



DECISION

Longo Brothers Fruit Markets Inc. v. John Obeye / DOMAIN MAY BE FOR SALE,
CHECK AFTERNIC.COM

Claim Number: FA1706001734634

PARTIES

Complainant is **Longo Brothers Fruit Markets Inc.** ("Complainant"), represented by **Zak Muscovitch** of **Muscovitch Law P.C.**, Canada. Respondent is **John Obeye / DOMAIN MAY BE FOR SALE, CHECK AFTERNIC.COM** ("Respondent"), Czechoslovakia.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<mylongos.com>**, registered with **Gransy, s.r.o. d/b/a subreg.cz**.

PANEL

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

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on June 6, 2017; the FORUM received payment on June 6, 2017.

On June 9, 2017, Gransy, s.r.o. d/b/a subreg.cz confirmed by e-mail to the FORUM that the **<mylongos.com>** domain name is registered with Gransy, s.r.o.

d/b/a subreg.cz and that Respondent is the current registrant of the name. Gransy, s.r.o. d/b/a subreg.cz has verified that Respondent is bound by the Gransy, s.r.o. d/b/a subreg.cz 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 June 12, 2017, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of July 3, 2017 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@mylongos.com. Also on June 12, 2017, 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 July 6, 2017, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the FORUM appointed Houston Putnam Lowry, Chartered Arbitrator, 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 name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

Language of the Proceeding

7.1 Pursuant to Section 11 of the [UDRP Rules](#) under the UDRP, the language of the proceeding shall be the language of the Registration Agreement. The Disputed Domain Name is registered with Gransy S.R.O D/B/A Subreg.Cz ("Gransy"). The Gransy Registration Agreement is in the English language. Accordingly, the language of the proceeding shall be English. Gransy also has a version of the Registration Agreement in the Czech language. It is therefore unclear which registration agreement should apply, however it is submitted that where there are multiple registration agreements, and one of them is in English, a Complainant may properly bring the claim in the English language. Furthermore, where the subject domain name is in English characters and the website pointed to the disputed domain name is in English, this will be further grounds for conducting the proceeding in the English language (See [Tradesy Inc. v. Eartha Dickerson](#), WIPO Case No. D2014-2271).

7.2 Lastly and importantly, in the case of [Compagnie Générale des Etablissements Michelin v. Ivan Toplij, Poste Restante](#), WIPO Case No. D2016-2628, which was a case brought against Ivan Toplij, the suspected true beneficial owner of the Domain Name (as discussed further below), there was no issue at all with respect to the Complaint being brought in the English language. Accordingly, it is respectfully

submitted that the proceeding be conducted in English.

The Domain Name and Registrant

7.3 Since notice of this dispute, the Domain Name has undergone three (3) changes in the registrant, and is likely a case of “cyberflying”, as discussed further below.

7.4 The first notice of dispute was as a result of Complainant sending a Demand Letter to the registrant, on May 1, 2017. At the time that the Demand Letter was issued, the registrant was **Ivan Toplij**, of Prague, Czech, and the registrar was the same as it is now, namely Gransy.

7.5 At the time this Complaint was originally filed, i.e. on June 6, 2017, the Domain Name had since been put under privacy protection, and as such was registered to **“Domain Admin”**, with a Registrant Organization of *“Whois protection, this company does not own this domain name s.r.o”*. The registrar was still Gransy. According to historical Whois reports obtained from DomainTools, the Domain Name was concealed by privacy protection on or about **May 28, 2017**, which was *after* receipt of a Demand letter, as will be explained below.

7.6 Subsequently, Complainant was informed by the FORUM on **June 9, 2017**, that upon commencement of the proceeding, the registrant had ‘changed’ as a result of privacy protection being lifted, and that the apparent registrant was now **“John Ob eye”** with an organization of *“DOMAIN MAY BE FOR SALE, CHECK AFTERNIC.COM”*. The registrar, Gransy, remained the same. Accordingly, Complainant has amended the within Complaint to take this latest change into account.

7.7 In summary, when Mr. Toplij received the Demand Letter from Complainant, he concealed himself using privacy protection and transferred the Domain Name to an

alias, still or co-conspirator, Mr. Obeye, to further hinder Complainant.

7.8 It is likely that Mr. Toplij continues to be the beneficial owner of the Domain Name, notwithstanding the aforesaid concealment, as the content of the associated website has not changed (as will be discussed further below), and there has additionally, been no change in the name servers or registrar (Name Server History from DomainTools). Moreover, the domain name continues to be offered for sale at Sedo at the same price. In other words, nothing has changed in terms of the circumstances, other than the name of the registrant, under highly suspicious circumstances following receipt of a Demand Letter.

