

ADMINISTRATIVE PANEL DECISION

Multi Media, LLC v. Super Privacy Service LTD c/o Dynadot
Case No. D2019-2004

1. The Parties

The Complainant is Multi Media, LLC, United States of America (“United States” or “US”), represented by Walters Law Group, United States.

The Respondent is Super Privacy Service LTD c/o Dynadot, United States.

2. The Domain Names and Registrar

The disputed domain names <chaturbate.sex> and <chaturbate.shop> are registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 16, 2019. On August 16, 2019, the Center transmitted, by email, to the Registrar a request for registrar verification in connection with the disputed domain names. On August 19, 2019, the Registrar transmitted, by email, to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on August 23, 2019 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 August 27, 2019.

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”), 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 that the proceedings commenced on September 9, 2019. In accordance with the Rules, paragraph 5, the Center set the due date for Response to September 29, 2019. The Respondent did not submit any response. On September 30, 2019, the Center notified the Parties of the commencement of the Panel appointment process.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on October 11, 2019. 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

As reflected in the registration records for the disputed domain names in the public Whois database (a copy of that record appears in Annex A to the Complaint), the disputed domain names <chaturbate.sex> and <chaturbate.shop> were registered on May 15, 2019, and March 1, 2019, respectively, and will expire on May 15, 2020, and March 1, 2020, respectively.

A. The Complainant's CHATURBATE Marks

As indicated in the Complaint, the Complainant owns two US trademark registrations for the term "chaturbate" both in block letters alone, and in stylized form with a design element (collectively referred to as the "CHATURBATE Marks"). The Complainant has provided, in Annexes F and G, respectively, to the Complaint, copies of its registration certificates for these registrations. Pertinent details of these two registrations are as follows:

- i. CHATURBATE (stylized with a design element)
United States Registration No. 4,988,208; registered: June 28, 2016.

This service mark is registered for use in connection with: "Streaming of audio, visual and audiovisual material via a global computer network; Telecommunication services, namely, transmission of voice, data, graphics, images, audio and video by means of telecommunications networks, wireless communication networks, and the Internet", all in international class 38; and "Providing a web site that gives computer users the ability to upload, exchange and share photos, videos and video logs; Providing an online non-downloadable Internet-based system application featuring technology enabling users to stream live broadcasts of audio, visual and audiovisual material via a global computer network", all in international class 42. The registrant claims that both first use and first use in commerce of each of these marks when used in conjunction with the services in both classes 38 and 42 commenced as of June 30, 2011.

- ii. CHATURBATE (block letters)
United States Registration No. 4,288,943; registered: February 12, 2013.

This service mark is registered for use in connection with: "Streaming of audio, visual and audiovisual material via a global computer network; Telecommunication services, namely, transmission of voice, data, graphics, images, audio and video by means of telecommunications networks, wireless communication networks, and the Internet", all in international class 38; and "Providing a web site that gives computer users the ability to upload, exchange and share photos, videos and video logs; Providing an online non-downloadable Internet-based system application featuring technology enabling users to stream live broadcasts of audio, visual and audiovisual material via a global computer network", all in international class 42. The registrant claims that first use and first use in commerce of this mark when used in conjunction with the services in both classes 38 and 42 commenced as of April 30, 2011, and June 30, 2011, respectively.

B. The Parties and their activities

The Complainant provides adult-themed entertainment content, including streaming audio and video, to its users. It does so through its website, which it owns and operates, at "www.chaturbate.com". A screenshot of the home page of that website appears in Annex E to the Complaint. The Complainant registered its domain name on February 26, 2011, and has been using it in conjunction with its website since June 30,

2011. The Complainant, as part of its affiliate program, offers certain individuals a limited license to use the Complainant's CHATURBATE Marks pursuant to certain terms. Those terms do not include use of either of these marks in an affiliate's domain name. The Complainant believes that the Respondent is one of its prior affiliates.

The Respondent's website at <chaturbate.shop> originally redirected Internet users to a website at <cam.sexy> which provides services that directly compete with the Complainant. A copy of the home page at the <cam.sexy> website, as it appeared on June 28, 2019, is provided in Annex J to the Complaint.

