

ADMINISTRATIVE PANEL DECISION

PrideStaff, Inc. v. Nathaniel Groce

Case No. D2023-3790

1. The Parties

Complainant is PrideStaff, Inc., United States of America (“United States” or “U.S.”), represented by Frost Brown Todd LLC, United States.

Respondent is Nathaniel Groce, United States.

2. The Domain Name and Registrar

The disputed domain name <pridestaffllc.com> (the “Domain Name”) is registered with Network Solutions, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 12, 2023. On September 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 15, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent (Perfect Privacy, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on September 18, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on September 26, 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 Respondent of the Complaint, and the proceedings commenced on September 29, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 19, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 23, 2023.

The Center appointed John C. McElwaine as the sole panelist in this matter on November 2, 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

Complainant is a corporation organized under the laws of the State of California, United States founded in 1978. Relevant to this proceeding, Complainant owns a United States registration for PRIDESTAFF, U.S. Reg. No. 2,116,589, registered on November 25, 1997, for employment agency services; personnel relocation services; personnel placement and recruitment services; temporary personnel placement and recruitment services; contract staffing services; personnel management consulting services; and personnel outplacement services in Class 35 (the "PRIDESTAFF Mark.>").

The Domain Name was registered on August 15, 2023. The Domain Name does not resolve to an active website.

5. Parties' Contentions

A. Complainant

Complainant contends that the Domain Name should be transferred because each of the three elements required in paragraph 4(a) of the Policy has been established.

Complainant begins by providing background supporting the alleged well-known nature of the PRIDESTAFF Mark. Complainant asserts that it was founded in 1978 and has grown to be one of the most well-known staffing firms in the United States. Complainant alleges that it has over 85 offices throughout the United States engaged in the business of providing professional staffing services for both employers with professional staffing needs and individuals looking for job placement services. Complainant further asserts that it owns and uses the <pridestaff.com> domain name from which customers can learn all about Complainant, request staffing services, and apply for employment. Complainant contends it has used the PRIDESTAFF Mark as a service mark continuously and exclusively in connection with job placement services since 1995 and that Complainant is well-known in the staffing industry having received numerous independent awards and recognitions from unrelated third parties, showcasing the strength and value of the PRIDESTAFF Mark.

With respect to the first element of the Policy, Complainant contends that the Domain Name is comprised entirely of Complainant's PRIDESTAFF Mark with only the addition of "llc", resulting in a domain name that is confusingly similar to Complainant's PRIDESTAFF Mark.

With respect to the second element of the Policy, Complainant asserts that there is no evidence that Respondent has any rights or a legitimate interest in the Domain Name. Complainant alleges that Respondent is not a franchisee or otherwise affiliated with Complainant. Complainant contends that Respondent does not use and has not made demonstrable preparations to use the Domain Name in connection with a *bona fide* offering of goods or services, and that the Domain Name leads to an inactive website. Because of this, Complainant concludes that such passive holding of the Domain Name satisfies the second element within paragraph 4(a) of the Policy.

With respect to the third element of the Policy, Complainant alleges that Respondent registered the Domain Name in bad faith because Complainant's PRIDESTAFF Mark had become well-known in the United States long before the registration date of the Domain Name. Complainant further contends that Respondent's passive holding of the Domain Name is evidence of bad faith use under the Policy 4(a)(iii).

In addition, Complainant alleges that Respondent registered the Domain Name to capitalize on the goodwill associated with the PRIDESTAFF Mark by those seeking employment services. Complainant contends that Respondent set up Mail exchange (“MX-records”) that would enable Respondent to use the Domain Name for emails. Lastly, Complainant asserts that Respondent’s used of a privacy shield is a further inference of bad faith.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

Even though Respondent has defaulted, paragraph 4 of the Policy requires that, in order to succeed in this UDRP proceeding, Complainant must still prove its assertions with evidence demonstrating:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