7.9 Furthermore, it is apparent that Mr. Toplij took steps to conceal his registration of the Domain Name after receiving a Demand Letter from Complainant on May 1, 2017, or alternatively, upon receipt of the Demand Letter, took steps to transfer the Domain Name to a fake name of John Obeye, used as an alias, or as a co-conspirator.

7.10 Mr. Toplij registered the Domain Name on or about **April 1, 2016**. Accordingly, assuming that Mr. Toplij is in fact the underlying registrant or at least the beneficial owner of the Domain Name as believed, whether in association with Mr. Obeye or on his own using an alias, then April 1, 2016 is the key date for determining bad faith registration and use, asdpo will be discussed further herein. If it is truly Mr. Obeye alone, then June 10, 2017 is the key date, but that doesn't change anything.

Complainant

7.11 Complainant is Longo Brothers Fruit Markets Inc. ("Longo's"), an Ontario, Canada corporation.

7.12 Longo's is a family-owned Canadian business that started in 1956 when three brothers, Tommy, Joe and Gus Longo opened their first fruit market. It was a small

1,500 square foot store on Yonge Street in Toronto.

7.13 Today, Longo's, with 17 family members working in the company, operates 30 grocery stores across the Greater Toronto Area and nearby municipalities, including stores as large as 48,000 square feet. Since 2004, Longo's is also the owner and operator of GroceryGateway.com, a leading online retailer of home-delivered groceries. Longo's employs more than 5,000 people.

7.14 Longo's has been recognized numerous times for its success and good business practices, including Longo's CEO, Anthony Longo receiving the Retail Council of Canada's Grand Prix 2017 Lifetime Achievement Award.

7.15 Longo's was included in "Canada's 10 Most Admired Corporate Cultures" in 2016 and is a Platinum Winner of "Canada's Best Managed Companies", after being included in the prestigious list for 7 years running.

7.16 Although Longo's only has stores in Ontario, Canada, its website, Longos.com has been available internationally on the Internet since it was first launched on July 7, 2000 or earlier.

7.17 As a result of its widespread business operations as aforesaid, in combination with numerous accolades as aforesaid, the consuming public and the business community in the greater Toronto area in particular, has come to associate LONGO and LONGO'S exclusively with Complainant and Complainant has thereby accumulated substantial goodwill and reputation.

7.18 Moreover, a Google search for LONGOS and MY LONGOS on Google.cz (the Czech version) with an IP address in Prague, Czech, reveals that Complainant's website for LONGOS.COM shows up in the very first spot and throughout the first page of results. As such, anyone (including Respondent)

searching for LONGOS or MY LONGOS on the Internet, would inevitably find and thereby become aware, of Complainant and its LONGOS brand.

Complainant's Trademarks

7.19 As aforesaid, Complainant is the registrant of 37 registered trademarks which include the word, "LONGO" or "LONGO'S", including the following 2 registered trademarks.

Canadian Trademark Registration No. 1484087 LONGO'S &
Design (Class 35)
Registered February 22, 2012

Canadian Trademark Registration No. 0691505 Longo's Own
(Class 29, 30, 32)
Registered November 19, 1993

Respondent

7.20 The beneficial owner of the Domain Name is believed to be Mr. Toplij using an alias or alternatively, Mr. Toplij in a conspiracy along with the recorded registrant, Mr. Obeye, who is likely merely the nominal registrant. In either event, Respondent is a cybersquatter. Mr. Toplij has been found *at least once before*, to have cybersquatted on a domain name. [*Compagnie Générale des Etablissements Michelin v. Ivan Toplij, Poste Restante*](#), WIPO Case No. D2016-2628, where the Panel found in favour of Complainant, Compagnie Générale des Etablissements Michelin of Clermont-Ferrand and determined that Mr. Toplij has registered michelin-tenjin.com in bad faith. Respondent did not respond to the complaint, and the Panel determined that Mr. Toplij had registered and used the Domain Name in bad faith and had no legitimate interest in it.

7.21 The likely beneficial owner of the Domain Name, Mr. Toplij, is the registrant of

at least 11,299 domain names. This is proof that he is a professional “domainer” rather than someone who registers domain names for his own use. The sole purpose of registering such a volume of domain names is to monetize them or resell them. Mr. Obeye *too* is associated with over 7,000, although it is likely that this is one and the same person, and he too if he exists in reality at all, is also a professional domainer.

