

## **ADMINISTRATIVE PANEL DECISION**

**Inversiones MCN S.A.S. v. Domains By Proxy, LLC DomainsByProxy.com /  
Tamarak Marketing, Tamarak Capital  
Case No. D2022-3219**

### **1. The Parties**

The Complainant is Inversiones MCN S.A.S., Colombia, represented by Holland & Knight LLC, Colombia.

The Respondent is Domains By Proxy, LLC DomainsByProxy.com, United States of America (“United States”) / Tamarak Marketing, Tamarak Capital, United States, represented by Stoel Rives, LLP, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <habi.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 August 31, 2022. On August 31, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 31, 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 September 1, 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 September 2, 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 September 5, 2022. On September 13, 2022, the Respondent requested an extension of the Response due date. In accordance with the Rules, paragraph 5, the due date for Response was September 29, 2022. The Response was filed with the Center on September 29, 2022.

The Center appointed John Swinson as the sole panelist in this matter on October 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

The Complainant is a company based in Bogotá, Colombia. It was established in July 2019. The Complainant operates an online platform to allow sellers of real estate to sell properties online.

The Complainant owns trademark registrations in Colombia, Mexico and Peru, and has pending applications in these countries and Chile. The Complainant's trademark registrations include HABI in logo format (the work HABI is located inside of a purple house) which is Colombian registration number 646241 filed on September 27, 2019. The Complainant also has trademark registrations for the word TUHABI and HABIMETRO. The Complainant does not own a trademark registration for the word HABI alone.

The Complainant uses a slogan in Colombia that includes the word HABI, which is "Es Simple, Es Seguro, Es Habi". This translates as "It is simple, it is secure, it is Habi."

The Complainant registered the domain name it currently uses, namely <habi.co>, on September 20, 2019. This domain name currently resolves to a website in Spanish.

The Complaint lists "Tamarak Marketing" as the Registrant and "Habi Partners Inc" ("Habi Partners") as the Respondent. The Complaint does not explain this. Most of the Complaint concerns Habi Partners and no substantive submissions are made concerning Tamarak Marketing.

The entity who is listed in the Registrar's records as the owner of the disputed domain name is Tamarak Marketing (listed as the Registrant Name) and Tamarak Capital (listed as the Registrant Organization). It is unclear to the Panel the role of Tamarak Marketing and Tamarak Capital or their relationship to Habi Partners.

The exhibits to the Response includes a Subscription Agreement dated February 2021 where Tamarak LLC makes a subscription to Habi Investment Fund I, LLC.

Much of the evidence of both of the parties concerns the entity called Habi Partners. Habi Partners was incorporated on April 5, 2019.

It appears that Habi Partners controls the disputed domain name and the website located at the disputed domain name. This is discussed further below.

Habi Partners obtained a trademark search report in March 2019 that searched for and reviewed United States trademarks for HABI. The Complainant, not existing at this time, did not appear on this search report.

The CEO of Habi Partners, Mr. Whiting, submitted a signed declaration. He says "On April 9, 2019, [Habi Partners] through Registrant Tamarak Marketing secured several domains using the word HABI, including <gohabi.com>, <behabi.com>, <gethabi.com>, <hellohabi.com>, <heyhabi.com>, and <hihabi.com>." Habi Partners used <gohabi.com> as its primary domain name from April 2019 until January 2021 as discussed further below.

The disputed domain name was registered on December 12, 1997.

Mr. Whiting contacted the then owner of the disputed domain name in April and May 2019 with the intention of buying the disputed domain name. Mr. Whiting offered USD 5,000 and hinted that he was prepared to offer USD 10,000, but the owner of the disputed domain name at that time wanted USD 25,000 because it

was a four-letter domain name. No purchase then resulted, and so it appears that Habi Partners launched using <gohabi.com>.

Habi Partners filed for a United States trademark registration on April 29, 2019 for HABI in relation to mobile phone software that can be used for home financing. This application has been accepted, but has not issued as a registration because no Statement of Use has yet been filed. See Serial No. 88984683. Habi Partners has also filed a divisional United States trademark application from this application for HABI in respect of financial services, and has filed a statement of use claiming a date of first use in respect of these services of April 30, 2019. See Serial No. 88984683. Being a divisional application, this application has the benefit of the April 29, 2019 filing date.

