

ADMINISTRATIVE PANEL DECISION

Easy Online Solutions, Ltd. d/b/a MojoHost v. Scott Larsen, Mojo Impact Web Services, Mojo Impact Marketing Solutions
Case No. D2020-2689

1. The Parties

The Complainant is Easy Online Solutions, Ltd. d/b/a MojoHost, United States of America (“United States”), represented by Silverstein Legal, United States.

The Respondent is Scott Larsen, Mojo Impact Web Services, Mojo Impact Marketing Solutions, United States.

2. The Domain Name and Registrar

The disputed domain name <mojoimpacthosting.com> (the “First Disputed Domain Name”) is registered with 1&1 IONOS SE (the “Registrar”). The disputed domain name <mojoimpactwebhosting.com> (the “Second Disputed Domain Name”) is registered with Wild West Domains, LLC (the “Registrar”). The First Disputed Domain Name and the Second Disputed Domain Name are collectively referred to as the “Disputed Domain Names”)

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 14, 2020. On October 15, 2020, the Center transmitted by email to the Registrars a request for registrar verification in connection with the Disputed Domain Names. On October 19, and October 20, 2020, the Registrars transmitted by email to the Center its verification responses confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 October 27, 2020. In accordance with the Rules, paragraph 5, the due date for Response was November 16, 2020. The Respondent did not submit a formal response.

However, the Respondent sent two email communications to the Center on November 4, 2020 and November 13, 2020. Accordingly, on November 17, 2020 the Center informed the Parties that it would proceed to appoint a panel.

The Center appointed Lynda M. Braun as the sole panelist in this matter on November 20, 2020. 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

Founded in 1999, the Complainant is a business that provides computer processing, website hosting, software as a service cloud computing, and data preparation services. The Complainant owns, among others, the following trademarks, registered in the United States Patent and Trademark Office (“USPTO”):

- MOJOHOST, United States Registration No. 4,177,472, registered on July 24, 2012, in International class 42;
- THAT’S GOOD MOJO, United States Registration No. 5,786,802, registered on June 25, 2019, in International class 42;
- MOJOCDN, United States Registration No. 5,879,619, registered on October 8, 2019, in International class 42; and
- MOJOCLOUD, United States Registration No. 5,895,310, registered on October 29, 2019, in International class 42.

The Complainant has offered its services under the MOJOHOST trademark since April 1, 2004, under the THAT’S GOOD MOJO trademark since September 8, 2017, under the MOJOCDN trademark since February 20, 2018, and under the MOJOCLOUD trademark since October 1, 2018, and now offers the services under the foregoing trademarks across a variety of industry sectors. The foregoing trademarks will hereinafter collectively be referred to as the “MOJO Mark”. The Complainant also owns the <mojohost.com>, <thatgoodmojo.com>, <mojocdn.com>, and <mojocloud.com> domain names through which its services are offered.

The Disputed Domain Name <mojoimpacthosting.com> was registered on August 26, 2020, and the Disputed Domain Name <mojoimpactwebhosting.com> was registered on September 9, 2020. The Disputed Domain Names resolve to websites that offer Internet hosting services that are substantially similar to and in direct competition with the Complainant’s services.

5. Parties’ Contentions

A. Complainant

The following are the Complainant’s contentions:

- the Disputed Domain Names are confusingly similar to the Complainant’s trademark;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names; and
- the Disputed Domain Names were registered and are being used in bad faith.

The Complainant seeks the transfer of the Disputed Domain Names from the Respondent to the Complainant in accordance with paragraph 4(i) of the Policy.

B. Respondent

The Respondent did not submit a formal response. However, the Respondent sent two email communications to the Center on November 4, 2020 and November 13, 2020, reproduced in part below:

"[...] As to this matter, I have canceled <mojoimpacthosting.com> and have requested Wild West Domains, LLC to cancel <mojoimpactwebhosting.com>/ I release any and all claims to these domains."

"One domain, mojoimpacthosting.com, has been deleted. Only mojoimpactwebhosting.com remains because it is locked.

To resolve this, please circulate a settlement form, as you suggested.[...]"

6. Discussion and Findings

In order for the Complainant to prevail and have the Disputed Domain Names transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)(i-iii)):

- (i) the Disputed Domain Names are 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 Disputed Domain Names; and
- (iii) the Disputed Domain Names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

This element consists of two parts: first, does the Complainant have rights in a relevant trademark and, second, are the Disputed Domain Names identical or confusingly similar to that trademark. The Panel concludes that the Disputed Domain Names are confusingly similar to the MOJO Mark as set forth below.

