

ADMINISTRATIVE PANEL DECISION

Helbiz, Inc. v. Ilya Tardikov

Case No. D2022-0103

1. The Parties

The Complainant is Helbiz, Inc., United States of America (“United States”), represented by Stokes Lawrence, P.S., United States.

The Respondent is Ilya Tardikov, Russian Federation.

2. The Domain Name and Registrar

The disputed domain name <hbznews.com> is registered with Registrar of Domain Names REG.RU LLC (the “Registrar”).

3. Procedural History

The Complaint in English was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on January 13, 2022. On January 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 14, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on February 4, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On the same date, the Center sent to the Parties a document in English and Russian in relation to the language of the proceeding. On February 7, 2022, the Complainant filed an amended Complaint and submitted a request for English to be the language of the proceeding. The Respondent made no comments on the Complainant’s request in respect of the language of the proceeding.

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 February 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 7, 2022. The Respondent did not submit any response.

Accordingly, the Center notified the Respondent's default on March 8, 2022.

The Center appointed Assen Alexiev as the sole panelist in this matter on March 22, 2022. 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 an urban transportation company headquartered in New York City that allows users to instantly rent electric scooters directly from the Helbiz mobile app. It was founded in 2015 and is publicly listed on the Nasdaq under the symbol "HLBZ". The Complainant is operating in 13 cities in the United States and 23 cities in Italy.

The Complainant is the owner of the following trademark registrations for the brand "HELBIZ" (the "HELBIZ trademark"):

- the United States trademark HELBIZ with registration No. 5,908,417, applied for on March 18, 2016 and registered on November 12, 2019 for goods and services in International Classes 9 and 39; and
- the Canadian trademark HELBIZ with registration No. TMA1082506, applied for on May 17, 2018 and registered on September 30, 2020 for goods and services in International Classes 9, 35, 38, 39, and 42.

The Complainant is the registrant of the domain name <helbiz.com>, registered on June 27, 2015, which it uses for its official website. The Complainant is also the owner of the domain names <helbiz.biz>, <helbiz.info>, <helbiz.mobi>, <helbiz.org>, <helbiz.uk>, and <helbiz.us>, all registered in 2017.

The disputed domain name was registered on June 23, 2019. It resolves to a website with the title "Helbiz News", the content of which is related of the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant maintains that it has common law trademark rights in the HELBIZ trademark, which it has used since 2015 in connection with its electric scooter business via the Internet and its mobile app in multiple countries. According to the Complainant, as a result of its long and substantial use, the HELBIZ trademark has become well-known and the public recognizes it as identifying the Complainant's goods and services. In this regard, the Complainant submits that it has invested substantial resources promoting its services under the HELBIZ trademark, which appears prominently on its website located at <helbiz.com>, as well as on its other promotional and marketing materials, and the Complainant is publicly listed on the Nasdaq under the symbol "HLBZ".

According to the Complainant, the disputed domain name is confusingly similar to the Complainant's HELBIZ trademark and to its domain name <helbiz.com>, because the disputed domain name incorporates the HELBIZ trademark with minor typographical variations and the dictionary word "news", which are insufficient to distinguish it from trademark, especially considering that the Complainant's Nasdaq listing is under the symbol "HLBZ".

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name, because it is not affiliated with the Complainant and the Complainant has not authorized the Respondent to use the HELBIZ trademark. The Complainant adds that the Respondent is not commonly known under the disputed domain name and has no relevant trademark rights, and has not used the disputed domain name in connection with a *bona fide* offering of goods or services. The Complainant points out that the Respondent registered the disputed domain name in 2019 – four years after the Complainant

registered its <helbiz.com> domain name and started using its HELBIZ trademark. According to the Complainant, the Respondent's use of the disputed domain name, which consists of the Complainant's HELBIZ trademark with minor omissions in combination with the term "news", is intended to take advantage of the Complainant's goodwill and reputation by creating an apparent association or commercial link between the Complainant and the Respondent. The Complainant notes that the disputed domain name does not indicate that it is devoted to criticism of the Complainant, but resolves to a criticism website that is directed at the Complainant and includes the HELBIZ trademark prominently featured on it. The disputed domain name thus attracts Internet traffic and potentially deprives the Complainant of visits by Internet users.

The Complainant maintains that the Respondent has registered and is using the disputed domain name in bad faith. It points out that the Respondent knew of the Complainant's HELBIZ trademark when it registered the disputed domain name, because its website is critiquing the Complainant. The registration and use of the disputed domain name was intended to take advantage of the Complainant's goodwill by creating a false sense of affiliation, sponsorship, or association with the Complainant.

B. Respondent

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

6. Discussion and Findings

6.1. Procedural issue – language of the proceeding

According to the information provided by the Registrar, the language of the Registration Agreement for the disputed domain name is Russian. Under paragraph 11 of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

The Complainant requests that the language of the proceedings be English. It notes that the disputed domain name resolves to a criticism website directed at an American company domiciled in the United States, where English is the national language, and the content of this website is in English. The Complainant also notes that it has no knowledge of the Russian language, and requiring the Complainant to translate the Complaint into Russian would result in significant cost and delay.

The Center has sent all its communications to the Respondent in both English and Russian, and has invited the Respondent to express its views on the language of the proceeding. The Respondent has not submitted a Response or any objections to the Complainants' request that the proceedings be held in English, and the website at the disputed domain name is indeed in English.

The above satisfies the Panel that the Respondent would not be disadvantaged if the language of the proceeding is English, and that using the English language in this proceeding would be fair and efficient.

Therefore, in exercise of its powers under paragraph 11 of the Rules, the Panel decides that the language of this administrative proceeding will be English.

