

## **ADMINISTRATIVE PANEL DECISION**

### Tempus Fugit, LLC v. Jason Burnham

### Case No. D2024-1439

#### **1. The Parties**

The Complainant is Tempus Fugit, LLC, United States of America (“United States”), represented by Assouline & Berlowe, P.A., United States.

The Respondent is Jason Burnham, United States, self-represented.

#### **2. The Domain Name and Registrar**

The disputed domain name <culturedesign.com> is registered with GoDaddy Online Services Cayman Islands Ltd. (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 4, 2024. On April 9, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 9, 2024, 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 April 10, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 30, 2024. The Respondent sent email communications to the Center on April 11 and 28, 2024. After being granted an automatic four-day extension, the Respondent submitted a response on May 3, 2024.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on May 23, 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 limited liability company established under the law of the State of Delaware, United States, with a principal place of business in Miami Beach, Florida, United States. The Complainant provides business consulting services, including consulting for marketing campaigns, under a number of brand names incorporating the word “culture” or “cultures”, such as CULTUREMAIL, CULTURE WALL, CULTURE SPRINT, CULTURESHRINE, CULTUREOS, CULTURE FLYWHEEL, HIGH PURPOSE CULTURES, and CULTURE SCIENCE ASSESSMENT, all of which were registered as trademarks with the United States Patent and Trademark Office (“USPTO”) between 2014 and 2022.

The Complainant obtained USPTO registration for the most relevant “culture” brand for present purposes, CULTURE DESIGN as a word mark, on May 9, 2017, registration number 5198963, claiming first use in commerce in January 2010. The Complaint claims common law protection for this mark since 2010. The registration is in International Class 35 for “creative and strategic consultation regarding development and production of marketing campaigns”.

The Complainant operates a website at “www.gapingvoid.com”, headed “gapingvoid Culture Design Group”. The home page prominently displays the Complainant’s CULTURE DESIGN mark with a trademark registration symbol. The Complainant also maintains an online presence on several social media platforms using the GAPINGVOID registered mark and displaying the Complainant’s name as “GAPINGVOID Culture Design Group”. The Complainant reports more than 89,000 followers on Instagram and 78,000 followers on X (formerly known as Twitter). The Complainant’s website includes examples of media recognition of the Complainant as early as 2015 with reference to its “culture” brands.

The Registrar reports that the disputed domain name was created on June 12, 1999, and is registered to the Respondent Jason Burnham, an individual showing a postal address in the State of New York, United States and furnishing a Gmail contact email address. The Complaint attaches screenshots of the website to which the disputed domain name resolved (the “Respondent’s former website”) in May 2023, headed “Culture Design” and advertising the business consulting services of Culture Design, LLC, aimed at helping organizations “design cultures that inspire and empower actors and stakeholders with purpose and unify the organization or community to a set of purpose-centered guiding principles, cultural governance, and performance management”.

The Respondent states that he purchased the disputed domain name in 2019 (for USD 5,000), when he formed a small consulting business by the same name. The Panel notes that the online database of the New York Department of State shows that Culture Design, LLC, at the same postal address given in the registrant details for the disputed domain name, is an active New York limited liability company registered with the state on September 17, 2020. The Panel further notes that the Internet Archive’s Wayback Machine shows a website substantially similar to the Respondent’s former website associated with the disputed domain name in November 2020.

The Complainant sent a cease-and-desist letter by email to the Respondent and Culture Design, LLC on May 2, 2023. The Respondent replied on May 10, 2023, indicating that he was winding up the business of Culture Design, LLC, which had not been profitable during the COVID 19 pandemic. The Respondent stated that he was previously unaware of the Complainant and expressed surprise that it had obtained a trademark registration for CULTURE DESIGN, as “culture design is a profession and practice area”. The Respondent cited numerous websites for companies and organizations using that term in their names or offerings. However, as the Respondent lacked the resources for a legal challenge, he told the Complainant to “[c]onsider Culture Design, LLC ceased and desisted”. The Respondent attaches correspondence showing that the parties discussed the sale of the disputed domain name, but the Complainant offered only half of what the Respondent had paid for it. The Parties did not reach an agreement, and the Respondent has since renewed the disputed domain name and uses it to redirect to his LinkedIn profile advertising consulting services that compete with some of those offered by the Complainant.

## **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 includes its CULTURE DESIGN mark identically and that the Respondent has “no bona fide reason” to register or use the mark, as the Respondent is not associated with the Complainant and uses the disputed domain name to promote competing services. The Respondent continues to do so, renewing the disputed domain name registration, after receiving a cease-and-desist demand. The Complainant contends that the Respondent must have been aware of the Complainant’s mark from the outset, given the Complainant’s long-time use of the CULTURE DESIGN mark and the fact that the Parties have been direct competitors for several years. The Respondent’s recent disputed domain name renewal and use of the term identical to the mark in the Respondent’s social media accounts further support an inference of bad faith. The Complainant argues that the Respondent has used the disputed domain name to misdirect Internet users to a competing business and to disrupt the Complainant’s business.

