

ADMINISTRATIVE PANEL DECISION

Fieldd Pty Ltd v. Jessica Duarte

Case No. D2022-4980

1. The Parties

Complainant is Fieldd Pty Ltd, United States of America (“United States”), represented by Wiley Rein LLP, United States.

Respondent is Jessica Duarte, United States, represented by Lewis & Lin, LLC, United States.

2. The Domain Name and Registrar

The disputed domain name <fieldd.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 23, 2022. On December 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 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 Complainant on December 29, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on January 3, 2023.

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 Respondent of the Complaint, and the proceedings commenced on January 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 30, 2023. The Response was filed with the Center on January 25, 2023.

On January 30, 2023, Complainant requested termination of the proceeding. On the same date, Respondent objected to the termination and requested that the matter proceed to a decision.

The Center appointed Ingrīda Kariņa-Bērziņa, Matthew S. Harris and Diane Cabell as panelists in this matter on February 23, 2023. The Panel finds that it was properly constituted. Each member of 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

Complainant is a start-up company offering software and services to facilitate bookings, dispatch, client communications, task automation, payment, tracking, and analytics to companies providing mobile services to consumers. It claims more than 127,000 end users in 20 countries. Complainant asserts unregistered trademark rights in the FIELDD sign, for which it has filed trademark applications in the United States and Australia on November 22, 2022, claiming use in commerce dating to November 12, 2019.

Complainant has registered several domains incorporating the “FIELDD” sign including <fieldd.com.au>, <fieldd.ca>, <fieldd.me> and others. It operates its primary business website at the domain name <fieldd.co>.

Respondent is a private individual residing in Austin, Texas. Previously, together with her wife, she was co-owner of a Texas company called Fieldd Software Services L.L.C.

The record reflects that the disputed domain name was purchased by Respondent in 2014. From 2014 to 2018, the registrant name was listed as Respondent, and the registrant organization was listed as Fieldd Software LLC. From 2018 to 2022, the registrant organization continued to be listed as Fieldd Software LLC and the registrant name was not visible. From June 2022, the registrant organization was listed as Domains By Proxy, LLC. The Whois record of December 2022 lists Respondent as the registrant.

The Parties dispute whether the disputed domain name was continuously controlled by Respondent since 2014, or whether there was a change in control.

At the time of this Decision, the disputed domain name resolved to a website stating that it is operated by “Fieldd Fence & Deck” and offers residential fence and deck construction services. This website was established by Respondent in late 2022. From 2014 to 2019, the disputed domain name hosted content related to Respondent’s earlier software business.

The record reflects that, prior to and following the filing of the Complaint, the Parties had engaged in unsuccessful negotiations for the purchase of the disputed domain name. In 2019, Complainant contacted Respondent seeking to purchase the disputed domain name. Respondent indicated that she would sell for \$9,500 USD. In 2020, Respondent listed the disputed domain for sale for \$32,500. From June through October 2022, Complainant contacted Respondent multiple times seeking to purchase the domain name. Complainant offered a purchase price \$2,000 USD, which Respondent did not accept. She subsequently removed the listing for the disputed domain name. On November 22, 2022, Complainant sent Respondent a demand letter requesting transfer of the disputed domain name. In January 2023, following the filing of the Complaint, Complainant requested that Respondent sell the disputed domain name for a reasonable price, such as \$100 USD.

The record also reflects that Complainant a civil complaint against Respondent in relation to the disputed domain name on January 30, 2023.

5. Parties' Contentions

A. Complainant

Complainant's contentions may be summarized as follows:

Under the first element, Complainant states that the disputed domain name, registered by the current registrant sometime between August 18 and November 23, 2022, is identical to Complainant's senior FIELDD mark.

Under the second element, Complainant states that Respondent's current use of the disputed domain name is mere pretense to cover up her bad faith registration of the domain name. The website at the disputed domain name lacks significant information necessary to function as a promotion of services, including no information regarding the fencing and decking services provided. Respondent operates another website for an entity called "The Boardwalk Home Services Co. L.L.C." which makes no mention of Fieldd Fence & Deck, the name that entity supposedly assumed. Respondent is undertaking elaborate efforts to feign use of the disputed domain name to avoid the consequences of cybersquatting and to conceal her effort to extort a sales price that exceeds Respondent's out-of-pocket expenses. Respondent is not commonly known by the disputed domain name. Complainant has not licensed or otherwise authorized Respondent to use its FIELDD mark.

Under the third element, Complainant states that bad faith is to be assessed not at the date of first registration, but at the date of latest registration. Fieldd Software was a legal entity owned jointly by Ms. Duarte and an individual named Paula Jones, and therefore the transfer of ownership from Fieldd Software to Ms. Duarte after August 18, 2022 constitutes a clear change in ownership and a new registration. Respondent registered and used the disputed domain name to leverage an inflated purchase price from the mark holder. Respondent was not using the disputed domain name when the Parties began negotiations for purchase of the disputed domain name. Respondent began pretextual use only after Complainant made Respondent aware that her actions constituted cybersquatting. Respondent used false contact information by concealing her identity by using a privacy registration service. Respondent was aware her actions were improper.

Complainant requests transfer of the disputed domain name.