7.22 In fact, to-date, Respondent has done both, namely monetize the Domain Name and attempt to sell it.

7.23 Attached is a screenshot from Sedo, a marketplace for selling domain names, which shows that the Domain Name has been listed for sale, both before *and* after the Domain Name changed registrations to Mr. Obeye, as aforesaid.

7.24 Attached are screenshots of how Respondent is using the Domain Name in bad faith, both before *and* after the change in registrants. The first screenshot shows that when visiting MyLongos.com, the user is taken to a website which provides a fake “survey”. Such “surveys” are well-known scams that are used for phishing personal details to use for illegal and illicit purposes, to otherwise convince unwitting users to send money to a criminal or fraudulent enterprise, to generate money from advertisers who use these unscrupulous means to scam visitors, or to install malware on the user’s computer for further illicit purposes. Attached to the Complaint is a screenshot of what happens when visiting the Disputed Domain Name using a Chrome browser with appropriate security settings.

7.25 The Disputed Domain Name is *not* the only cybersquatted domain name owned by the suspected beneficial owner, Mr. Toplij. Respondent has also been the registrant of the following cybersquatted domain names corresponding to well-known brands:

- a) geniunesaab.com (SAAB)
- b) harleydavson.com (HARLEY DAVIDSON)
- c) goolgke.com (GOOGLE)
- d) Yhaho.net (YAHOO)

7.26 On May 1, 2017, Complainant through counsel, sent a Demand letter to the then registrant, Ivan Toplij. Complainant received no response at all. Had the Mr. Toplij had any bona fide defense at all to this Complaint, it is likely that he would have been forthcoming with a response. It is also likely that Mr. Toplij and Mr. Obeye are either in business together, well connected to each other, or one and the same person. Essentially, after the Demand Letter was received, privacy protection was established and the name of the registrant was changed, and this surely is no coincidence.

Confusingly Similar

7.27 To prove this element, Complainant must have trademark rights, and the Domain Name must be identical or confusingly similar to Complainant's trademark.

7.28 As aforesaid, Complainant is the owner of 37 registered trademarks which incorporate or consist of the word, LONGO or LONGOS. For the purpose of this proceeding however, Complainant primarily relies upon Canadian Trademark Registration No. 1484087 for LONGO'S & Design and Canadian Trademark Registration No. 0691505 for LONGO'S OWN (the "Complainant's Marks").

7.29 It is submitted that the Disputed Domain Name is confusingly similar to Complainant's Marks.

7.30 The predominant feature of the LONGOS & Design trademark is the word element, “LONGOS”. It is well established in domain name disputes, as set out in the [*WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition*](#) (“*WIPO Overview 3.0*”) at Section 1.11, that, figurative, stylized or design elements in a trademark are typically disregarded for the purpose of assessing identity or confusing similarity, with such assessment generally being between the alpha-numeric components of the domain name, and the dominant textual components of the relevant mark. Accordingly, once the stylized aspect of the LONGOS & Design mark is omitted from consideration, it is clear that the predominant element is the clear textual wording of LONGOS, which is included in its entirety in the Disputed Domain Name. As numerous prior panels have held, the fact that a domain name wholly incorporates a complainant's registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy despite the addition of other words to such marks (See [*Oki Data Americas, Inc. v. ASD Inc.*](#), WIPO Case No D2001-0903).

7.31 Moreover, the addition of the pronoun, “my” to the entirety of Complainant’s mark renders the Domain Name confusingly similar to Complainant’s mark pursuant to Policy ¶4(a)(i), as held in [*USABOX, Inc. v. Hakan Ozcingir*](#), NAF Claim Number: FA1012001361390 (MyUSABox.com), where the Panelist corrected recognized that “my” is often part of an online marketing strategy that allows individuals to personalize content in relation to products and services offered under a particular trademark.

7.32 This approach has been held time and time again over the course of numerous UDRP decisions. See, for example [*Sonic Foundry, Inc. v. Allan Carlton*](#), WIPO Case No. D2012-2389 (mymediasite.com); [*Infospace.com, Inc. v. Delighters, Inc.*](#), WIPO Case No. D2000-0068, (finding that the domain name <myinfospace.com> is confusingly similar to complainant’s mark); see also, [*NIIT Ltd. v. Parthasarathy Venkatram*](#), WIPO Case No. D2000-0497 (finding that the “domain name <myniit.com> which incorporates the word NIIT as a prominent part thereof, is

confusingly similar to Complainant's trade name and trademark NIIT"). UDRP arbitrators are in accord with these UDRP decisions; [PC2Call Limited v. Bernard Ferrie](#), FA103181, where the Panel found the domain name <mypc2call.com> to be confusingly similar to complainant's mark PC2CALL.

