

ADMINISTRATIVE PANEL DECISION

Xactware Solutions, Inc. v. DOMAIN ADMINISTRATOR, Buy this domain on Dan.com ----

Case No. D2024-0551

1. The Parties

The Complainant is Xactware Solutions, Inc., United States of America (“United States”), represented by McCarter & English, LLP, United States.

The Respondent is DOMAIN ADMINISTRATOR, Buy this domain on Dan.com ----, United States.

2. The Domain Name and Registrar

The disputed domain name <xactxpert.com> is registered with Dynadot Inc (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 6, 2024. On February 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 7, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (DOMAIN ADMINISTRATOR, Super Privacy Service LTD c/o Dynadot) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 8, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on February 14, 2024.

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 Respondent of the Complaint, and the proceedings commenced on February 15, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 6, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 7, 2024.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on March 12, 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 Delaware corporation that is a subsidiary of Verisk Analytics, Inc., a Fortune 500 company that provides analytics for the insurance industry. The Complainant provides computer software for professionals in the field of building, restoration and repair under the XACTWARE mark. In connection with these services, it uses marks containing the “XACT” element, including XACTIMATE, which is a product for property claims estimation. In this connection, the Complainant is the proprietor of United States Trademark Registration No. 1816735 for XACTIMATE (word mark), registered on January 18, 1994, for goods in class 9, claiming a date of first use in 1986. The Complainant operates a user portal at the domain name <xactimate.com>.

The Complainant promotes a related software product under the brand “XactXpert,” for which it asserts unregistered rights dating from April 26, 2023, when this product was first promoted on the website of the Complainant’s parent entity Verisk Analytics at the domain name <verisk.com>, followed by a press release the following day. On April 27, 2023, the Complainant filed an application with serial no. 97910800 to register the mark XACTXPRT (word mark) in the United States. As of the date of this Decision, the application was still pending. The Panel notes that the application was made on an intent-to-use basis.

The disputed domain name was registered on May 2, 2023. It redirects to a third-party website on which it is offered for sale for USD 15,000.

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 the disputed domain name incorporates the dominant feature of its XACTIMATE mark, namely, the letters “xact”, and is identical to its XACTXPRT unregistered mark. The Respondent is not known by the disputed domain name and is not using it in connection with a bona fide offering of goods or services. The disputed domain name is being offered for sale for USD 15,000, thereby improperly capitalizing on the goodwill in the XACTIMATE and XACTXPRT marks, which are not dictionary words. The disputed domain name was registered less than a week after the Complainant began promoting the XactXpert product online, issued the press release and filed to register the trademark. The disputed domain name was registered solely for the purpose of offering it for sale.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the UDRP requires the Complainant to make out all three of the following:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the Respondent has registered and is using the disputed domain name in bad faith.

Under paragraph 15(a) of the Rules, “[a] Panel shall 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”.

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.

To establish unregistered or common law trademark rights for purposes of the UDRP, the Complainant must show that its mark has become a distinctive identifier which consumers associate with the Complainant’s goods and/or services. According to UDRP practice, relevant evidence of acquired distinctiveness could include the amount of sales under the mark, the nature and extent of advertising using the mark, the degree of actual public recognition, and consumer surveys. [WIPO Overview 3.0](#), section 1.3.

The Complainant asserts common-law rights in the XACTXPRT mark dating from April 26, 2023, the date that the XactXpert product was first publicized online by the Complainant. It also published a press release to that effect on April 27, 2023. The evidence contains an affidavit attesting to these assertions by an employee of the Complainant, who commenced his employment in May 2023, following the establishment of these facts.

The Panel notes that the XACTXPRT mark is not a dictionary term. However, the Panel finds the record as described above contains insufficient evidence to adduce that the XACTXPRT mark has acquired distinctiveness. In particular, the Panel notes that the evidence does not allow any conclusions to be drawn about whether and to what extent the mark is being used in the market. The record reveals that information about the XactXpert product was made public by the Complainant on its parent-company website and in a press release, but the record is silent on whether and to what extent this product has been marketed or sold. The Panel observes that the April 27, 2023 trademark filing for this mark was made on an intent-to-use basis, not on the basis of actual use in commerce. There is no evidence available to support a finding that consumers have come into contact with the XACTXPRT mark.

On this record, the Panel finds the Complainant has not established unregistered trademark or service mark rights in the XACTXPRT mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.3.

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

The Panel finds that a dominant element of the Complainant’s XACTIMATE mark, namely, “xact,” is recognizable 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, “xpert”) may bear on assessment of the second and third elements, the Panel finds the addition of such a 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 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 Panel notes that, at the time of the Complaint and of this Decision, the disputed domain name did not resolve to an active website. On that basis, the Panel is unable to find that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services. The evidence does not indicate that the Respondent is commonly known by the disputed domain name or that the Respondent is making legitimate noncommercial or fair use of it.

The disputed domain name, which reflects the dominant element of the Complainant’s trademark, resolves to a website on which it is offered for sale. The Panel notes that offering the disputed domain name for sale is not a use that would support a finding of rights or legitimate interests. See [WIPO Overview 3.0](#), section 2.2.

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 finds that the Respondent has registered the disputed domain name primarily to sell the disputed domain name for valuable consideration in excess of the Respondent’s costs related to the disputed domain name (absent any evidence from the Respondent to the contrary. See [WIPO Overview 3.0](#), section 3.1.1.

In particular, the Panel notes that the Complainant’s rights in its XACTIMATE mark predate the registration of the disputed domain name by nearly 30 years. The Complainant has provided evidence that it has used the “xact” prefix for the names of several of its products. The disputed domain name reflects this dominant element of the Complainant’s mark (namely, “xact”) together with the term “xpert,” which in turn renders it identical to the name of the XactXpert product publicized by the Complainant on its parent company website, and via a press release, just a few days before the Respondent registered the disputed domain name. The sum of USD 15,000 is certainly in excess of the costs related to registering the disputed domain name (absent any evidence from the Respondent to the contrary). Finally, the Respondent has not provided any credible evidence-backed rationale for registering the disputed domain name. Under the circumstances, the Panel does not believe that any such rationale exists.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

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 <xactxpert.com> be transferred to the Complainant.

/Ingrīda Kariņa-Bērziņa /

Ingrīda Kariņa-Bērziņa

Sole Panelist

Date: March 26, 2024