

ADMINISTRATIVE PANEL DECISION

Wakefit Innovations Private Limited v. madison gray, Mark Gilpin
Case No. D2024-4418

1. The Parties

The Complainant is Wakefit Innovations Private Limited, India, represented by Wadhwa Law Chambers, India.

The Respondent are madison gray, United States of America (“United States”), and Mark Gilpin, United States, self-represented.

2. The Domain Names and Registrar

The disputed domain names <wakefit.com> and <wake.fit> (each a “Disputed Domain Name”, and together the “Disputed Domain Names”) are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 28, 2024. On October 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On October 30, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Names which differed from the named Respondent (Domains By Proxy, LLC and WakeFit LLC) and contact information in the Complaint.

The Center sent an email communication to the Complainant on October 31, 2024 with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrar, requesting the Complainant to either file separate complaint(s) for the Disputed Domain Names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity and/or that all domain names are under common control. The Complainant filed an amended Complaint on November 5, 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 November 7, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 27, 2024. The Response was filed with the Center on November 27, 2024.

The Center appointed Nick J. Gardner as the sole panelist in this matter on November 29, 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 India. It was incorporated in 2016 and commenced its business in the same year. It offers for sale via a variety of different outlets what it describes as “mattresses of unparalleled quality”. There is no dispute that it has a very substantial and significant business in India in this respect. Its turnover in 2023-2024 was 120 million USD. There is also no dispute that it owns a number of figurative and word registered trademarks in India for the term “wakefit”, e.g., the Indian trademark registration number 3105561 for WAKEFIT, filed on November 23, 2015. These are referred to as the “Indian WAKEFIT trademark” in this decision. There is evidence that the Complainant has carried out some online sales to customers in Japan and the UAE. Apart from this evidence there is no other evidence that the Complainant has any activity or reputation outside India.

The Complainant’s principal website is linked to the domain name <wakefit.co>. It also owns a number of other domain names including the terms “wake” and “fit” – for example <wake-fit.com>.

The Disputed Domain Name <wakefit.com> was registered on October 28, 2009. It is registered in the name of Madison Gray. It resolves to a website which promotes a device intended to assist in exercising described as the “Water Assisted Kore Exercise” device. The Disputed Domain Name <wake.fit> was registered on October 10, 2017 in the name of Mark Gilpin. It resolves to a parking page with commercial links.

5. Parties’ Contentions

A. Complainant

The Complainant submits that the named Respondents are, in fact, the same entity and/or both Disputed Domain Names are under common control. It relies upon the following (a) both registrants share the same street address; (b) they use the identical phone number; (c) both registrants utilize the same email address; (d) both Disputed Domain Names, <wakefit.com> and <wake.fit>, are adopted to target the Complainant’s trademark; (e) the Respondents’ representative, via a letter dated April 11, 2024, attempted to sell the Disputed Domain Names together on behalf of the Respondents, reinforcing the idea of common ownership or control.

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Names. The Complaint is lengthy and makes numerous points which are to some extent repetitive. The Panel will set out what it understands to be the main thrust of the Complainant’s case,

The Complainant contends that the Disputed Domain Names are each identical or confusingly similar to the Indian WAKEFIT trademark and that the Respondents have no rights or legitimate interests in the Disputed Domain Names. It says the Respondents are engaged in a “pattern of engaging in cybersquatting activities”. It says this is reflected in the correspondence that has passed between the parties. It sets out the following table in this regard.

