

ADMINISTRATIVE PANEL DECISION

Muitas Ltd v. Jonathan Weld

Case No. D2021-3928

1. The Parties

The Complainant is Muitas Ltd, United States of America (“United States”), represented by Silverstein Legal, United States.

The Respondent is Jonathan Weld, United States.

2. The Domain Name and Registrar

The disputed domain name <clips4crypto.com> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 23, 2021. On November 24, 2021, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On November 24, 2021, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on December 2, 2021, 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 amendment to the Complaint on December 2, 2021.

The Center verified that the Complaint together with the amendment to the 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 December 15, 2021. In accordance with the Rules, paragraph 5, the due date for Response was January 4, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 6, 2022.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on January 28, 2022. 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 a limited liability company organized under the laws of Cyprus. The Complaint states that the Complainant “owns and operates” the website “www.clips4sale.com” (the “Complainant’s website”), although the Complainant’s website indicates that the operators are Tropical Sun Corp. of Matawan, New Jersey (United States), and Tropical Sun Ltd. of Cyprus. It appears from the “Intellectual Property Rights” section of the Complainant’s website that the Complainant (“licensor”) manages the relevant trademark rights for these entities, which operate the business. Therefore, the Panel refers to the three entities collectively hereafter as the “Complainant”.

The browser tab for the Complainant’s website characterizes it as a site offering “Amateur Porn / Fetish Porn Videos”. This accurately describes the site content, which consists of short video “clips” on adult subjects, with warnings that the site is not suitable for children. The Complaint explains that the Complainant’s website has “for several years” provided a platform that allows users “to post and sell audiovisual content through clip stores on the World Wide Web.” The website advertises itself as “the world’s biggest fetish catalog of over 7 million clips” and allows “content creators” to establish a membership and earn commissions based on views of their uploaded videos and images. The site, which is available in 11 languages, also includes a blog, interviews, promotions, and news features. According to the Wikipedia article about the Complainant’s website, “Clips4Sale is the largest clip site on the internet with over 7 million clips and 105,000 independent content producers on its platform.”

The Complainant holds the following United States trademark registrations following a series of assignments, most recently in June 2021:

MARK	REGISTRATION NUMBER	REGISTRATION DATE
CLIPS4SALE.COM (standard characters)	3508680	September 30, 2008
CLIPS4SALE (standard characters)	3554200	December 30, 2008
CLIPS4 (standard characters)	4800900	August 25, 2015
CLIP4 (standard characters)	4814248	September 15, 2015

In addition, the Complainant claims common law rights in CLIPS4SALE. Without further elaboration, the Complainant states that its predecessor in interest registered the domain name <clips4sale.com> on July 21, 2003, and that the Complainant has “extensive common law rights in the CLIPS4SALE mark that began by, at latest, July 21, 2002”. The Panel notes that the Internet Archive’s Wayback Machine has archived screenshots of a website substantially similar to the Complainant’s current website associated with the domain name <clips4sale.com> from 2003 onward.

The Registrar reports that the Domain Name was created on January 13, 2018, and is registered to the Respondent Jonathan Weld, listing no organization and showing a postal address in California, United States and a Gmail address for his contact email.

It does not appear that the Respondent has ever developed an active website associated with the Domain Name. Instead, it has resolved to a landing page headed with the Domain Name and the line, “parked free, courtesy of GoDaddy.com” with a link to the Registrar’s “Domain Broker Service”. Otherwise, the landing page displays third-party, pay-per-click (“PPC”) advertising links, chiefly to sites relating to cryptocurrency trading and video clips.

5. Parties' Contentions

A. Complainant

The Complainant asserts that the Domain Name is confusingly similar to its registered CLIPS4, CLIP4, CLIPS4SALE, and CLIPS4SALE.COM trademarks and its unregistered, CLIPS4SALE common law mark. The Complainant contends that it has not given the Respondent permission to use these marks, and there is no sign that the Respondent is known by a corresponding name or is using the Domain Name in connection with a *bona fide* offering of goods or services.

The Complainant argues that the Respondent's bad faith should be inferred from its "exact reproduction" of the dominant portion of the Complainant's arbitrary and well-known marks and its failure to use the Domain Name for any purpose other than PPC parking. This has the result of misdirecting Internet users for commercial gain. The Complainant concludes that there is "no plausible circumstance under which the Respondent could legitimately register or use the Disputed Domain Name and that, therefore, the Disputed Domain Name was registered and is being used by the Respondent in bad faith."