From the evidence provided to the Panel by the Respondent, it appears that Habi Partners started its initial business activities in April 2019, but did not launch its HABI home equity investment services until January 2021.

In December 2020, Mr. Whiting re-opened discussions with the then owner of the disputed domain name. According to Mr. Whiting, on or around December 22, 2020, Habi Partners completed the transaction and purchased the disputed domain name. The Habi Partners website went live using the disputed domain name in January 2021, and the other domain names (e.g. <gohabi.com>) were redirected to the website at the disputed domain name from this time.

In March and April 2022, Mr. Whiting stated that he noticed a significant amount of traffic on the website at the disputed domain name coming from Colombia. He researched the issue, and identified the Complainant as a likely cause, and contacted the Complainant to discuss a solution. Mr. Whiting proposed to the Complainant a “geo IP forward” application on the disputed domain name so that visitors located in Colombia would be automatically redirected to the Complainant’s website. As part of these discussions, the Complainant asked Mr. Whiting whether he would be interested in selling the disputed domain name. Mr. Whiting said that he was not interested. After further discussions, in which the Complainant appears to have pushed Mr. Whiting for a sales price, on July 1, 2022, Mr. Whiting responded to the Complainant that his Board was prepared to sell the disputed domain name to the Complainant for the cost of rebranding, which was USD 12,500,000 paid over three years, or USD 5,000,000 plus equity in the Complainant. Mr. Whiting wrote in an email to the Complainant:

“I’ve discussed the possibility of selling the Habi.com domain with the board. We don’t currently have any intention of going through the time and spending the money needed to do a “rebrand”. In short, I imagine we are far off and it would be best to discuss the geo IP forward. Nevertheless, if there was the interest to purchase the domain and the rights thereof terms would need to be [the amounts set out above].”

When this offer was rejected by the Complainant, Mr Whiting responded:

“Understood and was our anticipated outcome. If you’d still like to pursue the geo IP forward let me know.”

At the present time, the disputed domain name resolves to Habi Partner’s website, which is in English, and offers financial loan and mortgage products to consumers in the United States. From information obtained by the Panelist via this website, Habi Partners only currently invests in Utah and a few select areas of the United States.

## **5. Parties’ Contentions**

### **A. Complainant**

In summary, the Complainant made the following submissions:

The Complainant owns several registered trademarks and has pending trademark applications in Colombia, Mexico, Peru and Chile that include the term HABI. The Complainant uses the domain name <habi.co> and owns several other domain names that include the term HABI.

The disputed domain name is identical to the Complainant's HABI trademark.

The Respondent is not commonly known by the disputed domain name and has not acquired or registered a trademark relating to the disputed domain name. The Respondent has not proven use of HABI to the United States Trademark Office and so its trademark application for HABI has not issued as a registration.

The first active website at the disputed domain name was in January 2021.

From a review of the public records, Habi Partners has no operation.

The Respondent's main purpose of acquiring the disputed domain name was to offer it to the Complainant.

The Respondent's failure to make good faith use of the disputed domain name indicates that the Respondent's primary purpose was to sell the disputed domain name.

The traffic to the website at the disputed domain name only comes from Colombia.

The Complainant tried to buy the disputed domain name in 2020, but was unable to make contact with the owner of the disputed domain name at that time.

The registration of the disputed domain name has been conducted in bad faith and is obviously being used for misleading consumers.

Habi Partners Inc. requested sales price ranging from USD 5,000,000 to USD 12,500,000 is an absurd amount of money for the disputed domain name, with no proof of use or legitimate commercial activity.

## **B. Respondent**

In summary, the Respondent made the following submissions:

In April 2019, the Respondent formed Habi Partners, Inc., filed a United States trademark application for HABI, and contacted the prior owner of <habi.com> to negotiate a purchase. These events occurred before the Complainant owned any rights in its asserted HABI mark and before the Complainant even existed.

The Complainant argues that "all trademarks and distinctive signs containing the word 'HABI' are owned or requested by the Complainant." However, several other companies worldwide, in addition to the Respondent, are using the mark "HABI".

The Complainant argues that web traffic on habi.com is "solely Colombian." However, the Complainant's own evidence shows that even during an abnormal spike in web traffic, over 40% of the traffic on the disputed domain name is from the United States.