B. Respondent

Respondent's arguments may be summarized as follows:

In response to the contentions made under the first element, Respondent does not deny that the disputed domain name is comprised of a term in which Complainant has rights. Respondent states that these rights were formed five years after Respondent registered the disputed domain name.

In response to the contentions made under the second element, Respondent states that she acquired the Domain Name in May 2014 because the word "field" corresponded with her career in various field service work and the double "d" consonant ending matched a trend in the software industry at the time. Respondent, together with her wife Paula Jones, established Fieldd Services Software LLC in the fall of 2014 and eventually had approximately 195 unique users. Respondent had registered her FIELDD Service Software trademark, which lapsed in 2021. Around 2017-2018, Respondent decided to dissolve the company but she continued to use the disputed domain name to warehouse data and information from the business, and to use a related email account. The fact that the disputed domain name at one point did not resolve to an active website does not of itself serve to extinguish the Respondent's otherwise lengthy interest in the disputed domain name. Complainant's assertions of a change in control are without a basis. The underlying registrant has always been Respondent, and Complainant has treated Respondent as the registrant of the disputed domain name by contacting her regarding its purchase over the course of two years.

In response to the contentions made under the third element, Respondent states that the disputed domain name was made available for sale to the general public on Afternic in 2020, two years before Respondent used a privacy service. Respondent has demonstrated an unbroken chain of ownership of the disputed domain name, which has not been transferred. Even if Respondent had transferred it to her company, Fieldd Software L.L.C. was a company controlled by Respondent. Respondent could not have registered the disputed domain name in bad faith when the registration predated Complainant's trademark rights by five years.

In August 2022, Respondent had started a home services company under the name "The Boardwalk Home Services Co., LLC." At that time, she registered the business alias "Fieldd Fence & Deck" as a business alias in the State of Texas and filed to register it as a United States trademark. Respondent has been involved in field services businesses since 1999, and her current business is real and not a sham as alleged by Complainant.

Due to Complainant's conduct, Respondent decided to no longer offer the disputed domain name for sale and instead put it into use. Respondent elected to use a privacy service in 2022 to protect her name and address from Complainant, who had over several years barraged Respondent with text messages to her personal phone number, visited her place of work, contacted her family and employees, and emailed her with demands. There is an unbroken chain of underlying ownership of the disputed domain name which predates Complainant's adoption of the FIELDD mark by five years. The use of a privacy service does not constitute a new registration. Respondent has used the disputed domain name as a descriptive term in connection with various field services. Respondent has never targeted Complainant. There is no basis for a finding of passive holding.

Respondent requests a finding of Reverse Domain-Name Hijacking for the following reasons. Complainant is represented by counsel specialized in domain name matters who should have known better than to file a complaint based on a false narrative. The Complaint deliberately appended a later Whois record, rather than the May 1, 2014 record that stated that Respondent had been the registrant of the disputed domain name. By improperly claiming that Respondent's use of the privacy service was a new registration, Complainant has attempted to seize the disputed domain name by force. Complainant has been frustrated in its efforts to purchase the disputed domain name from Respondent for amounts ranging from \$100 to \$2,000.

By sending another demand letter subsequent to the filing of the Complaint, Complainant suggests it does not wish for the Panel to rule.

6. Discussion and Findings

The decision that follows is that of a majority of the panelists in this case and references to findings of the "Panel" should be understood accordingly.

6.1. Procedural Issues

A. Complainant's Request for Termination of the Proceeding

On January 30, 2023, Complainant filed a request to terminate the proceeding due to the fact that, on that same date, Complainant had initiated civil proceedings for cybersquatting and trademark infringement against Respondent. Complainant appended a Supplemental Filing that will be discussed below, and a copy of the civil action to this request. On the same date, Respondent objected to the termination of the proceeding. Respondent stated that Complainant's objective was to avoid a decision of Reverse Domain-Name Hijacking in a UDRP proceeding, and that Respondent had been forced to spend significant sums in filing the Response. Therefore, Respondent requests that the Panel issue a Decision on the merits.

Paragraph 17(b) of the Rules provides that if, before the Panel's decision is made, it becomes unnecessary or impossible to continue the administrative proceeding for any reason, the Panel shall terminate the administrative proceeding, unless a Party raises justifiable grounds for objection within a period of time to be determined by the Panel.

Paragraph 18(a) of the Rules provides that in the event of any legal proceedings initiated prior to or during an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, the Panel shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or to proceed to a decision.

The request for withdrawal of the Complaint can be interpreted as if Complainant no longer wishes to receive a decision on the merits, which raises the question of whether it has now become unnecessary to continue the administrative proceeding.

In this case, Complainant, after receiving the Response but prior to Panel appointment, has requested that the proceeding be terminated. Respondent insists on the continuation of the proceeding and the issuance of a decision on the merits, and the Parties have not reached a settlement of their dispute.

Respondent promptly objected to termination of the proceeding on two grounds, namely that the Respondent seeks a decision on the merits to justify her expense and trouble in preparing a Response to what she views as an unfounded Complaint; and a finding under Paragraph 15(e) of the Rules.

