

ADMINISTRATIVE PANEL DECISION

Microban Products Company v. Super Privacy Service LTD c/o Dynadot /
Akin Demir

Case No. D2022-2869

1. The Parties

The Complainant is Microban Products Company, United States of America (“United States”), represented by Nelson Mullins Riley & Scarborough, LLP, United States.

The Respondent is Super Privacy Service LTD c/o Dynadot, United States / Akin Demir, Türkiye.

2. The Domain Name and Registrar

The disputed domain name <biosmartpoweredbymicroban.com> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 4, 2022. On August 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 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 August 8, 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 August 8, 2022.

The Center verified that the Complaint 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 August 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 5, 2022.

The Center appointed David Taylor as the sole panelist in this matter on September 19, 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

The Complainant is a company engaged in the manufacturing of chemical additives that provide antibacterial, antifungal, and antimicrobial properties to various products including textiles, polymers, and glass. The Complainant makes its antimicrobial and odor-control products available in some 30 countries.

The Complainant is the owner of a substantial number of trademarks for MICROBAN, registered in jurisdictions throughout the world, including but not limited to the following:

- United States Trademark Registration No. 1141006, MICROBAN, registered on November 4, 1980 (assigned to the Complainant on November 20, 1984);
- European Union Trade Mark No. 000348276, MICROBAN, registered on October 20, 1998; and
- International Trademark Registration No. 1263886, MICROBAN, registered on January 14, 2015.

In addition to its MICROBAN trademarks, the Complainant is the registrant of the domain name <microban.com>, which resolves to a public-facing website.

On September 24, 2021, the Complainant filed United States Trademark Application No. 97043786 before the United States Patent and Trademark Office (“USPTO”) in respect of “BIOSMART POWERED BY MICROBAN”.

The disputed domain name was registered on September 28, 2021. Prior to submission of the Complaint to the Center, the disputed domain name redirected to a “Sedo.com” parking page, where the disputed domain name was listed with a buy-now price of USD 995. At the time of this decision, the disputed domain name redirects to GoDaddy.com, LLC’s domain broker service web page.

5. Parties’ Contentions

A. Complainant

The Complainant asserts rights in the MICROBAN trademark. The Complainant further claims to have rights in respect of its pending trademark application for “BIOSMART POWERED BY MICROBAN”. The Complainant submits that the disputed domain name is confusingly similar to its MICROBAN trademark, and identical to its pending trademark application for “BIOSMART POWERED BY MICROBAN”.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name, in that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services, the Respondent is not commonly known by the disputed domain name, nor is the Respondent making any legitimate noncommercial or fair use of the disputed domain name.

The Complainant submits that the disputed domain name was registered and is being used in bad faith. The Complainant argues that the Respondent registered the disputed domain name in order to create confusion with the Complainant, and that the Respondent could not credibly argue that it did not have knowledge of the Complainant’s rights having registered the disputed domain name only four days after the Complainant’s submission of its application for registration of “BIOSMART POWERED BY MICROBAN” before the USPTO. The Complainant refers to the Respondent’s use of the disputed domain name to resolve to a “Sedo.com”

page where the disputed domain name was listed for sale, and submits that this signals an intent on the part of the Respondent to profit from the sale of the disputed domain name comprising the Complainant's trademark.

The Complainant requests transfer of the disputed domain name.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

In order to prevail the Complainant must demonstrate on the balance of probabilities that it has satisfied the requirements of paragraph 4(a) of the Policy:

- (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 was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights in the trademark MICROBAN, the registration details of which are provided in the factual background section above.

The disputed domain name comprises the Complainant's MICROBAN trademark in its entirety, preceded by the element "biosmartpoweredby", under the generic Top-Level Domain ".com".

Prior UDRP panels have found that in 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 to that mark for purposes of UDRP standing; see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

Insofar as the Complainant's pending trademark application for "BIOSMART POWERED BY MICROBAN" is concerned, it is well established that a pending trademark application would not by itself establish trademark rights within the meaning of paragraph 4(a)(i) of the Policy; see [WIPO Overview 3.0](#), section 1.1.4; see also *Intellect Design Arena Limited v. Moniker Privacy Services / David Wieland, iEstates.com, LLC*, WIPO Case No. [D2016-1349](#):

"[...] it is the preponderant view of panels under the Policy that unless such applications have proceeded to grant they do not constitute trademarks in which a complainant has UDRP-relevant rights."