Because of Respondent’s default, the Panel may accept as true the reasonable factual allegations stated within the Complaint and may draw appropriate inferences therefrom. See *St. Tropez Acquisition Co. Limited v. AnonymousSpeech LLC and Global House Inc.*, WIPO Case No. [D2009-1779](#); *Bjorn Kassoe Andersen v. Direction International*, WIPO Case No. [D2007-0605](#); see also paragraph 5(f) of the Rules (“If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint”). Having considered the Complaint, the Policy, the Rules, the Supplemental Rules and applicable principles of law, the Panel’s findings on each of the above cited elements are as follows.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires Complainant show that the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights. Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.2. Complainant has provided evidence that it is the owner of a valid and subsisting trademark registration for the PRIDESTAFF Mark.

Here, the Domain Name consists of the entirety of Complainant’s PRIDESTAFF Mark with the addition of “llc” which is the abbreviation for “limited liability company” in the United States. The Mark is clearly recognizable in the disputed domain name and the addition of this common suffix “llc” does not prevent a finding of confusing similarity under the first element. Accordingly, the Panel finds the Domain Name to be confusingly similar, if not legally identical, to Complainant’s PRIDE STAFF Mark. Thus, it is the Panel’s finding that Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the Policy, paragraph 4(a)(ii), Complainant has the burden of establishing that Respondent has no rights or legitimate interests in the Domain Name. Because it is difficult to produce evidence to support a negative statement, the threshold for the complainant to prove a lack of legitimate interest is low.

Complainant needs to only make a *prima facie* showing on this element, at which point the burden of production shifts to Respondent to present evidence that it has rights or legitimate interests in the Domain Name. If Respondent has failed to do so, Complainant is deemed to have satisfied its burden under paragraph 4(a)(ii) of the Policy. See *Vicar Operating, Inc. v. Domains by Proxy, Inc. / Eklin Bot Systems, Inc.*, WIPO Case No. [D2010-1141](#); see also *Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, WIPO Case No. [D2000-1415](#); *Inter-Continental Hotels Corporation v. Khaled Ali Soussi*, WIPO Case No. [D2000-0252](#).

The Policy paragraph 4(c), provides a non-exhaustive list of circumstances in which a respondent could demonstrate rights or legitimate interests in a contested domain name:

- (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.

With respect to Complainant's contention that Respondent is not commonly known by the Domain Name, the Panel notes that the Whois information lists Respondent as "Nathaniel Groce". In addition, Complainant asserts that Respondent is not a franchisee or otherwise permitted to use the PRIDESTAFF Mark. The Panel therefore finds that Respondent is not commonly known by the Domain Name. See *Moncler S.p.A. v. Bestinfo*, WIPO Case No. [D2004-1049](#) ("the Panel notes that the Respondent's name is "Bestinfo" and that it can therefore not be "commonly known by the Domain Name.").

Complainant also contends that the Domain Name leads to an inactive website, and as such, is not being used in connection with a *bona fide* offering of goods or services pursuant to Policy paragraph 4(c)(i). The Panel notes that the Domain Name consists of Complainant's well-known PRIDESTAFF Mark and an abbreviation that is a designation of a purported legal entity. It is hard to imagine a use of this Domain Name that would amount to fair use or in connection with a *bona fide* service. Respondent was given an opportunity to explain its intentions and rebut these contentions but has not answered. The Panel therefore finds that such passive holding of a well-known trademark is not fair use nor demonstrable preparations to use the Domain Name in connection with a *bona fide* offering of goods or services. See *Société nationale des télécommunications: Tunisie Telecom v. Ismael Leviste*, WIPO Case No. [D2009-1529](#) (noting that passive holding of a disputed domain name "does not constitute a legitimate use of such a domain name" that would give rise to a legitimate right or interest in the name); *Philip Morris USA Inc. v. Daniele Tornatore*, WIPO Case No. [D2016-1302](#) (Respondent had no rights or legitimate interests in the disputed domain name where the disputed domain name resulted to an inactive website); *Philip Morris USA Inc. v. Elijah Etame*, WIPO Case No. [D2016-0968](#) ("the Panel cannot imagine any potentially legitimate interest that Respondent might have in the disputed domain names based on the manner in which the disputed domain names have been used on the inactive websites").

