



## DECISION

Casale Media, Inc. v. (Name redacted) / PERFECT PRIVACY, LLC

Claim Number: FA1610001696719

### PARTIES

Complainant is **Casale Media, Inc.** (“Complainant”), represented by **Zak Muscovitch** of **Muscovitch Law P.C.**, Canada. Respondent is **(Name redacted) / PERFECT PRIVACY, LLC** (“Respondent”), Canada.

### REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are **<casalemedia.support>** and **<casalemedia.xyz>** registered with **Network Solutions, LLC** and **Key-Systems, LLC**, respectively.

### PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

The Honourable Neil Anthony Brown QC as Panelist.

### PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on October 5, 2016; the FORUM received payment on October 5, 2016.

On Oct 5, 2016, Oct 11, 2016, Network Solutions, LLC; Key-Systems, LLC confirmed by e-mail to the FORUM that the **<casalemedia.support>** and **<casalemedia.xyz>** domain names are registered with Network Solutions, LLC; Key-Systems, LLC and that Respondent is the current registrant of the names.

Network Solutions, LLC; Key-Systems, LLC has verified that Respondent is bound by the Network Solutions, LLC; Key-Systems, LLC registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On October 11, 2016, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of October 31, 2016 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@casalemedia.support, postmaster@casalemedia.xyz. Also on October 11, 2016, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

Having received no response from Respondent, the FORUM transmitted to the parties a Notification of Respondent Default.

On November 8, 2016 pursuant to Complainant's request to have the dispute decided by a single-member Panel, the FORUM appointed The Honourable Neil Anthony Brown QC as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the FORUM has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2. Therefore, the Panel may issue its decision based

on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the FORUM'S Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

## RELIEF SOUGHT

Complainant requests that the domain names be transferred from Respondent to Complainant.

## PARTIES' CONTENTIONS

### A. Complainant

Complainant, Casale Media, Inc., is in the business of internet advertising. Complainant has rights in the CASALE MEDIA mark based on registration of the mark with the United States Patent and Trademark Office ("USPTO") (*e.g.*, Reg. No. 3,205,802, registered February 6, 2007). Respondent's domain names **<casalemedia.support>** and **<casalemedia.xyz>** are confusingly similar to the CASALE MEDIA mark as the domains include the entire mark and merely add the generic top-level domain ("gTLD") ".support," and ".xyz."

Respondent has no rights or legitimate interests in the disputed domain names. There is no indication that Respondent has been commonly known as CASALE MEDIA. Respondent's use of the disputed domain names, to attempt to create a spoof website and fraudulently duplicate Complainant's website and services for commercial gain, is not a *bona fide* offering of goods or services or a legitimate noncommercial or fair use.

Respondent's registration and use of the domain names meets the grounds of bad faith. Respondent registered the domain names for the purpose of disrupting Complainant's business and to confuse internet users as to the source and affiliation of the infringing domain names. Further, Respondent should be

considered as having actual knowledge of Complainant's rights in the CASALE MEDIA mark based on use of Complainant's name and logo on the resolving websites.

#### B. Respondent

Respondent failed to submit a Response in this proceeding.

#### PRELIMINARY ISSUE: IDENTIFICATION OF RESPONDENT

Complainant contends that Respondent has falsely registered the <casalemedia.xyz> domain name using the name of (Name redacted). On that basis, Complainant has submitted that the Panel should "... redact (Name redacted)'s name from the style of cause of this proceeding, as it would be unfortunate and tremendously unfair to (Name redacted), to have a legal proceeding succeed against his or her name, when in reality he or she is not a party to the proceeding and is not guilty of any wrongdoing whatsoever". In support of that submission, Complainant has included a declaration from (Name redacted) indicating that he or she has not registered the <casalemedia.xyz> domain name or authorized its registration. *See* Compl., at Attached Ex. I. Further, as of October 31, 2016, the FORUM had not received any formal Response and proceeded with the Panel appointment. The Panel will resolve this issue by taking the following rules and decisions into account in making a determination on whether redaction of (Name redacted)'s identity is proper and appropriate.

