

## **ADMINISTRATIVE PANEL DECISION**

Solace Nutrition, LLC v. David Lee  
Case No. D2022-1613

### **1. The Parties**

The Complainant is Solace Nutrition, LLC, United States of America (“United States”), represented by Furr Law Firm, United States.

The Respondent is David Lee, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <solaceprobiotic.com> (the “Disputed 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 May 4, 2022. On May 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On May 5, 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 the Complainant on May 9, 2022 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 amended Complaint on May 13, 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 the Respondent of the Complaint, and the proceedings commenced on May 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 8, 2022.

The Center appointed Lynda M. Braun as the sole panelist in this matter on June 16, 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 June 16, 2022, David Lee (through an email address different to the registrant's email address as confirmed by the Registrar) sent an email to the Center asking for the complaint to be notified to a different email address. On June 29, 2022, the Panel issued the Administrative Panel Procedural Order No. 1 ("Panel Order No. 1"), instructing the Center to provide David Lee with a copy of the Notification of Complaint documents, asking the Respondent why acceptance of a Response after the Response due date is appropriate, and extending the decision due date to July 19, 2022. On July 1, 2022, the Respondent sent an email communication in response to the Panel Order No. 1. On August 8, 2022, the Panel issued the Administrative Panel Procedural Order No. 2 ("Panel Order No. 2"), instructing the Center to forward a copy of the Notification of Complaint documents to the email address mentioned before, and extending the decision due date to August 20, 2022. The Center did not receive further submissions in response to Panel Order No. 2. On August 13, 2022, the Panel issued the Administrative Panel Procedural Order No. 3 ("Panel Order No. 3"), instructing the Center to forward a copy of the Notification of Complaint documents to all the relevant email addresses, giving an opportunity for the Respondent and/or for Oryx Biomedical Inc to file comments to the Complaint (if any), extending the decision due date to August 30, 2022. The Center did not receive further submissions in response to Panel Order No. 3.

#### **4. Factual Background**

The Complainant is a worldwide medical nutrition company that manufactures and sells safe, reliable, and effective nutrition supplements that help individuals with metabolic nutritional needs and chronic diseases. Based in the United States and operating since 2005, the Complainant sells multi-vitamin and mineral formulas, CoQ10, D-Ribose, creatine, amino acids, Vitamin B2, Vitamin B7, low carbohydrate formulas, omega 3, carbohydrate formula, and cholesterol formulas.

The Complainant owns, among others, the following trademarks: SOLACE NUTRITION, United States Registration No. 4,532,030, registered on May 13, 2014, with a first use in commerce of December 31, 2005, in international class 5; and SOLACE NUTRITION, United States Registration No. 4,528,109, registered on May 13, 2014, with a first use in commerce of December 31, 2005, in international class 5 (hereinafter collectively referred to as the "SOLACE NUTRITION Mark").

The Complainant owns the domain name <solacenuitrition.com>, which resolves to its official website at "www.solacenuitrition.com".

The Disputed Domain Name was registered on June 14, 2016, and initially resolved to a website that advertised and sold nutritional supplements such as probiotics, similar to those sold by the Complainant on its official website. As of the writing of this Decision, the Disputed Domain Name redirects users to <benedlife.com> where the website advertises and sells nutritional supplements and probiotics. The Respondent apparently rebranded itself, but still uses the Disputed Domain Name to arrive at its website.

#### **5. Parties' Contentions**

##### **A. Complainant**

The following are the Complainant's contentions:

- the Disputed Domain Name is confusingly similar to the Complainant's SOLACE NUTRITION Mark;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;

- the Disputed Domain Name was registered and is being used in bad faith; and
- the Complainant seeks the transfer of the Disputed Domain Name from the Respondent to the Complainant in accordance with paragraph 4(i) of the Policy.

## **B. Respondent**

The Center received an email from a third party claiming to have a relationship with the Respondent and asking for time to submit a response. The email was received after the response due date, as a result the Panel issued a Panel Order requesting the sender of the email to clarify his relationship with the Respondent and proving them with an opportunity to explain why additional time for a response should be granted. The sender of the email clarified that he was Mr. David Lee (the Respondent), the President of Oryx Biomedical Inc., and asked for the Complaint to be sent to a different email address. Subsequent procedural orders were issued by the Panel including an invitation to the Respondent and/or Oryx Biomedical Inc., to file any comments to the Complainant's contentions.

The Panel notes that no response to the Complainant's contentions, or any substantive argument, has been submitted, neither a reasonable explanation on why acceptance of a Response after the Response due date would be appropriate. The Panel also notes that the Respondent has been using in its communications the email address to which the notification of Complaint was forwarded (including the Complaint and the corresponding annexes).

In these circumstances, the Panel finds that the Respondent has been provided with several opportunities to submit his arguments, and to reply to the Complainant's contentions, and considers that there are not sufficient reasons to further delay the proceeding so the Panel has proceeded to render this Decision.

## **6. Discussion and Findings**

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

- (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.

### **A. Identical or Confusingly Similar**

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry: a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the SOLACE NUTRITION Mark.

It is uncontroverted that the Complainant has established rights in the SOLACE NUTRITION Mark based on its years of use as well as its registered trademarks for the SOLACE NUTRITION Mark in the United States Patent and Trademark Office. The consensus view is that the registration of a mark satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1. Thus, the Panel finds that the Complainant has rights in the SOLACE NUTRITION Mark.