The Panel considers these grounds for objection to be justifiable. Respondent had already been put to the time and expense of engaging legal representation before the Complainant requested to withdraw the Complaint. Termination of the proceeding would potentially leave the Complainant free to refile a complaint under the Policy whereas continuing the proceeding will give Respondent an opportunity to obtain findings regarding the merits of the Complaint and Respondent's request for consideration under paragraph 15(e) of the Rules. The Panel notes, in particular, that Complainant's post-Complaint demand letter and communications with Respondent indicate that Respondent would be at a disadvantage if a decision were not rendered. See, for example, *Türkiye'nin Otomobili Girişim Grubu Sanayi Ve Ticaret Anonim Şirketi v. The Office of George Gould*, WIPO Case No. [D2021-1949](#), *Intellect Design Arena Limited v. Moniker Privacy Services / David Wieland, iEstates.com, LLC*, WIPO Case No. [D2016-1349](#).

Therefore, the Panel declines to terminate this proceeding and will proceed to render its Decision on the merits. The Panel notes that, despite the initiation of litigation by Complainant, there exist no circumstances that would prevent this dispute from being resolved under the UDRP. See [WIPO Overview 3.0](#), section 4.14.6.

B. Admissibility of Complainant's Supplemental Filing

Paragraph 10 of the UDRP Rules vests the panel with the authority to determine the admissibility, relevance, materiality and weight of the evidence, and also to conduct the proceedings with due expedition.

Paragraph 12 of the UDRP Rules expressly provides that it is for the panel to request, in its sole discretion, any further statements or documents from the parties it may deem necessary to decide the case.

Unsolicited supplemental filings are generally discouraged, unless specifically requested by the panel. See [WIPO Overview 3.0](#), section 4.6.

The Panel has reviewed Complainant's unsolicited Supplemental Filings of January 30, 2023 (entitled "Notice of U.S. Federal Court Litigation and Request for Termination of Proceeding") and finds that it does not contain any new evidence or information necessary to the consideration of this matter.

As discussed above, the Panel has decided to issue a decision on the merits. Consistent with UDRP practice and mindful of its duty to render a decision expeditiously, the Panel does not find that there are any

exceptional circumstances that would require the admission of the Supplemental Filing, which reiterates the substance of the Complaint rather than introducing evidence not previously available to Complainant. Accordingly, the Panel notes Complainant's request to terminate the proceeding but will not further consider the substance of this Supplemental Filing nor refer it to Respondent for comment.

6.2 Substantive Issues

Paragraph 4(a) of the UDRP requires Complainant to make out all three of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) Respondent has registered and is using the disputed domain name in bad faith.

Under paragraph 15(a) of the Rules, "[a] Panel shall decide a complaint 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".

A. Identical or Confusingly Similar

As a threshold matter, the Panel must decide whether Complainant has standing to bring a UDRP action based on unregistered trademark rights.

The Panel notes that pending trademark applications would not by themselves establish trademark rights within the meaning of UDRP paragraph 4(a)(i). WIPO Overview of WIPO Panel Views on selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.1.4.

Based on the evidence presented, the Panel finds that Complainant has established its unregistered rights in the FIELDD mark. It has provided evidence that its mark has, through use, become a distinctive identifier, which consumers associate with Complainant's goods and services. The Panel finds that the mark does not consist solely of descriptive terms. The Panel finds that Complainant has provided evidence of use of this mark on its website, on apps and in publications that support its assertion of rights in the FIELDD mark as of the date of the Complaint. See [WIPO Overview 3.0](#), section 1.1.3.

Complainant thereby satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. In comparing the disputed domain name to Complainant's mark, the Panel finds they are identical. It is the consensus view of UDRP panels that, where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark. [WIPO Overview 3.0](#), section 1.7.

It is the well-established view of UDRP panels that a generic Top-Level Domain such as ".com" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#), section 1.11.1, and cases cited thereunder).

Accordingly, the Panel would be prepared to find that Complainant has established the first element under paragraph 4(a) of the Policy for standing purposes, but such a finding is not necessary here in light of the discussion on the third element below.

B. Rights or Legitimate Interests

In light of the finding on the third element below, the Panel need not come to a determination that Complainant has established the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(b), provides that for the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, 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 the respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the respondent has registered the disputed 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the respondent's website or location or of a product or service on the respondent's website or location. (Policy, paragraph 4(b)).

Complainant contends that Respondent acquired the disputed domain name on August 18, 2022, when Respondent became the sole and named registrant of the disputed domain name, because the previous registrant, Fieldd Software L.L.C., by that time had ceased to exist. Respondent acquired the disputed domain name in 2022 for the purpose of selling it to Complainant for valuable consideration in excess of Respondent's out-of-pocket costs directly related to the disputed domain name.

Respondent maintains that she has continuously controlled the disputed domain name since purchasing it on May 1, 2014, and that the changes since that time are only formal.

The Parties do not dispute that Claimant established trademark rights to its FIELDD mark in 2019.

It is well settled that transfer to a third party would amount to a new registration. The issue in this case is whether the circumstances support a finding of a new registration and, if so, at what date. See [WIPO Overview 3.0](#), section 3.9.

Complainant relies on several cases, such as *Certipost NV v. Virtual Point Inc.*, WIPO Case No. [D2008-1183](#). The Panel finds that the facts in that case may be distinguished from those the current case, namely, the respondent confirmed that a formal transfer had taken place between the private individual who had registered the domain name and a company he later established. In this case, Respondent denies that any transfer, formal or otherwise, has taken place.

