

ADMINISTRATIVE PANEL DECISION

S A International, Inc., SAIEP, LLC v. Registration Private,
Domains By Proxy, LLC / Jamanl Hassanli
Case No. D2022-2788

1. The Parties

Complainant is S A International, Inc., SAIEP, LLC, United States of America (“United States”), represented by Phillips Winchester, United States.

Respondent is Registration Private, Domains By Proxy, LLC, United States / Jamanl Hassanli, United States of America.

2. The Domain Name and Registrar

The disputed domain name <flexicrack.com> 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 July 29, 2022. On July 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 August 1, 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 August 8, 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 August 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 29, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on August 30, 2022.

The Center appointed Phillip V. Marano as the sole panelist in this matter on September 7, 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 is the creator and owner of software products used in applications for the design, printing, and cutting of vinyl. Complainant, SAIEP, LLC, owns valid and subsisting registrations for the FLEXI trademark in numerous countries, including the trademark for FLEXI (Reg. No. 3,681,593) in the United States, with the earliest priority dating back to March 1995. Complainant, SA International, Inc., is the exclusive trademark licensee of the same FLEXI trademark. As discussed below, for the purposes of this proceeding, SAIEP, LLC and SA International, Inc. are referred to collectively as “Complainant”.

Respondent registered the disputed domain name on October 4, 2021. At the time this Complaint was filed, the disputed domain name resolved to a website ostensibly offering “cracked” versions of Complainant’s FLEXI software products and other software products offered by Complainant, as well as third party software providers including Adobe and Onyx. The term “cracked” refers to software versions whose security features have been disabled to allow copying and use without authorization from the relevant intellectual property owner.

5. Parties’ Contentions

A. Complainant

Complainant asserts ownership of the FLEXI trademark and has adduced evidence of trademark registrations in the United States, with earliest priority dating back to March 1995. The disputed domain name is confusingly similar to Complainant’s FLEXI trademark, according to Complainant, because it entirely incorporates Complainant’s FLEXI trademark and addition of the related term “crack” does not distinguish the disputed domain name.

Complainant further asserts that Respondent lacks any rights or legitimate interests in the disputed domain name based on: the lack of any evidence that Respondent is known by the term “flexicrack” or Complainant’s FLEXI trademark; the lack of any authorization, affiliation, or connection between Respondent and Complainant; and Respondent’s use of the disputed domain name to offer to Internet users illegal copies of Complainant’s FLEXI software products with Complainant’s technological protection measures circumvented.

Complainant argues that Respondent has registered and used the disputed domain name in bad faith for numerous reasons, including: Respondent’s use of the disputed domain name to offer unauthorized cracked versions of Complainant’s software products; Respondent’s unauthorized use of Complainant’s logo and copyrighted literary works describing Complainant’s products; Respondent’s registration data is obviously incorrect because the street address provided is the same nine digits as the telephone number provided; and Respondent’s use of the disputed domain name to offer to Internet users illegal versions of Complainant’s FLEXI software products with Complainant’s technological protection measures circumvented.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

To succeed in its Complaint, Complainant must establish in accordance with paragraph 4(a) of the Policy:

- i. The disputed domain name is identical or confusingly similar to a trademark 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 has been registered and is being used in bad faith.

Although Respondent did not reply to Complainant's contentions, the burden remains with Complainant to establish by a balance of probabilities, or a preponderance of the evidence, all three elements of paragraph 4(a) of the Policy. A respondent's default would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true. UDRP panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case, *e.g.* where a particular conclusion is *prima facie* obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 4.2 and 4.3; see also *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#) ("The Respondent's default does not automatically result in a decision in favor of the Complainant. The Complainant must still prove each of the three elements required by Policy paragraph 4(a)").

The Panel finds that for the purpose of this dispute, the interests of Complainants are co-extensive based on Complainant's unopposed assertion of an exclusive trademark licensing relationship between Complainants, and that it is appropriate for them to proceed as joint Complainants. See *e.g. Volkswagen Group of America, Inc. v. Kim Hyeonsuk a.k.a. Kim H. Suk, Domain Bar, Young N. and Kang M.N.*, WIPO Case No. [D2014-1596](#); *Starwood Hotels & Resorts Worldwide Inc., et. al. v. Media Insight a/k/a Media Insights*, WIPO Case No. [D2010-0211](#) ("The consolidation of multiple complainants in a single complaint generally should be permitted if the complainants have a truly common grievance against the respondent, and it is equitable and procedurally efficient to do so.")

