

ADMINISTRATIVE PANEL DECISION

Magpul Industries Corp. v. Domains By Proxy, LLC / Jen Workman, The FAL Files, Inc.

Case No. D2022-2468

1. The Parties

Complainant is Magpul Industries Corp., United States of America, represented by Sideman & Bancroft LLP, United States of America.

Respondent is Domains By Proxy, LLC / Jen Workman, The FAL Files, Inc., United States of America, represented by Tumey LLP, United States of America.

2. The Domain Names and Registrar

The disputed domain names <magpul.biz>, <magpulcentral.com>, <magpulgear.com>, <magpulshop.com>, <magpulstore.com>, <magpulstore.info>, <magpulstuff.com> and <pmagsrus.com> are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 7, 2022. On July 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 8, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 July 12, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 1, 2022. On July 27, 2022, Respondent sent an email communication to the Center requesting an additional four days to file a Response. Pursuant to paragraph 5(b) of the Rules, the Response due date was extended to August 5, 2022. The Response was filed with the Center on August 4, 2022. On August 15, 2022, the Center suspended the proceedings upon Complainant’s request. On September 22, 2022, Complainant requested that the proceedings be reinstated. The proceedings were

reinstated and the Center informed the Parties that it would proceed to panel appointment on September 22, 2022.

The Center appointed Georges Nahitchevansky as the sole panelist in this matter on September 26, 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.

4. Factual Background

Complainant, Magpul Industries Corp., is a manufacturer of firearm related products and accessories. Complainant owns several trademark registrations for the MAGPUL mark in the United States of America ("United States") and internationally, most of which issued to registration after November 2008, with the exception of one United States registration that issued to registration on February 12, 2008 (Registration No. 3381306). Complainant also owns a United States registration for PMAG which issued to registration on April 21, 2009 (Registration No. 3608684). Lastly, Complainant also owns and uses the domain name <magpul.com> for a website providing information concerning Complainant and its products and through which Complainant sells its MAGPUL products.

Respondent operates a discussion forum regarding firearms. Respondent registered all of the disputed domain names on November 23, 2008. The disputed domain names do not appear to have been used for an active website or web page and have mostly resolved, to this day, to Registrar parking pages with links.

5. Parties' Contentions

A. Complainant

Complainant contends that it has strong rights in the MAGPUL and PMAG marks on account of Complainant's trademark registrations for these marks and on the basis that Complainant is well-known in the firearms industry.

Complainant asserts that the disputed domain names are confusingly similar to its MAGPUL and PMAG marks as they each fully incorporate the MAGPUL mark or PMAG (in a plural form) with a generic or descriptive word or abbreviation.

Complainant maintains that Respondent has no rights or legitimate interests in the disputed domain names as Respondent (i) has not used the disputed domain names with a *bona fide* offering of goods or services, (ii) is not commonly known by the disputed domain names, and (iii) is not making a legitimate noncommercial or fair use of the disputed domain names as they all appear to have been inactive and/or only used with a parked page since November 2008.

Lastly, Complainant argues that Respondent has registered and used the disputed domain names in bad faith as Respondent knew or had reason to know of Complainant's MAGPUL and PMAG marks, given that the marks are well-known internationally in the firearms industry, and did so in order to confuse consumers into believing that the disputed domain names are connected to Complainant. In addition, Complainant argues that Respondent acted in bad faith by registering multiple domain names based on the MAGPUL and PMAG marks after Complainant obtained trademark registrations for those marks.

B. Respondent

Respondent rejects Complainant's contentions, but expressly agrees to a transfer of the disputed domain names to Complainant. In that regard, Respondent admits that it registered the disputed domain names in November 2008, but contends that it do so for a legitimate interest related to a firearms business that was

abandoned after Respondent experienced a cyberattack. Respondent notes that almost all of Complainant's United States and foreign trademark registrations, with the exception of one for MAGPUL, issued to registration well after Respondent registered the disputed domain names. Respondent also asserts that in 2010 it contacted Complainant regarding one of the disputed domain names to see if Complainant "was interested in taking it over". Complainant apparently never responded. Lastly, Respondent argues that Complainant has taken no action with regard to the disputed domain names for over 14 years, despite having been contacted by Respondent in 2010. Such a failure to take action, according to Respondent, undermines any claim of harm by Complainant.

6. Discussion and Findings

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

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names are registered and are being used in bad faith.

Here, however, Respondent in its Response has expressly agreed to the remedy requested by Complainant in the Complaint and agreed to a transfer of the disputed domain names to Complainant. The Panel notes that a consent to transfer by Respondent can provide a basis for an order for transfer without a need to consider the individual UDRP grounds. See section 4.10 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The Panel agrees with this approach, taking into account Respondent's unequivocal consent to transfer the disputed domain names to Complainant and given that Complainant has not rejected such consent to transfer and has not expressed a preference for a recorded decision.

Accordingly, the Panel orders the transfer of the disputed domain names to Complainant.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders, without making any findings adverse to Respondent or Complainant, that the disputed domain names, <magpul.biz>, <magpulcentral.com>, <magpulgear.com>, <magpulshop.com>, <magpulstore.com>, <magpulstore.info>, <magpulstuff.com>, <pmagsrus.com> be transferred to Complainant.

/Georges Nahitchevansky/

Georges Nahitchevansky

Sole Panelist

Date: October 10, 2022