

ADMINISTRATIVE PANEL DECISION

BakeMark USA LLC v. Jeff Allen, Bakes Mark
Case No. D2024-3351

1. The Parties

The Complainant is BakeMark USA LLC, United States of America (“United States”), represented by Snell & Wilmer, LLP, United States.

The Respondent is Jeff Allen, Bakes Mark, Nigeria.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 15, 2024. On August 15, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 16, 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”) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 19, 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 August 22, 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 August 22, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 11, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 13, 2024.

The Center appointed Kiyoshi Tsuru as the sole panelist in this matter on September 19, 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 incorporated in the United States of America, leader in the industry of bakery ingredients, products, supplies, manufacturing and distributing services, across the United States of America, Canada and other countries.

The Complainant is the owner of several trademark registrations including:

Trademark	Registration No.	Jurisdiction	Date of Registration	Class
BAKEMARK	2416253	United States	December 26, 2000.	Class 29, Class 30, and Class 35.
BAKEMARK	2564995	United States	April 30, 2002.	Class 29, Class 30, and Class 35.
 BAKEMARK	2927655	United States	February 22, 2005.	Class 29, Class 30, and Class 35.

The Complainant operates its official website through the domain name <bakemark.com>, registered in 1998.

The disputed domain name was registered on February 19, 2024, and resolved to a website displaying the Complainant's trademarked logo, without any disclaimer as to the lack of association with the Complainant, as well as images taken from the Complainant's official website. At the date of writing this Decision, the disputed domain name does not resolve to an active website.

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

I. Identical or Confusingly Similar.

That the Complainant has been using its BAKEMARK trademarks since 1998 and has invested considerable amounts of money promoting its goods and services under said trademarks throughout the United States, Canada and other countries such as Mexico, New Zealand, the United Kingdom, China, Türkiye, Hungary, Australia, Oman and more, which also establishes common law rights over said trademarks.

That years before the Respondent registered the disputed domain name, the Complainant registered and used its website to which the domain name <bakemark.com> resolves, to offer and promote its products and services. That the Respondent is seeking to capitalize on the goodwill and recognition of the Complainant's BAKEMARK trademarks by registering the disputed domain name to impersonate the Complainant and to confuse and defraud consumers into thinking that the Respondent is affiliated with the Complainant.

That the disputed domain name is identical or confusingly similar to the Complainant's BAKEMARK trademarks and its domain name <bakemark.com>.

That the disputed domain name <bakesmark.com> incorporates the Complainant's BAKEMARK trademarks entirely, and that the addition of the letter "s" following the term "bake" does not reduce the substantial identity between the Complainant's BAKEMARK trademarks and the disputed domain name (citing *Kimley-Horn and Associates, Inc. v. Secoo Gio*, WIPO Case No. [D2021-4189](#) and *M/s Nalli Chinnasami Chetty v. Nalli's Silks Sari Centre*, WIPO Case No. [D2009-0664](#))

That the addition of the generic top-level domain (gTLD) ".com" to the Complainant's BAKEMARK trademarks in the disputed domain name does not reduce the substantial identity between the Complainant's BAKEMARK trademarks and the disputed domain name either (citing *Pomellato S.p.A v. Tonetti*, WIPO Case No. [D2000-0493](#)).

II. Rights or Legitimate Interests

That the Respondent has no rights or legitimate interests in the disputed domain name, that there is no evidence that the Respondent is commonly known by "bakesmark" or BAKEMARK, that the Complainant has not authorized the Respondent to use the Complainant's BAKEMARK trademarks or to register them as a domain name, and that there is no affiliation, connection or association between the Respondent and the Complainant.

That the term "bakemark" used in the Complainant's BAKEMARK trademarks is an arbitrary term coined by the Complainant and that, therefore, the disputed domain would not be one that the Respondent "would legitimately choose unless seeking to create an impression of association with the Complainant" (citing *Sbarro Franchise Co., LLC v. Domain Admin Domain Admin whoisprotection.biz/Burc Caglayan*, WIPO Case No. [D2016-1837](#) and *Biogen MA Inc. v. Privacy Protect, LLC/ On behalf of spinrazahcp.com owner, Domain Administrator*, WIPO Case No. [D2018-0615](#)).

That there is no evidence showing that the Respondent has used or intends to use the disputed domain name in connection with a bona fide offering of goods or services or in relation to a noncommercial fair use.

That the disputed domain name resolved to a website that comprised an "almost identical copy" of the Complainant's official website (to which the Complainant's <bakemark.com> domain name resolves) and that such use cannot establish rights or legitimate interests in the disputed domain name (citing *smava GmbH v. Anna Brunner*, WIPO Case No. [D2021-4089](#)).

That the Complainant requested the host of the Respondent's website (to which the disputed domain name resolved) to take down the infringing website and that the host complied. That the disputed domain name now resolves to an inactive website, which also cannot constitute the basis for a finding of rights or legitimate interests in the disputed domain name (citing *FIL Limited v. Stewart Lawton*, WIPO Case No. [D2021-3635](#)).

III. Registered and Used in Bad Faith

That the Complainant owns numerous trademark registrations for BAKEMARK which were registered long before the Respondent registered the disputed domain name, and that given the Complainant's use of its BAKEMARK trademarks internationally in the market, "it is ... not plausible to conceive of a plausible circumstance in which the Respondent would have been unaware of [these facts]" at the time of registering

the disputed domain name, thus its registration was done in bad faith (citing *Telstra Corp. Ltd. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), and *Johnson & Johnson v. Daniel Wistbacka*, WIPO Case No. [D2017-0709](#)).