No	Date	Event
1	November 6, 2018	The Respondent/domain name holder approached the Complainant through MediaOptions.com to offer for sale the Disputed Domain Name <wakefit.com>.
2	November 7, 2018	The Respondent/domain name holder sought USD 150,000 for the Disputed Domain Name <wakefit.com>.
3	November 14, 2018	The Complainant made a counter offer of USD 2,000 for the Disputed Domain Name <wakefit.com>.
4	November 22, 2018	Pursuant to negotiations between the parties, the Complainant made a second offer of USD 3,000 for the Disputed Domain Name <wakefit.com>.
5	December 12, 2023	The Respondents/domain name holders approached the Complainant once again through VPN.com.
6	April 11, 2024	The Respondents/domain name holders once again expressed their desire to sell the Disputed Domain Names to the Complainant.
7	May 3, 2024	The Complainant made an offer of USD 3,000 for the Disputed Domain Names.
8	June 26, 2024	The Respondents implied that they have other offers for the Disputed Domain Names and their trademarks in United States of America.
9	June 28, 2024	A holding email was sent by the Complainant to the Respondents.
10	September 20, 2024	The Complainant reiterated that the offer of USD 3,000 was fair considering the business value associated with the Disputed Domain Names <wakefit.com> and <wake.fit> in their geographical and demographical audience and given that the Respondents have not been using these domain names.
11	September 21, 2024	The Respondents replied to the Complainant's email stating that the offer by the Complainant is not acceptable.

So far as bad faith is concerned the Complainant produces a very large amount of evidence as to its fame and reputation in India. As there is no dispute about this issue the Panel does not find it necessary to set that out here.

The Respondent then says as follows "A search on the United States Patent and Trademark Office (USPTO) website reveals that there is no valid trade mark under the Respondents' name. Further a check has revealed that the Respondents was administratively dissolved by the Secretary of State, State of Georgia, on December 31, 2015, and filed for voluntary dissolution in the State of Florida on November 09, 2021. Public records indicate that Respondents has been dissolved and has not conducted business for almost a decade. Documentary evidence for the same is attached and marked as Annexure S"

The Complainant then goes on to say as follows:

"The Respondents have engaged in a pattern of conduct where domain name(s) were registered or retained to prevent the Complainant from reflecting the trade mark in a corresponding domain name. By retaining the domain "www.wakefit.com" and acquiring the domain name wake.fit, the Respondents have intentionally obstructed the Complainant, who has legitimate trade mark rights and interests, from using the domain names that corresponds to their established and registered trademarks. This is a clear example of the Respondents' bad faith registration strategy aimed at obstructing the legitimate trade mark owner.

The Respondents' actions have directly interfered with the Complainant's ability to conduct business by creating barriers to their online presence and thereafter demanded a highly inflated amount of USD 150,000 from the Complainant for these domain names. This disruption is evident in the Respondents' attempt to leverage the domain for financial gain by repeatedly offering to sell it to the Complainant at an inflated price, knowing that the Complainant relies on its online presence for business operations.

Furthermore, the Respondents' domain name, "www.wakefit.com", is not in genuine use for any business activities. It does not facilitate the sale of any products and contains minimal content, clearly indicating that it was established with the intent of cyber-squatting. The Respondents' claim to social media links on the website, which are non-functional, further proves the lack of legitimate business use and reinforces the intention to mislead and confuse consumers".

B. Respondent

The Respondents' case is effectively summarised in the opening paragraph of the Response, as follows:

"The Complainant states that it adopted the mark Wakefit in August 2015 and was incorporated in 2016. This mark is identical to Respondents' trademark created in 2010. Additionally, the Respondent registered the domain wakefit.com on Oct 28th, 2009. This complaint is without merit as Respondent was making use of the domain name with a website and in connection with a bona fide offering of goods or services six years prior to the Complainant's business, Wakefit Innovations, existed. At the time of Respondents' registration of the domain, Respondent had never heard of and had no knowledge of the Complainant's business."

The Respondent say that the Complainant's several attempts to purchase the Disputed Domain Name <wakefit.com> over many years has demonstrated their acknowledgement of the Respondents' legitimate ownership.

