

ADMINISTRATIVE PANEL DECISION

GRANTIFY LTD v. William Hood, WLH, LLC

Case No. D2023-1507

1. The Parties

The Complainant is GRANTIFY LTD, United Kingdom, represented by Shakespeare Martineau LLP, United Kingdom.

The Respondent is William Hood, WLH, LLC, United States of America (“United States”), self-represented.

2. The Domain Names and Registrar

The disputed domain names <grantify.app>, <grantify.com>, <grantify.net>, and <grantify.org> are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 27, 2023. On April 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 7, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Carlos Paredes, Registration Private, Domains By Proxy, LLC,) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 13, 2023, 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 April 18, 2023.

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 April 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 14, 2023. On May 11, 2023, the Respondent requested an extension of the due date for Response under paragraph 5(b) of the Rules. On May 12, 2023, the Center extended the

due date for the Response to May 18, 2023. The Respondent sent the Response to the Center on May 18, 2023.

On May 31, 2023, the Complainant submitted a supplemental filing, and on June 7, 2023, the Respondent submitted a supplemental filing in reply.

The Center appointed Assen Alexiev as the sole panelist in this matter on June 6, 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 was incorporated in October 2019. It assists startup businesses to acquire government grant funding in the United Kingdom and more recently in the United States.

The Complainant is the owner of the following trademark registrations for the sign “GRANTIFY” (the “GRANTIFY trademark”):

- the United Kingdom trademark GRANTIFY LTD with registration No.UK00003564144, registered on June 25, 2021, for services in International Class 36; and
- the United Kingdom trademark GRANTIFY with registration No. UK00003564268, registered on June 25, 2021, for services in International Class 36.

The Complainant’s official website is located at the domain name <grantify.io>, registered on August 26, 2020.

The disputed domain name <grantify.com> was registered on November 25, 2009, and was acquired by the Respondent on April 26, 2021. It resolves to an underdeveloped website for the Respondent’s product.

The disputed domain names <grantify.org>, <grantify.net>, and <grantify.app> were registered by the Respondent on March 30, 2021. The disputed domain names <grantify.org> and <grantify.net> resolve to parking webpages of the Registrar containing advertising links for grants and scholarships, and the disputed domain name <grantify.app> is inactive.

The Respondent is one of the partners in a venture contracted in 2019 to develop a software framework originally intended for the hotel/travel industry. According to the Respondent, the venture has been referred to as “Grantify” since January 2021 but has later changed its business plans.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

The Complainant contends that the disputed domain names are identical to its GRANTIFY trademark, because they are comprised of this trademark without the addition of any other words or symbols.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain names, as it has not been authorized by the Complainant to use the GRANTIFY trademark and has not used the disputed domain names in connection with a *bona fide* offering of goods or services or made a legitimate noncommercial or fair use of the disputed domain names. The Complainant adds that the Respondent is not been commonly known by the disputed domain names.

The Complainant submits that on December 8, 2020, it made an enquiry to purchase the disputed domain name <grantify.com> and received a response from a person named Carlos Paredes with an offer to sell this disputed domain name to the Complainant for the sum of USD 10,000. The Complainant submits that Carlos Paredes is aware of the Complainant and that the Respondent's acquisition of the disputed domain names was an attempt to stifle the Complainant's growth in the market, but also states that it has no information whether there is any connection between the Respondent and Carlos Paredes.

According to the Complainant, the Respondent's only interest in the disputed domain names is to divert online traffic away from the Complainant and to force the Complainant to purchase one or all of the disputed domain names at an inflated price. The Complainant discusses that the Respondent is illegitimately using the website at the disputed domain name <grantify.com> as means to collect personal data. The Complainant submits that it resolves to a website marketing sham financial and technology services whose nature is not clearly described. Some of the internal webpages featured on this website are incomplete and contain Latin holding text, while some of the links featured on it refer to an "Internal Server Error" or to articles that appear to bear no logical commercial relationship to the Respondent. The "Meet the team" webpage includes photos of individuals who appear to have no connection to the business purportedly marketed by the website, of images that bear the same name but appear to be of different people with different job titles, or images that seem to be of the same person but bear different names. The Complainant adds that the disputed domain names <grantify.org>, <grantify.net>, and <grantify.app> resolve to parking webpages containing pay-per-click advertising links to funding arrangements for education institutions, which could be deemed confusingly similar to the services provided by the Complainant.

The Complainant contends that the disputed domain names were registered and are being used in bad faith.

