

ADMINISTRATIVE PANEL DECISION

Postnet International v. Manar Massarwa

Case No. D2022-0856

1. The Parties

The Complainant is Postnet International, United States of America (“United States”), represented by Barzanò & Zanardo Milano SpA, Italy.

The Respondent is Manar Massarwa, Israel.

2. The Domain Name and Registrar

The disputed domain name <postnet.center> is registered with Network Solutions, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 11, 2022. On March 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 16, 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 March 17, 2022, 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 March 17, 2022.

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 March 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 11, 2022.

The Center appointed Reyes Campello Estebaranz as the sole panelist in this matter on April 13, 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 a franchised chain, founded in 1993, of more than 650 independently owned and operated marketing service providers with full-service print shops, known for providing customized print, marketing and shipping solutions to the 28 million small businesses in the United States and millions more around the world. The Complainant's centers provide design services and printing services, as well as marketing, packaging and shipping services.

The Complainant holds registrations of the trademark POSTNET in a large number of countries around the world including United States registration 1,801,313, registered on October 26, 1993, for services in Classes 35, 36, 38, 39 and 42.

Prior decisions under the Policy have recognized the international reputation of the trademark POSTNET.¹

The Complainant also owns several domain names that contain the POSTNET mark, including <postnet.com> (registered on March 27, 1995) and <postnetfranchise.com> (registered on June 25, 2000), which resolve to its corporate websites.

The disputed domain name was registered on November 18, 2021, and it resolves to a website in English, and partly in Hebrew and Arabic language, that offers various services and products, including shopping consultation services and the sale of costume jewelry. Some of the sections of this website appear to be incomplete including for example as title of some sections the terms "Service Name" instead of any reference to a specific service. This website does not include any information about its owner or that of the disputed domain name, or any contact details except a contact form and a subscription form.

5. Parties' Contentions

A. Complainant

Key contentions of the Complaint may be summarized as follows:

Due to its numerous franchisees, its longstanding use, and huge promotional and advertising investments, the trademark POSTNET is well known internationally, being a 25-time award recipient of Entrepreneur Magazine's Top 500 Franchises.

The disputed domain name is identical to the POSTNET mark. The generic Top Level Domain ("gTLD") ".center" is merely instrumental to the use of the Internet, but, in this case, the term "center" reinforces the risk of confusion, as it could be considered an official website dedicated to the Complainant's centers or, in general, a point of contact for POSTNET affiliated.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not an authorized dealer, agent, distributor, wholesaler or retailer of the Complainant, and nothing indicates that the Respondent is commonly known by the disputed domain name. Considering that the disputed domain name is identical to the Complainant's trademark, and the fact that the term "postnet" is a fanciful combination of words, it is very difficult to conceive any possible right or legitimate interest which the Respondent could have. The use of the disputed domain name in association with the new extension

¹ See *Postnet International v. Manjo Morias*, WIPO Case No. D2021-3880.

“.center” strengthens the potential confusion for Internet users that could be misled about the control of the disputed domain name, as it could be considered as an official website/online presence of the trademark POSTNET.

The disputed domain name was registered and is being used in bad faith. The trademark POSTNET is well known. It is inconceivable that the Respondent was not aware of the Complainant’s trademark rights at the time of the registration of the disputed domain name. The disputed domain name was registered for the purpose of misleading potential consumers, capitalizing on the POSTNET mark reputation, to tarnish this trademark, and to prevent the Complainant from reflecting its trademark in a corresponding domain name. The disputed domain name is redirected to a website dedicated to different services, partially similar (consultant services) to those offered by the Complainant. Such a conduct, where the Respondent sought or realized commercial gain using the reputation of the trademark POSTNET to promote third parties’ services, constitutes bad faith.

The Complainant has cited previous decisions under the Policy and various sections of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) that it considers supportive of its position, and requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

The Complainant has made the relevant assertions as required by the Policy and the dispute is properly within the scope of the Policy. The Panel has authority to decide the dispute examining the three elements in paragraph 4(a) of the Policy, taking into consideration all of the relevant evidence, annexed material and allegations, and performing some limited independent research under the general powers of the Panel articulated, *inter alia*, in paragraph 10 of the Rules.

A. Identical or Confusingly Similar

The Complainant has rights in the POSTNET mark by virtue of its trademark registrations as well as its continuous use of this mark on the market.

The disputed domain name incorporates the POSTNET mark in its entirety, and the gTLD “.center” is a technical requirement, generally disregarded for the purpose of the analysis of the confusing similarity. See sections 1.7, and 1.11, of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain name is identical to the Complainant’s trademark, and the first element of the Policy under paragraph 4(a)(i) has been satisfied.

