

ADMINISTRATIVE PANEL DECISION

Houzz Inc. v. Domain Administrator, Fundacion Privacy Services LTD
Case No. D2023-4768

1. The Parties

The Complainant is Houzz Inc., United States of America (“United States” or “U.S.”), represented by IPLA, LLP, United States.

The Respondent is Domain Administrator, Fundacion Privacy Services LTD, Panama.

2. The Domain Name and Registrar

The disputed domain name <houzzpro.com> is registered with Media Elite Holdings Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 16, 2023. On November 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 22, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 November 29, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 19, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 22, 2023.

The Center appointed Mladen Vukmir as the sole panelist in this matter on January 3, 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

The Complainant is a U.S. company. It owns an online platform for home remodeling and design. The Complainant offers an all-in-one software solution for professionals and homeowners to coordinate and plan home renovations from start to finish, named "Houzz Pro".

The Complainant is the owner of numerous earlier registered HOUZZ trademarks in various jurisdictions, including HOUZZ word trademark registered in the United States on April 10, 2012, under the registration number 4124845 for goods and services in classes 35, 37, and 42 (the "HOUZZ trademark").

The Complainant operates its online platform through its official website created under the domain name <houzz.com>, registered on October 29, 2006.

The disputed domain name was registered on November 25, 2019. The disputed domain name resolves to a website which sends frequent notifications falsely warning Internet users that their anti-virus software has expired, and then redirects them to a website to purchase security software.

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 name. Notably, the Complainant contends that:

(i) it owns 72 registered HOUZZ and HOUZZ-formative trademarks worldwide. The HOUZZ trademark is widely recognized by consumers throughout the U.S. and the world. The Complainant maintains that it has continuously used the HOUZZ trademarks in connection with goods and services that provides since at least as early as August 2008;

(ii) the disputed domain name is nearly identical to its HOUZZ trademark, while the disputed domain name incorporates the Complainant's HOUZZ trademark in its entirety with merely the addition of word "pro" at the end. "Houzz" is an arbitrary term that has no meaning outside its use as it means to identify "Houzz" as a source of certain products and services;

(iii) there is no evidence the Respondent has rights or legitimate interests in respect of the disputed domain name. The Respondent is not a licensee of the Complainant, nor otherwise authorized to use the Complainant's HOUZZ trademark for any purpose. The Complainant maintains that the Respondent is not commonly known as "Houzz", "Houzz Pro", or the disputed domain name; and

(iv) the Respondent registered and is using the disputed domain name in bad faith, primarily to profit from and exploit the HOUZZ trademark and misdirect Internet users to its own website. Further, the disputed domain name is being used to disseminate malicious software. When users navigate to the website created under the disputed domain name, and are redirected to the website featuring security software, their computer is induced to then generate frequent notifications falsely warning users that their anti-virus software has expired. The notifications attempt to draw users back to the website to make a purchase. The Complainant states that the Respondent knowingly registered the disputed domain name containing the exact reproduction of the HOUZZ trademark and to capitalize on users' recognition of the HOUZZ trademark.

B. Respondent

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

6. Discussion and Findings

The Panel now proceeds to consider this matter on the merits in light of the Complaint, the lack of the Response, the Policy, the Rules, the Supplemental Rules, and other applicable legal authority pursuant to paragraph 15(a) of the Rules.

Paragraph 4(a) of the Policy provides that the Complainant must prove, with respect to the disputed domain name, each of the following:

- (i) the disputed domain name is confusingly similar to a trademark 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 has been registered and is 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 name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant is the holder of a number of the HOUZZ trademarks registered before the competent authorities worldwide. As such, the Panel finds 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 Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here "pro", may bear on assessment of the second and third elements, the Panel finds the addition of this term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The generic Top-Level Domain ".com" is a standard registration requirement and as such may be disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

Based on the available record, 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 a disputed domain name.

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 name. 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 name such as those enumerated in the Policy or otherwise.

The Respondent is not authorized by the Complainant to use the HOUZZ trademarks, and there is no indication that the Respondent is commonly known under the disputed domain name. There is no apparent relation from the record between the Respondent and the Complainant, nor does it arise that the Complainant has ever licensed or otherwise permitted the Respondent to use its HOUZZ trademarks, or to apply for or use any domain name incorporating the same trademark.

There is no evidence in the case file or otherwise apparent to the Panel that the Respondent has been using the disputed domain name in connection with a *bona fide* offering of goods or services or making a legitimate noncommercial or fair use of the disputed domain name. The Respondent has failed to provide any reply to the Complaint, and accordingly failed to rebut the Complainant's showing that the Respondent has no rights or legitimate interests in the disputed domain name.

The nature of the disputed domain name, comprising the Complainant's trademark and an additional related term "pro", indicates an awareness of the Complainant and its HOUZZ trademark and creates a risk of implied affiliation or association with the Complainant, which does not support a finding of any rights or legitimate interests in this case. [WIPO Overview 3.0](#), section 2.5.1.

Based on the available record, 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.

In the present case, the Panel notes that the Respondent registered and is using the disputed domain name to redirect to a website, which sends frequent notifications falsely warning Internet users that their anti-virus software has expired, and then Internet users to are redirected to a website featuring security software. The Panel finds that it is highly unlikely that the Respondent was unaware of the Complainant and its well-known HOUZZ trademark when it registered the disputed domain name. In this Panel's view, the Respondent chose to register the disputed domain name that reproduces the Complainant's HOUZZ trademark to take advantage of its reputation without any authorization from the Complainant, and to divert Internet users, for commercial gain, by creating a likelihood of confusion with the Complainant.

Therefore, the Panel concludes that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website, 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 of a product or service on the Respondent's website.

Based on the available record, 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 name <houzzpro.com> be transferred to the Complainant.

/Mladen Vukmir/

Mladen Vukmir

Sole Panelist

Date: January 17, 2024