

ADMINISTRATIVE PANEL DECISION

SMARTCATCH v. Domain, Administrator, NameFind LLC
Case No. D2024-0544

1. The Parties

The Complainant is SMARTCATCH, France, represented by Selarl Oriamedia, France.

The Respondent is Domain, Administrator, NameFind LLC, United States of America (“United States”), represented by Levine Samuel, LLP, United States.

2. The Domain Name and Registrar

The disputed domain name <smartcatch.com> 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 February 6, 2024. On February 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same date, 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 February 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2024. The Response was filed with the Center on February 19, 2024.

On March 19, 2024, the Parties requested the suspension of the Administrative Proceedings for settlement discussions and thus, the proceedings were suspended on March 20, 2024. On April 12, 2024, the Complainant sent a communication to the Center requesting the reinstatement of the proceedings and the proceedings were reinstated on that same day.

The Center appointed Steven A. Maier, Christiane Féral-Schuhl, and Nick J. Gardner as the Administrative Panel in this matter on May 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 company registered in France. It is a university spin-off enterprise with activities based on the development and production of capture devices for circulating biomarkers in the health field. The Complainant was founded in September 2016.

The Complainant is the owner of the following:

- France trademark registration number 4267510 for the word mark SMARTCATCH, registered on February 3, 2017, in International Classes 9 and 10;
- France trademark registration number 4702961 for a figurative mark comprising a logo and the words SMART CATCH, registered on March 12, 2021, in International Classes 9, 10 and 42; and
- International trademark registration number 1780371 for a figurative mark SMARTCATCH in stylized lettering, registered on December 20, 2023, in International Classes 9 and 10 and designating the European Union, the United Kingdom and the United States.

The Complainant operates a website at “www.smartcatch.fr”.

The disputed domain name was first registered on May 29, 2004. There is a dispute about the date of the Respondent’s acquisition of the disputed domain name, as further discussed below.

The disputed domain name has resolved to a webpage indicating that the disputed domain name is for sale, and including what appear to be pay-per-click (“PPC”) links to third-party advertisers.

5. Parties’ Contentions

A. Complainant

The Complainant submits that the disputed domain name was registered by the Respondent on May 9, 2023. However, it provides no evidence in support of this assertion, i.e., of the date upon which the Respondent acquired the disputed domain name. The Panel notes that the date relied on by the Complainant is in fact the “Updated Date” returned by a Whois search, which also specifies the “Creation Date” of the disputed domain name as May 29, 2004.

The Complainant submits that its SMARTCATCH trademarks, other extant trademark applications, and its domain name <smartcatch.fr> are distinctive of the Complainant to its customers and commercial partners, having been used for many years. However, the Complainant does not exhibit evidence (other than a reference to its website) of any reputation or goodwill that it claims to have acquired in the SMARTCATCH trademark.

The Complainant submits that the disputed domain name is identical or confusingly similar to its trademark SMARTCATCH.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It states that the Respondent does not operate its business under the name SMARTCATCH, nor is there any evidence that it intends to use the disputed domain name for its business. The Complainant submits that the Respondent’s only use of the disputed domain name has been for a parking site.

The Complainant submits that the disputed domain name has been registered and is being used in bad faith. It produces evidence that the disputed domain name has been offered for sale by the Registrar at a price of USD 8,385.82 with an annual fee of USD 26.60, which it contends is particularly high and exceeds a normal price. It submits therefore that the Respondent registered the disputed domain name for the purpose of selling it to the Complainant for consideration in excess of its costs directly related to the disputed domain name.

The Complainant states that it intends to expand its activities in the United States and is already working on this project. It contends that the Respondent's registration of the disputed domain name is prejudicial to those activities, as the Complainant will be unable to reference its goods and services as it would wish by reference to the "vocation commercial" disputed domain name.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

The Respondent exhibits evidence, by way of a DomainTools domain name history report, that it acquired the disputed domain name on December 21, 2015, and has since remained the owner of the disputed domain name.