The Respondents say that contrary to the timeline offered by the Complainant, the first contact was not instigated by the Respondent on June 11, 2018, but the first date of contact and the Respondent's first knowledge of the existence of Wakefit Innovations was one year prior on August 30, 2017 when the Complainant made contact with the Respondents via their Wakefit business Facebook page and requested a video call meeting for the purpose of discussing the Disputed Domain Name <wakefit.com> which they regarded as "essential" for their business. In a video call the Complainant asked the Respondent if there was interest in selling the Disputed Domain Name, the Respondents replied that the business was still active and ongoing and was considering different options for future product offerings, but the Respondents were willing to hear an offer from the Complainant. The Complainant asserted that the Respondents should make the first offer. Upon providing this offer, the Complainants stated their budget was limited and the discussion did not go further at that time.

The Respondents say that the Complainant's correspondence timeline (above) is a list of dates in which the Complainant has excluded, without explanation or justification, documented instances of their unsolicited communications to the Respondent regarding attempts to acquire the Disputed Domain Name. The Complainant's selective omission of these dates therefore appears calculated to strengthen their unsubstantiated allegations of cybersquatting.

The Respondents say that the Complainant's characterization of the Respondents' domain name use contains material misrepresentations. The Disputed Domain Name <wakefit.com> has been consistently employed for legitimate business purposes since its registration. The website's current content and configuration has not changed and any assertion of cyber-squatting is refuted by the chronological record, as the Respondents' domain name registration and active business use preceded the Complainant's existence by approximately six years. Therefore, allegations regarding consumer confusion or misleading intent are chronologically impossible, without merit, and constitute prejudicial and damaging assertions against the Respondents' established business interests.

The Respondents request a finding of Reverse Domain Name Hijacking ("RDNH").

6. Discussion and Findings

6.1 Procedural Issues – Multiple Respondents

The amended Complaint was filed in relation to nominally different domain name registrants. The Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control (see above). The Complainant requests the consolidation of the Complaint against the multiple Disputed Domain Name registrants pursuant to paragraph 10(e) of the Rules.

The Disputed Domain Name registrants appear to concede that they jointly are in common control of the Disputed Domain Names

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

In addressing the Complainant's request, the Panel will consider whether (i) the Disputed Domain Names or corresponding websites are subject to common control; and (ii) the consolidation would be fair and equitable to all Parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

As regards common control, the Panel notes that the Respondents appear to use the same address, telephone number, and email address, and have proceeded in the Response on the basis that they jointly control the Disputed Domain Names

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the disputes regarding the nominally different Disputed Domain Name registrants (referred to below as "the Respondent") in a single proceeding.

6.2 Substantive Matters

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are:

- (i) that the Disputed Domain Names are 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 Names;
- and,
- (iii) that the Disputed Domain Names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has established that it is the owner of the Indian WAKEFIT trademark

The Disputed Domain Name <wakefit.com> is identical to this. It is well established that the generic Top-Level Domain ("gTLD"), in this case ".com", does not affect the Disputed Domain Name for the purpose of determining whether it is identical or confusingly similar. See, for example, *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. [D2000-0429](#).

It does not matter for the purposes of this element that the Disputed Domain Name was registered before the Indian WAKEFIT trademark existed – the Panel agrees with the consensus approach as explained in [WIPO Overview 3.0](#), section 1.1.3:

“While the UDRP makes no specific reference to the date on which the holder of the trademark or service mark acquired its rights, such rights must be in existence at the time the complaint is filed.”

Registration of a domain name before a complainant acquires trademark rights in a name does not prevent a finding of identity or confusing similarity under the UDRP. The UDRP makes no specific reference to the date on which the holder of the trademark or service mark acquired rights. However, in such circumstances it may be difficult to prove that the Disputed Domain Name was registered in bad faith under the third element of the UDRP. See below as to bad faith issues.

The Disputed Domain Name <wake.fit> is in the opinion of the Panel identical or confusingly similar to the Indian WAKEFIT trademark. See [WIPO Overview 3.0](#) at section 1.11.3 “Where the applicable TLD and the second-level portion of the domain name in combination contain the relevant trademark, panels may consider the domain name in its entirety for purposes of assessing confusing similarity (e.g., for a hypothetical TLD “.mark” and a mark “TRADEMARK”, the domain name <trade.mark> would be confusingly similar for UDRP standing purposes)”.