6.2. Substantive issues

Paragraph 4(a) of the Policy sets forth the following three requirements, which have to be met by the Complainant to obtain the transfer of the disputed domain name:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: “[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name [...]”

The Respondent has however submitted no Response and has not disputed the Complainant’s contentions and evidence in this proceeding.

A. Identical or Confusingly Similar

The Complainant has submitted evidence that demonstrates its rights in the HELBIZ trademark. This trademark was registered several months after the registration of the disputed domain name. As discussed in section 1.1.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), the UDRP makes no specific reference to the date on which the holder of the trademark or service mark acquired its rights, but such rights must be in existence at the time the complaint is filed. The fact that a domain name may have been registered before a complainant has acquired trademark rights does not by itself preclude a complainant’s standing to file a UDRP case, nor a panel’s finding of identity or confusing similarity under the first element. The Panel is therefore satisfied that the Complainant has established its standing to file the Complaint.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the generic Top-Level Domain (“gTLD”) section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). See section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). The Panel sees no reason not to follow the same approach here, so it will disregard the “.com” gTLD of the disputed domain name.

The relevant part of the disputed domain name is therefore “hbznews”, which includes the sequence “hbz” as its dominant element, and the dictionary word “news”. The sequence “hbz” includes the prominent letters of the HELBIZ trademark, which can be recognized in the disputed domain name. As already held by previous UDRP panels, the addition of descriptive or geographical terms would not prevent a finding of confusing similarity between a domain name and a trademark where the trademark is clearly recognizable in the disputed domain name. See section 1.8 of the [WIPO Overview 3.0](#).

In addition, as discussed in section 1.7 of the [WIPO Overview 3.0](#), in specific limited instances where a panel would benefit from affirmation as to confusing similarity with the complainant’s mark, the broader case context such as website content trading off the complainant’s reputation, may support a finding of confusing similarity. Here, the website at the disputed domain has the title “Helbiz News” and its entire content is related to the Complainant, and the email address indicated on this website contains the sequence “helbiznews”. This satisfies the Panel that the Respondent chose the disputed domain name due to its similarity with the name of the Complainant and its HELBIZ trademark.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the HELBIZ trademark.

B. Rights or Legitimate Interests

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to

have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, stating that the Respondent is not commonly known under it, has no relevant trademark rights, and has not been authorized by the Complainant to use the HELBIZ trademark. The Complainant points out that the Respondent registered the disputed domain name four years after the Complainant registered its <helbiz.com> domain name and started using its HELBIZ trademark. According to the Complainant, the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services, as it does not indicate that it is devoted to criticism of the Complainant, but nevertheless resolves to a criticism website that is directed at the Complainant and includes the HELBIZ trademark prominently featured on it.

The Respondent has not disputed the Complainant's statements and the evidence submitted by it. It has not alleged having rights or legitimate interests in the disputed domain name.

The evidence submitted by the Complainant shows that the disputed domain name resolves to a website that contains materials criticizing the Complainant. The main page of this website contains no disclaimer for the lack of relationship with the Complainant, but only a link at the bottom titled "Disclaimer", which redirects to another subpage of the website that contains the statement "It's the unofficial site of Helbiz News". The Panel does not regard this as a proper disclaimer for the lack of relationship with the Complainant. Moreover, use of a domain name is not considered fair in circumstances where the domain name falsely suggests an affiliation with the trademark owner (*Eli Lilly and Company and Novartis Tiergesundheit AG v. Manny Ghumman / Mr. NYOB / Jesse Padilla*, WIPO Case No. [D2016-1698](#)).

It therefore appears from the evidence as more likely than not that the Respondent has registered and used the disputed domain name to create an impression in Internet users that the website at the disputed domain name is related to the Complainant and offers news about it, without making them aware of the lack of relationship between the Parties, and then going on to criticize it – *i.e.*, effectively a bait-and-switch. Such use by the Respondent of the disputed domain name is not fair, but is misleading.

On the basis of the above, the Panel finds that the Complainant has met its burden under the second element.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

"(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

In the present case, the disputed domain name was registered several months before the HELBIZ trademark was registered. As discussed in section 3.8 of the [WIPO Overview 3.0](#), 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. As an exception to this general proposition, in certain limited circumstances where the facts of the case establish that the respondent's intent in registering the domain name was to unfairly capitalize on the complainant's nascent (typically as yet unregistered) trademark rights, panels have been prepared to find that the respondent has acted in bad faith.

The Panel finds that there are several considerations that support a conclusion that in registering the disputed domain name the Respondent has indeed attempted to unfairly capitalize on the Complainant's then unregistered trademark rights. The disputed domain name is confusingly similar to the Complainant's HELBIZ trademark and is being used for a website that is titled "Helbiz News" and is entirely directed at the Complainant. It does not contain a proper disclaimer of the lack of relationship between the Parties and of the lack of endorsement of the website by the Complainant, but indicates an email address that contains the sequence "helbiznews", thus also referring to the Complainant.

In view of the above and incorporating the analysis under the first and second elements, the Panel finds as more likely than not that the Respondent was aware of the Complainant and of its yet unregistered HELBIZ trademark when registering the disputed domain name, and that by registering and using it, the Respondent has intentionally attempted to attract Internet users to its website by creating a likelihood of confusion with the Complainant's HELBIZ trademark as to the affiliation or endorsement of the Respondent's website and of the content offered on this website. Therefore, the Panel finds that the Respondent has registered and used the disputed domain name in bad faith.

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 <hbznews.com> be transferred to the Complainant.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: April 5, 2022