The Respondent's purpose in registering the disputed domain name is to serve the Respondent's HABI-branded business, and the Respondent has made repeated efforts in good faith to reduce and avoid any confusion with the Complainant. Yet the Complainant has not responded in good faith. The allegation that the Respondent had a "purpose of misleading consumers" is false.

The Response includes many pages and exhibits to show that the Respondent selected the HABI trademark and name, and conducted business under the HABI trademark, before the Complainant existed.

The Respondent has used its HABI trademark in commerce since at least April 30, 2019, which gives the Respondent superior rights in the trademark HABI over the Complainant. When a domain name is registered before a trademark right is established, the registration of the domain name was not in bad faith because the registrant could not have contemplated the complainant's non-existent right.

In 2022, the Respondent reached out to the Complainant to express appreciation for the Complainant and to discuss a solution to reduce confusion.

The Complainant requested to purchase the disputed domain, and the Respondent declined multiple times. The Respondent never intended to sell the disputed domain name to the Complainant unless the Complainant would agree to a price that would incentivize the Respondent to give up all the work it had invested in its HABI brand since 2019 and begin again with a new brand.

Whether judging by trademark application filing date, by domain name registration date, or by actual use of HABI as a brand, the Respondent's use of HABI pre-dates and has priority over the Complainant's use from all three perspectives. Despite the Respondent's prior rights in the HABI trademark, the Complainant has tried to leverage its rapid growth and popularity in Latin America to take away the Respondent's legitimate use of the disputed domain name. The Respondent requests a finding that the Complainant has attempted Reverse Domain Name Hijacking in violation of the Policy.

## **6. Discussion and Findings**

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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.

The onus of proving these elements is on the Complainant.

Paragraph 15(a) of the Rules directs the Panel to decide the 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. Procedural Issues – the Respondent**

The party who owns the disputed domain name, according to the Registrar's records, is Tamarak Marketing or Tamarak Capital. Both the Complainant and the Response list in their submissions "Tamarak Marketing" as the Registrant and "Habi Partners Inc" as the Respondent.

Little information is provided regarding Tamarak Marketing, and the relationship between Tamarak Marketing and Habi Partners is unclear. It appears that Tamarak Marketing is an agent of Habi Partners, but no evidence was provided to support this, and neither party directly asserted this.

The burden of proof is on the Complainant, and there is no evidence before the Panel that directly associates the conduct of Habi Partners with the Registrant of the disputed domain name. The Panel could take the view that the conduct of Habi Partners is not relevant to the second and third elements of the Policy discussed below.

However, both parties have proceeded on the basis that Habi Partners controls the disputed domain name and the website at the disputed domain name. The evidence provided supports this.

The Panel will proceed on the basis that the Respondent is Tamarak Marketing, and that the conduct of Habi Partners is relevant to and can be associated with the Respondent. This approach, taken by the Complainant, has not been objected to by the Respondent.

In the reasons below, unless expressly stated otherwise, the term "Respondent" will be used to include Habi Partners.

## **B. Identical or Confusingly Similar**

Paragraph 4(a)(i) of the Policy provides that the Complainant must establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant owns trademark registrations for device trademarks that include HABI as the only word in the device.

Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy when the domain name includes the trademark, or a confusingly similar approximation. See, for example, *Consumer Reports, Inc. v. Wu Yan, Common Results, Inc.*, WIPO Case No. [D2017-0371](#); and *Captain Fin Co. LLC v. Private Registration, NameBrightPrivacy.com / Adam Grunweg*, WIPO Case No. [D2021-3279](#).

The disputed domain name includes HABI in its entirety.

The Panel concludes that the disputed domain name is identical or confusingly similar to the Complainant's HABI trademark.

The Complainant succeeds on the first element of the Policy.

## **C. Rights or Legitimate Interests**

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or

(iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant.

The Panel's view is that Habi Partners has *bona fide* use of HABI as a trademark before notice of the dispute, and if Habi Partners was the registered owner of the disputed domain name, the Complainant would not succeed on the second element of the Policy. However, as discussed above, Habi Partners' exact relationship with Tamarak Marketing is unclear, and so the Panel does not wish to decide this dispute on that basis.

In view of the Panel's finding in respect of bad faith below, the Panel does not need to decide this issue.