On July 1, 2019, the Complainant sent a cease and desist letter (a copy of which appears in Annex L to the Complaint) to an email address, noted in the "Terms and Conditions" section of the <cam.sexy> website (screenshots of that section appear in Annex K to the Complaint), demanding that the website owner cease use of the Complainant's CHATURBATE Marks and transfer the <chaturbate.shop> disputed domain name to the Complainant. Shortly thereafter, the Respondent began redirecting Internet traffic from <chaturbate.shop> to the Respondent's website at <chaturbate.sex> which is a mirror site of the Complainant's website at <chaturbate.com>. A screenshot of the web page resulting from the re-direction as it occurred on July 9, 2019, appears in Annex M to the Complaint.

On July 30, 2019, the Complainant once again sent a message to that email address which stated that its recipient's (presumably then the Respondent's) use of the Complainant's CHATURBATE Marks in connection with the disputed domain names infringed the Complainant's trademark rights and demanded that the recipient cease and desist from any further use. The Respondent, through its response – a copy of which appears in Annex B to the Complaint, offered to sell the two disputed domain names (and a third domain name which included the mark CHATURBATE, specifically <chaturbate.io>, but which is not the subject of the present dispute) to the Complainant for USD 5,000.

As of August 8, 2019, both of the disputed domain names resolve to the Respondent's adult entertainment websites which each provides services that directly compete with those offered by the Complainant through its own website (a screenshot of the current home pages at the <chaturbate.shop> and <chaturbate.sex> as captured on August 8, 2019 appear in Annexes N and O to the Complaint, respectively.)

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is identical, or at the very least confusingly similar, to its mark CHATURBATE.

Specifically, the disputed domain names <chaturbate.sex> and <chaturbate.shop> contain this mark to which the generic Top-Level Domains ("gTLDs") ".sex" and ".shop", respectively, have been appended, with these gTLDs failing to sufficiently distinguish either name from the mark so as to avoid confusing Internet users.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in UDRP paragraph 4(a)(i).

(ii) Rights or Legitimate Interests

The Complainant contends that, for various reasons, the Respondent has no rights or legitimate interests in either of the disputed domain names pursuant to paragraphs 4(a)(ii) and 4(c) of the Policy.

Specifically, the Respondent is not commonly known by the name “chaturbate” and, given the Complainant’s prior exclusive rights in its mark CHATURBATE, could never have been so known. In that regard, the Respondent did not register the disputed domain names <chaturbate.shop> and <chaturbate.sex> until March 1, 2019, and May 15, 2019, respectively, and did not begin offering its competing services until then – some six years after the Complainant first registered its mark CHATURBATE and eight years after it began use of that mark and thus, through its use, started acquiring legal rights of exclusivity in that mark.

The Respondent registered and uses the disputed domain names, each of which incorporates the Complainant’s mark CHATURBATE, to resolve to its own websites through which it offers adult entertainment services that directly compete with those of the Complainant and, by so doing, intentionally exploit and injure the Complainant’s reputation and goodwill in its mark to the Respondent’s own financial benefit. As these actions reflect bad faith, the Respondent is incapable of showing it has rights or legitimate interests in either of these names.

Further, as the Complainant did not grant the right to any of its affiliates to utilize either of the Complainant’s CHATURBATE Marks in a domain name, the Respondent was not licensed by nor did it have any approval from the Complainant to use the names as it did. For that reason as well, the Respondent’s use of the names was and continues to be illegitimate.

(iii) Registered and Used in Bad Faith

The Complainant also contends that the Respondent has registered and is using the disputed domain names in bad faith in violation of paragraph 4(a)(iii) of the Policy.