### **B. Respondent**

The Respondent contends that the Complainant has not satisfied all three of the elements required under the Policy for a transfer of the disputed domain name. The Respondent asserts that it was unaware of the Complainant and used a term, properly, both for the Respondent’s business and for the corresponding disputed domain name. In any event, the Respondent contends that the Complainant’s CULTURE DESIGN trademark registration is for strategic marketing consulting services, which is not the field practiced by the Respondent. Thus, the Respondent argues that there was no intended or actual confusion; the Respondent had a legitimate interest in using the words in the disputed domain name for their dictionary and professional meaning (the Response includes multiple examples of other parties that use the term “culture design”), and the Respondent had no bad faith. The Respondent has tried to avoid contention and potential confusion by taking down its website and X account and removing any content that might suggest consulting services related to marketing. The Respondent says he is working on a new business plan to use the disputed domain name for more “academic” and educational purposes, to avoid such conflict.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that a complainant must demonstrate each of the following:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) and the respondent has no rights or legitimate interests in respect of the domain name;
- (iii) and the domain name has been registered and is being used 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.

The Complainant has shown rights in respect of a trademark or service mark (the registered CULTURE DESIGN service mark) for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The Complainant also claims this as a common law mark since 2010, but the Complainant does not provide sufficient evidence of sales, advertising, media, or consumer recognition of that mark as a source-identifier before registration to establish this claim. See [WIPO Overview 3.0](#), section 1.3.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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

## **B. Rights or Legitimate Interests**

The Panel finds that, before notice to the Respondent of the dispute, the Respondent used the disputed domain name in connection with a bona fide offering of services on the Respondent's former website, evidently for more than two years, under a corresponding business name established in the form of a New York limited liability company. Rights or legitimate interests are normally assessed at the time of the UDRP proceeding, and while the Respondent has discontinued this website since receiving the Complainant's demand letter in 2023, the Respondent's limited liability company with the corresponding name and the associated LinkedIn social media site of the same name, with hundreds of followers, are both still active, and the Respondent continues to advertise and offer business consulting services relevant to the name. The disputed domain name continues to redirect to the Respondent's personal LinkedIn profile advertising the Respondent's consulting services. Thus, the Panel finds that the Respondent has rights or legitimate interests in the disputed domain name as he is effectively doing business under a corresponding name. [WIPO Overview 3.0](#), section 2.2.

The Panel finds the second element of the Policy has not been established.

## **C. Registered and Used in Bad Faith**

The Panel's conclusion under the second element above is dispositive unless the Panel finds that the Respondent registered not only the disputed domain name but also registered the corresponding business name, Culture Design, LLC, and has maintained a consulting business referring to that name with the purpose of exploiting the Complainant's trademark. That could not be deemed a bona fide offering of goods or services for purposes of the second element of the Complaint.

The Complainant's case depends on its contention that the Respondent must have been aware of the Complainant's mark when the Respondent purchased the disputed domain name in 2019, because the mark was long-established and used in the same business. The Respondent denies such awareness, however, and the Respondent's denial is credible. The Complainant claims common law protection for the mark since 2010 but without sufficient supporting evidence. The Complainant registered the mark two years before the disputed domain name was registered, for use in marketing campaign consulting, which is not the Respondent's business. The Complainant did not have a corresponding domain name but did business and operated a website under a different name, GAPPINGVOID, as it does to this day. The Respondent correctly observes that the term "culture design" (and variants such as "culture by design") is commonly used by many other parties describing an approach to organizational behavior and management. The Complainant does not appear in the first screens of Internet search results using "culture design" as a search term, and then it surfaces under the GAPPINGVOID name. Thus, it was hardly inevitable that the Respondent would come across the Complainant's mark when the Respondent set up his management consulting company and registered the disputed domain name in 2019, offering "culture design" services to companies and other organizations.

Given these facts, the Panel finds the Respondent's account of his knowledge, motivation, and conduct plausible and aligned with the actual use of the disputed domain name. This overcomes the Complainant's inferences of bad faith under the third element and confirms the Panel's conclusion under the second element of the Complaint.

The evidence in the case file as presented does not indicate that the Respondent's aim in registering the disputed domain name was to profit from or exploit the Complainant's trademark.

The Panel finds the third element of the Policy has not been established.

## **7. Decision**

For the foregoing reasons, the Complaint is denied.

*/W. Scott Blackmer/*

**W. Scott Blackmer**

Sole Panelist

Date: June 6, 2024