A. Identical or Confusingly Similar

Ownership of a nationally or regionally registered trademark serves as *prima facie* evidence that Complainant has trademark rights for the purposes of standing to file this Complaint. [WIPO Overview 3.0](#), section 1.2.1. Complainant submitted evidence that the FLEXI trademark has been registered in the United States with priority dating back to March 1995. Thus, the Panel finds that Complainant's rights in the FLEXI trademark have been established pursuant to the first element of the Policy.

The only remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's FLEXI trademark. In this Complaint, the Panel agrees that the disputed domain name is confusingly similar to Complainant's FLEXI trademark because, disregarding the ".com" generic Top-Level Domain ("gTLD"), the trademark is contained in its entirety within the disputed domain name. [WIPO Overview 3.0](#), section 1.7. ("This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name ... [I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar..."). In regards to gTLDs, such as ".com" domain name, they are generally viewed as a standard registration requirement and are disregarded under the first element. [WIPO Overview 3.0](#), section 1.11.

The combination with the term "crack" does not prevent a finding of confusing similarity between Complainant's FLEXI and the disputed domain name. [WIPO Overview](#), section 1.8 ("Additional terms 'whether descriptive, geographic, pejorative, meaningless, or otherwise' do not prevent a finding of confusing similarity under the first element"); see also *AT&T Corp. v. WorldclassMedia.com*, WIPO Case

No. [D2000-0553](#) (“Each of the domain names in dispute comprises a portion identical to [the ATT trademark] in which the Complainant has rights, together with a portion comprising a geographic qualifier, which is insufficient to prevent the composite domain name from being confusingly similar to Complainant’s [ATT trademark]”); see *OSRAM GmbH v. Cong Ty Co Phan Dau Tu Xay Dung Va Cong Nghe Viet Nam*, WIPO Case No. [D2017-1583](#) (“[T]he addition of the letters ‘hbg’ to the trademark OSRAM does not prevent a finding of confusing similarity between the Disputed Domain Name and the said trademark.”).

In view of Complainant’s registrations for the FLEXI trademark, which is reproduced in its entirety within the disputed domain name, the Panel concludes that Complainant has established the first element of the Policy.

B. Rights or Legitimate Interests

Complainant must make out a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name, shifting the burden of production on this element to Respondent to come forward with evidence demonstrating such rights or legitimate interests. Where, as in this Complaint, Respondent fails to come forward with any relevant evidence, Complainant is deemed to have satisfied the second element of the Policy. [WIPO Overview 3.0](#), section 2.1.

It is evident that Respondent, identified by Whois data for the disputed domain name as “Jamanl Hassanli”, is not commonly known by the disputed domain name or Complainant’s FLEXI trademark.

UDRP panels have categorically held that use of a domain name for illegal activity – including the impersonation of the complainant and other types of fraud – can never confer rights or legitimate interests on a respondent. Circumstantial evidence can support a credible claim made by Complainant asserting Respondent is engaged in such illegal activity, including that Respondent has masked its identity to avoid being contactable, or that Respondent’s website has been suspended by its hosting provider. [WIPO Overview 3.0](#), section 2.13. See *e.g. Graybar Services Inc. v. Graybar Elec, Grayberinc Lawrence*, WIPO Case No. [D2009-1017](#) (“Respondent has used the domain name to pretend that it is the Complainant and in particular to create false emails pretending that they are genuine emails coming from the Complainant and one of its senior executives”). See also *The Commissioners for HM Revenue and Customs v. Name Redacted*, WIPO Case No. [D2017-0501](#) (“In addition, the disputed domain names ... have had their web hosting suspended as a result of fraudulent activities. This is evidence of bad faith registration and use of the disputed domain names.”) In its Complaint, Complainant has submitted persuasive evidence detailing Respondent’s illegal scheme to distribute unauthorized versions of Complainant’s software products with Complainant’s technological protection measures disabled, including: Respondent’s website, which advertises “cracked” versions of Complainant’s software, makes unauthorized use of Complainant’s trademarks and copywritten literary works describing Complainant’s software products; and the assertion that Complainant does not offer “unlimited” software subscriptions, in contrast to the subscriptions ostensibly offered on Respondent’s website.