It is uncontroverted that the Complainant has established rights in the MOJO Mark based on its registered trademarks for the MOJO Mark in the USPTO. The general rule is that "registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive". *CWI, Inc. v. Domain Administrator c/o Dynadot*, WIPO Case No. D2015-1734. The Respondent has not rebutted this presumption, and therefore the Panel finds that the Complainant has rights in the MOJO Mark.

The Disputed Domain Name <mojoimpacthosting.com> consists of the dominant portion of the MOJO Mark followed by the dictionary terms "impact" and "hosting", and then followed by the generic Top-Level Domain ("gTLD") ".com". The Disputed Domain Name <mojoimpactwebhosting.com> consists of the dominant portion of the MOJO Mark followed by the dictionary terms "impact", "web" and "hosting", and then followed by the gTLD ".com". As stated in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), "in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing".

Numerous UDRP decisions have reiterated that the addition of a dictionary or descriptive word to a trademark is insufficient to avoid confusing similarity. See *Allianz Global Investors of America, L.P. and Pacific Investment Management Company (PIMCO) v. Bingo-Bongo*, WIPO Case No. D2011-0795; *Hoffman-La Roche, Inc. v. Wei-Chun Hsia*, WIPO Case No. D2008-0923; *Nintendo of America, Inc. v. Fernando Sascha Gutierrez*, WIPO Case No. D2009-0434. As stated in section 1.8 of the WIPO Overview 3.0, "where the relevant trademark is recognizable within the disputed domain name, the addition of other

terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element”.

Finally, the addition of a gTLD such as “.com” in a domain name is technically required. Thus, it is well established that such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. D2012-0182.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainant.

B. Rights or Legitimate Interests

Under the Policy, a complainant has to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent carries the burden of production of evidence that demonstrates rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See WIPO Overview 3.0, section 2.1.

There is no evidence in the record suggesting that the Respondent has rights or legitimate interests in the Disputed Domain Names. The Complainant has not authorized, licensed, or otherwise permitted the Respondent to use the Complainant’s MOJO Mark. There is also no evidence that the Respondent is commonly known by the Disputed Domain Names or by any name similar to them. Finally, the Complainant does not have any business relationship with the Respondent and based on the use made of the Disputed Domain Names to resolve to a website in direct competition with the Complainant’s, the Panel finds that the Respondent is not making a *bona fide* offering of goods or services nor making a legitimate noncommercial or fair use of the Disputed Domain Names. See *SoftCom Technology Consulting Inc. v. Olariu Romeo/Orv Fin Group S.L.*, WIPO Case No. D2008-0792 (the close proximity between the goods and services offered by the Complainant and the Respondent indicates that the Respondent is taking advantage of the similarity between Complainant’s mark and the domain name and is doing so for commercial gain).

Accordingly, the Panel finds that the second element of paragraph 4(a) of the Policy has been met by the Complainant.

C. Registered and Used in Bad Faith

The Panel finds that, based on the record, the Complainant has demonstrated the Respondent’s bad faith registration and use of the Disputed Domain Names pursuant to paragraph 4(b) of the Policy.

First, the Disputed Domain Names were registered long after the Complainant first began using the MOJO Mark. The Panel finds it likely that the Respondent had the Complainant’s MOJO Mark in mind when registering the Disputed Domain Names, demonstrating bad faith.

Second, the Respondent demonstrated bad faith registration and use by attracting, for commercial gain, Internet users to the Respondent’s websites that directly compete with and offer the identical services offered by the Complainant, thus creating a likelihood of confusion with the Complainant’s MOJO Mark. The use of a domain name to attract Internet users to a registrant’s website by creating a likelihood of confusion with a complainant’s mark as to the source, sponsorship, affiliation or endorsement of the registrant’s online location for commercial gain demonstrates registration and use in bad faith. Thus, the Respondent’s use of the significant goodwill in the MOJO Mark by registering the Disputed Domain Names and using those Disputed Domain Names to misdirect visitors to the Respondent’s websites demonstrates the Respondent’s bad faith registration and use of the Disputed Domain Names under the Policy, paragraph 4(b)(iv).

Accordingly, the Panel finds that the third element of paragraph 4(a) of the Policy has been met by the Complainant.

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 Disputed Domain Names <mojoimpacthosting.com> and <mojoimpactwebhosting.com> be transferred to the Complainant.

/Lynda M. Braun/

Lynda M. Braun

Sole Panelist

Date: December 4, 2020