7.33 Furthermore, of course it is well established in prior UDRP cases that the addition of a ".com" suffix is irrelevant when determining if a disputed domain name is identical or confusingly similar to a trademark. See, for example, [Isleworth Land Company v. Lost In Space, SA](#), FA0208000 117330 (FORUM Sept. 23, 2002), and [BIC Deutschland GmbH & Co KG v. Paul Tweed](#), WIPO Case No. D2000-0418 (June 20, 2000)).

7.34 Accordingly, it is submitted that the Disputed Domain Name is considered confusingly similar with the LONGOS & Design trademark.

7.35 It is also submitted that the Disputed Domain Name is also confusingly similar to Complainant's LONGO'S OWN trademark, as aside from the Disputed Domain Name including the predominant word of the LONGO'S OWN mark in its entirety, it also merely replaces "OWN" with "MY", thereby resulting in confusing similarity. Both terms do nothing to eliminate confusion, and actually result in additional confusion since both terms convey such similar meanings, i.e. they are both possessive forms so in this context, both words are confusingly similar.

No Legitimate Interest

7.36 Paragraph 6(a)(ii) of the Policy requires Complainant to prove that Respondent has no rights or legitimate interests in the disputed domain name. It is, however, the consensus view among UDRP panels that if Complainant makes a *prima facie* case that Respondent has no rights or legitimate interests, and Respondent fails to show one of the three circumstances under paragraph 4(c) of the Policy, then Respondent

may lack a legitimate interest in the disputed domain name. See [WIPO Overview of WIPO Panel Views on Selected Questions 3.0, paragraph 2.1](#), and [Belupo d.d v. WACHEM d.o.o.](#), WIPO Case D2004-0100).

7.37 Respondent has no rights or legitimate interest in the Domain Name. The Domain Name's dominant feature is Complainant's mark combined with a mere pronoun, "my". Respondent has not been commonly known as MY LONGOS or LONGOS or by the Domain Name prior to Respondent's registration of the Disputed Domain Name. See, for example, [RMO, Inc. v Andy Burbidge](#), FA0103000096949 (FORUM).

7.38 Respondent has not been authorized or licensed to use Complainant's Marks in the Disputed Domain Name or any derivative form of them (See; [Six Continents Hotels, Inc. v. IQ Management Corporation](#), WIPO Case No. D2004-0272; [Six Continents Hotels, Inc. v. Patrick Ory](#), WIPO Case No. D2003-0098 ("There is no evidence of any commercial relationship between Complainant and Respondent which would entitle Respondent to the mark. Consequently, the Panel concludes that Respondent has no rights nor legitimate interests in the Domain Name given there exists no relationship between Complainant and Respondent that would give rise to any license, permission or authorization by which Respondent could own or use the Domain Name."); see also [Marriott International, Inc. v. Thomas, Burstein and Miller](#), WIPO Case No. D2000-0610 (transferring domain name <marriottreward.com> where "[n]o evidence was presented that at any time had Complainant ever assigned, granted, licensed, sold, transferred or in any way authorized Respondent to register or use the marks MARRIOTT REWARDS or MARRIOTT in any manner").

7.39 Respondent has not used the Domain Name in connection with a bona fide offering of goods or services, nor has Respondent made legitimate noncommercial or fair use of the Disputed Domain Name. Respondent is intentionally attempting to

divert Internet users to its malware scam/survey website via the Disputed Domain and is therefore not making legitimate noncommercial, or fair use of the Disputed Domain pursuant to Policy ¶4(a)(ii). See [*BJ's Wholesale Club v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID: 64382986619850 Whois Privacy Services Pty*](#), WIPO Case No. D2015-1601 (“The use of the disputed domain name to divert Internet traffic to a malware scam is not a *bona fide* offering of goods or services. See [*Spoke Media Holdings, Inc. v. Andrey Volkov*](#), WIPO Case No. D2010- 1303. Complainant has made a *prima facie* showing that Respondent has no rights or legitimate interests in the disputed domain name; Respondent, by virtue of its default, has failed to rebut that showing.”)

7.40 Furthermore, there are no plausible grounds which would provide Respondent with any legitimate interest in a Domain Name corresponding to Complainant’s Marks. Mere registration of the disputed domain name does not itself confer rights or legitimate interests in the disputed domain name. See [*Terrain Inc. v. Geocaching Zero*](#), WIPO Case No. D2008-0666; [*Société Nationale des Chemins de Fer Français v. RareNames, Inc., RareNames WebReg and RN WebReg*](#), WIPO Case No. D2008-1849; [*St Andrews Links Ltd v. Refresh Design*](#), WIPO Case No. D2009-0601; [*Gibson, LLC v. Jeanette Valencia*](#), WIPO Case No. D2010-0490).