Policy ¶ 4(j) provides that "[a]ll decisions under this Policy will be published in full over the Internet, except when an Administrative Panel determines in an exceptional case to redact portions of its decision." In *Wells Fargo & Co. v. John Doe as Holder of Domain Name <wellzfargo.com>*, FA 362108 (FORUM Dec. 30, 2004) and *Wells Fargo & Co. v. John Doe as Holder of Domain Name <wellsfargossl>*, FA 453727 (FORUM May 19, 2005), the panels omitted the

respondents' personal information from the decisions, pursuant to Policy ¶ 4(j) to protect the respondents who claimed to be victims of identity theft from becoming aligned and associated with acts the actual registrant appeared to have sought to impute to the respondents.

That view is consistent with other decisions, such as *S&C Electric Company v. sandc india / [redacted]*, NAF Case: FA1412001592719 (Jan. 2, 2015) where the panel said: "Since Respondent's Intermediary is not the true party in interest, its name has been redacted from the caption of this decision and is not mentioned elsewhere in this decision for its protection, being merely referred to as Respondent's Intermediary."; and *Alliance Healthcare Services Inc. v. [Name redacted] / Whois Agent, Whoisprivacy Protection Service Inc.*, WIPO Case No. D2015-1666.

FORUM Supplemental Rule 15(b) provides that "All requests pursuant to Policy paragraph 4(j) and Rule 16(b) to have a portion of the decision redacted, must be made in the *Complaint, the Response, or an Additional Submission* that is submitted before the Panel's decision is published." (emphasis added). The request of Complainant to redact (Name redacted)'s name was made in the Complaint and was therefore in compliance with Forum Supplemental Rule 15(b).

The panel also finds that the redaction of the second Respondent's name would be the redaction of "a portion of the decision."

It should also be noted that Rule 1 defines "respondent" as "the holder of a domain-name registration against which a complaint is initiated;" and FORUM Supplemental Rule 1(d) further defines "the holder of a domain-name registration" as "the single person or entity listed in the WHOIS registration information at the time of commencement." The Panel also notes UDRP

decisions which hold that the registrar-confirmed registrant of a disputed domain name (per the WHOIS at commencement of the proceeding) is the proper respondent, notwithstanding the possibility that said respondent's identity was stolen. *See, e.g., Banco Bradesco S/A v. Gisele Moura Leite*, D2014-0414 (WIPO Apr. 30, 2014).

Taking these provisions and decisions into account, the proper role of the Panel is to decide whether this is an exceptional case that warrants the redaction of (Name redacted)'s name and location and any other information that might identify (Name redacted).

The Panel finds on the evidence that this is an exceptional case and that the redaction of (Name redacted)'s name and location and any other information that might identify (Name redacted) is justified and the Panel so determines.

For completeness, the Panel also determines under Rule 16(b) of the UDRP Rules that a portion of the decision in this matter not be published, namely any reference to (Name redacted)'s name and location and any other information that might identify (Name redacted).

The reasons for these findings, as Complainant submits and argues persuasively, are as follows.

This proceeding concerns two domain names, <casalemedia.support> and <casalemedia.xyz>. Complainant filed an application under the Uniform Rapid Suspension System (URS) relating to the <casalemedia.support> domain name. The proceeding thus initiated resulted in an order being made that the domain name be suspended. That order was made on September 6, 2016. The <casalemedia.xyz> domain name was apparently registered on August 26, 2016,

giving the name of (Name redacted) as the registrant and it was used to direct internet users to the website at [www.casalemedia.support](http://www.casalemedia.support).

The name and contact details of (Name redacted) and some information that might identify him or her were clearly used by Respondent and without his or her or Complainant's permission. Indeed, Complainant has adduced in evidence a Declaration by (Name redacted) stating that he or she did not register the **<casalemedia.xyz>** domain name and that an unknown person used his or her name and contact details without permission.

The Panel agrees with the submission of Complainant that:

“ Apparently, Respondent used (Name redacted)'s name in furtherance of ( a) nefarious plot to confuse visitors to (the) illicit Infringing Website, as such visitors could possibly check the Whois record and see that the recorded registrant was (Name redacted), and thereby mistakenly believe that the Infringing Website was owned and controlled by Complainant. Alternatively, the Respondent may have mischievously used (Name redacted)'s name and address so that Complainant would, outrageously, be forced to name (Name redacted) – (words redacted), as a Respondent in the within UDRP proceeding.”