Complainant also relies on *ehotel AG v. Network Technologies Polska Jasinski Lutoborski Sp.J.*, WIPO Case No. [D2009-0785](#). The Panel finds that the facts in that case are also distinct from the current case. In *ehotel AG* the named registrant was changed from a private individual to a company controlled by that private individual, with evidence that the change had been made because the respondent was attempting to distance itself from the bad-faith acts of that individual. The Panel does not find a similar fact pattern in this case.

Complainant cites *BMEzine.com, LLC. v. Gregory Ricks / Gee Whiz Domains Privacy Service*, WIPO Case No. [D2008-0882](#) for the proposition that a transfer from one privacy service to another is a new registration. Again, the facts in that case differ. In *BMEzine.com*, the respondent was found to have made this transfer to deliberately conceal his identity. There is no such contention here.

The Panel notes that the contact information (mailing address, e-mail address) remained unchanged from the time that Respondent acquired the disputed domain name in 2014 until the last pre-GDPR Whois record (dated in the record as April 9, 2017), supporting Respondent's claim of common control during that time period. See *Van der Graaf Inc. v. Privacydotlink Customer 3564326 / DUBAI DOMAINS*, WIPO Case No. [D2018-2236](#).

There is no allegation in the record that a formal transfer of rights took place at any time.

The conduct of Complainant demonstrates that Complainant at all times knew and believed Respondent to have been in control of the disputed domain name. The originally filed Complaint, while addressed to a privacy service, directly references Respondent Jessica Duarte. Complainant clearly thought that she was in control of the disputed domain name at that time also. See, for example, *Green Globe Limited v. Domains By Proxy, LLC / Green Globe LLC*, WIPO Case No. [D2020-1822](#).

Complainant has not shown that Respondent adopted the privacy shield in 2022 for any nefarious purpose. See, for example, *Breazy Inc. v. Domains by Proxy, LLC, DomainsByProxy.com / VR PRODUCTS I LLC*, WIPO Case No. [D2021-1486](#). See also [WIPO Overview 3.0](#), section 3.6.

Further, the Panel does not find that adopting a privacy shield in and of itself formed a new registration that would substantiate a finding of bad faith. See also *Angelica Fuentes Téllez v. Domains by Proxy, LLC / Angela Brink*, WIPO Case No. [D2014-1860](#).

Complainant maintains that Respondent effected a new registration in 2022 for the purpose of selling it to Complainant at a profit. The problem with that argument is that the Parties do not contest that the disputed domain name was made available for sale by Respondent on Afternic already from 2020, two years prior to the alleged break in control and new registration.

Complainant has not brought forth evidence that there was any break in the ownership continually held by the same named organization from 2014 to mid-2022. There is no allegation that the registration of the disputed domain name had lapsed during that time. The Panel does not find the dissolution of the Fieldd Software Service L.L.C. entity in 2017 extinguished domain name rights. See *SHL Medical AG v. Jacobus Petrus Elisabeth Antonius Swalen and Jacques Swalen, SHL Technologies*, WIPO Case No. [D2020-2333](#). The fact that the domain name registration persisted following the dissolution of the entity supports Respondent's contention that she, and not the organization, was the actual registrant.

The Panel does not find that Respondent's establishment of a new website at the disputed domain name in 2022 is indicative of bad faith. Respondent had operated websites at that domain name from 2014 to 2018. Having held the disputed domain name for a number of years, it does not seem improbable that she would use it for a new business in a sector (deck and fence construction) related to her previous business and remote from Complainant's business of offering software to mobile service companies.

Even if the domain-name registration were considered to have been made anew in 2022, the Panel notes that Respondent's previous trademark registration for FIELD SOFTWARE SERVICE (in force until 2021) and previous registration and good-faith use of the <fieldd.com> domain name are plausible reasons for her to have later registered that domain name.

The Panel finds that Respondent's 2022 website makes no reference to Complainant or its mark. There is no evidence available to suggest that Respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the respondent's website or

location or of a product or service on the respondent's website or location. There is evidence that Respondent used the domain name in connection with its dictionary meaning in connection with "field services," which the Parties both use as a term referring to services offered to customers at their place of residence or business.

The Panel notes Respondent at no point contacted the Complainant to offer the disputed domain name for sale. Rather, beginning in 2020, Complainant repeatedly urged Respondent to sell it the domain name.

In the view of the Panel, the facts of this case indicate that Complainant greatly desired to acquire the disputed domain name, but for a price less than Respondent wished to receive for it. In a November 2022 text message, Complainant stated as much, writing: "If I had the money I'd pay you. But we don't." In these circumstances, the Panel is unable to find that Respondent registered and used the disputed domain name in bad faith.

Accordingly, the Panel finds that Complainant has not established the third element under paragraph 4(a) of the Policy.

7. Reverse Domain-Name Hijacking ("RDNH")

Paragraph 15(e) of the Rules provides that, "[i]f after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at RDNH or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding". It is the Panel obligation to consider whether a finding of RDNH should be made even in the absence of a request from the Respondent. Further, mere lack of success of a complaint is not in itself sufficient for a finding of RDNH.