Nevertheless, the Panel finds that the addition of the element "biosmartpoweredby" in the disputed domain name, immediately before the Complainant's MICROBAN trademark does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's MICROBAN trademark which remains recognizable in the disputed domain name; see [WIPO Overview 3.0](#), section 1.8.

The Panel finds the disputed domain name to be confusingly similar in the MICROBAN trademark in which the Complainant has rights. The Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element; see [WIPO Overview 3.0](#), section 2.1.

The Respondent is not a licensee of the Complainant, nor has the Complainant granted any permission for the Respondent to make use of its MICROBAN trademark in a domain name or otherwise.

As noted above, the disputed domain name previously resolved to a “Sedo.com” parking page listing the disputed domain name for sale with a buy-now price of USD 995. At the time of this decision, the disputed domain name redirects to GoDaddy.com LLC’s domain broker service web page. In light of the similarity between the disputed domain name and the Complainant’s MICROBAN trademark, and the timing of the registration of the disputed domain name *vis-à-vis* the Complainant’s filing of its trademark application for “BIOSMART POWERED BY MICROBAN” before the USPTO, a mere four days earlier, the Panel infers that the Respondent’s parking and offering the disputed domain name for sale was intended to capitalize on the reputation and goodwill associated with the Complainant. Such activity does not qualify as use of the disputed domain name in connection with a *bona fide* offering of goods or services pursuant to paragraph 4(c)(i) of the Policy.

The Respondent registered the disputed domain name using a privacy service to mask its identity. The Respondent’s identity has been disclosed by the Registrar as “Akin Demir”, which bears no resemblance to the disputed domain name whatsoever. There is no evidence of the Respondent having acquired any trademark rights that are reflected in the disputed domain name, nor has the Respondent made use of the disputed domain name so as to confer reputation in the disputed domain name on the Respondent. The Panel finds there to be no evidence that the Respondent is commonly known by the disputed domain name as contemplated by paragraph 4(c)(ii) of the Policy. Nor is the Respondent making any legitimate noncommercial or fair use of the disputed domain name within the meaning of paragraph 4(c)(iii) of the Policy.

For reasons set out above, the Panel finds that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has not come forward to produce any evidence to rebut the Complainant’s case. Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Complainant’s rights in the MICROBAN trademark predate the Respondent’s registration of the disputed domain name by many years. The Panel notes that the Respondent proceeded to register the disputed domain name only four days after the Complainant filed its trademark application for “BIOSMART POWERED BY MICROBAN” before the USPTO. Prior UDRP panels have held that a respondent’s registration of a domain name to unfairly capitalize on a complainant’s yet unregistered trademark rights amounts to bad faith, including where registration of a domain name occurs following the complainant’s filing of a trademark application; see [WIPO Overview 3.0](#), section 3.8.2.

In light of the timing of the Respondent’s registration of the disputed domain name, and the Respondent’s parking the disputed domain name and listing it for sale via Sedo.com with a buy-now price of USD 995, the Panel considers that the Respondent registered the disputed domain name opportunistically, primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the Complainant or to a competitor of the Complainant, for valuable consideration likely in excess of the Respondent’s documented

out-of-pocket costs directly related to the domain name, in bad faith pursuant to paragraph 4(a)(i) of the Policy. See in this regard *Fat Face Holdings Limited v. DOMAIN ADMINISTRATOR, DOMAIN IS FOR SALE AT WWW.DAN.COM*, WIPO Case No. [D2021-2945](#):

“The Panel finds it hard to find any plausible explanation for a good faith registration of the Disputed Domain Name given this occurred a day after the Complainant filed a trademark application for FAT FACE MADE FOR LIFE in the United Kingdom, and on the same day of the trademark application for FAT FACE MADE FOR LIFE in the European Union.

The obvious inference is that the Respondent is engaged in a practice of speculatively registering a domain name, which corresponds to a filed trademark application and then hopes to sell that domain name to the trademark owner, probably for valuable consideration in excess of the out-of-pocket costs. That amounts to evidence of registration and use in bad faith within paragraph 4(b)(i) of the Policy.”

The current redirection of the disputed domain name to GoDaddy.com LLC’s domain broker service web page does not materially alter the Panel’s findings.

The Panel finds that the disputed domain name was registered and is being used in bad faith. The Complainant has satisfied the requirements of paragraph 4(a)(iii) 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 <biosmartpoweredbymicroban.com> be transferred to the Complainant.

/David Taylor/

David Taylor

Sole Panelist

Date: October 3, 2022