7.41 The combination of factors including the obvious evidence of Respondent’s voluminous domain name registrations, history of cybersquatting, and registration of other infringing domain names, combined with a scam phishing website and the offer to sell the domain name, should lead the Panel to infer that Respondent has no rights or legitimate interests in the disputed Domain Name. See [*Hardees Food Systems Inc. v. Ali Abdelwahed*](#), WIPO Case No. DAE2009-0002).

7.42 Accordingly, in the absence of rights or legitimate use demonstrated by Respondent, it is respectfully submitted that the Panel ought to find that based upon

the foregoing, Complainant has made out a *prima facie* case. It is respectfully submitted that the Panel should find that pursuant to Paragraph 4(a)(ii) of the Policy, Complainant has established that Respondent lacks rights or legitimate interests in that the disputed Domain Name.

Bad Faith Registration and Use

7.43 Where, as in this case, Respondent has failed to show rights or legitimate interests in the Domain Name, registration and use in bad faith can commonly be inferred. See [*Imerys v. Unknown \(gfg fdgdf, dfgdfg\)*](#), WIPO Case No. D2007-0045.

7.44 The use of a ‘privacy service’ to conceal Whois details, particularly where the Domain Name infringes upon a complainant’s trademark *and after notice of the dispute*, can be evidence of bad faith. See [*Fifth Third Bancorp v. Secure Whois Information Service*](#), WIPO Case No. D2006-0696). Respondent’s efforts to hide its identity through a Whois privacy service *after receiving a Demand Letter*, raises the inference that Respondent has reason to hide its identity, and that reason is that it registered and used the Domain Name in bad faith, in order to unfairly interfere with Complainant’s business (See, for example, [*Lewis Silkin LLP v. Heinz Siepenkötter / Siepenkötter kg*](#), WIPO Case No. D2014-1196). Furthermore, although Respondent has no legal obligation to respond to Complainant’s Demand Letter, the resulting inference is that Respondent has no rights or legitimate interest in the Domain Name, or would have affirmatively stated same in response.

7.45 Respondent engaged in “**cyberflying**” and this is evidence of bad faith. In [*PREPADOM v. Domain Drop S.A. \(PREPADOM-COM-DOM\)*](#), D2006-0917 (WIPO Oct. 9, 2006), the panel defined “cyber-flying” as “changing ownership of a domain name with intent to escape a current dispute”. It has also been explained as, “a practice of changing the registrant of a domain name before or during a UDRP

proceeding in an attempt to disrupt the proceeding and circumvent the Policy.” See [Nokia Corporation v. Nokia HYIP](#), FA0801001128341 (FORUM MARCH 5, 2008).

7.46 As set out above, that is what has occurred in this case. As in the [PREPADOM](#) case, and also in [Chamber of Commerce of the United States of America v. Albert Bauer](#), FA1007001335605 (FORUM Sept. 24, 2010, it is respectfully submitted that the Panel should find that Respondent is a temporary registrant in a plot to evade transfer of the disputed domain name to Complainant and is therefore engaged in cyberflying, which is evidence of registration and use in bad faith under Policy (See [See Kirkbi AG v. Company Require / Karlina Konggudinata and Pool.com, Inc.](#), D2004-0359 (WIPO July 12, 2004); see also [BOSU Fitness, LLC v. Kolombo Networks](#), FA 1266587 (FORUM July 22, 2009).

7.47 In addition to the above, Respondent specifically registered the Domain Name in bad faith *because of* Complainant and its marks. As held in [The Fragrance Foundation, Inc. v. Texas International Property Associates](#), WIPO Case No. D2008-0982, panels consider a higher standard of diligence on the part of professional domainers such as Respondent, to be appropriate and, “[i]t seems to this Panel and others that people who make a living from registering vast numbers of domain names must make a reasonable effort...to ensure that they are not infringing on the rights of others”. Accordingly, it is submitted that it is clear that Respondent registered the Domain Name without making any reasonable efforts to ensure that the Domain Name does not infringe upon Complainant’s trademark rights, *or alternatively*, turned a blind eye to Complainant’s rights, which in itself is evidence of bad faith registration.

7.48 In this particular case, it is entirely implausible that a professional Domainer with more than 11,000 domain names registered, would not have either;

- a) conducted a perfunctory Google search to see that the term was confusingly similar to a well-established business with trademark rights; or

b) been willfully blind and just proceeded to register the Domain Name without any due diligence to determine whether it was confusingly similar to a well-established brand.