The Panel agrees with those conclusions.

For these reasons, the Panel therefore agrees with the submission of Complainant that “it would be unfortunate and tremendously unfair to (Name redacted) to have a legal proceeding succeed against his (or her) name, when in reality he (or she) is not a party to the proceeding and is not guilty of any wrongdoing whatsoever”. The Panel, for those reasons, makes the foregoing determinations for redaction.

## PRELIMINARY ISSUE – MULTIPLE RESPONDENTS

In the instant proceedings, Complainant has alleged that the entities which control the two domain names at issue are effectively controlled by the same person and/or entity, which is operating under several aliases.

Paragraph 3(c) of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) provides that a “complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.” In that regard, FORUM Supplemental Rule 1 (d) (i) provides that “A Complainant wishing to make an argument for a single Respondent having multiple aliases must comply with Supplemental Rules 4(c) and 17(a)(i)”. Complainant has complied with that provision.

Complainant contends that the <casalemedia.support> was suspended under the prior URS proceeding. After Respondent was notified of the suspension of the <casalemedia.support> domain name, the <casalemedia.support> domain name redirected to the <casalemedia.xyz> domain name which Complainant submits indicates that Respondent has controlled and is the registrant of both domain names. *See* Compl., at Attached Annex G.

The Panel finds on the evidence that the two domain names at issue are commonly owned/controlled by a single Respondent who is using multiple aliases.

The Panel therefore agrees with Complainant and so finds that “...the holder of both of the Disputed Domain Names are the same holder, or at very least are under the same practical control, thereby entitling Complainant to bring the within proceeding against both Domain Names.”.

## FINDINGS

1. Complainant is a Canadian company engaged in the industry of selling brand name display media.
2. Complainant has rights in the CASALE MEDIA mark based on registration of the mark with the USPTO (*e.g.*, Reg. No. 3,205,802, registered February 6, 2007).
3. The disputed domain name <casalemedia.support> was created on November 26, 2014, and the <casalemedia.xyz> domain name was created on August 26, 2016.
4. Respondent has used the disputed domain names to attempt to create a spoof website and fraudulently duplicate Complainant's website and services for commercial gain.

## DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and

draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. *See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (FORUM July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

#### **Identical and/or Confusingly Similar**

The first substantive issue that arises is whether Complainant has a trademark or service mark on which it can rely. Complainant submits that it has rights in the CASALE MEDIA mark based on registration of the mark with the USPTO (*e.g.*, Reg. No. 3,205,802, registered February 6, 2007). *See* Compl., at Attached Annex B. Panels routinely find that a complainant has rights in a mark based on registration of the mark with the USPTO. *See Metro. Life Ins. Co. v. Bonds*, FA 873143 (FORUM Feb. 16, 2007) (finding that a USPTO trademark registration adequately demonstrates a complainant's rights in a mark under Policy ¶ 4(a)(i)). The Panel makes that finding in the present case.

The second issue that arises is whether the disputed **<casalemedia.support>** and **<casalemedia.xyz>** domain names are identical or confusingly similar to Complainant's CASALE MEDIA mark. Complainant contends that the **<casalemedia.support>** and **<casalemedia.xyz>** domain names are confusingly similar to the CASALE MEDIA mark. Respondent's domain names incorporate the CASALE MEDIA mark in its entirety, remove spaces, and add the gTLD ".xyz" or ".support." Panels have held that merely adding a gTLD and removing spaces from a mark is not relevant to an analysis of confusing similarity. *See Oculus VR, LLC v. Ivan Smirnov*, FA 1625898 (FORUM July 27, 2015) (concluding

that “Panels have consistently held that the addition of a gTLD does not distinguish a domain name from a mark, and that the removal of spaces between words of a mark is irrelevant.”). The Panel therefore concludes that Respondent’s domain names are confusingly similar to the CASALE MEDIA mark for purposes of Policy ¶ 4(a)(i).

Complainant has thus made out the first of the three elements that it must establish.