The term CHATURBATE is a coined word which the Complainant devised and then used, in conjunction with offering adult entertainment services, including streaming audio and video, approximately eight years prior to the earliest date on which the Respondent registered either name. Since the Respondent used both names in offering competing services identical to those offered by the Complainant, it is inconceivable that the Respondent was unaware of the Complainant, its mark CHATURBATE, and the services which the Complainant offered through its website under its mark, when the Respondent selected and registered both names. Moreover, the Respondent intentionally chose both names for their considerable potential to exploit the goodwill and reputation which the Complainant acquired in its mark CHATURBATE by confusing Internet users as to source, sponsorship, affiliation or endorsement of the Respondent’s website and services relative to those of the Complainant.

Through using the names, the Respondent diverted Internet traffic otherwise destined to the Complainant’s site to the Respondent’s sites instead and, by doing so, deliberately disrupted the Complainant’s business, for the Respondent’s own financial benefit. Specifically, once the Respondent registered the disputed domain name <chaturbate.shop>, it used that name to redirect incoming Internet traffic likely destined to the Complainant’s website to the website <cam.sexy>, which offered services directly competing with those then offered by the Complainant’s website. A short time after the Complainant sent its cease and desist letter, the Respondent used both disputed domain names to redirect ensuing Internet traffic to the Respondent’s website at <chaturbate.sex> that mirrored the Complainant’s website. After the Respondent refused the Complainant’s demand to transfer both disputed domain names, the Respondent then used both names to resolve to different adult entertainment websites which also offered services directly competitive with those offered by the Complainant through its own website.

Furthermore, the Respondent’s unsolicited offer to sell the disputed domain names (as well as another not the subject of the present proceeding) to the Complainant for USD 5,000 – a sum in excess of its costs of registration, the offering having been made only after the Respondent received the Complainant’s cease and desist letter which explicitly put it on notice of the Complainant’s registered CHATURBATE Marks and its exclusive rights in those marks, also reflects bad faith.

Lastly, the Respondent's attempt to conceal its identity by registering the names through a privacy service is additional evidence of bad faith.

B. Respondent

In view of the lack of any Response, this administrative proceeding continued by way of default. Hence, under paragraphs 5(f), 14(a), and 15(a) of the Rules, the Panel decided this proceeding on the basis of the Complainant's undisputed factual allegations which the Panel finds are not inherently implausible.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that both of the present disputed domain names <chaturbate.sex> and <chaturbate.shop> are, for all practical purposes, identical to the Complainant's mark CHATURBATE.

The only difference between each of these disputed domain names and the mark is merely the appending of a corresponding one of gTLDs ".sex" and ".shop", to the CHATURBATE Marks, with this addition generally being ignored in assessing confusing similarity/identity. Well-established UDRP precedent holds that "the addition of a gTLD, the deletion of spaces or other such trifling changes are *de minimus*, if not completely irrelevant, in assessing confusing similarity/identity and thus are typically ignored". See, e.g., *Jelani Jenkins v. Amy Lewis*, WIPO Case No. D2014-0695.

Though ".sex" and ".shop" are two of the so-called "new" TLDs, as contrasted with the conventional gTLDs of, e.g., ".com" (the gTLD in the domain name at issue in *Jelani Jenkins*), ".org", and ".net", nevertheless the gTLD, whether "new" or conventional, used in a domain name is viewed as a standard registration requirement and as such continues to be disregarded in assessing confusing similarity or identity. See, section 1.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0").

Hence, the Complainant has satisfied its burden under UDRP paragraph 4(a)(i).

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to either of the disputed domain names under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize the Complainant's mark CHATURBATE in a domain name.

Further, it is clearly evident to the Panel that the Respondent has not used either of the disputed domain names in connection with a *bona fide* offering of goods or services or made any prior demonstrable preparations to do so but rather uses both names, each of which totally incorporates the Complainant's mark CHATURBATE, to resolve to websites that offer adult entertainment services that are identical to and hence directly competitive with those offered by the Complainant through its own website. Using a domain name in a manner that intentionally infringes the exclusive trademark rights of another, let alone as a vehicle through which directly competitive services are offered, fails to qualify as a *bona fide* use under paragraph 4(c)(i) of the Policy. Nor does such a use constitute either a legitimate noncommercial or fair use of the disputed domain name under paragraph 4(c)(iii) of the Policy.

