

## **ADMINISTRATIVE PANEL DECISION**

Maxon Computer Inc. v. Gean Fabio

Case No. D2023-2435

### **1. The Parties**

The Complainant is Maxon Computer Inc., United States of America (“United States or U.S.”), represented by DLA Piper US LLP, United States.

The Respondent is Gean Fabio, Brazil.

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

The disputed domain names <pluraleyes4.com> and <pluralsynchronizer.com> are registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 6, 2023. On June 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 6, 2023, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 8, 2023, 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 13, 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 the Respondent of the Complaint, and the proceedings commenced on June 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 11, 2023.

The Center appointed Peter Burgstaller as the sole panelist in this matter on July 28, 2023. 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 part of the “Maxom Group” which provides software solutions for content creators, including for animation, visual effects, 2d and 3d modeling, and motion graphics as well as for synchronizing audio and video recordings.

The Complainant is the owner of the registered trademark PLURALEYES, registered in the U.S., Registration No. 3847789, registered September 14, 2010 as well as in China, Registration No. 3847789, registered September 14, 2016, in the international class 9.

The disputed domain name <pluraleyes4.com> was registered on February 18, 2022, and the disputed domain name <pluralsynchronizer.com> was registered on June 17, 2022 (Annex 1 to the Complaint).

The disputed domain names were used to address websites, very similar to the Complainant’s website, offering the Complainant’s software PLURALEYES for sale (Annexes 6 and 7 to the Complaint); currently the disputed domain names do not resolve to active websites.

A takedown request on behalf of the Complainant was sent to the Respondent on July 6, 2022, and a follow up on July 12, 2022; the Respondent did not respond (Annex 8 to the Complaint).

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant is a subsidiary of Maxon Computer GmbH, headquartered in Germany. The Complainant provides, together with Maxon Computer GmbH and another United Kingdom subsidiary (together “Maxon Group”) software solutions for content creators, including for animation, visual effects, 2d and 3d modeling, and motion graphics as well as for synchronizing audio and video recordings. These software products are well known and have received many prestigious industry awards over the years.

In 2020, Red Giant, LLC merged into Maxon Computer GmbH. Through this merger, the Maxon Group acquired the PLURALEYES trademark and associated software designed to assist editors, visual effects artists and motion designers. These software tools are staples in the film, broadcast, and advertising industries. The PLURALEYES software has been sold as part of the Maxon Group’s product which enables users to sync video and audio. The PLURALEYES software is advertised at the Maxon Group’s website.

The Complainant became aware of the disputed domain names, when customers contacted the Complainant’s customer support team to report that by using the disputed domain names the Respondent deceives visitors by luring them to purchase counterfeit PLURALEYES software which they believed to be legitimate PLURALEYES software at the time of purchase.

The websites under the disputed domain names prominently feature the Complainant’s PLURALEYES mark alongside the Complainant’s copyright protected text and visual content, and suggest that visitors of the website can purchase licenses and download the Complainant’s PLURALEYES software from the websites.

The disputed domain names are confusingly similar to the Complainant’s registered trademarks PLURALEYES, registered in the U.S., Registration No. 3847789, registered September 14, 2010 as well as in China, Registration No. 3847789, registered September 14, 2016, in the international class 9.

In addition to its trademark registration, the Complainant owns common law rights and the related goodwill to its PLURALEYES mark; the Complainant has been using the PLURALEYES name and mark in connection with its computer software for synchronizing audio and video recordings since at least as early as May 2009.

The addition of the suffix “4” to the PLURALEYES mark as well as the descriptive term “synchronizer” to the dominant term PLURAL cannot avoid the confusing similarity with the Complainant’s mark PLURALEYES.

The Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent has no relationship with the Complainant and no authorization to use the PLURALEYES mark, to appropriate the disputed domain names, or to otherwise associate itself and its infringing software content with the Complainant. The Respondent is not affiliated with the Complainant or the PLURALEYES mark in any manner. It has not filed any applications for registration of PLURALEYES in any trademark offices or jurisdictions worldwide and is not commonly known by the disputed domain names. Further, the Respondent is using the disputed domain names to attract Internet users seeking legitimate information about the Complainant and/or seeking to purchase the Complainant’s PLURALEYES software.

Moreover, the disputed domain names were registered and are being used in bad faith: The Respondent uses the disputed domain names to attract Internet users to its website for the purposes of marketing and selling infringing PLURALEYES software. An Investigator (test purchaser organized by the Complainant) purchased the PLURALEYES license to be used on one computer for 12 months for \$197.00 from the disputed domain name <pluraleyes4.com>; the Complainant accessed and analyzed the software and it turned out that it was an identical copy of the Complainant’s software, sold without authorization.

The Respondent must also have been aware of the Complainant’s PLURALEYES mark when registering the disputed domain names, since the disputed domain name <pluraleyes4.com> comprises the entirety of the PLURALEYES mark and the disputed domain name <pluralsynchronizer.com> uses a term which refers to a function of the Complainant’s software.

The Complainant has also engaged an anti-piracy take-down provider, which sent a takedown request to the contact listed on the websites under the disputed domain names: [...]@gmail.com on July 6, 2022, and a follow up communication on July 12, 2022. The Respondent did not answer.

