

ADMINISTRATIVE PANEL DECISION

Serious Trade Solutions S.R.L. v. Cristian Baceanu, ONLY CBG S.R.L
Case No. D2023-3595

1. The Parties

The Complainant is Serious Trade Solutions S.R.L., Romania, represented by IP Boutique - Cabinet P.I., Romania.

The Respondent is Cristian Baceanu, Romania ("1st Respondent"), and ONLY CBG S.R.L, Romania ("2nd Respondent"), represented by Vilau | Associates, Romania.

2. The Domain Names and Registry

The disputed domain names <legalizeit.ro> ("Disputed Domain Name 1"), <legalize-it.ro> ("Disputed Domain Name 2"), <legalizeitshop.ro> ("Disputed Domain Name 3"), are registered with ROTLD (the "Registry").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 25, 2023. On August 28, 2023, the Center transmitted by email to the Registrar and Registry a request for Registrar verification in connection with the Disputed Domain Names. On August 28 and 29, 2023, the Registry transmitted by email to the Center its verification response disclosing registrant and contact information for one of the originally Disputed Domain Names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on August 30, 2023 providing the registrant and contact information disclosed by the Registry, and inviting the Complainant to submit an amendment to the Complaint adding the additional Registry-disclosed registrant as a Respondent and to provide relevant arguments or evidence demonstrating that all named registrants are, in fact, the same entity and/or that all Disputed Domain Names are under common control; and/or indicate which Disputed Domain Names will no longer be included in the current Complaint. The Complainant filed an amendment to the Complaint removing two domain names.

On August 30, 2023, the Center informed the parties in Romanian and English, that the language of the registration agreement for the Disputed Domain Names is Romanian. On September 1, 2023, the Complainant confirmed its request that English be the language of the proceeding and submitted the Complaint translated into Romanian. On September 4, 2023, the Respondent sent an email agreeing to the Complainant's request.

The Center verified that the Complaint together with the amendments to 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 September 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 27, 2023. The Response was filed with the Center September 25, 2023.

The Center appointed Gabriela Kennedy, Ingrida Kariņa-Bērziņa, and Katalin Szamosi, as panelists in this matter on October 18, 2023. The Panel finds that it was properly constituted. Each member of 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.

On October 23 and 25, 2023, the Complainant submitted unsolicited supplemental filings (“Supplemental Filings”).

On October 24, 2023, the Respondent submitted an unsolicited supplemental filing (“Supplemental Filing”).

4. Factual Background

The Complainant is a company headquartered in Romania which owns and operates a business named “Legalizeit” selling smoking-related items and accessories and cannabis oil. The Complainant owns a trademark containing LEGALIZEIT (the “Complainant’s Trademark”) in Romania, namely Romanian Trademark Registration No. 159489 for the mark  registered in Classes 5, 34, and 35 on March 4, 2019.

Disputed Domain Name 1 was registered by the 1st Respondent on March 3, 2016. Disputed Domain Name 2 was registered by the 1st Respondent on July 9, 2017. At the time the Panel was rendering its decision and at filing of the Complaint, Disputed Domain Name 1 resolves to a website in Romanian, offering smoking-related items and accessories and cannabis oil under the mark LGZ (the “1st Respondent’s Website”). The Complainant noted that prior to the filing of the Complaint, the 1st Respondent’s Website displayed the stylized mark “legalizeit” (with the letter “e” being a stylized cannabis leaf placed sideways). Disputed Domain Name 2 redirects to Disputed Domain Name 1 and resolves to the Respondent’s Website.

Disputed Domain Name 3 was registered by the 2nd Respondent on August 3, 2023. The 1st Respondent is a shareholder and co-director of the 2nd Respondent. At the time the Panel was rendering its decision and at filing of the Complaint, Disputed Domain Name 3 did not resolve to an active website.

5. Parties’ Contentions

A. Complainant

- (a) The Disputed Domain Names are identical or confusingly similar to the Complainant’s Trademark. The Complainant has been using the Complainant’s Trademark for a number of years. The Complainant enjoyed a legal right in the Complainant’s Trademark as a trade name before it changed its company name from LEGALIZE IT S.R.L. to SERIOUS TRADE SOLUTIONS S.R.L. The Complainant has held registered rights in the Complainant’s Trademark in Romania since 2018.

- (b) The Respondent has no rights or legitimate interests in the Disputed Domain Names. The Respondent has not obtained any authorization from the Complainant to use the Complainant's Trademark as part of a domain name or otherwise. The Respondent is not commonly known by the Disputed Domain Names. Disputed Domain Names 1 and 2 are being used to divert Internet traffic to the Respondent's Website that competes with the Complainant's business. This is particularly the case when the Respondent's Website used to display the Complainant's Trademark (albeit in a modified form).
- (c) The Disputed Domain Names were registered and are being used in bad faith. The 1st Respondent registered Disputed Domain Names 1 and 2 while he was still a shareholder of the Complainant, with insider knowledge and in anticipation of the Complainant acquiring registered rights in the Complainant's Trademark. The Disputed Domain Names were wrongfully registered in the Respondent's personal name when they should have been held by the Complainant. Moreover, the 2nd Respondent registered Disputed Domain Name 3 when the 1st Respondent was no longer a shareholder of the Complainant. The Disputed Domain Names were used to attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant's Trademark.