The Respondent submits that it is a distinguished reseller of generic domain names and acquired the disputed domain name in the course of that business. It contends that the terms "smartcatch" or "smart catch" are common phrases in the English language and are not exclusively referable to the Complainant. The Respondent exhibits evidence of several trademark registrations (both live and expired) for the marks SMARTCATCH or SMART CATCH by parties other than the Complainant. The Respondent also notes that the disputed domain name was first registered some 20 years before the Complainant's trademark.

The Respondent accepts that, for the purposes of the UDRP, the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

The Respondent denies that it has no rights or legitimate interests in respect of the disputed domain name. It asserts that the Complainant has failed to make out a prima facie case in that regard, but submits in any event that there is nothing objectionable about its use of the disputed domain name.

The Respondent points to section 2.9 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), which states:

"Panels have recognized that the use of a domain name to host a page comprising PPC links would be permissible – and therefore consistent with respondent rights or legitimate interests under the UDRP – where the domain name consists of an actual dictionary word(s) or phrase and is used to host PPC links genuinely related to the dictionary meaning of the word(s) or phrase comprising the domain name, and not to trade off the complainant's (or its competitor's) trademark."

The Respondent submits that the PPC links on its website have been consistent with the semantic understanding of the phrase "smart catch", having included cell phone accessories and other goods or services having no relevance to the Complainant's activities (although it concedes that other links may have appeared to the Complainant in France).

The Respondent submits that, in any event, it cannot have registered the disputed domain name in order to target the Complainant's trademark, since it acquired the disputed domain name in December 2015 and the Complainant could have had no market presence before it came into existence in September 2016. The Respondent denies that it registered or has used the disputed domain name in bad faith. It contends that the business of buying and selling domain names should result neither in a finding of lack of rights or legitimate interests, nor of registration or use in bad faith, where there has been no targeting of a third-party trademark and no evidence of a pattern of abusive domain name registrations.

The Respondent further contends that there is nothing objectionable in its offer to sell the disputed domain name for a price of between EUR 7,000 to 8,000 plus an annual fee. It submits that it is not unlawful for it to offer the disputed domain name for sale at a price that exceeds the amount that the Complainant is willing to pay. The Respondent reiterates that, based on the relevant timeline, there can be no finding that it was targeting the Complainant's trademark at the time it registered the disputed domain name.

The Respondent submits that the Complainant is guilty of Reverse Domain Name Hijacking in this case. It contends that the Complainant is legally represented, yet has launched the Complaint on specious grounds, having produced no evidence to establish the matters required by either second or third element under the Policy. The Respondent submits that the Complainant is seeking a "free upgrade" of its French domain name by making false and unsubstantiated claims and by using the Policy as a tool to attempt to wrest the disputed domain name from its lawful owner.

6. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are 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 has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has established that it is the owner of trademark registrations for, or including, the mark SMARTCATCH. The disputed domain name is identical to that trademark and the Panel therefore finds that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Panel accepts the Respondent's submissions that the buying and selling of domain names, and/or their use to redirect to PPC links, are not necessarily objectionable activities under the second or third elements of the Policy. The question for the Panel is whether the Respondent registered and has used the disputed domain name for purposes genuinely related to some common meaning of the disputed domain name, or alternatively to target the Complainant's goodwill attaching to its trademark.

The Panel finds in this case that the mark SMARTCATCH is comprised of two dictionary words, "smart" and "catch", and that, even in combination, the terms "smartcatch" or "smart catch" have been used in commerce by a variety of different parties – although the Panel is not necessarily in agreement with the Respondent's contention that the term as a whole is a common English phrase. Aside from the third-party trademark registrations identified by the Respondent, a simple Google search of the term "smartcatch" produces results relating to, for example, fishing technology, food preparation and insect control.

The Panel also finds that the Complainant has failed to provide any substantial evidence of its business profile or activities that could give rise to an inference that the Respondent had the Complainant's trademark in mind when it registered the disputed domain name. Indeed, the Panel finds such circumstances to be impossible in this case, since the Respondent has provided evidence that it acquired the disputed domain name in December 2015, some four months before the date of the Complainant's first trademark application. and nine months before it submits it came into existence.

