

## **ADMINISTRATIVE PANEL DECISION**

### **Asset Marketing Services, LLC v. Smayka Smaks Case No. D2023-0227**

#### **1. The Parties**

The Complainant is Asset Marketing Services, LLC, United States of America (“United States”), represented by Law Offices of Armen R. Vartian, United States.

The Respondent is Smayka Smaks, United Kingdom.

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

The disputed domain name <usagovmint.com> (the “Domain Name”) 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 January 18, 2023. On January 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 19, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 the Respondent of the Complaint, and the proceedings commenced on January 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 13, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 13, 2023.

The Center appointed Nicholas Smith as the sole panelist in this matter on February 17, 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 United States company that since 2006 has sold coins made of precious metals, collectable currency, and related accessories, under a trademark consisting of the word GOVMINT (the "GOVMINT Mark"). The Complainant is also the registrant of the domain name <govmint.com> where it offers its products for sale to the general public. According to the Complainant's website, it is "one of the largest distributors of collectible coins and currency issues in the United States; and, of course, as a private retailer, [it is] not affiliated with the U.S. government or U.S. Treasury in any way."

The Complainant holds a number of registered trademarks for the GOVMINT Mark, including United States trademark registration number 3,704,893, registered since November 3, 2009, for services that include services relating to an online retail store featuring coins in class 35.

The Domain Name <usagovmint.com> was registered on October 24, 2022. It is presently inactive but prior to the commencement of the proceeding resolved to a website ("the Respondent's Website") that purports to offer collectable coins and coins made of precious metal, under the Complainant's GOVMINT Mark in direct competition with the Complainant's coin retail services.

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

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

The Complainant makes the following contentions:

- (i) the Domain Name is identical or confusingly similar to the Complainant's GOVMINT Mark;
- (ii) the Respondent has no rights nor any legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

The Complainant is the owner of the GOVMINT Mark having registered the GOVMINT Mark in the United States and various other jurisdictions. The Domain Name wholly incorporates the GOVMINT Mark along with the geographical term "usa", and the generic Top-Level Domain ("gTLD") ".com".

There are no rights or legitimate interests held by the Respondent in respect of the Domain Name. The Complainant has not granted any license or authorization for the Respondent to use the GOVMINT Mark. The Respondent does not use the Domain Name for a *bona fide* purpose or legitimate noncommercial purpose. Rather the Domain Name resolves to a page that offers collectable coins in direct competition with the Complainant. This does not provide the Respondent with rights or legitimate interests.

The Domain Name was registered and is being used in bad faith. By using the Domain Name to resolve to a website that purports to offer collectable coins in competition with the Complainant, the Respondent is using the Domain Name to attract Internet users searching for the Complainant to a competing website for commercial gain by creating a likelihood of confusion with the Complainant's GOVMINT Mark.

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

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

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

To prove this element the Complainant must have trademark or service mark rights and the Domain Name must be identical or confusingly similar to the Complainant's trademark or service mark.

The Complainant is the owner of the GOVMINT Mark, having registrations for the GOVMINT Mark as a trademark in the United States. The Domain Name wholly incorporates the GOVMINT Mark along with the geographic abbreviation "usa", and the gTLD ".com", which can be discounted as an essential element of any domain name.

Previous UDRP panels have repeatedly held that the addition of other terms to a wholly incorporated trademark (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element; see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). See also *The Bank of Nova Scotia v. Whois Protection*, WIPO Case No. [D2007-0884](#); and *Valero Energy Corporation, Valero Marketing and Supply Company v. Domain Name Proxy, LLC, Navigation Catalyst Systems, Inc.*, WIPO Case No. [D2011-1227](#).

The Panel finds that the Domain Name is confusingly similar to the Complainant's GOVMINT Mark.

Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

### B. Rights or Legitimate Interests

To succeed on this element, a complainant must make out a *prima facie* case that the respondent lacks rights to or legitimate interests in the domain name. If such a *prima facie* case is made out, then the burden of production shifts to the respondent to demonstrate rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests in a domain name:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

The Respondent is not affiliated with the Complainant in any way. The Respondent has not been authorized by the Complainant to register or use the Domain Name or to seek the registration of any domain name incorporating the GOVMINT Mark or a mark similar to the GOVMINT Mark. There is no evidence that the Respondent is commonly known by the Domain Name or any similar name. There is no evidence that the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a legitimate noncommercial fair use or a *bona fide* offering of goods and services. The Respondent's use of the Domain Name to display a webpage offering collectible and high-value coins in direct competition with

the coins offered by the Complainant under the same trademark does not, on the face of it, amount to use for a *bona fide* offering of goods and services.

The Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has had the opportunity to put on evidence of its rights or legitimate interests, including submissions as to why its conduct amounts to a right or legitimate interest in the Domain Name under the Policy. In the absence of such a Response, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name under paragraph 4(a)(ii) of the Policy.

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

For the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or
- (ii) the Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location. (Policy, paragraph 4(b)).

The Panel finds that the Respondent must have been aware of the Complainant and its reputation in the GOVMINT Mark at the time the Respondent registered the Domain Name. The Respondent has provided no explanation, and neither it is immediately obvious, why an entity would register a domain name incorporating the GOVMINT Mark and redirect it to a website purportedly offering collectable coins unless there was an awareness of and an intention to create a likelihood of confusion with the Complainant and its GOVMINT Mark. In these circumstances, the Respondent's conduct in registering the Domain Name when it was aware of the Complainant's rights and lacked rights or legitimate interests of its own, amounts to registration in bad faith.

The Respondent's Website purports to offer collectable coins in direct competition with the Complainant. Given that the Respondent has offered no plausible explanation for the registration of the Domain Name, the Panel finds that that the Respondent is using the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the GOVMINT Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website. As such, the Panel finds that the Domain Name is being used in bad faith.

Accordingly, the Panel finds that the Respondent has registered and is using the Domain Name in bad faith under 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 Domain Name, <usagovmint.com> be transferred to the Complainant.

*/Nicholas Smith/*

**Nicholas Smith**

Sole Panelist

Date: March 1, 2023