7.49 In the context of professional domainers who register large numbers of domain names for resale or to monetize through advertising, it has been held that:

“respondents cannot . . . shield their conduct by closing their eyes to whether domain names they are registering are identical or confusingly similar to trademarks. . . . Where . . . a respondent registers large swaths of domain names for resale, often through automated programs that snap up domain names as they become available, with no attention whatsoever to whether they may be identical to trademarks, such practices may well support a finding that respondent is engaged in a pattern of conduct that deprives trademark owners of the ability to register domain names reflecting their marks.” (See [Mobile Communication Service Inc. v. WebReg, RN](#), WIPO Case No. D2005-1304).

7.50 This approach was also upheld in [mVisible Technologies, Inc. v. Navigation Catalyst Systems, Inc.](#), WIPO Case No. D2007-1141, where the unanimous Panel consisting of David Bernstein, Sandra Franklin, and David Sorkin, ruled that even when a Respondent claims that it was “not specifically familiar” with a complainant’s trademark, bad faith registration can still be found:

As for Respondent’s claim that it was not specifically familiar with Complainant’s trademark, even if the Panel would credit that assertion, that assertion is not enough to avoid a finding of bad faith registration.

Although there may be no obligation that a domain name registrant conduct trademark or search engine searches to determine whether a domain name may infringe trademark rights, **a sophisticated domainer who regularly registers domain names for use as PPC landing pages cannot be willfully blind to whether a particular domain name may violate trademark rights. In this context, a failure to conduct adequate**

searching may give rise to an inference of knowledge.

7.51 Accordingly, bad faith registration occurred either because Respondent failed to perform any searching notwithstanding that he is in the business of registering thousands of domain names, or he was willfully blind to the results of the search he did conduct. Any search conducted by Respondent would have shown that LONGOS was a well-established trademark owned by and primarily associated with Complainant, *supra*.

7.52 There is no reasonable possibility, and no evidence from which to infer, that the Domain Name was selected purely at random or by coincidence, since it entirely incorporated Complainant's LONGOS mark (*see*; [Albrecht v. Natale](#), FA 95465 (FORUM Sept. 16, 2000; and also *see*; [Cruise America, Inc. v. Domain Manager, Domain Brokers](#), WIPO Case No. D2016-0717; "the use of a disputed domain name in a website which directs users who have been confused into believing that they are communicating with Complainant to websites containing scareware and malware is clearly potentially damaging to Complainant, and constitutes use in bad faith.").

7.53 Nor is there any plausible likelihood that given Respondent's history of cybersquatting and given the use that he has put the domain name to, namely malware, that he registered the Domain Name because it corresponded to a surname or for any other purpose.

7.54 Respondent registered a Domain Name which is confusingly similar to Complainant's mark, and has intentionally used it to misdirect users for a nefarious purpose, namely an apparent malware phishing scam featuring a bogus survey or for some other kind of advertising monetization that seeks to take advantage of Complainant's trademark rights.

7.55 This Respondent has a pattern of cybersquatting, for which he has already

been held accountable for in a previous UDRP case as aforesaid, and moreover has owned other clearly infringing domain names. Where a respondent has a prior record of cybersquatting in a previous UDRP proceeding and where there is evidence of other infringing domain names which were registered by Respondent, bad faith registration and use may be concluded, as was done in the case of [MarkMonitor Inc., Thomson Reuters Canada Limited, Thomson Reuters Organization LLC, and Thomson Reuters Corporation v. Domain Admin, E-Promote](#), WIPO Case No. D2016-0693 (“Assisting the Panel in its conclusions regarding this element of the Policy is Complainants’ accepted contention that Respondent has registered thousands of domain names, with many of such registrations of dubious legitimacy. Moreover, confirmation of Respondent’s propensity toward abusive cybersquatting behavior is suggested in the numerous adverse rulings rendered against Respondent by prior UDRP panels, as kindly submitted for the Panel’s notice in the Complaint. Ergo, the Panel believes that Policy paragraph 4(b)(ii) is also applicable in sustaining a finding of bad faith regarding Respondent’s actions in this case. *See, inter alia, Kiss Nail Products, Inc. v. E-Promote*, [WIPO Case No. D2009-1303](#); *Pfizer Inc., Pfizer Ireland Pharmaceuticals v. E-Promote*, [WIPO Case No. D2009-0532](#); *VeriSign Inc. v. Domain Admin, E-Promote*, [WIPO Case No. D2006-1501](#)”).

