

ADMINISTRATIVE PANEL DECISION

Customink, LLC v. Lan Pham
Case No. D2023-1963

1. The Parties

The Complainant is Customink, LLC, United States of America, represented by Vedder Price P. C., United States of America (“United States”).

The Respondent is Lan Pham, United States.

2. The Domain Name and Registrar

The disputed domain name <custominkllc.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 3, 2023. On May 3, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 3, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name(s) which differed from the named Respondent (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 4, 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 May 4, 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 May 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 29, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 28, 2023.

The Center appointed William F. Hamilton as the sole panelist in this matter on June 30, 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 well-known retailer of customized t-shirts, clothing, and accessories throughout the United States.

Since 1999 the Complainant has conducted its business under the mark CUSTOM INK (the “Mark”). The Complainant owns numerous registrations of the Mark with the United States Patent and Trademark Office, the earliest of which is Registration No. 2714550, dated May 6, 2003.

The disputed domain name was registered on April 18, 2023. The disputed domain name does not currently resolve to an active website. However, the disputed domain name previously resolved to a commercial website in competition with the Complainant. The Respondent replied to the Complainant’s cease and desist letter by demanding payment in exchange for the transfer of the disputed domain name.

5. Parties’ Contentions

A. Complainant

The Complainant asserts the disputed domain name is confusingly similar to the Mark because the disputed domain name is composed of the Mark and the abbreviation “llc”. The Complainant asserts that the Complainant never authorized the Respondent to use the disputed domain name, that the Respondent is not generally known by the disputed domain name, never operated a business under the disputed domain name, has not advertised the disputed domain name, and never engaged in any *bona fide* commercial activity in connection with the disputed domain name. The Complainant asserts that the Respondent knew or should have known of the Mark with reasonable investigation and registered and used the disputed domain name in bad faith to enhance the Respondent’s commercial business.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel that:

- (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 disputed domain name is confusingly similar to the Complainant’s Mark. The disputed domain name is composed of the Mark and the suffix “llc”, which is a standard United States business organization abbreviation. A domain name which wholly incorporates a complainant’s registered mark is sufficient to establish confusingly similarity for the purposes of the Policy when, as here, the Mark is clearly recognizable within the disputed domain name notwithstanding the addition of the abbreviation “llc”. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[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, geographic, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element”).

The generic Top-Level Domain (“gTLD”) of the disputed domain name, in this case “.com”, may be disregarded for the purposes of assessment under the first element, as it is viewed as a standard registration requirement. [WIPO Overview 3.0](#), section 1.11.1. *Monster Energy Company, a Delaware Corporation v. J.H.M. den Ouden*, WIPO Case No. [D2016-1759](#).

The Complainant has met its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Panel finds on the evidence presented that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has specifically disavowed providing the Respondent with permission to use the disputed domain name or the Mark. There is no evidence that the Respondent has conducted any *bona fide* business under the disputed domain name or is commonly known by the disputed domain name. The Complainant has thus established a *prima facie* case in its favor, which shifts the burden of production on this point to the Respondent. The Respondent, however, has failed to come forth with any evidence showing any rights or legitimate interests in the disputed domain name.

The disputed domain name originally resolved to an active website selling products in competition with the Complainant which likely caused unsuspecting Internet users to believe that the disputed domain name resolved to a website associated, sponsored, or affiliated with the Complainant.

The facts and circumstances presented to the Panel demonstrate that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy, bad faith may be established by any one of the following non-exhaustive scenarios:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent’s 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 on-line 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.

The Panel finds on the evidence presented that the disputed domain name was registered and is being used in bad faith.

The Mark is well-known in the United States where the Respondent resides. The Respondent was selling products that directly competed with the Complainant. It strains credulity to believe that the Respondent innocently and unknowingly composed the disputed domain name entirely of the Complainant’s Mark and

the abbreviation “llc”. The Panel finds that the Respondent was aware of the Complainant’s well-known Mark when registering and using the disputed domain name to attract unsuspecting Internet users to the Respondent’s website.

The disputed domain name does not currently resolve to an active website. However, the Respondent’s bad faith is further evidenced by the Respondent’s continued holding the disputed domain name (i) which is confusingly similar to the Mark, (iii) that previously resolved to a website selling competitive products, and (iii) where the Respondent has refused to relinquish the disputed domain name without significant payment from the Complainant. [WIPO Overview 3.0](#), section 3.1.1.

The Panel finds that the Respondent specifically targeted the Complainant and its Mark and registered the disputed domain name with the intent to divert Internet traffic and benefit commercially from unsuspecting Internet users seeking out the Complainant.

The Complainant has met its burden 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 disputed domain name <custominkllc.com> be transferred to the Complainant.

/William F. Hamilton/

William F. Hamilton

Sole Panelist

Date: July 14, 2023