On the available evidence, and where the Panel relies on a majority decision regarding the termination of the proceeding, the Panel is unable to conclude that Complainant would have known from the start that it was bound to lose, or that the Complaint was brought primarily to harass the domain-name holder. See [WIPO Overview 3.0](#), section 4.16.

As such, the Panel does not find that the Complaint was brought in bad faith.

8. Decision

For the foregoing reasons, the Complaint is denied.

/Ingrīda Kariņa-Bērziņa/
Ingrīda Kariņa-Bērziņa
Presiding Panelist

/Matthew S. Harris/
Matthew S. Harris
Panelist

/Diane Cabell/
Diane Cabell
Panelist
Date: March 22, 2023

Dissent of Matthew S. Harris

I have reached the conclusion that it is necessary for me to issue a formal dissent in this case. It is formal in the sense that, as I will explain, I express no concluded view as to whether the Complaint should or should not succeed. Instead, I respectfully disagree with the conclusion of my fellow panelists as to whether to accede to the Complainant's request that the proceedings be terminated in light of parallel proceedings taking place in the US courts.

Whether there is a substantive dismissal of the Complaint (as my fellow panelist have held should occur) or there is termination of these proceedings in favour of the US courts, will probably be of no practical consequence. The court will not in any way be bound by the determination of the Panel either way.

What is and what is not disputed in this case

Many of the key factual issues in this case appear to be undisputed. In particular, so far as the registration details for the disputed domain name (the "Domain Name") are concerned, the position appears to be as follows:

- (a) On initial registration the "Registrant Name" and "Registrant Organization" was recorded as "Jessica Duarte"
- (b) In around May 2014 the "Registrant Organization" changed to "Fieldd Software L.L.C"
- (c) As late as March 2022, although some registration details were masked, the Registrant Organization remained "Fieldd Software L.L.C" (see page 18 of Annex 3 to the Response)
- (d) In or about June 2022, the Respondent masked all registration details behind what it calls a privacy service (but what is probably technically a proxy service); *i.e.*, "Domains By Proxy LLC"
- (e) At some point between then and the commencement of the proceedings the details for "Registrant Organization" were completely removed.

It, therefore, appears to be clear that at all times the Respondent, Ms Duarte, was recorded as the underlying "Registrant Name" for the Domain Name. It is also essentially undisputed that the Domain Name has been under the *de facto* control of the Respondent Ms Duarte.

What is in the present dispute, are the consequences of the fact that the "Registrant Organization" details for the Domain Name have changed. The Complainant contends that as a consequence there has been a fresh registration and also relies upon in this respect the fact that in or about December 2017 Fieldd Software LLC, was wound up and thereby ceased to exist. The Respondent, in contrast effectively contends that there has been no fresh registration and that at all relevant times Ms Duarte has been the real registrant.

Why does whether there was a fresh registration matter?

The reason why whether and when there were fresh registrations in this case is of potential importance, arises out of the requirement that a complainant must show in UDRP proceedings that there has been bad faith registration and bad faith use.

If the domain name was not registered bad faith, the complaint will fail even if it can be shown that the domain name was subsequently used in bad faith. This is so no matter how egregious that subsequent bad faith use may be. To some, this can lead to unfair results. As a consequence, a number of domain name dispute resolution processes modelled on the UDRP have changed this aspect of the UDRP and have instead required mere demonstration of bad faith registration or bad faith use (see, for example, the Dispute

Resolution Service for .AU domain names). There were also a number of decisions in or around 2009 and 2010 that suggested that bad faith use alone was sufficient under the UDRP, but that reasoning has not been followed in subsequent cases; see section 3.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "[WIPO Overview 3.0](#)"). It is, therefore, now clear beyond any doubt that to succeed under the UDRP both bad faith registration and use must be shown.

However, if there has been a change of registrant in respect of a domain name, that may constitute a fresh registration for the purposes of the UDRP. In such a case the clock is potentially reset when it comes to the assessment of whether a registration was in bad faith.

The Complainant essentially contends that there has been just such a resetting of the clock in this case and at that time the Domain Name was re-registered, thus was done with the intention of taking unfair advantage of the Complainant's trade mark rights.

What constitutes a fresh registration?

Where a domain name is transferred between unconnected third parties there is clearly a fresh registration. However, section 3.9 of the [WIPO Overview 3.0](#) states;

"Where the respondent provides satisfactory evidence of an unbroken chain of possession, panels typically would not treat merely "formal" changes or updates to registrant contact information as a new registration."

The language used here carries with it a number of other questions. What is meant by "an unbroken chain of possession" and a mere "formal" change? A change in registration details to record a change in company name where the same legal entity owned the registration, is obviously a mere "formal" change. But what if the old and new registrants are separate, but related, legal entities and the domain name remains under the *de facto* control of the same person or entity?

This was the question that was faced by this panelist in *ehotel AG v. Network Technologies Polska Jasinski Lutoborski Sp.J.*, WIPO Case No. [D2009-0785](#), a case relied upon by the Complainant in this case. In the *ehotel AG* case the named registrant was changed from a private individual, Mr. Lutoborski, to a company controlled by that same private individual and I held that there was a fresh registration. In so doing I stated as follows;

"6.20 [A]s the Complainant correctly states, where a domain name is transferred from one entity to another entity then this can be treated as a fresh "registration" for the purposes of the Policy. In such a case bad faith can be assessed at the date of that transfer rather than as at the date of initial registration. The Complainant cites a number of cases in support of that proposition, but it has also long been recorded as a "consensus view" at paragraph 3.7 of the "[WIPO Overview of WIPO Panel Views on Selected UDRP Questions](#)".

