

ADMINISTRATIVE PANEL DECISION

HCCI Professional Protective Services, LLC v. Jonathan McMaster /
Anonymize, Inc.

Case No. D2022-1668

1. The Parties

The Complainant is HCCI Professional Protective Services, LLC, United States of America (“United States”), represented by Thomas P. Howard LLC, United States.

The Respondent is Anonymize, Inc. / Jonathan McMaster, United States, represented by Archer Softech, India.

2. The Domain Name and Registrar

The disputed domain name <hcciprotection.com> is registered with Epik, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 7, 2022. On May 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 9, 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 16, 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 16, 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 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 8, 2022. The Response was filed with the Center on June 6, 2022. On June 14, 2022, the Complainant filed “Supplemental Information” to address certain issues raised in the Response.

The Center appointed Evan D. Brown as the sole panelist in this matter on June 20, 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.

4a. Factual Background

The Complainant is a single-member Colorado limited liability company, established in 2019 to provide private security and related services. The Complainant retained the Respondent to provide website development and other services for the Complainant. One of the tasks the Respondent performed in the service of the Complainant was the registration of the disputed domain name, which was done on November 28, 2019. The parties do not dispute that the Respondent registered the disputed domain name at the instruction of the Complainant and for the Complainant.

Though it appears the parties were at one time friends, the relationship between them deteriorated, and they parted ways, such separation being reflected in dramatic communications between them in late April 2022. Around the same time (*e.g.*, in an email dated April 29, 2022), the Complainant demanded, among other things, that the Respondent “return the domain to [the Complainant’s] control”. The Respondent did not turn over control of the disputed domain name and set the disputed domain name to no longer point at the Complainant’s business website. This UDRP action ensued.

4b. Respondent Identity

The Registrar disclosed the registrant to be Anonymize, Inc, which is a Whois privacy service. However, due to the parties’ history the Complainant was able to identify the Respondent as Jonathan McMaster and provided his contact information so as to receive correspondence regarding this proceeding.

5. Parties’ Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant’s trademark; that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

For the first element under the Policy, the Complainant asserts it has been operating under the trade name HCCI PROFESSIONAL PROTECTION SERVICES and shortened variations thereof since 2019. It submitted documents showing it has registered the trade name HCCI PROTECTION with the Colorado Secretary of State. In the Supplemental Information filed with the Center, the Complainant asserts that the Colorado trade name registration, along with proof of use, establishes common law rights in the HCCI PROTECTION mark. The Complainant asserts that the disputed domain name is “identical in whole or in part” to the Complainant’s purported marks.

As for the second element, the Complainant asserts that the Respondent has no rights or legitimate interests in the disputed domain name because the Respondent’s only relation to the disputed domain name is as an independent contractor that registered the disputed domain name at the instruction of the Complainant and for the Complainant. For these reasons, according to the Complainant, the Respondent at no time acquired any ownership rights in the disputed domain name.

And for the third element, the Complainant states – with no elaboration whatsoever – that the Respondent registered the disputed domain name in bad faith. It asserts that the Respondent has used the disputed domain name in bad faith by attempting to block the Complainant from using the disputed domain name and by attempting to sell the disputed domain name on the open market for an amount in excess of the registration fees.

B. Respondent

The Respondent argues principally that the Complainant has failed to establish any of the three elements required under the Policy, that the present situation is a business dispute outside the scope of the UDRP that would be better resolved in court, and that the Complainant has engaged in Reverse Domain Name Hijacking.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (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, *AXA SA v. Huade Wang*, WIPO Case No. [D2022-1289](#).

The Panel finds that the Complainant has failed to establish the third element. Specifically, the Panel finds that the Complainant has provided no evidence that the Respondent registered the disputed domain name in bad faith.

A. Identical or Confusingly Similar

This element under the Policy functions primarily as a standing requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7. This element requires the Panel to consider two issues: first, whether the Complainant has rights in a relevant mark; and, second, whether the disputed domain name is identical or confusingly similar to that mark.

The Complainant asserts it has been operating under the trade name HCCI PROFESSIONAL PROTECTION SERVICES and shortened variations thereof since 2019. The evidence submitted to support this assertion, however, comprised of the company's articles of organization filed with the Colorado Secretary of State, photographs and social media posts, all show use of the name HCCI PROFESSIONAL PROTECTIVE SERVICES.

