

## **ADMINISTRATIVE PANEL DECISION**

UpTerra Corporation v. Maria Cypher, JustTheWord.com  
Case No. D2024-3177

### **1. The Parties**

The Complainant is UpTerra Corporation, United States of America (“United States” or “U.S.”), represented by Fish IP Law LLP, United States.

The Respondent is Maria Cypher, JustTheWord.com, United States, represented by Muscovitch Law P.C., Canada.

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

The disputed domain name <upterra.com> (the “Domain Name”) is registered with eNom, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 2, 2024. On August 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On August 6, 2024, the Registrar transmitted by email to the Center its verification response disclosing the registrant and contact information for the Domain Name which differed from the named Respondent (Catchword Accelerator) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 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 August 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 August 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 1, 2024. The Response was filed with the Center August 20, 2024.

On August 26, 2024, the Complainant filed a request headed “Request for withdrawal of Complaint”. On August 27, 2024, the Respondent filed a supplemental filing headed “Objection to Complainant’s withdrawal request and response to Complainant’s withdrawal request”. On August 30, 2024, the Complainant filed a further supplemental filing headed “Reply to Respondent’s objection to withdraw Complaint”. On September 3, 2024, the Respondent filed a further supplemental filing headed “Response to Complainant’s Third Filing”.

The Center appointed John C. McElwaine, Kimberley Chen Nobles, and David E. Sorkin as panelists in this matter on September 23, 2024. The Panel finds that it was properly constituted. Each member of 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.

As an initial matter, under the Policy and the Rules, parties have no right to unilaterally submit additional arguments or evidence beyond the Complaint and Response. However, a Panel may, in its sole discretion, request further statements or documents from the parties under paragraph 12 of the Rules; and a party’s request may be regarded as an invitation to the Panel to exercise this discretion. The *E.W. Scripps Company v. Sinologic Industries*, WIPO Case No. [D2003-0447](#). Given the fact that the Complainant is facing what amounts to a counterclaim by Respondent for Reverse Domain Name Hijacking, the Panel finds the Complainant’s supplemental filings relevant to the Panel’s determination of Reverse Domain Name Hijacking. See *Cosmos European Travels AG v. Eurotech Data Systems Hellos, Ltd.*, WIPO Case No. [D2001-0941](#) (admitting Complainant’s supplemental filing, where Respondent requested a finding of Reverse Domain Name Hijacking and “the Complainant is entitled to defend itself”). Further, when the Complainant’s supplemental filing is admitted, the Respondent’s supplemental filing should also be admitted in the interest of fairness. Rules 10(b) (“In all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.”) Accordingly, the Panel will consider the arguments furthered by both parties in their original and supplemental filings.

#### **4. Factual Background**

The Respondent is the founder and owner of JustTheWord.com, which is an unregistered business name of The Cypher Group, LLC dba Catchword. Catchword is a United States-based naming agency that has been in business since 1998. The Respondent registered the Domain Name on January 24, 2013.

The Complainant, UpTerra Corporation, was incorporated in the State of Delaware on January 1, 2022. The Complainant applied for a United States trademark for UPTERRA on October 20, 2020, on an intent-to-use basis. In its application, the Complainant claims first use of the UPTERRA mark on March 21, 2023. The Complainant’s trademark for UPTERRA (U.S. Trademark Registration No. 7279702) was registered on January 16, 2024, for “leasing of agricultural equipment” in Class 44.

Prior to filing the Complaint, the Complainant or its representatives made several attempts to purchase the Domain Name from the Respondent. On May 25, 2021, Mr. Jehan Zohrab, allegedly on behalf of the Complainant, attempted to negotiate the purchase of the Domain Name. On July 6, 2023, another alleged attempt to purchase the Domain Name was made by a person connected to the Complainant. On February 28, 2024, Complainant’s counsel contacted Respondent expressing interest in acquiring the Domain Name.

#### **5. Parties’ Contentions**

##### **A. Complaint (filed August 2, 2024, amended August 8, 2024):**

In its Complaint, the Complainant alleged that the Domain Name was identical or confusingly similar to its UPTERRA trademark. The Complainant claimed rights in the UPTERRA mark based on its U.S. Trademark Registration No. 7279702, registered on January 16, 2024, for “leasing of agricultural equipment” in

Class 44. The Complainant asserted that the Respondent had no rights or legitimate interests in the Domain Name and that it was registered and used in bad faith. On this last point, the Complaint argued that the Respondent offered to sell the domain for USD 18,500, which was more than its out-of-pocket costs.

**B. Response (filed August 20, 2024):**

In its Response, the Respondent strongly contested the Complaint and requested a finding of Reverse Domain Name Hijacking (“RDNH”). As grounds for dismissal of the Complaint, Respondent asserted that the Domain Name was registered by the Respondent on January 24, 2013, over 10 years before the Complaint was filed. Concerning its legitimate interests in the Domain Name, the Respondent alleged that it is a well-known naming agency that has legitimately owned and used the Domain Name since 2013. In response to the Complainant’s allegations of bad faith registration and use, the Respondent points out that the Complainant’s trademark rights only arose in 2024, long after the Domain Name’s registration. Respondent further alleges that the Complainant, through several proxies, attempted to purchase the Domain Name multiple times before filing the present UDRP case.