*6.21 Here although there has been a change to the listed registrant of record, there appears to have been no change in control over the Domain Name. Does this latter factor make a difference in the circumstances of the present case? In the opinion of the Panel it does not. Not all changes in registration details necessarily involve transfers and re-registrations for the purposes of the Policy. Examples might be where a registrant seeks to correct a typographical error in its name, or a company changes its name and changes the register to reflect that change. There may be other examples (see the discussion of the consequences of company "mergers" in *Aubert International SAS and Aubert France SA v. Tucows.com Co.*, [WIPO Case No. D2008-1986](#)). However, where there has been a change in registration details from one legal entity to another, then in the opinion of the Panel there will typically be a fresh registration. A transfer into the hands of an agent or proxy may still be a transfer and re-registration for the purposes of the Policy, even if that agent holds the domain name on the instructions of the original registrant. Therefore, whatever the arrangement between Mr. Lutoborski and the*

Respondent, and notwithstanding Mr. Lutoborski's apparent involvement in the Respondent's company, the Panel finds that there has been a fresh registration in this case.

6.22 Such an approach may mean that a domain name owner who transfers a domain name to another legal entity as evident from the Whois risks losing a domain name that may once have been legitimately acquired but is now being used in bad faith even where there is no change in underlying control. However, the Panel is unconvinced that this provides a good reason for interpreting the concept of registration under the Policy more restrictively. If at the time of transfer of the domain name the owner is using and intends to continue to use the domain name in good faith, then he will have nothing to fear. Second, it is questionable whether the Policy should be that indulgent to those who decide to use registration details that do not properly reflect or disguise (whether before or after a transfer) the true owner of that domain name.”

A similar transfer between connected parties (in that case a Mr Lohoti and a company he controlled_ was also held to be a fresh registration for similar reasons in *Certipost NV v. Virtual Point Inc.* WIPO Case No. [D2008-1183](#). In that case the UDRP panel stated:

“The Respondent argues for a “substance over form” approach, under which the 2008 transfer from Mr. Lahoti to his company should be effectively ignored, as merely a rearrangement of Mr. Lahoti’s business affairs. The Panel rejects that approach. First, the Respondent is a separate legal entity from Mr. Lahoti – it may, now or in the future, be subject to control by others. Secondly, in circumstances where there appears to have been bad faith use of a disputed domain name by a party who had earlier registered that domain name in good faith (as appears to have been the position in this case prior to the transfer of the Domain Name to the Respondent), the Panel sees no injustice in the “internal” transfer of the Domain Name within the wider business group, producing the “side effect” of giving the third party trade mark owner who has been subjected to the bad faith use, an opportunity to invoke the Policy which it would not otherwise have had (because it could not show that the original registration of the disputed domain name had been made in bad faith).”

That said, not all UDRP panels have adopted the same approach. For example, in *Mirza Juddani v. CDN Properties Incorporated* *CDN Properties Incorporated* WIPO Case No. [D2014-1354](#), the UDRP panel disregarded a transfer from an individual to a Panamanian company controlled by that individual.

Similarly in *Van der Graaf Inc. v. Privacydotlink Customer 3564326 / DUBAI DOMAINS*, WIPO Case No. [D2018-2236](#) was a case where the domain name in issue appears to have been registered first in the name of a company controlled by an individual and then was changed into the trading name of that individual. In that case the distinguished three-person panel stated as follows:

“As summarized in section 3.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), where the respondent provides satisfactory evidence of an unbroken chain of possession of the disputed domain name, panels typically would not treat formal changes or updates to registrant contact information as a new registration. In view of this, the Panel is prepared to accept that the disputed domain name came under the control of the Respondent or of the entity controlling the Respondent on December 22, 2017, and that the changes in the registrant contact information in respect of the disputed domain name that were made after that date did not reflect a transfer of control to an unrelated entity and should not be regarded as a new registration.”

It, therefore, would appear that the UDRP panel in both the *Mirza Juddani* and *Van der Graaf Inc* cases concluded that what mattered was *de facto* control. However, why this was considered determinative was not really explained, and it is hard to understand why this is the correct approach. There are frequent occasions where an asset or assets are transferred from one legal entity or person to another but they remain under the same *de facto* control. Nevertheless, that change in ownership between distinct legal entities can, and often will have very significant legal consequences, whether that be under the law of

insolvency or otherwise. This is so even if the transfer is, for example, between different companies in the same corporate group.

My fellow panelists have suggested that a number of past UDRP decisions in this respect can be understood as holding that there was a fresh registration notwithstanding the fact that the domain name remained under the control of the same person, where the transfer was made to conceal the Respondent's identity or escape the consequences of their wrongdoing. This is consistent with the wording to be found paragraph 3.7 of the second edition of the WIPO Overview¹. It is also one potential reading of the decision in *BMEzine.com, LLC v. Gregory Ricks / Gee Whiz Domains Privacy Service*, WIPO Case No. [D2008-0882](#).

