

ADMINISTRATIVE PANEL DECISION

**Pasted Nip LLC v. Privacy Service Provided by Withheld for Privacy ehf /
BACHELOR FORTUNE
Case No. D2022-2530**

1. The Parties

Complainant is Pasted Nip LLC, United States of America (“United States”), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States.

Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / BACHELOR FORTUNE, United States.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 12, 2022. On July 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 13, 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 July 13, 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 July 13, 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 July 14, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 3, 2022. Respondent did not submit any response. Accordingly, the Center notified the Parties of Respondent’s default on August 4, 2022.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on August 5, 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 sells nipple covers that are worn by women as an alternative to brassieres. It registered the domain name <pastednip.com> on January 6, 2020. It is the proprietor of United States trademark registration No. 6247776 for PASTED (NIP) (word mark), registered on January 12, 2021 for goods in class 25.

The disputed domain name was registered on May 29, 2022. It redirects to Complainant's own website. The record reflects that Respondent contacted Complainant on that date offering to sell the disputed domain name to Complainant. The email reads, in relevant part:

"How shall I best capitalize on PastedNips.com? Develop into another porn site [...] with link ads or sell it to you? As mentioned, I've re-directed the web name to your current PastedNip webpage."

5. Parties' Contentions

A. Complainant

Complainant's contentions may be summarized as follows:

Under the first element, Complainant states that it was founded in January 2020 and initially sold two products directly to consumers. It later entered the wholesale market. It currently sells eight products and plans to expand to 11 during 2022. It has approximately 1,300 customers in the United States, Puerto Rico, Canada, and Costa Rica. The disputed domain name contains Complainant's trademark in its entirety, simply adding the letter "s" at the end. Complainant notes that the parentheses in its United States trademark registration must be disregarded as they cannot be reproduced in a domain name.

Under the second element, Complainant states that it has never assigned, granted, licensed, sold, transferred or in any way authorized Respondent to register or use its trademark in any manner. The disputed domain name re-directs to Complainant's official website and Respondent is not using it in connection with any *bona fide* offer of goods or services. Respondent has not been commonly known by the disputed domain name and is not making a legitimate noncommercial or fair use of the disputed domain name. Respondent has indicated that he wanted to sell the disputed domain name to Complainant, which cannot establish rights or legitimate interests.

Under the third element, Complainant states that it is implausible that Respondent was unaware of Complainant when he registered the disputed domain name, since Respondent has caused the disputed domain name to redirect to Complainant's website. By indicating that he wanted to sell the disputed domain name to Complainant, Respondent has clearly registered it for that purpose. Respondent has also acted in bad faith by suggesting that he might develop the disputed domain name "into another porn site."

Complainant requests transfer of the disputed domain name.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the UDRP requires Complainant to make out all three of the following:

- (i) the disputed 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 disputed domain name; and
- (iii) Respondent has registered and is using the disputed domain name in bad faith.

Under paragraph 15(a) of the Rules, “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

A. Identical or Confusingly Similar

Complainant has provided evidence establishing that it has trademark rights in the PASTED (NIP) mark through registration in the United States. Complainant thereby 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.

In comparing Complainant’s mark with the disputed domain name, the Panel finds that the disputed domain name is confusingly similar to this mark as the trademark is clearly recognizable within the disputed domain name. The Panel finds that, for the purposes of comparing the trademark to the disputed domain name, the parentheses are not relevant as they cannot be reproduced in a domain name. See, for example, *Société Air France v. Indra Armansyah*, WIPO Case No. [D2016-2027](#).

It is the well-established view of UDRP panels that a generic Top-Level Domain such as “.com” is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel finds that Complainant has established the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The Panel finds that the evidence submitted by Complainant establishes a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain name. Respondent is not authorized by Complainant and has no rights in the PASTED (NIP) trademark.

Pursuant to [WIPO Overview 3.0](#), section 2.1, and cases thereunder, where Complainant makes out a *prima facie* case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

Respondent has not provided any rebuttal of Complainant’s *prima facie* case and has therefore not proved rights or legitimate interests in the disputed domain name. There is no evidence that Respondent is commonly known by the disputed domain name, or that there are any circumstances or activities that would establish Respondent’s rights therein. The disputed domain name consists of Complainant’s PASTED (NIP) mark (minus the parentheses which cannot be reproduced in a domain name), adding an “s”. The Panel finds that such composition cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. In this case, the Panel finds that the disputed domain name carries a risk of implied affiliation. See [WIPO Overview 3.0](#), section 2.5.1.

Moreover, the disputed domain name redirects to Complainant's own website. The Panel is satisfied that such redirection has been created with the intention of misleading Internet users. Complainant provides evidence, unchallenged by Respondent, that Respondent has offered to sell the disputed domain name to Complainant, in the alternative, proposing to use it to host a pornographic website. Such use cannot confer rights or legitimate interests. See [WIPO Overview 3.0](#), section 2.5.3. See also, for example, *CVS Pharmacy, Inc. v. Whois Privacy, Private by Design, LLC / Cue Balls*, WIPO Case No. [D2021-3178](#).

Accordingly, the Panel finds that Complainant has established the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Pursuant to paragraph 4(b) of the Policy, the Panel finds that Complainant has demonstrated Respondent's bad faith registration and use of the disputed domain name. Complainant's rights in its PASTED (NIP) mark predates the registration of the disputed domain name. The disputed domain name reflects Complainant's trademark in plural form, which clearly implies a link with Complainant's business.

Turning to use of the disputed domain name, the Panel finds that Complainant has demonstrated Respondent's bad faith. The disputed domain name redirects to Complainant's website. Such conduct is probative of bad faith, as Respondent thereby creates a real or implied ongoing threat to Complainant. See [WIPO Overview 3.0](#), section 3.1.4. Moreover, the record reflects that Respondent was fully aware of Complainant and its earlier rights. The circumstances indicate that Respondent registered the disputed domain name for the bad-faith purpose of selling it to Complainant. Indeed, Respondent's email correspondence with Complainant makes this intention explicit. In it, Respondent quite clearly threatens Complainant with creating a pornography site if Complainant does not agree to the sale. The Panel finds that it is implausible that Respondent did not intend to profit from this transaction. See [WIPO Overview 3.0](#), section 3.1.1. Lacking any independent rights in the disputed domain name, Respondent's actions demonstrate bad faith in registration and use of the disputed domain name.

The Panel therefore finds that Complainant has established the third element under paragraph 4(a) of the Policy.

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 <pastednips.com> be transferred to Complainant.

/Ingrīda Kariņa-Bērziņa/

Ingrīda Kariņa-Bērziņa

Sole Panelist

Date: August 19, 2022