

ADMINISTRATIVE PANEL DECISION

LIMITED LIABILITY COMPANY SSSTIK (LLC SSSTIK) v. Huy Duong Case No. D2024-1020

1. The Parties

The Complainant is LIMITED LIABILITY COMPANY SSSTIK (LLC SSSTIK), Ukraine, internally represented.

The Respondent is Huy Duong, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <ssstiktokio.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 7, 2024. On March 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 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 (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 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 amendment to the Complaint on March 8, 2024.

The Center verified that the Complaint together with the amendment to 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 March 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 1, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 8, 2024.

The Center appointed Luca Barbero as the sole panelist in this matter on April 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 Ukrainian company which specializes in the development of apps and websites.

The Complainant has provided evidence of ownership of the United States of America (“United States”) trademark registration No. 7084349 for SSSTIK (semi-figurative mark), filed on April 22, 2022, claiming first use as of June 10, 2020, and registered on June 20, 2023, in international class 9, for “Downloadable computer programs for editing images, sound, and video”, and 42, for “Computer software development in the field of mobile applications; Consulting services in the field of software as a service (SAAS); Design and development of software in the field of mobile applications; Design for others in the field of computer software; Providing a website allowing users to download music and music videos; Providing temporary use of non-downloadable computer software for creating music videos” (Annex D to the Complaint).

The disputed domain name was registered on August 4, 2023, and is pointed to a website allowing users to download videos from the Tik Tok social media app.

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 is confusingly similar to the trademark SSSTIK in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the term “tokio” and the generic Top-Level Domain (“gTLD”) “.com”.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that the Respondent is i) in no way related to the Complainant and is not licensed or otherwise permitted by the Complainant to use its trademark in any way; ii) is not commonly known by the disputed domain name; and iii) has not made use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use, since the disputed domain name is redirected to a pay-per-click site.

The Complainant submits that the Respondent registered and used the disputed domain name in bad faith since: i) the disputed domain name was registered well after the date of the Complainant’s trademark registration; ii) the Respondent must, or at least should have been aware of the Complainant’s rights when acquiring the disputed domain name given the fact that SSSTIK is not a dictionary word; iii) since the disputed domain name resolves to a website functioning as “video and audio downloader”, the Respondent registered the disputed domain name in a clear attempt to appear somehow related with the Complainant, thus creating a likelihood of confusion with the SSSTIK trademark; iv) the disputed domain name was registered primarily for the purpose of disrupting the business of a competitor; and v) as the disputed domain name resolves to a website mainly functioning as a “pay-per-click site”, the Respondent intentionally attempted users to its website for commercial gain.

B. Respondent

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

6. Discussion and Findings

According to 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.” Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that 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 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. Indeed, the Complainant has provided evidence of ownership of a valid trademark registration for SSSTIK. According to the trademark registration certificate (submitted as Annex D to the Complaint) “the mark consists of the term “SSSTIK” and a downwardly facing stylized arrow-shaped design element positioned to the left of the term “SSSTIK,” the stylized arrow-shaped design element disposed on a dark square background”.

The Panel notes that the core of the Complainant’s mark, consisting of the denominative element “ssstik”, is entirely reproduced within the disputed domain name, whilst the figurative elements in the mark can be disregarded for the purpose of assessing identity or confusing similarity. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), sections 1.7 and 1.10.

The Panel finds that the addition of the term “tokio” to the SSSTIK mark does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. As stated in section 1.8 of the [WIPO Overview 3.0](#), “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element”.

The Panel further notes that the third-party trademark TIK TOK is entirely reproduced in the disputed domain name. The Panel finds that such circumstance is insufficient in itself to avoid a finding of confusing similarity to the Complainant’s mark under the first element. [WIPO Overview 3.0](#), section 1.12.

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.

According to the evidence on record, there is no relationship between the Complainant and the Respondent, and the Complainant has not authorized the Respondent to register or use its trademark or the disputed domain name. Moreover, there is no element from which the Panel could infer a Respondent's right over the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

The Complainant has stated that it has been using the SSSTIK mark in connection with its web services, including video downloading services, since 2020, and has provided evidence of ownership of a trademark registration for SSSTIK in the United States, claiming first use as of June 10, 2020. Although the Complainant has not submitted evidence of actual use of its trademark, the Panel has verified that the Complainant's downloading services under the trademark SSSTIK are currently promoted online at the website at <ssstik.fun>, registered on March 23, 2022, and on which the Complainant's email address used to file the Complaint is based. The Panel also verified the Internet Archive ("www.archive.org") and found historical screenshots for the website "www.ssstik.fun" dated June 24, 2022, showing that the website was at that time used to promote the Complainant's services under the SSSTIK mark¹.

The Panel further notes that the disputed domain name resolves to a website promoting downloading services substantially identical to those provided by the Complainant, featuring a "sssTikTok" logo entirely reproducing the SSSTIK mark and displaying also banners advertising third-party products and services.

In view of the circumstances of this case and in absence of a Response, the Panel finds that the Respondent's use of the disputed domain name does not amount to a bona fide offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

Therefore, 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, in light of i) the prior registration and use of the Complainant's trademark SSSTIK in connection with the Complainant's audio and video downloading services; ii) the distinctiveness of the SSSTIK mark, and iii) the circumstance that the disputed domain name resolves to a website featuring services substantially identical to those of the Complainant, the Respondent was more likely than not aware of the Complainant and its trademark at the time of registering the disputed domain name.

The Panel also finds that the use of the disputed domain name in connection with a website offering substantially identical services to that offered by the Complainant under a similar logo and publishing

¹ As indicated in section 4.8 of the [WIPO Overview 3.0](#), "Noting in particular the general powers of a panel articulated inter alia in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision".

banners advertising third-party products and services, shows that the Respondent intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of its website according to paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the Complainant has also 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 <ssstiktokio.com> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: April 26, 2024