In the *BMEzine.com, LLC* case the UDRP panel referred to the "ordinary rule" that a change in registrant involved a fresh registration and held that this ordinary rule applied where there was a transfer between "privacy services", but also stated that there "might" be cases where the "ordinary rule" did not apply. Then (at footnote 7 in that decision) the Panel stated:

"A panel might ignore a transfer from one subsidiary to another within a conglomerate not timed coincidentally or otherwise with an event pertinent to the matters claimed to constitute bad faith, for example."

However, I would respectfully suggest that the reason why many transfers between subsidiaries "unconnected with the alleged matters claimed to constitute bad faith" can be "ignored" is not because there has been no fresh registration. It is simply that such a transfer, if undertaken for reasons that are unconnected with the complainant and the complainant's marks, is unlikely to be a registration in bad faith.

Similarly, in *BD Hotels, LLC v. POD Hotels Ltd* WIPO Case No. [D2016-0997](#), the UDRP panel concluded that a transfer between connected entities did not amount to a new registration, but that was expressed to be because there was no "some supervening evidence of bad faith intent".

The use of privacy services, particularly those used and controlled by registrars, also carries with it its own problems and questions. In the *ehotel AG* case, I suggested that the transfer into the name of an agent or proxy would be a change in registration. However, notwithstanding this and the statement about the "ordinary rule" in the *Van der Graaf Inc* case, there are strong arguments that where the Whols record for the domain name records the name of a privacy service operated by a registrar the position is indeed somewhat different. In such a case the privacy service effectively shields the name of the true registrant from the public but the real underlying registration details are still held by the privacy service. So, for example, in *Angelica Fuentes Téllez v. Domains by Proxy, LLC / Angela Brink*, WIPO Case No. [D2014-1860](#), where the respondent had transferred the domain name in issue into the name of a privacy service but remained the "underlying registrant", that transfer was ignored by the Panel. But if this is correct, conversely it follows that a change in registration details behind the privacy shield could still be a fresh registration for the purposes of the Policy.

This concept of an underlying masked true register is also consistent with the statement also be found in section 3.9 of the WIPO 3.0 that where a privacy service is being used "and the complainant credibly alleges that a relevant change in registration has occurred, it would be incumbent on the respondent to provide satisfactory evidence of an unbroken chain of registration".

Pulling this all together, I would suggest the correct approach is as follows;

- (i) A change in registration details where the same person or legal entity remains the registrant (for example, where a company has changed its name) is not a fresh registration for the purposes of

¹ "Panels have tended to the view that formal changes in registration data are not necessarily deemed to constitute a new registration where evidence clearly establishes an unbroken chain of underlying ownership by a single entity or within a genuine conglomerate, and it is clear that any change in Whols registrant data is not being made to conceal an underlying owner's identity for the purpose of frustrating assessment of liability in relation to registration or use of the domain name."

the Policy. This is a mere formal change or update as referred to in section 3.9 of the [WIPO Overview 3.0](#).

- (ii) A transfer of a domain name between connected persons if they are separate legal entities will be a fresh transfer for the purposes of the Policy even if the domain name remains under the same *de facto* control. However, whether there is registration in bad faith at that time, still needs to be separately assessed and will depend upon the particular facts of the case. If there are good reasons for the transfer that are unconnected with the complainant or the complainant's rights, this re-registration is unlikely to be in bad faith.
- (iii) Where a domain name is registered in the name of a registrar's privacy service, the mere use of such a service without any change in the underlying registrant will not normally result in their being a fresh registration. The position may be different if the change in registration is being used to disguise the identity of the registrant
- (iv) However, a change in the details of the registrant behind a privacy shield may will amount to a fresh registration. In such a case, points (i) and (ii) will equally apply.

Preliminary application of this analysis to the facts of the current case

If the above analysis as to what is a fresh registration for the purposes of the Policy is correct, it follows that there is at least a strong arguable case that there was a relevant change of registrant in this case. At all material times Ms Duarte was recorded either openly or behind a "privacy shield" as the "Registrant Name" for the Domain Name, but the "Registrant Organization" has clearly changed. When read as a whole the most sensible reading of that data is that although Ms Duarte was initially the registrant of the Domain Name, the registrant changed to Fieldd Software L.L.C in about May 2014 and then at some time between June 2022 and the commencement of these proceedings, it changed back to Ms Duarte. However, exactly when this change back into the name of Ms Duarte occurred is not clear since it happened behind a privacy service.

It is not claimed that the registration of the Domain Name by Fieldd Software L.L.C in about May 2014 was in bad faith. It was clearly not. But the registration back into the name of Ms Duarte some time after June 2022 is potentially different and the exact timing of that change in registration details is potentially important.

Why this is so arises out of the fact that in the opinion of this panelist, there is also at least a strong arguable case that from at least late November 2022 the use made by the Respondent of the Domain Name in connection with an alleged "Fieldd Fence & Deck" has been pretextual. There are a number of reasons for this.