The Disputed Domain Name consists of the SOLACE NUTRITION Mark with the term "nutrition" replaced by the term "probiotic", and then followed by the generic Top-Level Domain ("gTLD") ".com". It is well

established that a domain name that incorporates a trademark – or the dominant portion thereof – is deemed confusingly similar to that trademark for purposes of the Policy despite the substitution of another term. As stated in section 1.8 of [WIPO Overview 3.0](#), “where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element”. For example, numerous UDRP decisions have reiterated that the addition of terms to a trademark does not prevent a finding of confusing similarity. See *Allianz Global Investors of America, L.P. and Pacific Investment Management Company (PIMCO) v. Bingo-Bongo*, WIPO Case No. [D2011-0795](#); and *Hoffmann-La Roche Inc. v. Wei-Chun Hsia*, WIPO Case No. [D2008-0923](#).

Further, the addition of a gTLD such as “.com” in a domain name is technically required. Thus, it is well established that, as here, such element may typically be disregarded when assessing whether a disputed domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainant.

## **B. Rights or Legitimate Interests**

Under the Policy, a complainant has to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent carries the burden of production of demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

In this case, the Panel finds that the Complainant has made out a *prima facie* case. The Respondent has not submitted any arguments or evidence to rebut the Complainant’s *prima facie* case. Furthermore, the Complainant has not authorized, licensed or otherwise permitted the Respondent to use its SOLACE NUTRITION Mark. In addition, the Complainant does not have any type of business relationship with the Respondent nor has the Respondent made any demonstrable preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services for the purposes of the Policy. There is no evidence to support that the use made of the Disputed Domain Name to resolve to the Respondent’s competing website on which it displays and sells nutritional products, *i.e.*, probiotics, similar to those sold by the Complainant, the Panel finds that the Respondent was not making a *bona fide* offering of goods or services nor making a legitimate noncommercial or fair use of the Disputed Domain Name under the Policy. Such an infringing use can never be *bona fide* under ¶ 4(c)(i). Past UDRP panels have held that using a disputed domain name to resolve to a website offering goods that compete with those of the complainant does not establish rights or legitimate interests. On the contrary, here, the Respondent is using the term “solace” which is part of the SOLACE NUTRITION Mark for a Disputed Domain Name in order to obtain commercial gains and to deceive Internet users to mistakenly believe that they arrived at the Complainant’s official website. While “solace” is a dictionary term, the Panel finds that “solace” is not a term necessarily and directly connected to the nutrition business, and that the Respondent is using the Disputed Domain Name to sell competing products. In addition, while the Disputed Domain Name does not reproduce the “NUTRITION” element of the Complainant’s trademark, the “probiotic” term in the Disputed Domain Name could be easily connected with the nutrition field. The Panel considers that the combination of “solace probiotic” of the Disputed Domain Name results in a similar composition and concept to the one of the SOLACE NUTRITION Mark.

In sum, the Panel finds the Complainant has established an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

Accordingly, the Panel finds that the second element of paragraph 4(a) of the Policy has been met by the Complainant.

### C. Registered and Used in Bad Faith

The Panel finds that based on the record, the Complainant has demonstrated the existence of the Respondent's bad faith pursuant to paragraph 4(b) of the Policy.

First, the Respondent's registration and use of the Disputed Domain Name indicate that such registration and use has been done for the specific purpose of trading on the name and reputation of the Complainant and its SOLACE NUTRITION Mark. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#) (“[t]he only plausible explanation for Respondent's actions appears to be an intentional effort to trade upon the fame of Complainant's name and mark”).

Second, the Disputed Domain Name was registered more than a decade after the Complainant first began using its SOLACE NUTRITION Mark and several years after the Complainant registered the SOLACE NUTRITION Mark. Therefore, the Panel finds that the Respondent probably had the Complainant's SOLACE NUTRITION Mark in mind when registering the Disputed Domain Name. By using the SOLACE NUTRITION Mark, substituting the term “nutrition” with the term “probiotic”, the Panel arrives to the conclusion that the Respondent had knowledge of the Complainant, its business, and its SOLACE NUTRITION Mark when registering the Disputed Domain Name.

The fame of the SOLACE NUTRITION Mark, which was used and registered by the Complainant in advance of the Respondent's registration of the Disputed Domain Name, renders it wholly implausible that the Respondent created the Disputed Domain Name independently or had not known of the Complainant or its SOLACE NUTRITION Mark, since the Respondent used the resolving website of the Disputed Domain Name to sell competing products.<sup>1</sup> See *Asian World of Martial Arts Inc. v. Texas International Property Associates*, WIPO Case No. [D2007-1415](#). In light of the circumstances in this case, it is not possible to conceive of a plausible situation in which the Respondent would have been unaware of the Complainant's SOLACE NUTRITION Mark at the time the Disputed Domain Name was registered. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). The Respondent's awareness of the Complainant and its SOLACE NUTRITION Mark additionally suggests that the Respondent's decision to register the Disputed Domain Name was purportedly intended to cause confusion with the Complainant's SOLACE NUTRITION Mark or at least to take unfair advantage of its confusing similarity. Such conduct indicates that the Respondent registered and used the Disputed Domain Name in bad faith. Thus, the Panel finds that the Respondent had actual knowledge of the SOLACE NUTRITION Mark and targeted the Complainant when it registered the Disputed Domain Name, demonstrating the Respondent's bad faith. Moreover, the Respondent was seeking to drive traffic from the Complainant's customers to its own website, another indication of bad faith.

Accordingly, the Panel finds that the third element of paragraph 4(a) of the Policy has been met by the 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 <solaceprobiotic.com> be transferred to the Complainant.

/Lynda M. Braun/

**Lynda M. Braun**

Sole Panelist

Date: August 30, 2022

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<sup>1</sup> Bad faith is also demonstrated by the Respondent's use of the Disputed Domain Name to resolve to its website with nutritional products competing with those of the Complainant. In fact, the Complainant contends that there were several purported cases of actual confusion by consumers contacting the Complainant by phone and in writing about confusion between the two websites.