

ADMINISTRATIVE PANEL DECISION

Helcim Inc. v. Oleg Krilov
Case No. D2022-4136

1. The Parties

The Complainant is Helcim Inc., Canada, represented by Osler, Hoskin & Harcourt, LLP, Canada.

The Respondent is Oleg Krilov, Russian Federation.

2. The Domain Names and Registrar

The disputed domain names, <helcim-login.com>, <helcim-merchant.com>, <helcim-personal.com>, and <helcim-us.com>, are registered with Nicenic International Group Co., Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 2, 2022. On November 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 4, 2022, 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 (NiceNIC INTERNATIONAL GROUP CO., LIMITED) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 4, 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 November 4, 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 November 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 29, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 30, 2022.

The Center appointed Benoit Van Asbroeck as the sole panelist in this matter on December 2, 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 Canadian company established in 2007 providing payment processing services for merchants in North America. It offers its services via its website using the domain name <helcim.com>, which has been registered since March 17, 2006. The submitted screenshots of web pages to which that domain name resolves dated October 26, 2022 do indicate that the Head Office of a company named Helcim is located at the same address as the Complainant.

The Complainant owns several trademark registrations. The trademark registrations are as follows:

Canadian Trademark No. TMA1010983 for HELCIM YOUR TRUSTED PAYMENT PARTNER & DESIGN (figurative), registered on December 11, 2018, in International Classes 9, 16, 35, 36, and 42;

Canadian Trademark No. TMA1010977 for HELCIM COMMERCE & Design (figurative), registered on December 11, 2018, in International Classes 9, 16, 35, 36, and 42;

Canadian Trademark No. TMA1010982 for HELCIM YOUR TRUSTED PAYMENT PARTNER & Design (figurative), registered on December 11, 2018, in International Classes 9, 16, 35, 36, and 42;

Canadian Trademark No. TMA1010983 for HELCIM YOUR TRUSTED PAYMENT PARTNER & Design (figurative), registered on December 11, 2018, in International Classes 9, 16, 35, 36, and 42;

United States of America ("United States") Trademark No. 5766572 for HELCIM COMMERCE (figurative), registered on June 4, 2019 in International Classes 9, 16, 35, 36, and 42;

United States Trademark No. 5923712 for HELCIM YOUR TRUSTED PAYMENT PARTNER (figurative), registered on December 3, 2019 in International Classes 9, 16, 35, 36, and 42; and

United States Trademark No. 5923713 for HELCIM YOUR TRUSTED PAYMENT PARTNER (figurative), registered on December 3, 2019 in International Classes 9, 16, 35, 36, and 42.

The disputed domain names were registered on the following dates:

<helcim-login.com> on August 31, 2022;

<helcim-merchant.com> on September 28, 2022;

<helcim-personal.com> on September 22, 2022; and

<helcim-us.com> on September 27, 2022, all well after the Complainant secured rights to the trademarks listed above.

At the time of this Decision, the disputed domain names do not resolve to websites.

5. Parties' Contentions

A. Complainant

The Complainant asserts that each of the three elements specified in paragraph 4(a) of the Policy are present. The three elements being: (i) the disputed domain names are 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 names; and (iii) the disputed domain names have been registered and are being used in bad faith.

(i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The Complainant contends that the disputed domain names incorporate the Complainant's inherently distinctive element HELCIM, which is a coined word with no meaning in the English language, and add non-distinctive dictionary words after a hyphen, such as "login", "merchant", "personal", and "us". It claims that an average consumer, in this case likely a merchant, when presented with the words "Helcim" in combination with "login", "merchant", "personal", and "us", is undoubtedly going to presume that there is a connection between the disputed domain names and the Complainant's business. The Complainant concludes that the disputed domain names are identical or confusingly similar to its registered trademarks since the disputed domain names incorporate the entirety of its registered trademark HELCIM.

Furthermore, the Complainant asserts that the addition of the hyphenated terms "-login", "-merchant", "-personal", and "-us" in the disputed domain names do not prevent a finding of confusing similarity between the disputed domain names and its registered trademarks. In fact, the Complainant claims, UDRP panels have consistently held that where the relevant trademark is recognizable within the disputed domain name, the addition of the other terms, whether descriptive, geographical, pejorative, meaningless or otherwise, would not prevent a finding of confusing similarity under the first element. Moreover, the Complainant submits, it is well established in the domain name jurisprudence, that confusing similarity is established without regard to the addition of ordinary dictionary words.