Based on the foregoing, Complainant has made a *prima facie* showing of Respondent's lack of any rights or legitimate interests and Respondent has failed to come forward to rebut that showing. As provided for by paragraph 14 of the Rules, the Panel may draw such inference from Respondent's default as it considers appropriate. The Panel finds that Respondent does not have rights or legitimate interests in the Domain Name and that Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(a)(iii) of the Policy, Complainant must show that Respondent registered and is using the Domain Name in bad faith. A non-exhaustive list of factors constituting bad faith registration and use is set out in paragraph 4(b) of the Policy.

Bad faith registration can also be found where respondents knew or should have known of complainant's trademark rights and nevertheless registered a domain name in which they had no right or legitimate interest. See *Accor v. Kristen Hoerl*, WIPO Case No. [D2007-1722](#). Here, the PRIDESTAFF Mark represents the goodwill of a well-known staffing company. Based on Complainant's submission, which was not rebutted by Respondent, Respondent must have known of Complainant's PRIDESTAFF Mark when it registered the Domain Name, which is comprised prominently of Complainant's PRIDESTAFF Mark. See *WhatsApp Inc. v. Francisco Costa*, WIPO Case No. [D2015-0909](#) (finding that "it is likely improbable that Respondent did not know about Complainant's WHATSAPP trademark at the time it registered the Disputed Domain Name considering the worldwide renown it has acquired amongst mobile applications, and the impressive number of users it has gathered since the launch of the WhatsApp services in 2009".) Based on Complainant's reputation in respect to the PRIDESTAFF Mark, it is "not possible to conceive of a plausible situation in which the Respondent would have been unaware" of Complainant's well-known PRIDESTAFF Mark and its staffing services. *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

The fact that the Domain Name does not resolve to an active website does not obviate a finding of bad faith use of the Domain Name. When a domain name is being passively held, the question of bad faith use does not squarely fall under one of the aforementioned non exhaustive factors set out in paragraph 4(b) of the Policy. The three-member panel in *Magazine Publishers Inc. and Les Publications Conde Nast S.A. v. ChinaVogue.com*, WIPO Case No. [D2005-0615](#), made the following observations in its determination that the respondent was acting in bad faith:

- (i) the complainant's trademark has a strong reputation and is widely known, as evidenced by its substantial use in the United States of America and in other countries;
- (ii) the respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the domain name;
- (iii) the respondent registered the domain name in 1999, and seems not to have been using the domain name;
- (iv) the respondent did not reply to the complainant's communications before the proceedings; and
- (v) the respondent did not reply to the complainant's contentions.

In this case, Complainant's mark is well-known having been continuously used in the United States since at least 1995. Respondent did not respond to the Complaint and has provided no evidence of its intended use of the Domain Name. However, given the well-known nature of the PRIDESTAFF Mark, and the misleading nature of the addition of the abbreviation "llc" representing the purported type of legal entity, it seems highly likely that the Domain Name was registered to draw an improper association with Complainant.

Based on the uncontested facts discussed in the previous sections, Respondent does not appear to have any rights or legitimate interests in the Domain Name nor does there appear to be any justification for Respondent's choice to register the Domain Name. Accordingly, on balance, there does not appear to be any other reason for Respondent's registration of the Domain Name other than for the possibility to trade off the goodwill and reputation of Complainant's PRIDESTAFF Mark or otherwise create a false association with Complainant. With no response from Respondent, this claim is undisputed. This is additionally evidence of bad faith registration and use.

In sum, the Panel finds that Respondent knew or should have known of Complainant's trademark rights and that Respondent's present passive holding of the Domain Name is evidence of registration and use of the Domain Name in bad faith. For these reasons, the Panel holds that Complainant has met its burden of showing that Respondent registered and is using the Domain Name in bad faith.

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, <pridestaffllc.com>, be transferred to Complainant.

/John C McElwaine/

John C McElwaine

Sole Panelist

Date: November 16, 2023