

Respondent argues that transfers of domain names among related entities do not normally constitute new registrations and that as such Respondent's registration of the disputed domain name goes back to 1995, a date well before Complainant acquired any trademarks rights in the SKILLFUL and SKILL marks. Respondent contends that based on such facts, Complainant has failed to prove bad faith registration.

Lastly, Respondent asserts that it has not used the disputed domain name in bad faith as Respondent has legitimately used the disputed domain name in connection with its business and because Complainant cannot monopolize the common English word "skill" which is used by many other parties.

C. Complainant's Supplemental Filing

On April 25, 2022, Complainant provided the Center with copies of further communications between the parties from October and November 2021. On October 15, 2021, Complainant responded to Respondent's rejection of its demands in its August 27, 2021 letter. On November 19, 2021, Respondent again rejected Complainant's demands.

The Panel has reviewed these letters and accepts them as part of the case file.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

These requirements are conjunctive; all must be satisfied. As the Panel finds that Complainant has not proven bad faith registration of the disputed domain name, the Complaint fails. For that reason the Panel need not address the first two requirements of Paragraph 4(a).

Under Paragraph 4(a)(iii) of the Policy, a complainant must establish the conjunctive requirement that the respondent registered and used the disputed domain name in bad faith. The assessment of whether a disputed domain name was registered in bad faith has to be assessed at the time of the registration (the “acquisition”, if later than the initial registration) of the disputed domain name. WIPO Overview at section 3.8.1.

In the instant case, the parties are in disagreement as to the date that should be used for the registration of the disputed domain name. While Complainant acknowledges that the disputed domain name was originally registered in 1995, Complainant contends that a new registration occurred when the disputed domain name was transferred from Aquent, Inc. to Aquent, LLC in late 2007 or early 2008. Complainant also contends that a further acquisition of the disputed domain name occurred more recently, in early 2021, when the disputed domain name started to be used in connection with a website operated by Scout Exchange, LLC that the Complainant asserts is competitive with its business.¹

Respondent, on the other hand, maintains that the disputed domain name has remained within the control of the same corporate group of businesses since 1995 and that, as such, the transfers do not constitute new registrations/acquisitions. Respondent also argues that the disputed domain has not been transferred to Scout Exchange, LLC, remains in the name of Respondent, and has only been licensed to Scout Exchange, LLC, an affiliate of Respondent under common control by their parent company TRI Ventures, Inc.

Reviewing the parties’ evidence, there is no dispute that the disputed domain name was originally registered to MacTemps, Inc in 1995 and that MacTemps, Inc. changed its name to Aquent, Inc. in March 1999. The evidence also shows that Aquent, Inc. transferred the domain name to Aquent, LLC, a 99.8 per cent owned subsidiary of Aquent, Inc., in late 2007 or early 2008. Lastly, the evidence also shows that the disputed domain name has remained in the name of Aquent, LLC since that time and that while the current usage of the disputed domain name is by Scout Exchange, LLC which is a sister company of Aquent, LLC that is 99.8 per cent owned by TRI Ventures, Inc. (formerly known as Aquent, Inc.), the disputed domain name remains in the name of Respondent Aquent.

Given these facts the question before the Panel is whether bad faith registration is to be considered at the date of the original registration in 1995, when Complainant owned no trademark rights, or when the registrant of record changed in late to 2007 or early 2008, or more recently when the disputed domain name resolved to a website operated by Scout Exchange, LLC.

¹ Complainant also invokes the long-discredited [see [WIPO Overview 3.0](#), section 3.2.1, 4] “retroactive bad faith” theory that bad faith in registration can be imputed from subsequent bad faith use as an alternative ground for finding bad faith in this case. For the reasons stated in *Validas, LLC v. SMVS Consultancy Private Limited*, WIPO Case No. [D2009-1413](#), and many other cases, the Panel adheres to Policy precedent by rejecting that approach. Registration in bad faith means bad faith at the date of registration.

When a domain name is transferred from one entity to an unrelated entity, the change in registrant is considered a new registration. [WIPO Overview 3.0](#) at section 3.9. However, while a transfer could result in a new registrant being listed, panels have recognized that where a respondent can provide satisfactory evidence of an unbroken chain of possession of the disputed domain name, such “formal” changes or updates to registrant contact information will not be treated as a new registration. This is often the case when a transfer is between entities within the same corporate control group and has been done for a legitimate business reason and not simply for purposes of evading a procedure. *Id.* and cases cited therein.

To be sure, in determining the legitimacy of a transfer by a respondent claiming an unbroken chain of possession, panels may not only look for proof that the transfer has been done for a legitimate business purpose, but can consider the strength of a complainant’s mark and whether the transfer has resulted in a change of use specifically to take advantage of a complainant’s mark. *Id.*

With these principles in mind, the Panel is of the view that Respondent has established an unbroken chain of possession in the disputed domain name since 1995. See [WIPO Overview 3.0](#) at section 1.1.3 (“Where a domain name has been registered before a complainant has acquired trademark rights, only in exceptional cases would a complainant be able to prove a respondent’s bad faith.”)

The late 2007 or early 2008 transfer of the disputed domain name was to a controlled subsidiary of Aquent, Inc. and there is no evidence that such was done to take advantage of any trademark rights Complainant might claim in its newly adopted SKILLFUL mark. The transfer appears to simply be a change of which company within the TRI Ventures, Inc. (then Aquent, Inc.) corporate family would hold the disputed domain name, much in the same way that companies often move the ownership of their trademarks between holding companies and operating companies within the same corporate control group. As for the 2021 use of the disputed domain name by Scout Exchange, LLC, this does not appear to be a transfer of ownership of the disputed domain as Respondent has remained the listed registrant of the disputed domain name, as Complainant acknowledges.

That being said, the Panel notes that Scout Exchange, LLC is a sister company of Respondent also owned by Respondent’s parent. Respondent asserts that it has licensed the right to use the disputed domain name to Scout Exchange, LLC. While Complainant objects to the use of the disputed domain name by Scout Exchange, LLC for its website matching employers and recruiter for employees, that license does not establish that a transfer of the disputed domain name has occurred, and moreover such objection is better suited for disposition by a court of competent jurisdiction. Indeed, it is not altogether clear to the Panel whether any targeting of Complainant has even occurred here given (i) that the disputed domain name consists of a common word, (ii) the existence of multiple parties using the word “skill” in or as part of their trademarks, and (iii) the differences between the Complainant’s and Respondent’s services. Simply put, the Panel does not see this matter as a case of cybersquatting.

As the Panel finds that Respondent has established an unbroken chain of possession in the disputed domain name since 1995, when Complainant owned no rights in the SKILLFUL and SKILL marks, Complainant’s Complaint fails for not establishing bad faith registration of the disputed domain name by Respondent.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Georges Nahitchevansky/
Georges Nahitchevansky
Presiding Panelist

/Gregory N. Albright/
Gregory N. Albright
Panelist

/Richard G. Lyon/
Richard G. Lyon
Panelist
Date: May 26, 2022