To this end, the second and third elements of the Policy may be assessed together where clear indicia of bad faith suggests that there cannot be any Respondent rights or legitimate interests. [WIPO Overview 3.0](#), section 2.15.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy proscribes the following non-exhaustive circumstances as evidence of bad faith registration and use of the disputed domain name:

- i. Circumstances indicating that Respondent has registered or Respondent has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark to a competitor of that Complainant, for valuable consideration in excess of Respondent’s documented out of pocket costs directly related to the disputed domain name; or

- ii. Respondent has registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- iii. Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. By using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel notes first the composition of the disputed domain name, and accepts Complainant's evidence and prior panel determinations that the term "crack" in the context of software refers to software versions whose security features have been disabled to allow copying and use without authorization from the relevant intellectual property owner. See e.g. *Steinberg Media Technologies GmbH v. Privacy Service Provided by Withheld for Privacy ehf / Ghulam Muhuddeen*, WIPO Case No. [D2022-0427](#).

UDRP panels have categorically held that registration and use of a domain name for illegal activity – including copyright infringement and other types of fraud – is manifestly considered evidence of bad faith within paragraph 4(b)(iv) of the Policy. [WIPO Overview 3.0](#), section 3.1.3. Use of the disputed domain name by Respondent to pretend that it is authorized by, or associated with, Complainant "brings the case within the provisions of paragraph 4(b)(iii) of the Policy, for it shows Respondent registered the domain name primarily for the purpose of disrupting the business of a competitor, namely Complainant". *Graybar Services Inc. v. Graybar Elec, Grayberinc Lawrence*, WIPO Case No. [D2009-1017](#); see also *GEA Group Aktiengesellschaft v. J. D.*, WIPO Case No. [D2014-0357](#) (concluding that respondent's use of the domain name to disrupt the complainant's business by using it to impersonate the complainant for commercial gain was evidence of respondent's bad faith registration and use of the domain name). Circumstantial evidence can support a complainant's otherwise credible claim of illegal respondent activity, including evidence that: (i) goods are offered disproportionately below market value; (ii) goods are ordinarily only sold with Complainant's authorization; (iii) images of the goods used by a respondent suggest they are not genuine; (iv) the respondent has misappropriated copyrighted images from the complainant; (v) the goods at issue are extremely rare; (vi) the goods at issue have prompted consumer complaints; (vii) the respondent has masked its identity to avoid being contactable; and (ix) so-called "trap purchases" demonstrate illegal respondent activity. [WIPO Overview 3.0](#), section 2.13.2. As largely discussed above, Complainant has asserted that: Complainant's software products are only sold with Complainant's authorization through its exclusive licensee; Complainant's software products are never sold without Complainant's technological protection measures; Complainant's software products are never licensed using "unlimited" subscriptions; and Respondent has misappropriated Complainant's trademarks and logos, as well as copywritten literary works, on Respondent's website.

In addition, where it appears that a respondent employs a proxy service, or selects a registrar that automatically applies a proxy service, merely to avoid being contacted by a complainant or notified of a UDRP proceeding filed against it, UDRP panels tend to find that this supports an inference of bad faith. [WIPO Overview 3.0](#), section 3.6. Use of a privacy or proxy registration service to shield a respondent's identity and elude or frustrate enforcement efforts by a legitimate complainant demonstrates bad faith registration and use of a domain name. See *Fifth Third Bancorp v. Secure Whois Information Service*, WIPO Case No. [D2006-0696](#) (the use of a proxy registration service to avoid disclosing the identity of the real party in interest is also consistent with an inference of bad faith when combined with other evidence of evasive, illegal, or irresponsible conduct).

Finally, prior panel determinations agree, the use of false registration data in connection with a disputed domain name further supports a finding of bad faith registration and use. See e.g. *Action Instruments, Inc. v. Technology Associates*, WIPO Case No. [D2003-0024](#) ("Providing false contact information violates paragraph 2 of the Policy, which requires a registrant to represent that the statements it 'made in [its]

Registration Agreement are complete and accurate'. Maintaining that false contact information in the WHOIS records (which can easily be updated at any time) after registration constitutes bad faith use of the domain name because it prevents a putative complainant from identifying the registrant and investigating the legitimacy of the registration.”); *Royal Bank of Scotland Group v. Stealth Commerce v. a.k.a. Telmex Management Services, Inc.*, WIPO Case No. [D2002-0155](#); *Home Director, Inc. v. HomeDirector*, WIPO Case No. [D2000-0111](#). To this end, Complainant has asserted, and the Panel agrees, that the registration data provided by Respondent is most likely false given that Respondent's putative street address is the exact same nine digits as Respondent's telephone number.

In view of the above, the Panel concludes that Complainant has established the second, and third elements 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 <flexicrack.com> be transferred to Complainant.

/Phillip V. Marano/

Phillip V. Marano

Sole Panelist

Date: October 3, 2022