B. Rights or Legitimate Interests

Although the Complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, 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 primarily if not exclusively within the respondent’s knowledge. Thus, the consensus view is that paragraph 4(c) of the Policy shifts to the respondent the burden of production to come forward with relevant evidence of rights or legitimate interests in a disputed domain name, once the complainant has made a *prima facie* case that the respondent lacks rights or legitimate interests.

The Complainant's above-noted assertions and evidence in this case effectively shift the burden of production to the Respondent of producing evidence of rights or legitimate interests in the disputed domain name, providing the circumstances of paragraph 4(c) of the Policy, without limitation, in order to rebut the Complainant's *prima facie* case.

The Panel notes that the disputed domain name incorporates in its entirety the POSTNET mark, being identical to this mark, which generates an implied affiliation (and risk of confusion) with the Complainant and its trademark. The disputed domain name may give the impression that it is associated to the Complainant or any business related company, or to a point of contact for its affiliates or customers. The gTLD ".center" may contribute to this impression.

The Panel further considers that the Complainant has made out a strong *prima facie* case that the Respondent could not have rights or legitimate interests in the disputed domain name, not being authorized to use the POSTNET mark, and there is no evidence that suggests that the Respondent is commonly known by the disputed domain name.

In this respect, the Panel notes that the Respondent's name has no resemblance with the term "postnet". Additionally, the Panel, under its general powers articulated *inter alia* in paragraph 10 of the Rules, has corroborated, through a search over the WIPO Global Brand Database, that the Respondent has no trademark rights over the term "postnet", not having applied for or registered any trademark containing this term.

The Panel further notes that, according to the evidence provided by the Complainant, the disputed domain name has been used in connection to a website offering shopping consultation services and offering for sale costume jewelry, which appears to be incomplete or under construction, as some of its sections do not contain any specific information. The Panel further notes that the home page of this site appears to offer various business professional services, displaying images of laptops and tablets. This site further includes a "blog section" with various entrances related to design and management of Internet content in a professional or business environment, with titles like "How to get what you want in the work field", "10 tips for gaining competitive advantage", or "Contracts 101, read this before signing". The Panel finds that this website may give the impression that it is a new line of business in the field of design and management of Internet content provided by the Complainant or any business related company.

It is further remarkable that the Respondent has not replied to the Complainant's contentions, not alleging or providing any evidence regarding any rights or legitimate interests in respect of the disputed domain name.

Under these circumstances, the Panel concludes that the Respondent has not rebutted the Complainant's *prima facie* case, and nothing in the case file gives reason to believe that the Respondent has any rights or legitimate interests in respect of the disputed domain name. Therefore, the second element of the Policy under paragraph 4(a)(ii) has been established.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(a)(iii), requires that the Complainant establish that the disputed domain name has been registered and is being used in bad faith.

The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", being the Panel prepared to draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2, [WIPO Overview 3.0](#).

The Panel notes the international extensive use and presence over the Internet of the POSTNET mark since the registration of this trademark and company name for over 25 years.

The Panel further notes the international reputation of the POSTNET mark in the field of customized printing and shipping services, as has been recognized by previous decisions under the Policy.²

The Panel considers that all cumulative circumstances of this case point to bad faith registration and use of the disputed domain name:

(i) the disputed domain name incorporates the POSTNET mark in its entirety, being identical to this trademark;

(ii) the Complainant's trademark is well known in the design, printing and shipping services field, and the Complainant operates internationally, shipping internationally worldwide, including Israel where the Respondent is located according to the Registrar verification;

(iii) the disputed domain name has been used in connection to a website in the field of consulting services, including design and management of Internet content, which are services partially related to the fields where the Complainant operates (in particular, marketing and design services);

(iv) the website that is linked to the disputed domain name is mostly incomplete, apart from its home page and an online shop section that offers for sale costume jewelry (including information and prices), which appears to be the main commercial aim for the site;

(v) the Respondent's website does not include any information about the owner of the site; and

(vi) the Respondent has not offered any explanation of any rights or legitimate interests in the disputed domain name, and has not come forward to deny the Complainant's assertions of bad faith.

In light of the above, taking into consideration all cumulative circumstances of this case, on the balance of probabilities, the Panel considers that the disputed domain name was registered and is being used targeting the reputed POSTNET mark, in bad faith, with the intention of obtaining a free ride on the established reputation of the Complainant and its trademark. The evidence on record and the circumstances of this case show that the Respondent's purpose was to mislead Internet users, in order to generate traffic to his website with a commercial purpose, for promoting its online shop through the generated implied affiliation with the Complainant and its trademark.

Accordingly, the Panel concludes that the Complainant has met its burden of establishing that the disputed domain name has been registered and is being used 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 <postnet.center> be transferred to the Complainant.

/Reyes Campello Estebanz/

Reyes Campello Estebanz

Sole Panelist

Date: April 27, 2022

² See footnote number 1, *supra*.