With respect to the Respondent’s request for a finding of RDNH, the Respondent asserted that it sent a warning letter to the Complainant on August 13, 2024, explaining why the Complaint was meritless and requesting withdrawal, but that no timely response was received. The Respondent asserted that a finding of RDNH is appropriate based on the Complainant’s knowledge of the Respondent’s prior rights in the Domain Name, which was registered in 2013, long before the Complainant’s trademark rights arose in 2024. The Respondent further argued that the Complainant attempted to use the UDRP process after failing to acquire the Domain Name through multiple purchase attempts and proceeded with a meritless Complaint despite being warned of its deficiencies, demonstrating bad faith.

**C. Complainant’s Request for Withdrawal of Complaint (filed August 26, 2024):**

The Complainant submitted a request to withdraw the Complaint, stating that after reviewing the Response, it now understood the Respondent’s longstanding ownership of the domain name since 2013. The Complainant claimed it filed the Complaint in good faith, believing there may have been a change in domain ownership. It argued that it did not have clear evidence of the Respondent’s longstanding ownership until seeing the Response.

**D. Respondent’s Objection to Complainant’s Withdrawal Request (filed August 27, 2024):**

The Respondent objected to the Complainant’s withdrawal request, arguing that the Complainant should not be allowed to avoid a finding of RDNH by withdrawing at this late stage. Respondent further alleged that the Complainant had all the necessary information about the Respondent’s rights before filing the Complaint and that the Complainant ignored the Respondent’s warning letter sent on August 13, 2024, and only sought to withdraw after forcing the Respondent to incur the expense of filing a Response.

**E. Complainant’s Reply to Respondent’s Objection to Withdraw Complaint (filed August 30, 2024):**

In response to the substantive allegations of RDNH, the Complainant reiterated that it filed the Complaint in good faith, believing there may have been a change in domain ownership and that it did not have clear evidence of the Respondent’s longstanding ownership of the Domain Name until seeing the Response and its exhibits. Critical to this assertion, the Complainant also claimed that it had a “credible belief” there was a change in the Domain Name’s ownership due “prior to filing the Complaint.” With respect to the Complainant’s counsel’s failure to respond to Respondent’s warning letter, the Complainant claimed that its counsel was ill during the period when the warning letter was received. The Complainant also stated that it was willing to withdraw the Complaint with prejudice. For all of these reasons, the Complainant asserted that a finding of RDNH is not warranted.

## **F. Respondent's Response to Complainant's Third Filing (filed September 3, 2024):**

The Respondent's final response argued that the Complainant's new explanations were not credible and contradicted the original Complaint and that all necessary information about the Respondent's rights was available before the Complaint was filed. Respondent further reiterated that the Complainant's conduct throughout the proceeding demonstrates bad faith, including ignoring Respondent's warning letter, proceeding with a meritless Complaint, and attempting to use the UDRP after failing to purchase the domain name in the marketplace.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy requires the Complainant to prove its assertions with evidence demonstrating:

- (i) the 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 Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

Having considered the Complaint, the Response, the various supplemental filings, the Policy, the Rules, the Supplemental Rules, and applicable principles of law, the Panel's findings on each of the above-cited elements are as follows:

### **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. Ownership of a trademark registration prima facie satisfies that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. WIPO Overview, section 1.2. On this point, the Complainant has provided evidence that it is the owner of a United States trademark registration for UPTERRA. The Domain Name is identical to the UPTERRA trademark in which the Complainant has rights. Therefore, the Panel finds the first element of the Policy has been established.

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

In light of the Panel's finding in respect of the third element of the Policy, it is not necessary to address the second element of the Policy.

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

As the sole basis for bad faith in its Complaint, the Complainant alleged that Respondent violated paragraph 4(b)(i) of the Policy: "Respondent appears to have registered the domain name in bad faith because Respondent has no legitimate interest in using the domain name in connection with offering goods or services and is attempting to sell the domain name in excess of its out-of-pocket costs directly related to the domain name."

However, on its face, paragraph 4(b)(i) of the Policy requires more. The Domain Name must have been registered to sell it to "the complainant who is the owner of the trademark or service mark or to a competitor of that complainant." Such facts were never alleged to have existed. The Domain Name was registered by the Respondent on January 24, 2013, more than nine years before the Complainant was incorporated and more than eleven years before the Complainant's trademark was registered. As stated in [WIPO Overview](#)

[3.0](#), section 3.8.1: “Where a respondent registers a domain name before the complainant’s trademark rights accrue, panels will not normally find bad faith on the part of the respondent.”

