

ADMINISTRATIVE PANEL DECISION

Maxtrax Australia Pty Ltd v. Privacy service provided by Withheld for Privacy ehf / genaris james
Case No. D2022-1896

1. The Parties

The Complainant is Maxtrax Australia Pty Ltd, Australia, represented by Kane Kessler, PC, United States of America (“United States”).

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / genaris james, United States.

2. The Domain Name and Registrar

The disputed domain name <maxtraxs.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 25, 2022. On May 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 28, 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 June 2, 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 amended Complaint on June 6, 2022.

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 June 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 29, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 8, 2022.

The Center appointed Zoltán Takács as the sole panelist in this matter on July 12, 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 designer of an innovative, lightweight vehicle recovery and extraction device under the brand name Maxtrax, engineered and manufactured in Queensland, Australia.

The Complainant is owner of the United States Trade Mark Registration No. 3995206 for the word mark MAXTRAX, registered since July 12, 2011 for goods of class 12 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks.

Since January 19, 2018, the Complainant owns the domain name <maxtraxus.com>, which links to its United States website.

The disputed domain name was registered on November 14, 2021, and has been linked to a website offering for sale allegedly counterfeit Maxtrax products.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name <maxtraxs.com> is confusingly similar to its MAXTRAX trademark.

The Complainant further alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii) or (iii) of the Policy.

The Complainant claims that the Respondent is operating a website at the disputed domain name offering for sale counterfeit Maxtrax goods and falsely holding itself as the Complainant and/or affiliated or authorized distributor of the Complainant, which is proof of bad faith registration and use of the disputed domain name.

The Complainant requests that the disputed domain name <maxtraxs.com> be transferred from the Respondent to the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

It has been a consensus view in UDRP decisions that a respondent's default (*i.e.*, failure to submit a response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that;

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

A. Identical or Confusingly Similar

Under paragraph 4(a)(i) of the Policy, there are two requirements which the Complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain name is identical or confusingly similar to the trademark or service mark.

It has been a consensus view among UDRP panels that if the complainant owns a trademark, then it generally satisfies the threshold requirement of having trademark rights.

The Complainant produced proper evidence of having registered rights in the MAXTRAX trademark, and for the purpose of this proceeding, the Panel finds that the United States Trademark Registration No. 3995206 satisfies the requirement of having trademark rights for the purpose of the Policy.

Having determined the presence of the Complainant's trademark rights, the Panel next assesses whether the disputed domain name is identical or confusingly similar to the Complainant's trademark.

According to section 1.7 of the [WIPO Overview 3.0](#), 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. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

According to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable Top-Level Domain ("TLD") in a domain name (".com" in this case) is viewed as a standard registration requirement and as such is generally disregarded under the first element confusingly similar test.

The Complainant's MAXTRAX trademark is clearly recognizable within the disputed domain name. The disputed domain name differs from the Complainant's trademark only in the addition of the letter "s" to it, which does not prevent a finding of confusing similarity between the Complainant's trademark and the disputed domain name.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark and that requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services;

- (ii) it has been commonly known by the domain name;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

In the present case, the Complainant has submitted sufficient and uncontested evidence that it holds well-established rights in the MAXTRAX trademark.

The Respondent is not a licensee or distributor of the Complainant. The Respondent is not affiliated with the Complainant in any way. The Complainant has not granted any authorization for the Respondent to make use of its trademark, in a domain name or otherwise.

According to section 2.1 of the [WIPO Overview 3.0](#), while 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 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 the 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.

The Respondent defaulted and failed to respond, and by doing so failed to offer the Panel any type of evidence set forth in paragraph 4(c) of the Policy, or otherwise counter the Complainant’s *prima facie* case.

The Respondent used the disputed domain name to promote a web shop purporting to sell the Complainant’s products, which the Complainant identifies as counterfeit goods. Such use of the disputed domain name is fraudulent, illegal, and can never create any rights or legitimate interests in the disputed domain name (see section 2.13.1 of the [WIPO Overview 3.0](#)).

While panels are generally not prepared to accept merely conclusory or unsupported allegations of illegal activity, including counterfeiting, even when the respondent is in default, the Panel notes that even if the products sold on the website to which the disputed domain name resolves are genuine products from the Complainant, the website still does not qualify as fair use (see sections 2.13.2 and 2.8.1 of the [WIPO Overview 3.0](#)). In this instance, the disputed domain name fails under the *Oki Data* criteria for its failure to include any disclaimer as to its relation to the Complainant, further exacerbating the risk of implied affiliation caused by the identical replication of the trademark in the construction of the disputed domain name (see *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) and section 2.5.1 of the [WIPO Overview 3.0](#)).

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name in accordance with paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

- (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.

The Complainant presented undisputed evidence that the Respondent has registered and is using the disputed domain name in bad faith.

The "About Us" page of the Respondent's website at the disputed domain name is a word-for-word direct copy of the "About Us" text on the Complainant's website. The Respondent is evidently holding itself as the Complainant, which is false.

As described above, the Complainant accused the Respondent of using the disputed domain name via its website to offer for sale counterfeit goods under the Complainant's MAXTRAX trademark. Accordingly, it is evident that the Respondent was aware of the Complainant and purposefully registered the disputed domain name with the intent to target the Complainant.

As regards the claimed counterfeiting, it is the Complainant, the owner of the corresponding trademark that is in the best situation to competently review and make determination whether the goods at issue are genuine or counterfeit.

Although the Complainant did not submit direct evidence in favor of its allegations, the Panel finds that the following facts and circumstantial evidence are sufficient to support the Complainant's credible claim of the Respondent's illegal activity and draw an inference of counterfeiting on the part of the Respondent:

- the Respondent is not affiliated with the Complainant and has never been authorized to make use of the Complainant's MAXTRAX trademark in any way;
- there is no information on the identity of the business behind the website at the disputed domain name and no information whatsoever that could suggest or confirm the business' authenticity;
- the Complainant directly accused the Respondent of counterfeiting and while it is reasonable to expect that a legitimate business would evidently argue and defend against such serious allegations, the Respondent decided not to rebut or reject them, which is hardly a conduct of a legitimate reseller selling authentic goods to consumers.

Use of the disputed domain name to promote the sale of counterfeit goods is manifestly considered evidence of bad faith (see section 3.1.3 of the [WIPO Overview 3.0](#)).

Finally, even if the products sold on the website to which the inherently misleading disputed domain name resolves are genuine products from the Complainant, noting the Respondent is evidently holding itself as the Complainant, which is false, the Panel finds that the Respondent is intentionally attempting to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website at the disputed domain name (see paragraph 4(b)(iv) of the Policy).

Accordingly, the Panel finds that paragraph 4(a)(iii) of the Policy is satisfied.

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 <maxtraxs.com> be transferred to the Complainant.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: July 26, 2022