B. Respondent

- (a) The Respondent claims to have prior rights in the term "legalizeit" in comparison to the Complainant's Trademark. The 1st Respondent's registration of Disputed Domain Name 1 in March 2016 preceded the Complainant's use of the Complainant's Trademark as a trade name in July 2016. Such legal rights were extended when the 1st Respondent registered Disputed Domain Name 2. The Complainant obtained registered rights in the Complainant's Trademark based on the 1st Respondent's prior rights in Disputed Domain Names 1 and 2 and at the 1st Respondent's request. The 2nd Respondent's registration of Disputed Domain Name 3 was in consideration of the 1st Respondent's earlier rights in Disputed Domain Names 1 and 2.
- (b) The Respondent therefore has prior rights and legitimate interests in the Disputed Domain Names.
- (c) The Disputed Domain Names were registered and are used in good faith. As Disputed Domain Names 1 and 2 were registered prior to the registration of the Complainant's Trademark, they could not have been registered in bad faith. This is also the case for Disputed Domain Name 3 as it was registered based upon the 1st Respondent's prior rights in Disputed Domain Names 1 and 2.
- (d) The Respondent asked the Panel to make a finding of Reverse Domain Name Hijacking against the Complainant. The Complainant filed the Complaint with clear knowledge that the Respondent did not act in bad faith.

6. Discussion and Findings

6.1 Language of Proceedings

The Complaint was filed in English. The language of the registration agreement for the Disputed Domain Names is Romanian. The Respondent agrees to the Complainant's request that English be the language of the proceedings.

Pursuant to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the registration agreement, the language of the administrative proceedings shall be the language of the registration agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

Given the Respondent's consent, the Panel determines that English shall be the language of the present proceedings, but on the condition that the Respondent shall be permitted to submit any documents or assertions in Romanian.

6.2 Supplemental Filings

On October 23, 2023, the Complainant sent an unsolicited Supplemental Filing to the Center. The Complainant informed the Panel that it had received a favorable decision from the Bucharest County Court granting its application for an injunction and ordering the Respondent to cease using the Complainant's Trademark and Disputed Domain Name 1, among other orders ("Romanian Court Decision").

On October 24, 2023, the Respondent sent an unsolicited Supplemental Filing to the Center. The Respondent claims that the Romanian Court Decision was issued in preliminary injunction proceedings without an assessment of merits and that it was not final, not permanent, and not enforceable.

On October 24, 2023, the Complainant sent a second unsolicited Supplemental Filing to the Center, providing a translation of the Romanian Court Decision as shown on the Court's official Internet portal. The Complainant added that the Romanian Court Decision is an interim injunction which is immediately and provisionally enforceable as per Romanian legislation, until a potential appeal overturns this decision or until the case is settled on the merits, whichever comes first.

Neither the Rules nor the Supplemental Rules make express provision for supplemental filings, except at the request of the panel (see paragraph 12 of the Rules). Generally, UDRP panels only accept supplemental filings in exceptional circumstances where such a filing clearly shows its relevance to the case and the filing party shows that it was unable to provide the information contained therein in the original complaint or response (see section 4.6 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Having reviewed the parties' respective Supplemental Filings, the Panel is of the opinion that they do not contain responses to points respectively raised by the other Party. The Panel further notes that it is free to issue a UDRP decision on the merits even in an overlapping court-UDRP proceeding scenario or where a court order for injunctive relief has been issued (see section 4.14 of [WIPO Overview 3.0](#)). The Panel does not see any exceptional circumstances in this case that necessitate allowing the Supplemental Filings to be admissible. Even if they were to be admitted, the Panel considers that they would not affect the Panel's finding that the current dispute is not suitable for resolution under the UDRP (see next section). Accordingly, the Supplemental Filings are not admitted.

6.3 Substantive Issues

Paragraph 15(a) of the Rules instructs this Panel to "decide a 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".

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements:

- (i) The Disputed Domain Names are 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 Names; and
- (iii) The Disputed Domain Names have been registered and are being used by the Respondent in bad faith.

However, the Panel considers the present dispute to extend beyond the scope of the UDRP.

