

## **ADMINISTRATIVE PANEL DECISION**

IP86, LLC v. jones thammy

Case No. D2022-4287

### **1. The Parties**

The Complainant is IP86, LLC, United States of America ("United States"), represented by Osha Bergman Watanabe & Burton LLP, United States.

The Respondent is jones thammy, United States.

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

The disputed domain name <epconcommunitiesllc.com> (the "Disputed Domain Name") is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 10, 2022. On November 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On November 12, 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 November 16, 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 December 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 December 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 25, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 29, 2022.

The Center appointed Lynda M. Braun as the sole panelist in this matter on January 25, 2023. 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 in the United States that since 2002 has been involved in the provision of residential building construction services and related services such as building inspections and training courses in relation to construction services. The Complainant is a closely-related company to the Epcon Communities Franchising family of companies. The Complainant promotes its services under the EPCON and EPCON COMMUNITIES brands, including through its official website at "www.epconcommunities.com". The Complainant is the owner of various incontestable trademarks with the United States Patent and Trademark Office ("USPTO"), consisting of the terms EPCON and/or EPCON COMMUNITIES, including, but not limited to: EPCON, United States Registration No. 3,564,430, registered on January 20, 2009, in International Classes 35 and 37; EPCON COMMUNITIES, United States Registration No. 3,216,379, registered on May 6, 2007, in International Class 35, EPCON COMMUNITIES, United States Registration No. 3,079,215, registered on April 11, 2006, in International Class 37; and EPCON, United States Registration No. 5,190,678, registered on April 25, 2017, in International Class 36.

The aforementioned trademarks will hereinafter be referred to as the "EPCON COMMUNITIES Mark".

Moreover, the Complainant owns domain names incorporating the EPCON COMMUNITIES Mark, including <epconcommunities.com>, <epconcommunities.info>, <epconcommunities.net>, <epconcommunities.org>, <epconhomesandcommunities.com>, and <epconcommunitiesandhomes.com>, among others.

The Disputed Domain Name was registered on October 10, 2022, long after the Complainant established rights in and to the EPCON COMMUNITIES Mark. The Disputed Domain Name redirects to a passive landing page with no substantive content that states: "This site can't be reached. epconcommunitiesllc.com took too long to respond."

#### **5. Parties' Contentions**

##### **A. Complainant**

The following are the Complainant's contentions:

- the Disputed Domain Name is confusingly similar to the Complainant's EPCON COMMUNITIES Mark;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;
- the Disputed Domain Name was registered and is being used in bad faith; and
- the Complainant seeks the transfer of the Disputed Domain Name from the Respondent to the Complainant in accordance with paragraph 4(i) of the Policy.

##### **B. Respondent**

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

#### **6. Discussion and Findings**

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

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

#### **A. Identical or Confusingly Similar**

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry: a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the EPCON COMMUNITIES Mark.

It is uncontroverted that the Complainant has established rights in the EPCON COMMUNITIES Mark based on its registered and incontestable trademarks for the EPCON COMMUNITIES Mark in the United States. Moreover, the registration of a mark 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. Thus, the Panel finds that the Complainant has rights in the EPCON COMMUNITIES Mark.

The Disputed Domain Name consists of the EPCON COMMUNITIES Mark followed by the term "llc" (the abbreviation for a common business designation that stands for "Limited Liability Company"), followed by the generic Top-Level Domain ("gTLD") ".com". It is well established that a domain name that wholly incorporates a trademark may be deemed confusingly similar to that trademark for purposes of the Policy despite the addition of other terms. Moreover, where the trademark is recognizable in the Disputed Domain Name, the addition of a term such as "llc" does not prevent a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.8 ("where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element."). For example, numerous UDRP decisions have reiterated that the addition of other terms to a trademark does not prevent a finding of confusing similarity. See *Allianz Global Investors of America, L.P. and Pacific Investment Management Company (PIMCO) v. Bingo-Bongo*, WIPO Case No. [D2011-0795](#); and *Hoffmann-La Roche Inc. v. Wei-Chun Hsia*, WIPO Case No. [D2008-0923](#).

Further, the addition of a gTLD such as ".com" in a domain name is a technical requirement. Thus, it is well established that, as here, such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainant.

#### **B. Rights or Legitimate Interests**

Under the Policy, a complainant has to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent carries the burden of production of evidence that demonstrates rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

In this case, given the facts as set out above, the Panel finds that the Complainant has made out a *prima facie* case. The Respondent has not submitted any arguments or evidence to rebut the Complainant's *prima facie* case. Furthermore, the Complainant has not authorized, licensed or otherwise permitted the Respondent to use its EPCON COMMUNITIES Mark. Nor does the Complainant have any type of business

relationship with the Respondent. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any similar name, nor any evidence that the Respondent was using or making demonstrable preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services. See Policy, paragraph 4(c). Rather, the Disputed Domain Name does not resolve to an active website.

Moreover, the composition of the Disputed Domain Name, comprising the entirety of the EPCON COMMUNITIES Mark, carries a risk of implied affiliation and cannot constitute fair use here, as it effectively suggests sponsorship or endorsement by the Complainant. See [WIPO Overview 3.0](#), section 2.5.1.

The Panel concludes that nothing on the record before it would support a finding that the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name.

In sum, the Panel finds that the Complainant has established an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

Accordingly, the Panel finds that the second element of paragraph 4(a) of the Policy has been met by the Complainant.

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

The Panel finds that, based on the record, the Complainant has demonstrated the existence of the Respondent's bad faith pursuant to paragraph 4(b) of the Policy as set forth below.

The Panel finds that the Respondent had actual knowledge of the Complainant's EPCON COMMUNITIES Mark and targeted the Complainant when it registered the Disputed Domain Name, demonstrating the Respondent's bad faith. Based on the use of the EPCON COMMUNITIES Mark in the United States, it strains credulity to believe that the Respondent had not known of the Complainant or its EPCON COMMUNITIES Mark when registering the Disputed Domain Name. Moreover, the choice of addition term "llc" (a common business structure abbreviation that is also the same structure adopted by the Complainant) further supports such an inference. Such conduct indicates that the Respondent registered and used the Disputed Domain Name in bad faith.

Moreover, as described above, the Disputed Domain Name redirects to a passive landing page with no substantive content. Inactive or passive holding of the Disputed Domain Name by the Respondent does not prevent a finding of bad faith. See *Advance Magazine Publishers Inc. and Les Publications Condé Nast S.A. v. ChinaVogue.com*, WIPO Case No. [D2005-0615](#); and *Société pour l'Oeuvre et la Mémoire d'Antoine de Saint Exupéry – Succession Saint Exupéry – D'Agay v. Perlegos Properties*, WIPO Case No. [D2005-1085](#). It has long been held in UDRP decisions that the passive holding of a domain name that incorporates a well-known trademark without rights or legitimate interests may indicate that the Disputed Domain Name is being used in bad faith under paragraph 4(a)(iii) of the Policy. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); see also [WIPO Overview 3.0](#), section 3.3 (non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding). Here, the circumstances of this case, including the distinctiveness of the EPCON COMMUNITIES Mark, the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good faith use, and the implausibility of any good faith use to which the confusingly similar Disputed Domain Name may be put, support a finding of bad faith.

Accordingly, the Panel finds that the third element of paragraph 4(a) of the Policy has been met by the Complainant.

## 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 <epconcommunitiesllc.com> be transferred to the Complainant.

*/Lynda M. Braun/*

**Lynda M. Braun**

Sole Panelist

Date: February 8, 2023