That the Respondent is using the disputed domain name in bad faith, specifically regarding the website to which the disputed domain name resolved previously, before the Complainant requested its takedown, given that said website was a “substantial if not identical copy” of the Complainant’s official website, mimicking it to “attract Internet users by creating a likelihood of confusion with the BAKEMARK trademarks for commercial gain and/or to phish for personal data for improper purposes” (citing *smava GmbH v. Anna Brunner, supra*, and *Actelion Pharmaceuticals Ltd v. Fils James / Litemills*, WIPO Case No. [D2015-2115](#)).

That the disputed domain name is virtually identical or highly similar to the Complainant’s <bakemark.com> domain name, which is further evidence of bad faith use (citing *Modernatx, Inc. v. Emily Pray*, WIPO Case No. [D2023-0692](#)).

That the fact that the disputed domain name now resolves to an inactive website because its web host took it down in response to the Complainant’s request does not negate a finding of bad faith (citing *Phoenix Contact GmbH & Co. KG v. The Hoang, Cong Ty Co Phan Tu Dong Tien Hung*, WIPO Case No. [D2020-1211](#), *Television Francaise 1 v. Gilmore Thompson*, WIPO Case No. [D2022-4442](#), and *Actelion Pharmaceuticals Ltd v. Fils James / Litemills, supra*).

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets out the three requirements that the Complainant must prove in order to successfully request remedies:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark to which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in connection to the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

Given the Respondent’s default and therefore, failure to specifically address the case merits as they relate to the three UDRP elements, the Panel may decide this proceeding based on the Complainant’s undisputed factual allegations under paragraphs 5(f), 14(a), and 15(a) of the Rules (see *Joseph Phelps Vineyards LLC v. NOLDC, Inc., Alternative Identity, Inc., and Kentech*, WIPO Case No. D2006-0292; *Encyclopaedia Britannica, Inc. v. null John Zuccarini, Country Walk*, WIPO Case No. [D2002-0487](#); see also WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 4.3).

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 3.0](#), section 1.7.

The Complainant has shown rights in respect of the BAKEMARK trademarks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The disputed domain name entirely comprises the Complainant's BAKEMARK trademarks adding the letter "s" between the terms "bake" and "mark". The Panel finds that the Complainant's BAKEMARK trademarks are recognizable within the disputed domain name. [WIPO Overview 3.0](#), section 1.9. It is also well established that the addition of a gTLD ".com" is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the disputed domain name is confusingly similar to the Complainant's BAKEMARK trademarks 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

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. Specifically, the Respondent has failed to submit evidence of bona fide or legitimate noncommercial or fair use of the disputed domain name. No evidence was provided either in connection with the Respondent being commonly known by the disputed domain name.

Panels have held that the use of a domain name for illegal activity such as impersonation or passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. In the present case the Panel notes that the Respondent intended to confuse Internet users into believing that the website to which the disputed domain name resolved to belonged to the Complainant.

Pursuant to paragraphs 10 and 12 of the Rules, and in accordance with the section 4.8 of the [WIPO Overview 3.0](#), panels may undertake limited factual research into matters of public records (see *Mark Overbye v. Maurice Blank, Gekko.com B.V.*, WIPO Case No. [D2016-0362](#)), thus, based on this attribution, the Panel conducted an inspection of the WAYBACK MACHINE (web.archive.org) database in which it found that indeed, in the past, the website to which the disputed domain name resolved comprised content that was similar to that of the Complainant's official website. Previous panels have admitted the use of WAYBACK MACHINE for these purposes (see *The Procter & Gamble Company v. Gamulin Nikita* WIPO Case No. [D2011-0078](#), *La Francaise des Jeux v. Domain Drop S.A.*, WIPO Case No. [D2007-1157](#) and *G.U.C. S.A. v. Roberto Petralia*, WIPO Case No. [D2010-1865](#)).

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.

The Complainant has ascertained its rights over its BAKEMARK trademarks. The dates of registration of the Complainant's trademarks significantly precede the date of registration of the disputed domain name.

In the present case, the Panel notes that the Respondent has intentionally used the disputed domain name to attract, for commercial gain, Internet users to the website to which the disputed domain name resolved, by creating the impression among Internet users that it was related to, associated with, or endorsed by the Complainant, with such conduct constituting bad faith under paragraph 4(b)(iv) of the Policy (see section 3.1.4 of the [WIPO Overview 3.0](#); see also *trivago GmbH v. Whois Agent, Whois Privacy Protection Service, Inc. / Alberto Lopez Fernandez, Alberto Lopez*, WIPO Case No. [D2014-0365](#); and *Jupiter Investment Management Group Limited v. N/A, Robert Johnson*, WIPO Case No. [D2010-0260](#)).

Previous Panels have held that the use of a domain name for illegal activity, in this case, impersonation, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

At the date of writing of this decision, the disputed domain name does not resolve to an active website. Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the record, the Panel finds that the current non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3. Having reviewed the record, the Panel notes the distinctiveness and reputation of the Complainant's trademarks, and the composition of the disputed domain name, and finds that under the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Based on the available record, the Panel finds that the Complainant has successfully 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 <bakesmark.com> be transferred to the Complainant.

/Kiyoshi Tsuru/

Kiyoshi Tsuru

Sole Panelist

Date: October 3, 2024.