The Complainant submitted documents showing it has registered the trade name HCCI PROTECTION with the Colorado Secretary of State, but provided no evidence that such trade name has been used in commerce. The applicable laws of the State of Colorado do not require that use in commerce be asserted to support the registration of a trade name. C.R.S. §7-71-101 et seq. And the Statement of Trade Name of a Reporting Entity the Complainant provided as evidence contains no assertion that HCCI PROTECTION has been used in commerce.

The Panel therefore rejects the Complainant's assertions that the Complainant has established any trademark rights in either HCCI PROFESSIONAL PROTECTION SERVICES or HCCI PROTECTION.

Web page screenshots submitted as annexes to the Complaint show that the Complainant has used the mark HCCI PROFESSIONAL PROTECTIVE SERVICES to market and promote its services. For example, the screenshots show the mark has been affixed to company vehicles and on uniforms. The mark is used as the title of the company's business Facebook page. Photos show the mark appearing on business cards. The Facebook page was created in February 2019 and has gathered more than 300 followers in that time. The Panel finds in the circumstances of this case, where the Respondent was clearly aware of the Complainant's use of its business name, evidence to support the Complainant's rights in the mark HCCI PROFESSIONAL PROTECTIVE SERVICES.

This test to determine whether the domain name is identical or confusingly similar to a complainant's mark typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. [WIPO](#)

[Overview 3.0](#), section 1.7; *Supercell Oy v. Lombardo Fausto*, WIPO Case No. [D2017-0701](#) (<clashofheroes.net> confusingly similar to the mark CLASH OF CLANS). The confusing similarity test may also include recognizability by technological means such as search engine algorithms. [WIPO Overview 3.0](#), section 1.7; *Sodexo v. Lloyd Group*, WIPO Case No. [D2021-1214](#) (the panel therein found that a Google search affirmed recognizability by search engine algorithms). In some cases, such assessment may also entail a more holistic aural or phonetic comparison of the complainant's trademark and the disputed domain name to ascertain confusing similarity. *Boehringer Ingelheim International GMBH v. JH Kang*, WIPO Case No. [DCO2020-0001](#).

The distinctive "HCCI" portion of the Complainant's mark is recognizable in the disputed domain name. See *Supercell Oy v. Lombardo Fausto, supra*. ("the first two words of each name ('Clash of') stand out"). The Panel ran a Google search (which the Panel is permitted to conduct under the general powers of a panel articulated in the Rules) using the second level portion of the disputed domain "hcciprotection". The search returned results for the Complainant's LinkedIn and Facebook pages, each titled "HCCI Professional Protective Services". And the disputed domain name and the Complainant's mark are confusingly similar when viewed by means of a "holistic aural or phonetic comparison".

For these reasons, the Panel finds that the Complainant has established the first element under the Policy.

B. Rights or Legitimate Interests

Having found that the Complainant has failed to establish the third element under the Policy (discussed below), the Panel declines to make a determination under this second element.

C. Registered and Used in Bad Faith

The plain language of paragraph 4(a) of the Policy provides that the Complainant must prove that the disputed domain name "has been registered and is being used in bad faith". Under this third element, "it is clear that both bad faith use *and* bad faith registration are required." *e-Duction, Inc. v. John Zuccarini, d/b/a The Cupcake Party & Cupcake Movies*, WIPO Case No. [D2000-1369](#) (emphasis in original). Similarly, "if a domain name was registered in good faith, it cannot, by changed circumstances, the passage of years, or intervening events, later be deemed to have been registered in bad faith." *Substance Abuse Management, Inc. v. Screen Actors Models [sic] International, Inc. (SAMI)*, WIPO Case No. [D2001-0782](#).