It points out that Carlos Paredes offered to sell the disputed domain name <grantify.com> for a price of USD 10,000.00, which far exceeds any foreseeable out-of-pocket expenses associated with the registration and renewal of this disputed domain name. According to the Complainant, this offer for sale indicates that Carlos Paredes and the Respondent registered or acquired the disputed domain names primarily for the purpose of selling, renting, or otherwise transferring them to the Complainant or to a competitor of the Complainant. The Complainant submits that this proposition is further substantiated by the fact that, upon the Complainant turning down the offer by Carlos Paredes, the Respondent acquired the three other disputed domain names. According to the Complainant, due to the reputation of the Complainant's GRANTIFY trademark, at least Carlos Paredes was aware of it when the disputed domain names were registered or acquired. The Complainant goes on to state that the GRANTIFY trademark is distinctive and well known, so that Carlos Paredes and the Respondent knew or should have known of the existence of these trademarks at the time when the disputed domain names were registered or acquired. The Complainant further states that Carlos Paredes had knowledge of the Complainant's GRANTIFY trademark because it attempted to sell the disputed domain name <grantify.com> to the Complainant prior to the Respondent registering the other disputed domain names. According to the Complainant, the Respondent was aware of the value of the disputed domain name <grantify.com> for the Complainant and had the Complainant's GRANTIFY trademark in mind when registering the later disputed domain names primarily to disrupt the business of the Complainant.

The Complainant goes on to state that Carlos Paredes has engaged in a pattern of registering domain names comprising of well-known trade marks in which he has no obvious rights or legitimate interests, and has been involved in previous UDRP proceedings where he was found to have registered and used domain names in bad faith (see *D&D Group Pty Ltd v. Carlos Paredes*, WIPO Case No. [D2018-2257](#)).

The Complainant also states that its GRANTIFY trademark is distinctive and well known and it is not possible to imagine any plausible future active use of the disputed domain names by the Respondent that would not be illegitimate, as such use would amount to trademark infringement or an act of unfair competition.

In its supplemental filing, the Complainant notes that the evidence submitted by the Respondent contradicts its allegation to have purchased the disputed domain name <grantify.com> for USD 10,000, as it refers to an amount of USD 119.99 paid in relation to it.

B. Respondent

The Respondent denies the statements made in the Complaint. He states that several years ago he started a business that was named Grantify, and legitimately purchased the disputed domain names more than 2 years ago for this business, which developed a casino chip with embedded RFID that could be used off property as a “grant” of value with a noted price of USD 25, 50, or 100 and could be branded by merchants. This led to the idea for the name “Grantify”. Anyone with the chip could go to the merchant and exchange the chip for cash, which allowed the merchant to sell off-property services like tours and events. Since then, this business evolved and the name “Grantify” became no longer reflective of the Respondent’s product and is not under consideration as the future name of the company for reasons that have nothing to do with the Complainant. The Respondent confirms that he controls the disputed domain names with respect to content, that the website at the disputed domain name <grantify.com> was a demo website for his prior business model to highlight the “Grantify” function and software framework, and that any copyright violation was inadvertent and unintentional.

The Respondent adds that he is willing to sell the disputed domain names for a price of USD 15,000.

The Respondent submits that he has no relationship with Carlos Paredes and purchased the disputed domain name <grantify.com> via the Registrar and its brokerage service in March of 2021 for USD 10,000. The Respondent denies having had any knowledge of the Complainant prior to the receipt of the Complaint.

With his supplemental filing, the Respondent submits evidence that the price agreed for the acquisition by him of the disputed domain name <grantify.com> plus the related brokerage fees amounted to USD 9,000.

6. Discussion and Findings

6.1. Procedural issue – Proper Respondent

The Complainant submits that prior to filing of the Complaint it has corresponded with who it believed was the registrant of the disputed domain names. On December 8, 2020, it made an enquiry through the domain name registrar Epik to purchase the disputed domain name <grantify.com>, and received a response from a person named Carlos Paredes, who offered to sell this disputed domain name for the sum of USD 10,000.

The original Complaint named Carlos Paredes as the Respondent. Following the receipt of the communication from the Center of April 13, 2023, providing the registrant and contact information disclosed by the Registrar, the Complainant filed an amended Complaint on April 18, 2023, where it named Carlos Paredes as the First Respondent and named the registrant of the disputed domain names indicated by the Registrar as the Second Respondent. The amended Complaint develops arguments for the lack of rights and legitimate interests in the disputed domain names and for their registration and use in bad faith on the basis of the conduct of both Carlos Paredes and the Respondent.

In this situation, the Panel has to decide whether Carlos Paredes should be included in the proceeding as a respondent and whether his conduct has to be taken into account for the purposes of the determination of whether the Respondent has rights and legitimate interests in the disputed domain names and whether they have been registered and used in bad faith.

Under Paragraph 1 of the Rules, “Respondent” means the holder of a domain-name registration against which a complaint is initiated. In proceedings under the Policy, the identity of the holder of a domain name registration is indicated by the registrar with which the respective domain name is registered. Here, the Registrar has indicated that the registrant of the disputed domain names is William Hood, WLH, LLC. This person denies having any relationship with or information about Carlos Paredes, and has submitted evidence showing that on April 26, 2021 it has purchased the disputed domain name <grantify.com> from a third party with the assistance of the Registrar. There is no evidence whether the seller was Carlos Paredes,

and in its amended Complaint the Complainant states that it has no information whether there is any connection between the Respondent and this person.