Finally, the Respondent is using the disputed domain names to market and sell software that copies the Complainant’s source code, its user interfaces, and its trademarks without authorization, and to mislead consumers into believing the Respondent is authorized by and/or affiliated with the Complainant. This constitutes bad faith under the Policy.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in 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**

It is well accepted that the first element functions primarily as a standing requirement. 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 domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Complainant submitted evidence, which clearly establishes rights in the mark PLURALEYES.

In the present case, the disputed domain name <pluraleyes4.com> is confusingly similar with the Complainant's mark PLURALEYES because it comprises the Complainant's mark in its entirety and only adds the number "4" which cannot prevent a finding of confusing similarity under the first element of the Policy.

Regarding the identity or confusing similarity of the disputed domain name <pluralsynchronizer.com> the Panel finds, that although the identity or confusing similarity test is, as mentioned above, a side-by-side comparison of the disputed domain name and the Complainant's trademark, in specific limited instances, where a panel would benefit from affirmation as to confusingly similarity with the complainant's mark, the broader case context such as website content trading off the complainant's reputation, or a pattern of multiple respondent domain names targeting the complainant's mark within the same proceeding, may support a finding of confusing similarity (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition "[WIPO Overview 3.0](#)"). This is the case at hand, which is why the Panel concludes that the disputed domain name <pluralsynchronizer.com> is confusingly similar with the Complainant's PLURALEYES mark.

Finally, it has also long been held that Top-Level-Domains are generally disregarded when evaluating the confusing similarity of a disputed domain name.

Therefore, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

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

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is 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 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 (see section 2.1 of the [WIPO Overview 3.0](#)).

The Complainant's contentions that the Respondent has no rights or legitimate interests in the disputed domain names, that the Respondent has no connection or affiliation with the Complainant, and the Respondent has not received any license or consent, express or implied, to use the Complainant's trademarks in a domain name or in any other manner, as well as the Respondent not having rebutted these allegations, lead the Panel to the conclusion that the Complainant has made out an undisputed *prima facie* case so that the conditions set out in paragraph 4(a)(ii) of the Policy have been met by the Complainant.

This finding is also supported by the fact that the Respondent's use of the disputed domain names as shown in the screenshots submitted as Annex 6 to the Complaint, does not meet the requirements for a reseller or distributor to be making a *bona fide* offering of goods or services (see section 2.8 of the [WIPO Overview 3.0](#)).

Noting the above, and in the absence of any Response or allegations from the Respondent, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

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

As stated in many decisions rendered under the Policy (e.g. *Robert Ellenbogen v. Mike Pearson*, WIPO

Case No. [D2000-0001](#)) both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainant must show that:

- the disputed domain names were registered by the Respondent in bad faith, and
- the disputed domain names are being used by the Respondent in bad faith.

(i) The Complainant is the owner of the registered trademark PLURALEYES, which was registered long before the registration of the disputed domain names. Moreover, the Complainant has a strong Internet presence showing and providing the PLURALEYES products (Annexes 4 and 5 to the Complaint).

The Respondent features the Complainant's PLURALEYES mark alongside with the Complainant's copyright protected text and visual content on its website, addressed by the disputed domain names, and suggests that visitors of the website can purchase licenses and download the Complainant's PLURALEYES software from the websites (Annex 6 to the Complaint).

It is inconceivable for this Panel that the Respondent registered and used the disputed domain names without knowledge of the Complainant's rights, which in the circumstances of this case leads to the necessary inference of bad faith. This finding is supported by the fact that the disputed domain name <pluraleyes4.com> incorporates the Complainant's registered trademark PLURALEYES entirely, together with the suffix "4"; with regard to the disputed domain name <pluralsynchronizer.com> the suffix "synchronizer" clearly refers to a feature/function of the Complainant's PLURALEYES software, which is synchronizing audio and video recordings.

All of which in fact indicate that the Respondent must have been aware of the Complainant's business and trademark when registering the disputed domain names.

Therefore, in the circumstances the Panel is convinced that the disputed domain names were registered in bad faith by the Respondent.

(ii) Furthermore, the disputed domain names are actively used in bad faith: the Complainant put forward evidence that the disputed domain names resolved to websites which prominently feature the Complainant's PLURALEYES mark alongside the Complainant's copyright protected text and visual content, and suggest that visitors of the website can purchase licenses and download the Complainant's PLURALEYES software from the websites. Thereby the Respondent has attempted to attract Internet users to a website supposedly providing authorized products of the Complainant, which is not the case.

In fact, the Complainant organized a test purchase from the Respondent's website which actually revealed, that the Respondent not only offers but also sells identical copies of the Complainant's software from its websites addressed by the disputed domain names without authorization. The Respondent therefore intentionally, and for commercial gain, registered and is using the disputed domain names to attract 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 Respondent's website or of a product on the Respondent's web site. This clearly constitutes bad faith use of the disputed domain names under the Policy.

Taking all these aspects and evidence on record into consideration and the fact that the Respondent failed to respond to a takedown request sent on behalf of the Complainant and to the Complaint further supports the finding that the disputed domain names have been registered and are being used in bad faith under paragraph 4(a)(iii) of the Policy. The fact that the disputed domain names do not currently resolve to active websites does not prevent a finding of 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 <pluraleyes4.com> and <pluralsynchronizer.com> be transferred to the Complainant.

*/Peter Burgstaller/*

**Peter Burgstaller**

Sole Panelist

Date: August 11, 2023