Finally, the Complainant points to the timing of the registration of the disputed domain names. The disputed domain names were all registered recently, more than 15 years after the Complainant established its online presence and business using its abovementioned trademarks.

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

The Complainant contends that the Respondent is not commonly known by the disputed domain names and the Respondent has no association whatsoever with the Complainant's business. The contact details for the Respondent do not correspond to any company or entity that has any rights to the Complainant's trademarks. Furthermore, the Complainant asserts that there is no legitimate business being carried on at the disputed domain names and none of the disputed domain names are currently being used. The Complainant shows that one of the disputed domain names previously resolved to a website for a "NOLA Brasserie", but this is no longer the case. Finally, the Complainant submits that the passive holding of the disputed domain names does not establish rights or legitimate interests in these disputed domain names.

(iii) the disputed domain names have been registered and are being used in bad faith

The Complainant contends that the disputed domain names have been registered and are being used in bad faith. In support of this, the Complainant submits that the Respondent does not have any connection to the disputed domain names, which are also only passively held. According to the Complainant, the Respondent also failed to respond to a demand letter requesting the transfer of the disputed domain names and this failure in combination with the lack of legitimate business interests further demonstrates that the Respondent's use of the disputed domain names is in bad faith. Furthermore, relying on the "passive holding doctrine", the Complainant asserts that the fact that disputed domain names are not being used does not prevent a finding of bad faith registration and use. Finally, the Complainant points to what it perceives as active steps of the Respondent's to conceal its identity as further indicators of bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant is required to establish: (1) that it owns rights in a trademark or service mark, and, if so, (2) that the disputed domain names are identical or confusingly similar to its trademarks.

Firstly, the Panel finds that the Complainant has clearly evidenced that it owns registered trademark rights to trademarks containing the word “helcim”. The registered trademarks that the Complainant relies on are figurative, however the dominant portion of these trademarks is the word “helcim”. It is a consensus view of UDRP panels, with which the Panel agrees, that trademark registrations with design elements can *prima facie* satisfy the requirement that a complainant shows “rights in a mark” (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.10) so long as the textual elements are not overtaken. Finally, it should be noted that paragraph 4(a)(i) of the Policy does not set minimum requirements as to the jurisdiction(s) of the trademarks a complainant relies on, nor as to the number, nature, or scope of protection of such trademark(s).

Secondly, the Panel finds that the disputed domain names are confusingly similar to the Complainant’s registered trademarks since they all incorporate the dominant portion of those trademarks, the word “helcim” (see [WIPO Overview 3.0](#), section 1.7, as well as *L’Oréal, Lancôme Parfums et Beauté & Cie v. Jack Yang*, WIPO Case No. [D2011-1627](#), *Rapidshare AG, Christian Schmid v. InvisibleRegistration.com, Domain Admin*, WIPO Case No. [D2010-1059](#), and *The Stanley Works and Stanley Logistics, Inc. v. Camp Creek Co., Inc.*, WIPO Case No. [D2000-0113](#)). The addition of, respectively, “-login”, “-merchant”, “-personal”, and “-us” in the disputed domain names does not prevent the Panel’s finding of confusing similarity under the first element. The word “helcim” is clearly recognizable within the disputed domain names and it is a well-established view of UDRP panels, with which the Panel agrees, that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see for instance: *Ansell Healthcare Products Inc. v. Australian Therapeutics Supplies Pty, Ltd.*, WIPO Case No. [D2001-0110](#); *Nintendo of America Inc. v. Fernando Sascha Gutierrez*, WIPO Case No. [D2009-0434](#); *M/s Daiwik Hotels Pvt. Ltd v. Senthil Kumaran S, Daiwik Resorts*, WIPO Case No. [D2015-1384](#); and *BHP Billiton Innovation Pty Ltd v. Oloyi*, WIPO Case No. [D2017-0284](#)).

Finally, as for the applicable Top Level Domain, *i.e.*, the suffix “.com”, the Panel holds that this can be disregarded under the first element confusing similarity test (*CANAL + FRANCE v. Franck Letourneau*, WIPO Case No. [DTV2010-0012](#); *Bentley Motors Limited v. Domain Admin / Kyle Rocheleau, Privacy Hero Inc.*, WIPO Case No. [D2014-1919](#); and *SAP SE v. Mohammed Aziz Sheikh, Sapteq Global Consulting Services*, WIPO Case No. [D2015-0565](#)).