### **Rights or Legitimate Interests**

It is now well established that Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain names under Policy ¶ 4(a)(ii), and then the burden shifts to Respondent to show it does have rights or legitimate interests. *See Hanna-Barbera Prods., Inc. v. Entm’t Commentaries*, FA 741828 (FORUM Aug. 18, 2006) (holding that the complainant must first make a *prima facie* case that the respondent lacks rights and legitimate interests in the disputed domain name under UDRP ¶ 4(a)(ii) before the burden shifts to the respondent to show that it does have rights or legitimate interests in a domain name); *see also AOL LLC v. Gerberg*, FA 780200 (FORUM Sept. 25, 2006) (“Complainant must first make a *prima facie* showing that Respondent does not have rights or legitimate interest in the subject domain names, which burden is light. If Complainant satisfies its burden, then the burden shifts to Respondent to show that it does have rights or legitimate interests in the subject domain names.”).

The Panel finds that Complainant has made out a *prima facie* case that arises from the following considerations:

- (a) Respondent has chosen to take Complainant’s CASALE MEDIA mark and to use it in its domain names;

- (b) The <casalemedia.support> domain name was created on November 26, 2014 and the <casalemedia.xyz> domain name was created on August 26, 2016;
- (c) The <casalemedia.support> domain name, until it was suspended, resolved to a website that was clearly part of a phishing expedition perpetrated by Respondent and the <casalemedia.xyz> domain name has been used by Respondent to further that objective;
- (d) Complainant submits that Respondent engaged in the aforementioned activities without the permission or authority of Complainant and has adduced evidence to that effect which the Panel accepts;
- (e) Complainant submits that Respondent has not been commonly known by the disputed domain names or authorized to register them. WHOIS information associated with the <casalemedia.support> domain name shows that Respondent has used a privacy service to shield its identity as the registrant of that domain name. *See* Compl., at Attached Annex I. Panels have held that a respondent is not commonly known by a disputed domain name where a respondent has not been authorized to use a complainant's mark and there is no information to the contrary. *See Braun Corp. v. Loney*, FA 699652 (FORUM July 7, 2006) (concluding that the respondent was not commonly known by the disputed domain names where the WHOIS information, as well as all other information in the record, gave no indication that the respondent was commonly known by the domain names, and the complainant had not authorized the respondent to register a domain name containing its registered mark). The Panel therefore finds on the evidence that Respondent is not commonly known by the <casalemedia.support> domain name. The Panel also finds on the evidence that the registration and use of the <casalemedia.xyz> domain name were part of Respondent's deceptive *modus operandi* and that Respondent is not commonly known by the <casalemedia.xyz> domain name;

(f) Complainant next argues that Respondent has not used the disputed domain names in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Respondent's <casalemedia.support> domain name, as resolved for Respondent on June 18, 2016, leads to a website using the CASALE MEDIA mark and requesting that users enter login information or register on the website. *See* Compl., at Attached Annex D. Complainant maintains that Respondent has used the disputed domain name to pass itself off as Complainant and attempt to get users to host advertisements on their own websites for which the users are promised payment which never materializes. *See* Compl., at Attached Annex E. Prior to this proceeding Complainant brought a URS proceeding against the <casalemedia.support> domain name and had the domain name suspended. *See* Compl., at Attached Annex H. It is clear that Respondent became aware of the pending suspension of the <casalemedia.support> domain name and then registered and used the <casalemedia.xyz> domain name to mislead internet users to use that domain name to obtain access to the services previously located at <casalemedia.support>. Panels have held that using a complainant's marks in a disputed domain name to attempt to pass itself off as the complainant for commercial gain is not a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. *See Mortgage Research Center LLC v. Miranda*, FA 993017 (FORUM July 9, 2007) ("Because [the] respondent in this case is also attempting to pass itself off as [the] complainant, presumably for financial gain, the Panel finds the respondent is not using the <mortgageresearchcenter.org> domain name for a *bona fide* offering of goods or services pursuant to Policy ¶ 4(c)(i), or a legitimate noncommercial or fair use pursuant to Policy ¶ 4(c)(iii)."). It is a reasonable assumption that Respondent engaged in this conduct for commercial gain. The Panel therefore finds that Respondent has not used the disputed domain names within the parameters of Policy ¶ 4(c)(i) or ¶ 4(c)(iii).