In the circumstances, the Complainant is unable to establish that the Respondent registered the disputed domain name to target the Complainant or its rights and, moreover the Panel notes that there is no apparent overlap between the PPC links to which the disputed domain name has resolved and the Complainant's activities.

Further, for the reasons stated above the Complainant cannot establish that the Respondent registered the disputed domain name in order to target the Complainant's (then non-existent) trademark.

The Panel finds in these circumstances that the Complainant has failed to establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

A number of similar considerations as set out above also inform the Panel's deliberations in respect of bad faith.

Most significantly, since the Complainant has been unable to establish any existing trademark rights at the date the Respondent acquired the disputed domain name (the original 2004 creation date being irrelevant), the Complainant cannot establish that the disputed domain name was registered in bad faith and the Complainant must fail on that ground (see section 3.8.1 of [WIPO Overview 3.0](#); in that respect, the Complainant has also failed to provide any evidence that the Respondent registered the disputed domain name unfairly to capitalize on the Complainant's nascent trademark rights).

The Complainant has also been unable to establish that the Respondent's use of the disputed domain name, to redirect to PPC links and/or to offer it for sale, is indicative of bad faith on the Respondent's part. The Respondent has made out a credible case that it did not register the disputed domain name in order to take unfair advantage of the Complainant's trademark rights. In circumstances where the Respondent registered the disputed domain name otherwise than in bad faith, it is not prevented by the UDRP from subsequently offering the disputed domain name for sale at such price as it may see fit.

The Complainant has therefore failed to establish that the disputed domain name has been registered or is being used in bad faith.

D. Reverse Domain Name Hijacking

Paragraph 15(e) of the Policy provides that, if after considering the submissions, the Panel finds that the Complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or to harass the domain-name holder, the Panel shall declare in its decision that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

In this case, the Complainant incorrectly submitted that the Respondent registered the disputed domain name on May 9, 2023, when it had in fact acquired the disputed domain name on December 21, 2015, being several months before the Complainant even claims to have acquired any relevant trademark rights.

While this submission could be viewed as a mistake, the Complainant is legally represented in this case and should have been aware that its Complaint could not succeed in circumstances where the disputed domain name was registered before it acquired any relevant trademark rights. The Complainant should similarly have known that the "Updated Date" in a WhoIs search does not by itself establish a transfer of ownership (if there would be other evidence such as a change in content that may support such a claim, but that is not the case here), yet there is no evidence of any enquiries it may have conducted concerning the ownership history of the disputed domain name.

Furthermore, even if the Complainant was mistaken as to the registration date of the disputed domain name, it provides no evidence of its business profile or trading activities that might enable the Panel even to infer that the Respondent was at any material time aware of its SMARTCATCH trademark and has sought to profit

unfairly from its reputation attaching to that trademark. On the contrary, on the evidence available to the Panel, the terms “smartcatch” or “smart catch” are not exclusively referable to the Complainant in commerce.

Finally, the Complainant volunteers in its Complaint that it plans to expand its activities in the United States, is already working on this project, and that the Respondent’s registration of the disputed domain name is therefore prejudicial to its activities. In circumstances where the Complaint had no reasonable prospect of success under the terms of the Policy, the Panel accepts the Respondent’s contention that the Complainant is likely to have brought this proceeding in the hope of securing a transfer of the disputed domain name without having to pay the advertised asking price.

The Panel therefore finds that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

7. Decision

For the foregoing reasons, the Complaint is denied. Moreover, the Panel finds that the Complaint has been brought in bad faith and constitutes an attempt at Reverse Domain Name Hijacking.

/Steven A. Maier/

Steven A. Maier

Presiding Panelist

/Christiane Féral-Schuhl

Christiane Féral-Schuhl

Panelist

/Nick J. Gardner/

Nick J. Gardner

Panelist

Date: May 15, 2024