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 any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a domain name:

- (i) before any notice to the respondent of the dispute, use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name, even if the respondent has acquired no trade mark or service mark rights; or
- (iii) the respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

It is generally accepted that that paragraph 4(c) of the Policy in effect requires the Complainant to prove a negative. This is usually addressed by establishing whether the Complainant has established a prima facie case that the Respondent does not have any rights or legitimate interests in the Disputed Domain Names. If so then the burden of production shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the Disputed Domain Name (see for example *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#); *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

In the present case the Panel does not consider that even on its own case and evidence the Complainant has established such a prima facie case. The Complainant clearly acknowledges that the Disputed Domain Name <wakefit.com> was registered in 2009 some six years prior to the Complainant coming into existence. There is no suggestion or evidence that the Respondent obtained it at any later date than its date of registration. The Complainant’s own evidence also shows that this Disputed Domain Name resolves to a website which promotes a device intended to assist in exercising, described as a Water Assisted Kore Exercise device and which contains the following text “water assisted (k)ore exercise device. Unlike machines made of plastic and steel, WAKE has an organic, fluid feel that supports your back as you exercise. It is covered in soft suede and made to feel great and look great. WAKE takes the discomfort out of stretching and strengthening the core so that even the most diehard exercise avoiders will be able [to] incorporate it into a daily ritual. WAKE comes with two DVDs; WAKE with Pilates and WAKEfit which is a WAKE stretching and light exercise routine you do every day before you get out of bed”. There is nothing in the relevant material to suggest that this is not a bona fide website.

The Respondent’s evidence simply establishes in more detail what the Complainant’s evidence already showed – the Respondent was first in time with its choice of name. In the Respondent’s case it was selected

to combine the acronym for the Respondent's exercise device with the word "fit" and this was chosen in relation to a bona fide business. Furthermore, the Respondent's evidence shows quite clearly the Complainant knew this was the case. This is strikingly illustrated by the Complainant's first approach to the Respondent by means of what appears to be a Facebook message on August 30, 2017 from the Complainant to the Respondent which reads as follows "Hi Wakefit team. High-five on the awesome name both of us chose for our businesses! We are a memory-foam product-based company operating out of Bangalore, India specializing in mattresses and pillows looking to expand globally. To achieve that we believe a wakefit.com domain is essential and thus we wanted to have a conversation round it. Please let us know if you'd be interested and would be available to talk sometime next week. Thanks Wakefit Team".

The Response goes on in more detail to analyse all of the correspondence and events but the Panel does not consider it necessary to set all that material out here.

Accordingly, the Panel considers that the Complainant has failed to show the Respondent lacks any rights or legitimate interests.

C. Registered and Used in Bad Faith

The Panel finds on the evidence that the Respondent registered the Disputed Domain Name <wakefit.com> in 2009, some six years before the Complainant came into existence and started its business using the Indian WAKEFIT trademark. In the circumstances, it is impossible to suggest the Respondent registered the Disputed Domain Name <wakefit.com> in the knowledge of the Complainant's trademark and therefore with the intention of taking unfair advantage of that trademark and cannot therefore have registered it in bad faith for the purposes of the Policy (see [WIPO Overview 3.0](#), section 3.8).

The Panel does not consider there is anything wrong in the Respondent registering <wake.fit> in October 2017. By that date it was aware of the Complainant and it having also adopted the name "wakefit" but in circumstances where two different businesses in different parts of the world and in different areas of business use the term "wakefit", it seems to the Panel that the general principle of "first come first served" in relation to registration of domain names is applicable. Further the top level domain suffix ".fit" is arguably better suited to the Respondent's business (which involves a fitness related exercise device) as opposed to the Complainant's business (memory foam mattresses).

