

## **ADMINISTRATIVE PANEL DECISION**

**Domino Printing Sciences PLC v. Super Privacy Service LTD c/o Dynadot / Yegara, and Domino Marketing Solution PLC**  
Case No. D2022-0467

### **1. The Parties**

Complainant is Domino Printing Sciences PLC, United Kingdom, represented by Mills & Reeve LLP, United Kingdom.

Respondents are Super Privacy Service LTD c/o Dynadot, United States of America (“United States”) / Yegara, Ethiopia, internally represented, and Domino Marketing Solution PLC, Ethiopia, represented by Melkam Law, Ethiopia.

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

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 10, 2022. On February 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 14, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email to Complainant on February 14, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on February 16, 2022. On February 14, 2022, the Center received a communication from Respondent Yegara.

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 Respondents of the Complaint, and the proceedings commenced on February 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 9, 2022. On March 8, 2022, Respondent Domino

Marketing Solution PLC requested a time extension to file a response and the Center granted Respondents an automatic four calendar day extension for response under paragraph 5(b) of the Rules by updating the Response due date as March 13, 2022. The Response was filed by Respondent Domino Marketing Solution PLC with the Center on March 13, 2022.

The Center appointed Robert A. Badgley as the sole panelist in this matter on March 16, 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**

Founded in 1978, Complainant Domino Printing Sciences PLC is based in the United Kingdom. Complainant states that it “specializes in the development and manufacture of coding, marking and printing technologies,” and “supplies aftermarket products and digital printing solutions to the commercial printing sector, specializing in digital inkjet printers and control systems”. According to Complainant, it operates in more than 120 countries and employs over 2,800 people. It has manufacturing plants in the United Kingdom, United States, China, Switzerland, Germany, Sweden, and India.

Complainant states that it operates in Africa through a network of distributors, and that its 2020 sales in Ethiopia (Respondents’ country) exceeded GBP 65,000.

Complainant refers to a number of professional awards it has received in connection with its inkjet label printer and its industrial continuous inkjet printers.

Complainant operates a website at the domain name <domino-printing.com>.

Complainant holds a number of registered trademarks in various jurisdictions for the mark DOMINO, including: United Kingdom Intellectual Property Office Trademark No. UK00001201082, registered on August 4, 1983 in connection with “printing machines (not for office use) and parts and fittings therefor”; United Kingdom Intellectual Property Office Trademark No. UK00003010975, registered on January 24, 2014 in connection with “printing machines and apparatus; digital printers; impact printers” and related goods, as well as “air purifying apparatus and machines”; and United States Patent and Trademark Office Reg. No. 1,388,040, registered on April 1, 1986 in connection with “printing machines and parts therefore” (referred to below as the “DOMINO Mark”).

Respondent Yegara is a web hosting, design, and advertising company based in Ethiopia. On February 14, 2022, Respondent Yegara submitted a communication to the Center indicating that it is managing the Domain Name on behalf of the Respondent Domino Marketing Solution PLC.

Respondent Domino Marketing Solution PLC is a business in Ethiopia. Based on a business license, in the field of “consultancy activity on advertising”, which is annexed to the Response, Respondent Domino Marketing Solution PLC appears to have been in operation as early as 2013. According to Respondent Domino Marketing Solution PLC, its main business is the “provision of marketing solutions and services”. Respondent Domino Marketing Solution PLC offers printing services, but asserts that these services are “incidental” to its main business of providing marketing advice to clients.

The Domain Name was registered on November 9, 2021. The Domain Name resolves to a website where Respondent Domino Marketing Solution PLC advertises its marketing services. The home page states: “We Are Professional Marketing Solution Company!” Further content states that Respondent Domino Marketing Solution PLC operates in Ethiopia.

The site also features a number of examples where Respondent Domino Marketing Solution PLC has provided marketing advice to clients in terms of product packaging, custom novelty items for special events,

trade show merchandise, and accessories with a client's brand featured on an item like an umbrella, a cap, a mug, etc. According to Respondent Domino Marketing Solution PLC, it does not do the actual printing in such instances, but outsources such work to a third party vendor. Among the examples of the works in Respondent Domino Marketing Solution PLC's portfolio are a custom calendar, custom tee-shirts and shopping bags, and poster advertisements.

