

ADMINISTRATIVE PANEL DECISION

Smartmockups s.r.o. v. Nhuyen Ngoc Bao Tran, Tran Phuong Nen, Nen Tran Phuong, Cty Giai Tri
Case No. D2023-4728

1. The Parties

The Complainant is Smartmockups s.r.o., Czech Republic, represented by SafeNames Ltd., United Kingdom.

The Respondents are Nhuyen Ngoc Bao Tran, Tran Phuong Nen, Nen Tran Phuong, Cty Giai Tri, Viet Nam.

2. The Domain Names and Registrars

The disputed domain names <smartmockups.com> and <smartmockups.click> are registered with Mat Bao Corporation (the “Registrar”).

The disputed domain name <smartmockups.net> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

The disputed domain name <smartmockups.store> 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 November 14, 2023. On November 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 16, 2023, and November 17, 2023, the Registrars transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondents (Nhuyen Ngoc Bao Tran and GMO-Z.com RUNSYSTEM) and contact information in the Complaint.

The Center sent an email communication to the Complainant on November 20, 2023, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar(s), requesting the Complainant to either file separate complaint(s) for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity. The Complainant filed an amended Complaint on November 22, 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 Respondents of the Complaint, and the proceedings commenced on December 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 25, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on January 4, 2024.

The Center appointed Mihaela Maravela as the sole panelist in this matter on January 15, 2024. 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

According to information in the Complaint, the Complainant is an online graphic design platform founded in 2016 for anybody to create realistic design mock-ups quickly and easily. The Complainant has over 550,000 monthly users, and in 2020 alone, more than 3 million “mock-ups” were created by users ranging from aspiring ecommerce entrepreneurs to global Fortune 500 brands. In February 2021, the Complainant was acquired by Canva Pty Ltd, a globally used online graphic design platform, which has 130 million monthly active users in 190 countries.

The Complainant is the holder of a number of trademarks for SMARTMOCKUPS, including the European Union trademark No. 018313306 for SMARTMOCKUPS (word) registered on March 17, 2022 for class of services 45, and the European Union trademark No. 018313309 for SMARTMOCKUPS (figurative) registered on February 27, 2021 for classes of goods and services 9, 42, and 45. The Complainant is also the owner of the domain name <smartmockups.com> which it uses as its official website.

The disputed domain name <smartmockups.click> was registered on March 12, 2023, the disputed domain name <smartmockuprs.com> was registered on March 13, 2023, the disputed domain name <smartmockups.store> was registered on March 26, 2023 and the disputed domain name <smartmockups.net> was registered on March 29, 2023. The disputed domain names do not resolve to active websites at the time of this Decision. According to evidence with the Complaint, prior to the Complaint being filed, all disputed domain names used to host to identical content, replicating the Complainant’s SMARTMOCKUPS offerings.

5. Parties’ Contentions

A. Complainant

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

Notably, the Complainant contends that the disputed domain names <smartmockups.click>, <smartmockups.net>, and <smartmockups.store> are all identical to the Complainant’s SMARTMOCKUPS trademark. The disputed domain name <smartmockuprs.com> is confusingly similar to the Complainant’s trademark, as the Respondents added the additional letter ‘r’ between ‘p’ and ‘s’.

As regards the second element, the Complainant argues that to the best of its knowledge, the Respondents have not registered any trademarks for the SMARTMOCKUPS mark or ‘smartmokuprs’. The Complainant also did not find evidence suggesting that the Respondents hold unregistered rights in either of these terms.

Moreover, the Respondents have not been licensed by the Complainant to use domain names that feature the SMARTMOCKUPS trademark. The fact that the disputed domain names are currently inactive shows that the Respondents are not using the disputed domain names in connection with an offering of goods and services in good faith. The Complainant further asserts that there is no evidence of demonstrable preparations to use the disputed domain names in good faith.

With respect to the third element, the Complainant contends that it has accrued substantial goodwill and international recognition in the SMARTMOCKUPS mark for its provision of copyright-free images, videos and music. It has operated under this name since 2010, and its trademark registrations cover many jurisdictions around the world. Also, three of the disputed domain names contain exact-match domain names to the Complainant's SMARTMOCKUPS mark, and the other disputed domain name is a clear typo variation of the Complainant's mark. Typosquatting has been held in previous panel decisions to constitute clear evidence of bad faith. Under such circumstances, the Complainant submits that the disputed domain names' registration was clearly in connection with the SMARTMOCKUPS mark that it was undoubtedly made in bad faith.