All of these matters go to make out the *prima facie* case against Respondent. As Respondent has not filed a Response or attempted by any other means to rebut the *prima facie* case against it, the Panel finds that Respondent has no rights or legitimate interests in the disputed domain names.

Complainant has thus made out the second of the three elements that it must establish.

### **Registration and Use in Bad Faith**

It is clear that to establish bad faith for the purposes of the Policy, Complainant must show that the disputed domain names were registered in bad faith and have been used in bad faith. It is also clear that the criteria set out in Policy ¶ 4(b) for establishing bad faith are not exclusive, but that Complainants in UDRP proceedings may also rely on conduct that is bad faith within the generally accepted meaning of that expression.

Having regard to those principles, the Panel finds that the disputed domain names were registered and used in bad faith. That is so for the following reasons.

First, Complainant contends that Respondent's bad faith is evident from using the domain names in a manner that disrupts Complainant's business. As stated above, Respondent has used the disputed domain names to pass itself off as Complainant and offer services that compete with those offered by Complainant. *See* Compl., at Attached Annex D, E, F, G, & H. Panels have held that using another's mark in a domain name to offer services in competition with those of a complainant is tantamount to doing so in bad faith. *See DatingDirect.com Ltd. v. Aston*, FA 593977 (FORUM Dec. 28, 2005) ("Respondent is appropriating Complainant's mark to divert Complainant's customers to Respondent's competing business. The Panel finds this use of the disputed domain names is

evidence of both bad faith registration and use pursuant to Policy ¶ 4(b)(iii).”). The Panel therefore finds that Respondent has registered and used the domain names in bad faith pursuant to Policy ¶ 4(b)(iii).

Secondly, Complainant contends that Respondent is using the domain names to confuse internet users as to their source and affiliation and has done so in bad faith. Again, Respondent appears to be attempting to try to convince users that it is in fact Complainant so that it may obtain information by phishing and so that it may advertise on internet user’s websites without paying the users for displaying the advertisements. *See* Compl., at Attached Annex D, E, F, G, & H. Panels have held that a respondent attempting to pass off as a complainant for commercial gain may be demonstrative of bad faith under Policy ¶ 4(b)(iv). *See Am. Online, Inc. v. Miles*, FA 105890 (FORUM May 31, 2002) (“Respondent is using the domain name at issue to resolve to a website at which Complainant’s trademarks and logos are prominently displayed. Respondent has done this with full knowledge of Complainant’s business and trademarks. The Panel finds that this conduct is that which is prohibited by Paragraph 4(b)(iv) of the Policy.”). The Panel finds that Respondent has shown bad faith in that regard under Policy ¶ 4(b)(iv).

Thirdly, Complainant submits that in light of Respondent’s use of the domain names, to offer services similar to Complainant’s, and Respondent’s display of the CASALE MEDIA mark on its website, it is inconceivable that Respondent could have registered the <casalemedia.support> and <casalemedia.xyz> domain names without actual and/or constructive knowledge of Complainant’s rights in the mark. Although it has often been said that arguments of bad faith based on constructive notice alone may not be persuasive, the Panel concludes that Respondent had actual knowledge of Complainant’s rights in the mark prior to registering the disputed domain names and finds that actual knowledge is adequate evidence of bad faith under Policy ¶ 4(a)(iii). *See Univision Comm’cns*

*Inc. v. Norte*, FA 1000079 (FORUM Aug. 16, 2007) (rejecting the respondent's contention that it did not register the disputed domain name in bad faith since the panel found that the respondent had knowledge of the complainant's rights in the UNIVISION mark when registering the disputed domain name).

Fourthly, in addition and having regard to the totality of the evidence, the Panel finds that, in view of Respondent's registration of the disputed domain names using the CASALE MEDIA mark and in view of the conduct that Respondent engaged in when using the domain names, Respondent registered and used them in bad faith within the generally accepted meaning of that expression.

Complainant has thus made out the third of the three elements that it must establish.

## DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <casalemedia.support> and <casalemedia.xyz> domain names be **TRANSFERRED** from Respondent to Complainant.



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Honorable Neil Anthony Brown, Q.C.  
Arbitrator

The Honourable Neil Anthony Brown QC

Panelist

Dated: November 10, 2016