In this situation, the Panel finds no basis to include Carlos Paredes as respondent in the present proceeding, and will consider as proper Respondent only William Hood, WLH, LLC. The Panel also finds no basis to take into account the conduct of Carlos Paredes for the purposes of the decision on the issues of whether the Respondent has rights and legitimate interests in the disputed domain names and whether they have been registered and used in bad faith.

6.2. Procedural issue – Supplemental filings

Paragraph 10 of the Rules vests the Panel with the authority to determine the admissibility, relevance, materiality and weight of the evidence, and also to conduct the proceedings with due expedition, and Paragraph 12 of the Rules expressly provides that it is for the Panel to request, in its sole discretion, any further statements or documents from the Parties it may deem necessary to decide the case.

As discussed in section 4.6 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), unsolicited supplemental filings are generally discouraged, unless specifically requested by the Panel.

Here, both Parties have submitted supplemental filings without being invited to do so by the Panel. Nevertheless, they discuss just one evidentiary issue that is relevant to the case and the Complainant could not have addressed it in its Complaint, as it refers to evidence submitted with the Response. At the same time, the admission of the Parties' supplemental filings would not delay the proceeding. Therefore, the Panel decides to accept the supplemental filings of the Parties.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of the GRANTIFY trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1

The Panel finds the entirety of the GRANTIFY trademark is reproduced within the disputed domain names. Accordingly, the disputed domain names are identical to this trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Since the Complainant has failed to establish that the disputed domain names have been registered in bad faith, it is not necessary to decide whether the Respondent has rights or legitimate interests in the disputed domain names.

C. Registered and Used in Bad Faith

As discussed in sections 3.8.1, and 3.8.2 of the [WIPO Overview 3.0](#), where a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent. As an exception to this general proposition, in certain limited circumstances where the facts of the case establish that the respondent's intent in registering the domain name was to unfairly capitalize on the complainant's nascent (typically as yet unregistered) trademark rights, panels have been prepared to find that the respondent has acted in bad faith.

Here, the disputed domain name <grantify.com> was acquired by the Respondent on April 26, 2021, and the other disputed domain names were registered by the Respondent on March 30, 2021, while the GRANTIFY trademark was registered later - on June 25, 2021. The case file contains no evidence that supports a conclusion that the Respondent was itself somehow aware of the Complainant or of its yet unregistered GRANTIFY trademark at the time of acquisition and registration of the disputed domain names. The Complainant alleges that it has used the GRANTIFY trademark extensively in the United Kingdom, the European Union, and the United States since its incorporation in 2019, but does not submit any evidence about this. The Complainant mentions “published articles”, “testimonials”, “advertising campaigns in high-traffic platforms”, participation at “well-known trade summits”, social media accounts with “over 13,000 followers (combined)”, partnerships, ratings on the Trust Pilot Platform, “independent reviews by national UK newspapers”, etc., but there is no supporting evidence and it is not the Panel’s role to search online for the respective sources of information and to check the relevant publication dates in order to understand whether any of this information existed prior to the acquisition by the Respondent of the disputed domain names in the Spring of 2021. The Complainant has not submitted supporting evidence which should readily be at its disposal, even though, here, its trademark was registered after the Respondent acquired the disputed domain names. To sum up, the Panel does not find that the submitted evidence supports a finding that the Respondent would necessarily have been aware of the Complainant at the time of the acquisition of the disputed domain names. At the same time, the Respondent has submitted evidence that it had started to develop its own business under the brand Grantify in the beginning of 2021, and this business does not appear to have anything in common with the Complainant’s business. The explanation given by the Respondent of its choice of a name for its business also appears plausible, as well as the explanation why its website has remained undeveloped.

As discussed in Section 6.1 above, the evidence submitted by the Respondent shows that it acquired the disputed domain name <grantify.com> through domain name brokerage services provided by the Registrar, and there is no evidence whether the seller was Carlos Paredes. Notably, in its amended Complaint, the Complainant states that it has no information whether there is any connection between the Respondent and Carlos Paredes, so even if the latter was made aware of the Complainant because the Complainant contacted it in an attempt to acquire the disputed domain name <grantify.com>, this by itself does not support a conclusion that the Respondent was somehow made aware of the Complainant as well.

Taking all the above into account, the Panel finds no basis to conclude that the Respondent knew of the Complainant when it acquired the disputed domain names and targeted it with their acquisition. This excludes a finding of bad faith registration of the disputed domain names, so the Panel finds the third element of the Policy has not been established.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: June 20, 2023