First, there is the timing of that use, *i.e.* it commenced almost immediately after communications between the Complainant and the Respondent and in particular correspondence from the Complainant to the Respondent on November 18 2022 in which the Complainant accused the Respondent of cybersquatting. There is no evidence before the Panel of an intention to use the Domain Name in that manner prior to that date. My fellow panelists refer to the establishment of a company called The Boardwalk Home Services Co., LLC which registered the alias "Fieldd Fence & Deck" in November 2022. The Boardwalk Home Services Co., LLC does appear to date back to August 2022, but the date that the "Fieldd Fence & Deck" name was registered was November 19, 2022. This does not amount to demonstrable preparation to use the Domain Name or a name corresponding to the Domain Name "before any notice to [the Respondent] of the dispute" as set out in paragraph 4(b)(c) of the Policy. Second, the content of the website that first appeared from the Domain Name appears hurried and incomplete. Third, the use of the name "Fieldd" in the name "Fieldd Fence & Deck" is not really explained. The Response contends that this name was chosen because "The company [*i.e.* Boardwalk Home Services Co., LLC] offers a wide variety of field services", but there is no real explanation of why "Fieldd" with two "d's" was chosen in place of the word "field". Absent that explanation, the contention comes across as inherently contrived.

It, therefore, seems to me highly likely that what really happened here is that the “Field Fence & Deck” business was in reality set up in response to negotiations between the parties as to the sale of the Domain Name and with a view not to actually use by any business but with the intention of extracting the maximum price from the Complainant for the Domain Name because of its association with the Complainant’s marks. That is potentially use in bad faith.

However, even if this were correct, it does not necessarily follow that the Domain Name was registered by Ms Duarte in bad faith. That is likely to depend upon a number of factors, including when the Domain Name was effectively re-registered in the name of Ms Duane and what exactly were Ms Duarte’s intentions when that re-registration took place. Potentially relevant related questions here are who was entitled to claim the registration when Field Software L.L.C was wound up in December 2017 and when and in what circumstances did Ms Duarte decide to put the Domain Name up for sale.

In short, no matter how disapproving one might be as to the Respondent’s conduct in setting up a pre-textual website, if the Complainant cannot show bad faith registration of the Domain Name, this complaint under the UDRP would fail.

The impact of the US litigation

As is alluded to in the majority decision, the Complainant has commenced U.S. federal court proceedings against the Respondent alleging cybersquatting under the Federal Anti-Cybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d), and trade mark infringement under the Lanham Act, 15 U.S.C. Those proceedings have been commenced in the United States District Court for the Western District of Texas and appear to have been filed on January 30, 2023; *i.e.* after these UDRP proceedings were commenced and less than week after the Response was filed.

The Panel were notified of these court proceedings in an additional submission, large sections of which contained an attempted rebuttal of arguments and contentions put forward by the Respondent in her Response. However, regardless of whether those submissions are ones which the Panel should take into account, the Complainant was required to inform the Panel of those court proceedings under paragraph 18(b) of the Rules.

Paragraph 18(a) of the Rules states:

“In the event of any legal proceedings initiated prior to or during an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, the Panel shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or to proceed to a decision”

The Complainant has requested that the proceedings be terminated pursuant to this provision asserting that given the Respondent’s contentions in the UDRP proceedings this matter is better dealt with in court which has the benefit of “the exchange of discovery, examination of witnesses, presentation of reply arguments, and examination and cross examination of live witnesses, all of which are unavailable in a proceeding under the UDRP.” (citing *Weber-Stephen Prods. Co. v. Armitage Hardware*, WIPO Case [D2000-0187](#)).

UDRP panels are often reluctant to accede to requests to stay or dismiss proceedings pending determination of litigation and/or claims that the competing claims are too complicated for the UDRP and should be left to the courts, notwithstanding that court proceedings (at least in common law jurisdictions) have the associated advantages of discovery and cross examination. This is particularly so in cases where those proceedings have been commenced in a court after the commencement of UDRP proceedings and where the jurisdiction in which those proceedings have been commenced is only convenient to one of the parties. Such claims can all too often be used by one party in an attempt to frustrate ongoing UDRP proceedings when that party thinks there is a chance the case may be decided against it.

Nevertheless, there are UDRP cases where it is indeed appropriate to leave matters to the courts. As was stated by a three person panel (but which included this panelist) in *Ritzio Purchase Limited v. Domain Admin, PrivacyProtect.org et al* WIPO Case [D2015-0875](#):

"[...], it does not follow simply from the fact of the existence of parallel proceedings that a Panel should refuse to consider the substance of the Complaint. Instead the Panel believes that the correct approach is to examine each of the requisite elements of the Policy in turn. In the context of that examination it may become apparent that there is a substantive factual dispute between the parties that cannot be resolved under the Policy and/or is being addressed and/or can be better determined in another forum. Only at this stage does the question raise its head whether the Panel should decline to consider that issue further."

Having reviewed the Complaint filed by the Complainant in the US court proceedings, it appears that many of the substantive disputes between the parties in these UDRP proceedings are indeed replicated in the US proceedings, including the circumstances surrounding the registration of the Domain Name in the name of the Respondent and the Respondent's motives when doing so. Both the Complainant and the Respondent in these UDRP proceedings are also located in Texas and this is where the court proceedings have been commenced.

In the opinion of this panelist it is, therefore, preferable that these be left to be determined by the US court, and that a decision by the Panel in this respect one way or another, which would not be binding on that court, would serve no useful purpose. Accordingly, this panelist would exercise its discretion under Paragraph 18(a) of the Rules to terminate these UDRP proceedings in accordance with the Complainant's request.