7.56 The fact that Respondent has listed the Domain Name for sale on Sedo with a minimum asking price of \$500, which is in excess of his out of pocket expenses, is evidence of bad faith registration and use, as found in [Andrey Ternovskiy dba Chatroulette v. Domain Administrator, See PrivacyGuardian.org / Hank Foster, Hank Media LLC](#), WIPO Case No. D2017-0418.

7.57 Respondent knowingly chose a domain name consisting of Complainant’s Trademarks in combination with another descriptive term, or alternatively was willfully blind. Respondent thereby intentionally created a situation which is at odds with the legal rights and obligations of the parties and bad faith may therefore be found (*See, for example Guerlain S.A. v. HI Investments*, WIPO Case No. D2000-

0494; and see [Sociedad Española del Acumulador Tudor S.A. v. Asesoría Materiales Exportación S.L.](#), WIPO Case No. D2005-0621

7.58 Where a domain name is redirected to a malware scam, bad faith registration and use may be found. See [BJ's Wholesale Club v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID: 64382986619850 Whois Privacy Services Pty](#), WIPO Case No. D2015-1601). There is no plausible explanation for having registered the Domain Name in the circumstances, other than it was done to confuse users and to interfere with Complainant's trademarks and reputation.

7.59 Even if the actual beneficial owner of the Domain Name is the named respondent, Mr. Obeye, and not Mr. Toplij, then it must be noted that he just acquired the Domain Name mere days ago, owns thousands of names himself, and as a sophisticated Domainer, would have inquired of Mr. Toplij as to the existence of any notified disputed by a trademark owner such Complainant, or would have conducted his own searches which would have surely revealed Complainant. It is simply implausible that two large scale domainers, both with Prague, Czech addresses, are not in cahoots or business together, particularly in the circumstances of engaging privacy protection following a receipt of a Demand Letter, followed by transfer of the Domain Name.

B. Respondent

Respondent failed to submit a Response in this proceeding.

Preliminary Issue: Required Language of Complaint

The Registrar's registration agreement is available in both English and Czech, meaning Complainant may select whichever of the two languages Complainant prefers. See *FilmNet Inc. v Onetz*, FA 96196 (FORUM Feb. 12, 2001 (finding it appropriate to conduct the proceeding in English under Rule 11, despite Korean being designated as the required language in the registration agreement because Respondent submitted a

response in English after receiving the complaint in Korean and English). Apparently Respondent agreed to both versions of the registration agreement (according to the Registrar). It should be noted Respondent likely understands English because the domain name and resolving website are both in the English language.

Therefore, these proceedings shall be conducted in English.

FINDINGS

- (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.

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 Complainant must prove the following three elements to obtain an order transferring or cancelling a domain name:

- (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 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

Complainant claims rights in the two marks based upon its registration with the Canadian Intellectual Property Office ("CIPO") (LONGO'S—Reg. No. TMA818200, registered Feb. 22, 2012; LONGO'S OWN—Reg. No. TMA419754, registered Nov. 19, 1993). Registration with the CIPO (or any other governmental authority for that matter) suffices to demonstrate rights in a mark under Policy ¶4(a)(i), even if Respondent is located in another country. *See State Farm Mutual Automobile Insurance Company v. VistaPrint Technologies c/o Vistaprint North American Services Corp.*, FA 1617798 (FORUM June 3, 2015) (concluding that "Complainant's valid registration of the STATEFARM.COM mark with the CIPO sufficiently demonstrates Complainant's rights in the mark for purposes of Policy ¶4(a)(i)."). Complainant has rights in the LONGO'S and LONGO'S OWN marks.

Complainant claims Respondent's <mylongos.com> domain name is confusingly similar to Complainant's mark because it wholly appropriates the marks and appends the generic term "my". Addition of a generic term is insufficient to differentiate a disputed domain name from a mark under Policy ¶4(a)(i). A TLD (whether a gTLD, sTLD or

ccTLD) is disregarded under a Policy ¶4(a)(i) analysis because domain name syntax requires TLDs. *See Wiluna Holdings, LLC v. Edna Sherman*, FA 1652781 (FORUM Jan. 22, 2016) (Finding the addition of a generic term and gTLD is insufficient in distinguishing a disputed domain name from a mark under Policy ¶4(a)(i).). Respondent's domain name is confusingly similar to Complainant's marks.

The Panel finds Policy ¶4(a)(i) satisfied.