The Complainant has alleged that the Respondent is a corporation that has ceased to exist (see above). This allegation makes no sense as the Respondent comprises two individuals. If the Complainant's evidence is examined, it relates to a corporate entity named Wakefit LLC which utilises the same address as the Respondent. The Panel assumes this entity is or was a corporate vehicle used by the Respondent but as it was not the registrant of either of the Disputed Domain Names, and its role seems to the Panel to be irrelevant.

Accordingly, the Panel concludes there is no credible evidence to establish bad faith on the part of the Respondent and the Complainant has failed to discharge its burden of proof and has failed to establish that the third condition of paragraph 4(a) of the Policy has been fulfilled

7. Reverse Domain Name Hijacking

Reverse Domain Name Hijacking ("RDNH") is defined under the Rules as "using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name".

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 was brought primarily 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".

As set out in the [WIPO Overview 3.0](#) section 4.16, reasons articulated by panels for finding RDNH include:

(i) facts which demonstrate that the complainant knew it could not succeed as to any of the required three elements – such as the complainant’s lack of relevant trademark rights, clear knowledge of respondent rights or legitimate interests, or clear knowledge of a lack of respondent bad faith (such as registration of the Disputed Domain Name well before the complainant acquired trademark rights, (ii) facts which demonstrate that the complainant clearly ought to have known it could not succeed under any fair interpretation of facts reasonably available prior to the filing of the complaint, including relevant facts on the website at the Disputed Domain Name or readily available public sources such as the Whois database, (iii) unreasonably ignoring established Policy precedent notably as captured in this WIPO Overview – except in limited circumstances which prima facie justify advancing an alternative legal argument, (iv) the provision of false evidence, or otherwise attempting to mislead the panel, (v) the provision of intentionally incomplete material evidence – often clarified by the respondent, (vi) the complainant’s failure to disclose that a case is a UDRP refiling, (vii) filing the complaint after an unsuccessful attempt to acquire the Disputed Domain Name from the respondent without a plausible legal basis, (viii) basing a complaint on only the barest of allegations without any supporting evidence”.

The Panel considers that the Complaint is entirely unsatisfactory for multiple reasons. At its heart is the fact that the Disputed Domain Name <wakefit.com> was registered six years before the Complainant came into existence. There was no allegation that its ownership has at any time changed so the Complaint was (in relation to that Disputed Domain Name) doomed to failure, and the Complainant or its representatives ought to have known that was the case. Further the Complainant materially misrepresented the correspondence between the parties – notably by omitting the highly material fact that that the initial first contact between the parties was the Complainant approaching the Respondent to seek to buy the Disputed Domain Name <wakefit.com>, which it regarded as “essential” for its business and in effect acknowledging the Respondent had independently arrived at the “wakefit” name. Further the Complainant inaccurately presented the Respondent’s business and its website as being pretextual when that was clearly not the case. Additionally, there is no evidence at all to support the allegation that the Respondent was engaged in a “pattern of cybersquatting activities” and that allegation should not have been made. The allegation that the Respondent had ceased to exist was one which was presumably introduced to bolster the Complainant’s case but was an allegation which the Complainant or its representatives should have realised was factually wrong and made no sense.

Further, the Panel considers it should be able to rely upon the certification that a Complainant gives that “the information presented in this Complaint is to the best of the Complainant’s knowledge complete and accurate”. The Panel considers this is a case where such certification could not properly have been given having regard to the matters set out above.

Given the relevant facts, the nature of the Policy and the fact that the Complainant was legally represented, the Panel considers this was a case which should never have been brought and should certainly not have been presented in the manner it was. The Panel therefore finds that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

8. Decision

For the foregoing reasons, the Complaint is denied. The Panel finds that the Complaint constitutes an abuse of the administrative proceeding.

/Nick J. Gardner/

Nick J. Gardner

Sole Panelist

Date: December 5, 2024