The Complainant contends that it owns unregistered and registered rights in the Complainant's Trademark, and the Respondent has not obtained any authorization from the Complainant to use the Complainant's Trademark as part of a domain name or otherwise. On the other hand, the Respondent contends that it has prior rights in the term "legalizeit" since the 1st Respondent registered Disputed Domain Name 1. From the filings presented by the Respondent, it appears that when Disputed Domain Name 1 was registered, the Complainant was operating a different line of business in performing arts and only changed its name to the Complainant's Trademark after the 1st Respondent acquired shares in the Complainant. Further, when the 1st Respondent registered Disputed Domain Name 2, the Complainant was allegedly under the sole control and management of the 1st Respondent and his brother. There is no evidence that the 1st Respondent registered or used Disputed Domain Names 1 and 2 for illegitimate purposes.

The dispute therefore involves many factual and legal questions regarding the relationship between the 1st Respondent, the Complainant, circumstances relating to the registration of the Complainant's Trademark, and circumstances relating to the sale of the 1st Respondent's shares in the Complainant to the current sole shareholder ("Share Sale"), and even the legal effect of the Romanian Court Decision (insofar as relating to Disputed Domain Name 1).

The Panel notes that a complaint may be denied on the basis that it is impossible and inappropriate for the panel to attempt to reach a reasoned conclusion with respect to a broad dispute where examination of evidentiary records and credibility of the parties are essential. Where the depth of investigation and examination required lies beyond the ability of a panel restricted to a written record in a summary process, legal proceedings to be conducted in a court of law are the more appropriate forum to fully explore the complexities of fact and law (see *Dr. Arlen Lyle Salte, Break Forth Ministries Society v. Power to Change*, WIPO Case No. [D2019-1806](#)).

The Panel also notes that past panels have denied cases not on the UDRP merits but on the narrow grounds that the dispute between the parties exceeds the relatively limited "cybersquatting" scope of the UDRP, and would be more appropriately addressed by a court of competent jurisdiction (see section 4.14.6 of the [WIPO Overview 3.0](#)). Past UDRP panels, their governing instruments, and legislative background, are all clear that the Policy was designed to prevent extortionate or abusive behavior also known as "cybersquatting" and cannot be used to litigate all disputes involving domain names (see *Philippe Dagenais designer inc. / Philippe Dagenais v. Groupe Dagenais MDC inc. (formerly Philippe Dagenais Mobilier Décoration Conseils Inc.) / Mobilier Philippe Dagenais*, WIPO Case No. [D2012-0336](#); *Bugatti International S.A. v. Jacques Pensini, Point Office / Philippe Schriqui*, WIPO Case No. [D2022-2805](#); *Les Editions Jalou v. Sidharth Saigal and Chalk Media FZE*, WIPO Case No. [D2023-1430](#); *Anniversary University, LLC v. The History Factory*, WIPO Case No. [D2023-2180](#)). A panel may decide that the administrative proceeding is not an appropriate forum to evaluate certain contentions of the parties, while it has not been provided the facts or authority necessary to make that determination (see *Pinnacle Intellectual Property v. World Wide Exports*, WIPO Case No. [D2005-1211](#)).

The Panel is not in a position to make findings on the factual and legal questions discussed above, which are beyond the Panel's jurisdiction and would require a far more complete evidentiary record than what has been provided by the Parties.

Furthermore, the Panel would have to examine the possible legal effects of Romanian law on the parties' rights upon the Share Sale in order to come to a conclusion on this case. Whilst Disputed Domain Name 3 was registered after the Share Sale, the Panel considers that the registration and use of Disputed Domain Name 3 are inextricably linked to Disputed Domain Names 1 and 2 and the Panel does not consider it appropriate to rule on Disputed Domain Name 3 alone, as the ruling might create further market confusion as to the rightful owner of the Complainant's Trademark. The overall analysis would not fall within the scope of UDRP proceedings nor is the Panel qualified to make such an assessment.

The Panel therefore concludes that the case as presented falls outside the scope of the Policy in light of the complex factual matrix that underlies the dispute. Therefore, it is for a court of competent jurisdiction with greater inquisitorial powers to determine the ownership or disposition of the Disputed Domain Names (cf. e.g., *Private Media Group v. Anton Enterprises Inc., d/b/a Private USA*, WIPO Case No. [D2002-0692](#); *Run-Time Consulting Inc. v. BetterMarketing Inc. o/a Agito Internet Marketing*, WIPO Case No. [D2008-1062](#)).

The Panel holds that the current dispute is not suitable for resolution under the UDRP and accordingly there is no need to consider its merits under the UDRP. That said, this decision does not prevent either Party from further pursuing this dispute in a court of competent jurisdiction.

For the same reason, the Panel declines to make a ruling on the Respondent's request for a finding of finding of Reverse Domain Name Hijacking.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Gabriela Kennedy/

Gabriela Kennedy

Presiding Panelist

/Ingrīda Kariņa-Bērziņa/

Ingrīda Kariņa-Bērziņa

Panelist

/Katalin Szamosi/

Katalin Szamosi

Panelist

Date: November 1, 2023