B. Respondent

The Respondent did not submit a Response to the Complaint. On January 6, 2022, immediately following the Center's notification of the Respondent's default, a person called "Jon Frost" sent an email to the Center saying simply, "I would [sic] to get more information about the complaint". This person did not reply to the Center's email in response.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest a respondent of a domain name, a complainant must demonstrate each of the following:

- (i) the 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 respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

Under paragraph 15(a) of the Rules, "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

A. Identical or Confusingly Similar

The first element of a UDRP complaint "functions primarily as a standing requirement" and entails "a straightforward comparison between the complainant's trademark and the domain name". See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.7. The Complainant holds four trademark registrations including the elements CLIPS4 or CLIP4 and also asserts common law rights in the unregistered mark CLIPS4SALE. It is not necessary to assess the Complainant's claim to common law rights in addition to the registered trademarks, and the Complainant in any event has not submitted sufficient historical evidence of sales, advertising, and public recognition to establish acquired distinctiveness for the unregistered mark on this record (see WIPO Overview 3.0, section 1.3). The distinctive elements CLIPS4 or CLIP4 in the registered marks are incorporated in their entirety in the Domain Name. The Domain Name adds the dictionary term "crypto", a noun, adjective, or combining form in English derived from Greek and meaning "hidden", often referring online to cryptocurrency or

cryptography. The addition of such descriptive terms does not avoid a finding of confusing similarity. See *id.* section 1.8.

As usual, the generic Top-Level Domain (“gTLD”) “.com” is disregarded as a standard registration requirement. See *id.* section 1.11.2.

The Panel finds, therefore, that the Domain Name is confusingly similar to the Complainant’s registered CLIPS4 and CLIP4 formative trademarks for purposes of the Policy, paragraph 4(a)(i) and concludes that the Complainant has established the first element of the Complaint.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy gives non-exclusive examples of instances in which a respondent may establish rights or legitimate interests in a domain name, by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) that the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Because a respondent in a UDRP proceeding is in the best position to assert rights or legitimate interests in a domain name, it is well established that after a complainant makes a *prima facie* case, the burden of production on this element shifts to the respondent to come forward with relevant evidence of its rights or legitimate interests in the domain name. See WIPO Overview 3.0, section 2.1.

The Complainant has established trademark rights, a confusingly similar domain name, a lack of permissive use, and the use of the Domain Name only for PPC advertising. This shifts the burden of production to the Respondent. The Respondent has not come forward with any evidence of rights or legitimate interests, and none are apparent on this record.

The Panel concludes that the Complainant has established the second element of the Complaint.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(b), furnishes a non-exhaustive list of circumstances that “shall be evidence of the registration and use of a domain name in bad faith”, including the following (in which “you” refers to the registrant of the domain name):

“(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

The Complainant characterizes its trademarks as well-known. The Complainant’s website at “www.clips4sale.com” has been in operation for nearly 20 years, and it clearly has a large number of content providers and users, although the Complainant has not quantified the latter. The Complainant argues that its mark is arbitrary and distinctive. This is largely due to the simple replacement of the word “for” in the descriptive phrase “clips for sale” or “clip for sale” with the sound-alike numeral “4”. But that arbitrary and distinctive feature is exactly what the Domain Name mimics, followed by the dictionary word “crypto”. The Panel finds it more likely than not that the Respondent selected the Domain Name to exploit the Complainant’s well-known and distinctive marks, and the Respondent has not come forward to offer an

alternative explanation.

The Respondent has apparently allowed others to profit to date from the likelihood of confusion with the Complainant's trademarks, using the Domain Name for PPC advertising while the Respondent parks the Domain Name for potential future development or resale. This interim use of the Domain Name still accords with the example of bad faith in the Policy, paragraph 4(b)(iv), and the Respondent remains responsible in any event for the use of the Domain Name under the terms of the registration agreement. See WIPO Overview 3.0, section 3.5.

The Panel concludes that the Complainant has established bad faith in the registration and use of the Domain Name within the meaning of the Policy.

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 Domain Name <clips4crypto.com> be transferred to the Complainant.

/W. Scott Blackmer/

W. Scott Blackmer

Sole Panelist

Date: February 11, 2022