#### **D. Registered and Used in Bad Faith**

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and subsequently used the disputed domain names in bad faith.

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by the complainant. The question to be asked is whether the respondent registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant. This requires proof that when the respondent registered or acquired the disputed domain name, the respondent was aware of the Complainant or its trademark and then registered or acquired the disputed domain name with the intent to take advantage of the trademark value or significance of the complainant's trademark.

In this case, there is clear evidence that the Respondent selected HABI as its brand in March or April 2019. The Complainant was not established until July 2019, and there is no evidence of use of HABI by the founders of the Complainant prior to this date. Accordingly, the Respondent could not have selected HABI as its brand to target the Complainant who did not exist at that time.

Further, there is other evidence to support the Respondent's good faith. For example, the Respondent obtained a trademark search report in March 2019 (that of course did not list the Complainant) and, from the evidence before the Panel, took care when selecting HABI as its name and brand so not to infringe another's trademark rights.

Until December 2020, the disputed domain name was owned by a third party. Both the Complainant and the Respondent selected HABI as their branding knowing that the disputed domain name was unavailable. Both the Complainant and the Respondent had the opportunity to buy the disputed domain name from the owner, and in fact, the Respondent attempted to do so in April 2019 (before the Complainant existed) but could not afford the asking price, and then successfully purchased the disputed domain name in December 2020 (after the Complainant launched its business in Colombia) when the Respondent had raised capital and could afford the asking price.

When the Respondent acquired the disputed domain name in December 2020, the Complainant did exist and was trading in Colombia. It is unclear whether the Respondent knew of the Complainant at this time. The Respondent did not assert that the Respondent was unaware of the Complainant when acquiring the disputed domain name in December 2020. However, the evidence is clear that the Respondent did not purchase the disputed domain name because of the Complainant. The Respondent purchased the disputed domain name to implement its original plan from April 2019, and to replace its <gohabi.com> domain name with the disputed domain name to better match its brand and corporate name (which as stated above were selected before the Complainant in fact existed).

There is also no evidence that the Respondent acted in bad faith in using the disputed domain name. The Respondent's website does not target the Complainant's customers, is in a different language, and operates in a different geographical region. Although the Complainant and the Respondent are broadly in the same field, often called PropTech or real estate technology, the circumstances do not lead to a finding of bad faith. In fact, when the Respondent realized that the Respondent's website was receiving traffic from Colombia intended for the Respondent, which was to neither party's benefit, the Respondent reached out to the

Complainant to propose a technical solution to assist the Complainant.

The Respondent did not offer the disputed domain name for sale to the Complainant. The Complainant requested the Respondent sell the disputed domain name to the Complainant. The correspondence strongly suggests that the Respondent did not wish to sell the disputed domain name. In the circumstances, the price offered by the Respondent to the Complainant for the disputed domain name, although high, is not in the circumstances evidence of bad faith – a sale of the disputed domain name would require the Respondent to rebrand, and the disputed domain name is an intrinsically valuable four-letter domain name with many possible legitimate uses.

The Complainant has not demonstrated that the Respondent registered or sub sequential used the disputed domain name in bad faith.

#### **E. Reverse Domain Name Hijacking (RDNH)**

The Respondent seeks a finding of RDNH.

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”.

RDNH is defined in the Rules as “using the Policy in bad faith to attempt to deprive a registered domain name holder of a domain name”.

The Panel finds that this is a case of RDNH.

The Complainant tried to buy the disputed domain name from the Respondent and was unsuccessful. At that time, the Complainant made no allegations that the Respondent was acting in bad faith or was not entitled to own the disputed domain name.

There is no persuasive evidence in the record that the Respondent at any time targeted the Complainant’s rights in the Complainant’s trademarks.

The Complainant, when filing the Complaint, was aware that the Respondent had filed a United States trademark application for HABI before the Complainant existed. Unless the Complainant presented evidence or submissions that this trademark application was a sham, which the Complainant did not, the Complainant should have been aware from this fact alone that its chances of success in this dispute were grim. But the Complainant proceeded with its Complaint.

Accordingly, the Panel finds that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

#### **7. Decision**

For the foregoing reasons, the Complaint is denied.

*/John Swinson/*

**John Swinson**

Sole Panelist

Date: October 20, 2022