Rights or Legitimate Interests

Complainant must first make a *prima facie* case Respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶4(a)(ii). Then the burden shifts to Respondent to show it has rights or legitimate interests. *See Hanna-Barbera Prods., Inc. v. Entm't Commentaries*, FA 741828 (FORUM Aug. 18, 2006) (holding that Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under UDRP ¶4(a)(ii) before the burden shifts to 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.").

Complainant claims Respondent is not commonly known by <mylongos.com> and Complainant did not authorize Respondent to register a domain name reflecting the LONGO'S marks. Absent information in the record to the contrary, the WHOIS information and common sense allow the Panel to decide Respondent is not commonly known by the domain name. *See St. Lawrence Univ. v. Nextnet Tech*, FA 881234 (FORUM Feb. 21, 2007) (concluding a respondent has no rights or legitimate interests in a disputed domain name where there was no evidence in the record indicating that Respondent was commonly known by the disputed domain name); *see also Chevron*

Intellectual Property LLC v. Fred Wallace, FA1506001626022 (FORUM July 27, 2015) (finding that Respondent was not commonly known by the <chevron-europe.com> domain name under Policy ¶4(c)(ii), as the WHOIS information named “Fred Wallace” as registrant of the disputed domain name). Using a WHOIS privacy service further suggests a respondent is not commonly known by a disputed domain name. See *CheapCaribbean.com, Inc. v. Moniker Privacy Services*, FA1411001589962 (FORUM Jan. 1, 2015) (“The Panel notes that the WHOIS information merely lists a privacy service as registrant. In light of Respondent’s failure to provide any evidence to the contrary, the Panel finds there is no basis to find Respondent is commonly known by the disputed domain name pursuant to Policy ¶4(c)(ii).”). The WHOIS information of record listed “Ivan Toplij” as the registrant initially, but changed to “Domain Admin” then to “John Obeye” after that. None of these names bears any relationship to the disputed domain name. Respondent is not commonly known by the disputed domain name.

Complainant claims Respondent failed to use <mylongos.com> in connection with a *bona fide* offering of goods and services or for a legitimate noncommercial or fair use under Policy ¶¶4(c)(i) & (iii). The disputed domain name resolves to a website hosting surveys to steal information and money from Internet users for Respondent’s commercial gain. Using a disputed domain name to resolve to survey websites to steal Internet users’ information does not indicate rights and legitimate interests under Policy ¶¶4(c)(i) & (iii). See *Victoria’s Secret Stores Brand Mgmt., Inc. v. egyGossip.com*, FA 1288062 (FORUM Nov. 20, 2009) (finding that Respondent lacked rights and legitimate interests where the disputed domain name was used to solicit the completion of a survey by Internet users). Respondent also tries to insert malware into visitors’ computers. That is not a good faith use of the domain name. Respondent lacks rights and legitimate interests pursuant to Policy ¶¶4(c)(i) & (iii).

Respondent used a privacy service to register the disputed domain name. This means Respondent has done nothing to publicly associate itself with the disputed domain

name. Therefore, Respondent could not have acquired any rights regarding the domain name simply by registering it.

The Panel finds Policy ¶4(a)(ii) satisfied.

Registration and Use in Bad Faith

Complainant claims Respondent registered and uses <mylongos.com> in bad faith because Respondent offers to sell the domain in excess of its out-of-pocket expenses. Offering a domain name for sale for more than out-of-pocket costs of registration and maintenance of the domain is evidence of bad faith under Policy ¶4(b)(i). *See Vanguard Trademark Holdings USA LLC v. Wang Liqun*, FA 1625332 (FORUM July 17, 2015) (“A respondent’s general offer to sell a disputed domain name for an excess of out-of-pocket costs is evidence of bad faith under Policy ¶4(b)(i).”); *see also George Weston Bakeries Inc. v. McBroom*, FA 933276 (FORUM Apr. 25, 2007) (concluding that Respondent registered and was using the <gwbakeries.mobi> domain name in bad faith according to Policy ¶4(b)(i) where it offered it for sale for far more than its estimated out-of-pocket costs it incurred in initially registering the disputed domain name). Respondent offered the domain name for sale for \$500. This Panel knows a “.com” domain costs considerably less than \$500 to register. Respondent acted in bad faith under Policy ¶4(b)(i).

Respondent registered the disputed domain name with a privacy service. In a commercial context, this raises the rebuttable presumption of bad faith registration and use. Respondent has done nothing to rebut that presumption. This Panel is willing to find bad faith on this ground alone.

The Panel finds Policy ¶4(a)(iii) satisfied.

DECISION

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

Accordingly, it is Ordered the <mylongos.com> domain name be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist

Dated: Monday, July 17, 2017