There is no evidence that the Parties communicated with each other prior to the filing of the Complaint in this proceeding.

## **5. Parties' Contentions**

### **A. Complainant**

Complainant contends that it has established all three elements required under the Policy for a transfer of the Domain Name.

### **B. Respondent**

Respondent Yegara asserts that it provides services relating to the Domain Name on behalf of Respondent Domino Marketing Solution PLC. Respondent Domino Marketing Solution PLC asserts that it is a legitimate business offering services in a country where Complainant has little or no presence, and offering services unrelated to the goods that Complainant offers.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondents have 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.

Regarding Respondent identity, the Panel notes that in the initial Complaint, Complainant named Respondent Domino Marketing Solution PLC, as well as the concerned privacy service. However, upon confirmation from the Registrar that the registrant details for the Domain Name identified the registrant as "YEGARA", Complainant requested addition of Respondent Yegara in an amendment to the Complaint. Paragraph 1 of the UDRP Rules defines the respondent as "the holder of a domain name registration against which a complaint is initiated". In the circumstances, and taking into account the Complaint (and amendment), Respondent Yegara's above-referenced communication confirming a relationship between Respondents in connection to the Domain Name, and the Response submitted by Respondent Domino Marketing Solution PLC, the Panel considers it appropriate to apply its discretion to determine Respondents to be Super Privacy Service LTD c/o Dynadot / Yegara, and Domino Marketing Solution PLC.

### **A. Identical or Confusingly Similar**

The Panel concludes that Complainant has rights in the DOMINO Mark through registration and use demonstrated in the record. The Panel finds that the Domain Name is confusingly similar to the DOMINO Mark. The DOMINO Mark is entirely reproduced in the Domain Name, and the additional letters "plc" (which refers to "Public Limited Company" in some jurisdictions and "Private Limited Company" in others, such as Ethiopia) does not prevent a finding of confusing similarity between the DOMINO Mark and the Domain

Name.

Complainant has established Policy paragraph 4(a)(i).

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

Pursuant to paragraph 4(c) of the Policy, Respondents may establish their rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your 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) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial 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.

In view of the Panel's conclusion below in connection with the "Bad Faith" element, the Panel need not decide the "Rights or Legitimate Interests" issue.

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

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation", are evidence of the registration and use of the Domain Name in "bad faith":

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the Domain Name; or
- (ii) that Respondent has 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 Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other on-line location, by creating a likelihood of confusion with Complainant's Mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that Complainant has not carried its burden of proving that Respondents have registered and used the Domain Name in bad faith. The Panel finds insufficient evidence in this record to conclude, on a balance of probabilities, that Respondents more likely than not had Complainant's DOMINO Mark in mind when registering the Domain Name. That DOMINO Mark is not registered in Ethiopia, and Complainant's 2020 sales in that country do not strike the Panel as sufficiently robust to yield the conclusion that Complainant's DOMINO Mark enjoyed such renown that Respondents probably were aware of it.

Respondent Domino Marketing Solution PLC's business appears legitimate, and the Parties are not in any meaningful sense competitors. Although the word "printing" may be applied to both Parties' businesses, the overlap ends there. It appears that Complainant's core business is making printers, while Respondent

Domino Marketing Solution PLC's core business is providing marketing advice and services, which sometimes includes printing services.

The Panel notes Complainant's allegation that Respondent Domino Marketing Solution PLC's use of the Domain Name and corresponding website constitutes passing off under English law, but if that is so, it is not for this Panel to say. A successful claim under the UDRP is not coextensive with a passing off or trademark infringement claim.

The Complaint fails.

## **7. Decision**

For the foregoing reasons, the Complaint is denied.

*/Robert A. Badgley/*

**Robert A. Badgley**

Sole Panelist

Date: March 23, 2022