Given the Complainant's exclusive rights in its mark CHATURBATE, which predate the earlier date (March 1, 2019) on which the Respondent registered the disputed domain names, and the recognition, reputation and

good-will which the Complainant likely developed in its CHATURBATE Marks, the Respondent could not legitimately acquire such a public association or even an association with any mark similar to those of the Complainant — at least for the services provided by the Complainant under any of these marks — without interfering with the exclusive trademark rights of the Complainant. See, e.g., *Universal Services of America, LP d/b/a Allied Universal v. This Domain May be for Sale at https://www.networksolutions.com*, *New Ventures Services, Corp*, WIPO Case No. D2019-0834; *Praxis Capital, Inc. v. John C. Martinez, The Praxeology Group LLC*, WIPO Case No. D2019-0254; *Philip Morris USA Inc. v. Daniele Kanai, iKiss LLC*, WIPO Case No. D2015-1527; and *Valero Energy Corporation and Valero Marketing and Supply Company v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID: 62520014085963*, WIPO Case No. D2015-0787. Consequently, the Respondent is not commonly known by either of the disputed domain names or any of the Complainant's marks and hence does not qualify under paragraph 4(c)(ii) of the Policy.

Hence, the Respondent does not fall within any of paragraphs 4(c)(i) to 4(c)(iii) of the Policy and thus has no rights or legitimate interests in either name.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to each of the disputed domain names, constitute bad faith registration and use.

It is categorically clear to the Panel, even apart from any inference that could be drawn from the lack of any Response, that the Respondent was well aware of the Complainant and its mark CHATURBATE, and the potential for those names to cause confusion with the Complainant's mark. Yet, in spite of that knowledge, the Respondent intentionally and purposely registered the names for their potential to cause confusion, disrupt the Complainant's business, and to commercially profit therefrom.

The Respondent's bad faith registration and use becomes patently obvious from collectively viewing several factors present here. First, the CHATURBATE Mark is a unique term coined by the Complainant in conjunction with which it offers its entertainment services. There is no evidence of record that the term ever existed before, whether in English or in any other language. Second, the Complainant offered its services for eight years prior to the Respondent entering the Complainant's market with identical competing services. Third, not only did the Respondent offer identical services, it did so under domain names that identically incorporated the Complainant's mark CHATURBATE. By doing so, the Respondent relied on Internet users, upon entering either of the disputed domain name into their respective browsers and subsequently being diverted to one of the Respondent's websites, becoming confused, by the substantial similarity between that name and the Complainant's mark, as to the origin of the Respondent's services and particularly whether those services emanated from the Complainant – when they did not, or were somehow connected with, sponsored by, or associated with the Complainant – when, in fact, they were not. As the Respondent derived user revenue from the services it offered, it profited from diverting user traffic from the Complainant's website and depriving the Complainant of business and resulting user revenue which otherwise the Complainant might likely have gained. Ultimately, the Respondent injured the Complainant by illicitly and opportunistically exploiting the goodwill and reputation of the Complainant's mark for the Respondent own commercial benefit.

Bad faith is further shown by the Respondent's actions, with full knowledge of the Complainant's trademark rights and having received its cease and desist letter, of offering the disputed domain names (together with a third domain name at issue in another proceeding) to the Complainant for sale at a price, USD 5,000, that, in all likelihood, was higher than its costs of registration and will yield a profit to the Respondent.

Thus, the Panel finds that the Respondent registered and used each of the disputed domain names: primarily for the purpose of selling it to the Complainant at a profit (in violation of paragraph 4(b)(i) of the Policy), to disrupt the Complainant's business (in violation of paragraph 4(b)(ii) of the Policy) and intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to source, sponsorship, affiliation or endorsement of services on its website

(in violation of paragraph 4(b)(iv) of the Policy).

Consequently, the Respondent's conduct constitutes bad faith registration and use under paragraph 4(b) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient evidence of its allegations, with respect to both disputed domain names to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant.

The Panel now orders that the disputed domain names <chaturbate.sex> and <chaturbate.shop> be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: October 25, 2019