With respect to the use, the Complainant argues that all the disputed domain names used to host identical content directly infringing on the Complainant's SMARTMOCKUPS mark and business offerings as all four disputed domain names hosted a fake SMARTMOCKUPS page, where the Respondents pretended to be affiliated with the Complainant. References such as 'Smartmockups s.r.o' were also found at the bottom of the page, reinforcing the assertion that the Respondents tried to pass itself off as the Complainant. The Complainant submits that the Respondents intentionally attempted to attract and divert Internet users, for commercial gain, through its past use of the disputed domain names to host identical content as the Complainant's site, mimicking the Complainant's logo, colour scheme, and business offerings. Moreover, the Respondents have clearly targeted the Complainant by registering four domain names that contain the SMARTMOCKUPS mark, therefore, the Respondents have engaged in a pattern of abusive conduct, and this is evidence of bad faith registration and use.

B. Respondents

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

6. Discussion and Findings

6.1 Preliminary issue: Consolidation of Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the disputed domain names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

As regards the common control, the Panel notes that: (i) the disputed domain names were registered between March 12, 2023 and March 29, 2023, (ii) the disputed domain names are similar in construction in that three of them are identical to the SMARTMOCKUPS mark of the Complainant and the domain name

<smartmockuprs.com> is a misspelling version of the said mark (adding a 'r' between the letters 'p' and 's'), (iii) all disputed domain names contain Vietnamese-based registrant details, (iv) all disputed domain names shared the same content replicating the Complainant's SMARTMOCKUPS offerings.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different disputed domain name registrants (referred to below as "the Respondent") in a single proceeding.

6.2 Substantive Issues

No response has been received from the Respondent in this case. Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules. The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", and the Panel can draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2 of the [WIPO Overview 3.0](#).

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (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 in bad faith.

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 names. [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain names <smartmockups.click>, <smartmockups.net> and <smartmockups.store>. Accordingly, the mentioned disputed domain names are identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds that the Complainant's mark is recognizable within the disputed domain name <smartmockuprs.com> which consists of the obvious misspelling of the SMARTMOCKUPS trademark of the Complainant, with the addition of a letter "r" between the last two letters. This misspelling in the disputed domain name also referred to as typosquatting, does not prevent a finding of confusing similarity (see [WIPO Overview 3.0](#), section 1.9). Accordingly, the disputed domain name <smartmockuprs.com> is confusingly similar to the Complainant's mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

It is the settled view of panels applying the Policy that the Top-Level Domain ("TLD") (here ".com", ".net", ".click", ".store",) should be disregarded under the first element test.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in the disputed domain names.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

There is no evidence that the Respondent is using the disputed domain names in connection with a *bona fide* offering of goods or services.

Rather, according to the unrebutted evidence provided by the Complainant, the websites at the disputed domain names were used to host identical content as the Complainant’s site, mimicking the Complainant’s logo, colour scheme, and business offerings. Panels have held that the use of a domain name for illegal activity, here impersonation/passing off, or other types of fraud can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

On the date of this Decision, the disputed domain names do not resolve to active websites. The Panel finds that holding domain names passively, without making any use of them, also does not confer any rights or legitimate interests in the disputed domain names on the Respondent.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Complainant’s registration and use of the relevant trademarks predate the date at which the Respondent registered the disputed domain names. The disputed domain names resolved to websites reproducing the Complainant’s trademark. Given the distinctiveness of the Complainant’s trademarks, it is reasonable to infer that the Respondent has registered the disputed domain names with full knowledge of the Complainant’s trademarks, and to target those trademarks.

The disputed domain names resolved to websites which copied the look and feel of the Complainant’s websites, display the Complainant’s trademark, logo. As such, the disputed domain names suggest affiliation with the Complainant in order to attract consumers.

Panels have held that the use of a domain name for illegal activity, such as the sale of counterfeit goods or impersonation/passing off, or other types of fraud constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent’s registration and use of the disputed domain names constitutes bad faith under paragraph 4(b)(iv) of the Policy.

Moreover, the Respondent has not formally participated in these proceedings and has failed to rebut the Complainant's contentions or provide any evidence of actual or contemplated good-faith use, and indeed none would seem plausible. Although at the time of filing of the Complaint, the disputed domain names were inactive, considering the circumstances of this case, the Panel finds that such non-use of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding (see section 3.3 of the [WIPO Overview 3.0](#)).

The Panel finds that the Complainant has established the third element 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 names <smartmockuprs.com>, <smartmockups.click>, <smartmockups.net>, and <smartmockups.store> be transferred to the Complainant.

/Mihaela Maravela

Mihaela Maravela

Sole Panelist

Date: January 29, 2024