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy non-exhaustively lists three circumstances that shall demonstrate rights or legitimate interests:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to you 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 (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 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.”

It is a well-established view of UDRP panels, with which the Panel agrees, that a *prima facie* case advanced by a complainant is generally sufficient to satisfy the requirements under paragraph 4(a)(ii) of the Policy, and the burden of production shifts to the respondent to provide relevant evidence demonstrating rights or legitimate interests in the disputed domain name (*AGUAS DE CABREIROA, S.A.U. v. Hello Domain*, WIPO Case No. [D2014-2087](#); *Spigen Korea Co., Ltd., Spigen Inc. v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. [D2016-0145](#); and *HubSpot, Inc. v. WhoisGuard Protected, WhoisGuard, Inc. / Steve Johnson*, WIPO Case No. [D2016-1338](#)).

The Panel notes that the Respondent has not responded to any of the Complainant’s contentions, let alone submitted evidence to the contrary, and that, pursuant to paragraph 14 of the Rules, the Panel may draw such inferences from the Respondent’s failure to respond, as it considers appropriate. In the present case, taking into consideration the Respondent’s default, this Panel finds that the Complainant has made out an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names, in view of the circumstances of this case, including the following factors.

The Panel agrees with the Complainant that there is no evidence that the Respondent is using the disputed domain names for a *bona fide* offering of goods or services, the fact that the disputed domain names do not currently resolve to active websites indeed supports this. In addition, there is no evidence that the Respondent is sponsored by or affiliated with the Complainant in any way or that the Complainant has licensed, authorized, or permitted the Respondent to register domain names incorporating the Complainant’s trademarks. The Panel has taken note of the Complainant’s confirmation in this regard and has not seen any evidence that would suggest the contrary. Finally, there is no evidence that the Respondent has been commonly known by the disputed domain names.

For all the foregoing reasons, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy non-exhaustively lists four circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

“(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 web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

The Panel finds that the circumstances and evidence presented by the Complainant offer sufficient proof that both the Respondent’s registration and current use of the disputed domain names are in bad faith.

The Panel will first discuss the Respondent's registration of the disputed domain names. The Panel believes that the Respondent knew or, at least, should have known at the time of registration that the disputed domain names included the Complainant's abovementioned registered trademarks. The disputed domain names were all registered very recently, while the Complainant registered its abovementioned trademarks years ago. In addition, all disputed domain names contain the word "helcim", which is the dominant portion of the Complainant's registered trademarks. The Respondent's knowledge of the Complainant's registered trademarks may already be inferred from these circumstances (*SembCorp Industries Limited v. Hu Huan Xin*, WIPO Case No. [D2001-1092](#), and *American Funds Distributors, Inc. v. Domain Administration Limited*, WIPO Case No. [D2007-0950](#)).

Regarding the use of the disputed domain names, the Complainant points to the Respondent's failure to respond to the Complainant's demand letters requesting the transfer of the disputed domain names as an indicator of bad faith use. However, since these letters were sent to the Registrar and it is unclear from the facts and evidence presented whether the letters actually reached the Respondent, the Panel is not convinced that this fact alone can support a finding of bad faith use of the disputed domain names. Nevertheless, the fact that the Respondent failed to submit a response to the Complaint supports an inference of bad faith, which has not been refuted by the Respondent. In addition, the Panel agrees with the Complainant that the fact that the disputed domain names are not used does not prevent a finding of bad faith. It is a well-established view of UDRP panels, including in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), and *Jupiters Limited v. Aaron Hall*, WIPO Case No. [D2000-0574](#), that the non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding. Finally, the Panel agrees with the Complainant that there is also no evidence of any actual or intended use of the disputed domain names in good faith.

In light of the above, the Panel finds that the disputed domain names were registered and are being used by the Respondent 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 names, <helcim-login.com>, <helcim-merchant.com>, <helcim-personal.com>, and <helcim-us.com>, be transferred to the Complainant.

/Benoit Van Asbroeck/

Benoit Van Asbroeck

Sole Panelist

Date: December 16, 2022