The facts of this case are similar to those in *Charter Communications, Inc., Charter Communications Holding Company, LLC and Charter Communications Operating LLC v. Perfect Privacy, LLC / Sheri K Corwin*, WIPO Case No. [D2017-0040](#). In that case, the panel found that the respondent’s registration of the domain name predated the complainant’s trademark rights, and therefore, there could be no finding of bad faith registration. See also *John Ode d/b/a ODE and ODE - Optimum Digital Enterprises v. Intership Limited*, WIPO Case No. [D2001-0074](#) (“There are ample authorities supporting the view that a trademark that did not exist at the time the disputed domain name was registered cannot serve as the basis for a claim under the ICANN Policy, since it is impossible for the domain name to have been registered in bad faith.”)

Therefore, the Panel finds that the Respondent did not register the Domain Name in bad faith targeting of the Complainant or its trademark rights because the Complainant had no trademark rights at the time that the Respondent registered the Domain Name. [WIPO Overview 3.0](#), section 3.8.1. The Panel finds the third element of the Policy has not been established.

#### **D. Reverse Domain Name Hijacking**

Paragraph 15(e) of the Rules 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”. The mere lack of success of the complaint is not, on its own, sufficient to constitute reverse domain name hijacking. [WIPO Overview 3.0](#), section 4.16.

The Panel finds that the Complainant’s conduct warrants a finding of RDNH. To establish Reverse Domain Name Hijacking, a respondent typically must show that the complainant knew of its own lack of relevant trademark rights, or of the respondent’s rights or legitimate interests in, or lack of bad faith concerning, the disputed domain name.

Here, the evidence demonstrates that the Complainant was aware of the Respondent’s ownership and use of the Domain Name well before filing the Complaint. This is evidenced by multiple attempts to purchase the domain. On May 25, 2021, an agent of the Complainant, attempted to negotiate the purchase of the domain name. Communications from the Domain Name owner came from [...]@catchwordbrand.com, and stated: “Thanks for reaching out regarding Upterra.com. By way of quick background, our domains are owned by Catchword Branding, a leading naming firm”. On July 6, 2023, another individual linked to an employee of Complainant attempted to purchase the Domain Name. Lastly, on February 28, 2024, the Complainant’s counsel contacted the Respondent expressing interest in acquiring the Domain Name. These interactions demonstrate that the Complainant was aware of the Respondent’s ownership of the Domain Name before filing the Complaint and that the Complainant had failed to negotiate a price for the Domain Name it was willing to pay.

Moreover, the Complainant pled the 2013 registration date of the Domain Name and the 2024 registration date of the Complainant’s UPTERRA trademark registration. The Complainant “knew or should have known at the time it filed the Complaint that it could not prove one of the essential elements required by the Policy.” *carsales.com.au Limited v. Alton L. Flanders*, WIPO Case No. [D2004-0047](#) (finding Reverse Domain Name Hijacking “where the Respondent’s registration of the domain name predates the very creation of the Complainant’s trademark”); see also *Proto Software, Inc. v. Vertical Axis, Inc/PROTO.COM*, WIPO Case No. [D2006-0905](#) (finding Reverse Domain Name Hijacking where “Complainant is represented by Counsel who even on a rudimentary examination of the Policy and its application in this area should have appreciated that the Complaint could not succeed where the Respondent’s domain name had been registered three years prior to filing a trademark application or actual use of the mark.”).

The Complainant’s *ex post facto* claim in its Reply that it had a “credible belief” that a change in registration occurred is not only unsupported by the evidence but was known at the time the original Complaint was filed.

The Complainant states it reviewed archived webpages showing JustTheWord.com and more recently dealt with Catchword. However, this information was available to the Complainant prior to filing the Complaint, yet the Complaint contains no mention of a potential change in registration or any reference to [WIPO Overview 3.0](#), Section 3.9. It is also crucial to note that Section 3.9 does not reference a “credible belief” but instead that “*the complainant credibly alleges* that a relevant change in registration has occurred...” Additionally, for the Complainant to have a viable defense, it would have to include in its Complaint credible allegations that the transfer from JustTheWord.com to Catchword occurred after January 16, 2024, when the Complainant acquired its registered trademark. Such allegations were not made and are highly implausible given the Complainant’s prior interactions with Catchword dating back to 2021.

The evidence also strongly suggests that the Complainant attempted to use the UDRP process for leverage after failing to acquire the domain name through negotiation. This is an improper use of the UDRP process, as noted in previous cases such as *Charter Communications, Inc., Charter Communications Holding Company, LLC and Charter Communications Operating LLC v. Perfect Privacy, LLC / Sheri K Corwin*, WIPO Case No. [D2017-0040](#) (“This stratagem has been described in many UDRP cases as “a highly improper purpose” and it has often contributed to findings of RDNH.”)

In conclusion, the Complainant’s actions demonstrate the Complainant knew or should have known that it could not prove the essential elements required by the UDRP, particularly given the significant time gap between the domain registration and the Complainant’s trademark rights. This conduct falls squarely within the circumstances described in [WIPO Overview 3.0](#), section 4.16, justifying a finding of Reverse Domain Name Hijacking.

## 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.

*/John C. McElwaine/*

**John C. McElwaine**

Presiding Panelist

*/Kimberley Chen Nobles /*

**Kimberley Chen Nobles**

Panelist

*/David E. Sorkin/*

**David E. Sorkin**

Panelist

Date: October 7, 2024