The Respondent correctly observes that the Complainant has not alleged bad faith registration of the disputed domain name. All of the assertions in the Complaint under this third element deal with how the Respondent is alleged to have *used* the disputed domain name. Moreover, the Complainant's assertion that the Respondent "purchased the domain for and at the direction of [the Complainant]" undermines the claim that the Respondent was acting in bad faith when it registered the disputed domain name. In the "Supplemental Information" that the Complainant provided after the Response, the Complainant doubled down on these assertions, stating that the Respondent purchased "the domain as an agent for [the Complainant] and for [the Complainant]'s use." Neither the Complainant's assertions, nor the correspondence provided by the Complainant, support the notion that the Respondent was acting in bad faith by registering the disputed domain name. Instead, the record shows that by registering the disputed domain name, the Respondent was doing precisely what the parties had agreed the Respondent would do.

Having not shown that the Respondent registered the disputed domain name in bad faith (there being nothing in the record to lead the Panel to believe *e.g.*, that the registration was initially undertaken in the Respondent's name with a view to holding it as ransom), the Panel finds that the Complainant has failed to establish this third element under the Policy.

The Panel takes no position (not the least because there is not sufficient information in the various pleadings and annexes, but also given the limited scope of the Policy) on the status of and compensation outstanding between the Parties; to the extent the Complainant feels it has a cause of action under local law, it remains free to pursue those in court.

7. Reverse Domain Name Hijacking

The Respondent has asked the Panel to find that the Complainant engaged in Reverse Domain Name Hijacking (“RDNH”). The Panel declines to make such a finding.

Paragraph 15(e) of the Rules provides that, if “after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding”. Paragraph 1 of the Rules defines RDNH as “using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name”. Mere lack of success of the Complaint is not itself sufficient for a finding of RDNH (see paragraph 4.16 of the [WIPO Overview 3.0](#)).

Paragraph 4.16 of the [WIPO Overview 3.0](#) provides that RDNH is appropriate to address a party “unreasonably ignoring established Policy precedent notably as captured in this WIPO Overview – except in limited circumstances which *prima facie* justify advancing an alternative legal argument”. Here, the Complainant has entirely disregarded established Policy precedent regarding the need to prove registration in bad faith. The Complainant has made no assertion seeking to justify an alternative legal argument. This issue of bad faith registration is “not Policy arcana.” See *DIGITI limited liability company v. Privacy Administrator, Anonymize, Inc / Michele Dinoia, Macrosten LTD*, WIPO Case No. [D2018-2148](#), quoting from *Pick Enterprises, Inc. v. Domains by Proxy, LLC, DomainsByProxy.com / Woman to Woman Healthcare / Just Us Women Health Center f/k/a Woman to Woman Health Center*, WIPO Case No. [D2012-1555](#). Instead, the conjunctive requirement of both registration and use in bad faith is derived from the plain language of the Policy and longstanding, clear precedent.

Moreover, the Complainant is represented by counsel from a law firm that self-identifies on its website as experienced in intellectual property and business litigation. It is not unreasonable for the Panel to require that the Complainant and its counsel will not gloss over matters on which well-established Policy precedent weighs directly against the Complainant’s contentions. See *Intellect Design Arena Limited v. Moniker Privacy Services / David Wieland, iEstates.com, LLC*, WIPO Case No. [D2016-1349](#); citing *Spy Optic, Inc. v. James Lee*, WIPO Case No. [D2013-1411](#).

Based on the above, the Panel believes that the Complainant approaches the conduct necessary for a finding of RDNH. However, neither has the Respondent’s conduct been exemplary. The course of dealing between the parties, evidenced by the correspondence they exchanged, indicates that all relevant persons agreed that the disputed domain name was procured and was to be used for the Complainant’s business. The Respondent may have legitimate professional and/or personal grievances against the Complainant. In any event, by holding onto the disputed domain name and redirecting it away from the Complainant’s website, the Respondent appears to be engaging in self-help that is in the Panel’s view clearly unsavory. A finding of RDNH would make the Complainant the sole stigma bearer, which would not be equitable on these facts. The Panel in this case instead follows the style of *Rudy Rojas v. Gary Davis*, WIPO Case No. [D2004-1081](#) in which, invoking Shakespeare, that panel conjured “[a] plague o’ both your houses” to leave the parties as it found them.

8. Decision

For the foregoing reasons, the Complaint is denied.

/Evan D. Brown/

Evan D. Brown

Sole Panelist

Date: July 3, 2022