

## **ADMINISTRATIVE PANEL DECISION**

**CGBYTES INC. v. Ted Robinson**

**Case No. D2023-4248**

### **1. The Parties**

The Complainant is CGBYTES INC., Canada, represented by Thompson Dorfman Sweatman LLP, Canada.

The Respondent is Ted Robinson, Ukraine.

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

The disputed domain name <renderotica.org> is registered with Name.com, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 12, 2023. On October 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 16, 2023, 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 (Domain Protection Services, Inc), and contact information in the Complaint. The Center sent an email communication to the Complainant on October 25, 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 October 25, 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 November 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 23, 2023.

The Center appointed Marilena Comanescu as the sole panelist in this matter on December 6, 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. Further Procedural Considerations**

Under paragraph 10 of the Rules, the Panel is required to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and also that the administrative proceeding takes place with due expedition.

Since the Respondent's mailing address is stated to be in Ukraine, which is subject to an international conflict at the date of this Decision that may impact case notification, it is appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 of the Rules, whether the proceeding should continue.

Having considered all the circumstances of the case, the Panel is of the view that it should. The Panel notes that the courier was not able to deliver the written notice to the Respondent's address in Ukraine, whereas the Complaint was delivered to the Respondent's email address provided by the Registrar.

The Panel also notes that the Complainant has specified in the Complaint that any challenge made by the Respondent to any decision to transfer or cancel the disputed domain name shall be referred to the jurisdiction of the Courts of the location of the principal office of the concerned registrar. In this case, the principal office of the Registrar, Name.com, Inc., is in the United States of America (the "United States").

The Panel concludes that the Parties have been given a fair opportunity to present their case, and so that the administrative proceeding takes place with due expedition the Panel will proceed to a Decision accordingly.

#### **5. Factual Background**

The Complainant is an online marketplace and community servicing 3D graphic designers and artists, that offers a wide variety of digital content and tools to accelerate 3D production workflow. The Complainant carries on business worldwide, including in the United States, and has its offices in Canada.

The Complainant owns trademark registrations and applications for RENDEROTICA, such as the following:

- the European Union Trade mark registration number 018877393 for the word mark RENDEROTICA, filed on May 21, 2023, registered on December 2, 2023, covering services in Nice classes 35, 38, 41, 42, and 45; and
- the United States trademark application, serial No. 98002420 for the word mark RENDEROTICA, filed on May 18, 2023, claiming services in Nice classes 35, 38, and 42.

The Complainant carries its activity on the website under the domain name <renderotica.com> registered on December 6, 1999 and used since at least May 10, 2000 in connection with hosting adult-content, for selling adult 3D digital asset product for use with other software, and hosting a community forum.

The disputed domain name was registered on September 22, 2020 and, at the time of filing the Complaint, it was directed on a page that displays pay-per-click ("PPC") pages with sponsored links with adult-content, some of which ultimately resolve to the Complainant's competitor's websites.

According to Annex 15 to the Complaint, between May 6, 2022 and July 11, 2023, the disputed domain name has been used as a website for hosting 3D images and animations for the provision of access to files which have been copied from the Complainant's website.

## **6. Parties' Contentions**

### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that it owns common law rights in "RENDEROTICA" since at least 1999, the term "renderotica" carries no meaning in the English language other than as the Complainant's trademark; the disputed domain name is identical to its trademark and website; that the Respondent has no rights or legitimate interests in the disputed domain name; that the Respondent had wrongfully taken content from the Complainant's website and reproduced the content on the website under the disputed domain name, thus infringing the Complainant's copyright; the use of the disputed domain name by the Respondent has interfered with the Complainant's business; and that the Respondent registered and is using the disputed domain name in bad faith.

### **B. Respondent**

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

## **7. Discussion and Findings**

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in the disputed domain name; and
- (iii) the disputed domain name has 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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The date of registration of the trademark is not relevant under the first element for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.1.2.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The disputed domain name, reproducing exactly the Complainant’s mark and domain name, was used in connection with PPC pages diverting Internet users to, *inter alia*, competitors of the Complainant. Panels have held that the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the Complainant’s mark or otherwise mislead Internet users. [WIPO Overview 3.0](#), section 2.9.

Based on the available record, the Panel finds the second element of the Policy has been established.

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

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the complainant’s mark.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The Panel notes that the disputed domain name was registered before the Complainant accrues registered trademark rights. Given the distinctiveness of the Complainant’s mark; the use of the name “Rendetorica” by the Complainant since at least May 2000; the Complainant operating under the domain name <renderotica.com> (which differs from the disputed domain name in the Top-Level Domain), the composition of the disputed domain name; the use of the disputed domain name, either in connection with a website providing similar services and using without permission copyrighted images from the Complainant’s official website, or for PPC pages listing competing services; coupled with no credible explanation for the Respondent’s choice of the disputed domain name, the Panel accepts that the Complainant has established unregistered trademark rights in the name Rendetorica before the registration of the disputed domain name and that the Respondent knew and targeted the Complainant and its unregistered trademark at the time of registering the disputed domain name.

At the time of filing the Complaint, the disputed domain name resolved to a page providing PPC links listing services similar to those provided by the Complainant.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt “to attract, for commercial gain, Internet users to [the respondent’s] 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” is evidence of registration and use in bad faith.

Given that the disputed domain name incorporates the Complainant’s trademark exactly, reproduces the Complainant’s domain name, the website operated under the disputed domain name displayed PPC links to services similar to those provided by the Complainant and had no disclaimer, indeed in this Panel’s view, the Respondent has intended to attract Internet users accessing the website corresponding to the disputed domain name who may be confused and believe that the website was held, controlled by, or somehow affiliated with or related to the Complainant, presumably for the Respondent’s commercial gain. Such activities may also disrupt the Complainant’s business and tarnish its trademark.

The Respondent had not participated in the present proceeding and provided inaccurate or incomplete contact information in the Whois. Such facts, together with all the other elements in this case, supports, in the eyes of this Panel, a finding of bad faith behavior.

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy.

## **8. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <renderotica.org>, be transferred to the Complainant.

*/Marilena Comanescu/*

**Marilena Comanescu**

Sole Panelist

Date: December 20, 2023