

ADMINISTRATIVE PANEL DECISION

Dubizzle Limited BVI v. Rana Anabtawi
Case No. D2016-0843

1. The Parties

The Complainant is Dubizzle Limited BVI of Road Town, Tortola, British Virgin Islands, Overseas Territory of the United Kingdom and Northern Ireland, represented by CSC Digital Brand Services AB, Sweden.

The Respondent is Rana Anabtawi of Fujairah, United Arab Emirates.

2. The Domain Name and Registrar

The disputed Domain Name <dubyzzle.com> 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 April 27, 2016. On April 28, 2016, the Center transmitted, by email, to the Registrar a request for registrar verification in connection with the disputed Domain Name. On April 28, 2016, the Registrar transmitted, by email, to the Center its verification response confirming that the Respondent is listed as the registrant and also 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 that the proceedings commenced on May 4, 2016. In accordance with the Rules, paragraph 5, the due date for Response was set to May 24, 2016. Upon the Respondent's request dated May 24, 2016, the due date for Response was automatically extended until May 28, 2016. A Response was not filed with the Center.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on June 3, 2016. 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. Due to exceptional circumstances, the due date for the Panel's decision to be submitted to the Center was extended from June 17, 2016 to June 24, 2016.

4. Factual Background

As reflected in the registration record for the disputed domain name in the Whois database (a copy of the record appears in Annex 2 to the Complaint), the disputed domain name <dubyzzle.com> was registered on December 31, 2014 and is due to expire on December 31, 2016.

A. The Complainant's DUBIZZLE Marks

The Complainant owns various trademark registrations for the term DUBIZZLE (in block letters) in various countries in the Middle East including Egypt, Kuwait, Lebanon, Jordan, Oman, Qatar, Saudi Arabia and the United Arab Emirates (UAE); and also in Algeria, Pakistan and Tunisia. In Annex 6 to the Complaint, the Complainant has provided a list of its marks along with copies of the registration certificates for some of these marks. The following are details from several of the Complainant's UAE registrations - in the UAE, rights of trademark exclusivity under a registration commence as of its underlying filing date (see Article 16 of UAE Federal law No. 37 of 1992, amended by Federal Law No. 8 of 2002 - of which the Panel takes judicial notice):

1. DUBIZZLE

UAE trademark registration 194181; filing date: June 30, 2013

This mark is registered for use in connection with: "Computer rental; installation and maintenance of computer software; computer programming and computer design services; all services in this class relating to computers, computing apparatus and equipment, computer programming and computer design; design, drawing and commissioned writing services for the compilation of web pages on the Internet; creating and maintaining websites; hosting the websites of others; all services in this class relating to or concerned with the Internet or provided online from the Internet; information services included in this class", all in international class 42.

2. DUBIZZLE

UAE trademark registration 194180; filing date: June 30, 2013

This mark is registered for use in connection with: "Voice, data, sound and image communication services; multimedia communication services; telecommunications services; radio, television, satellite and cable broadcasting services; news agency services; transmission, provision and display of information for business or domestic purposes from a computer stored databank; broadcast of live performances and events; hiring, rental and leasing of communication apparatus and instruments; subscription television and Internet broadcasting services; provision of websites; providing access to and leasing access time to computer data bases; all services in this class relating to or concerned with the Internet or provided online from the Internet; provision and dissemination of information relating to all the aforesaid services", all in international class 38.

3. DUBIZZLE

UAE trademark registration 194179; filing date: June 30, 2013

This mark is registered for use in connection with: "Offering for sale and the sale of goods in the retail and wholesale trade; advertising, promotion and agency services; rental of advertising space; business management services; accountancy services, advisory, consultancy and information services all relating to business and business management; market research services; billing services; publicity and marketing services; subscription and subscriber advisory, information, consultancy and management services; arranging and conducting of trade shows and exhibitions; dissemination of advertising and promotional matter; all services in this class relating to or concerned with the Internet or provided online from the

Internet; provision and dissemination of information relating to all the aforesaid services", all in international class 35.

B. The Parties and Their Activities

The Complainant, founded in 2005 by J.C. Butler and Sims Whatley, is an online classified and community portal serving the Middle East and North Africa (MENA) region.

The Complainant's website, "www.dubizzle.com" which itself was launched in 2005, facilitates trade by providing an online marketplace where sellers can list items for sale and buyers can search listings and connect with sellers. Specifically, the website provides classified ads through which users can buy and sell goods, including vehicles, real estate, tickets, and electronics; and solicit and offer services, such as babysitting, event services, and repairs. The website also allows users to design ads to post on the website and to display ads on profiles across social networking sites, such as Facebook; and search for jobs across numerous locations and industries. A copy of the home page and several lower-level pages from the Complainant's site is provided in Annex 10 to the Complaint, with further business information regarding the Complainant provided in Annex 12 to the Complaint.

The Complainant, with a current presence in 11 countries and over 21 cities, has over 8 million visitors to its website who collectively view more than 290 million pages every month. As indicated in the web traffic analysis reports from Alexa and Compete provided in Annex 9 to the Complaint, the Complainant's website is followed by employees in the UAE of whom 40% are Western expatriates and 20% are from the MENA region.

The Complainant and its subsidiary company, Dubizzle Middle East FZ-LLC, have registered various domain names that incorporate the Complainant's DUBIZZLE Mark including <dubizzle.com>. A list of these names is provided in Annex 8 to the Complaint.

The disputed domain name resolves to the Respondent's website, presently under construction, that displays, on its home page, a sentence stating: "Dubizzle.com, the best FREE place to Buy a house, Sell a car, or Find a job in Middle East." directly below which a banner appears stating: "Coming Soon!" The Respondent's website uses similar red and white coloration and type fonts as on the Complainant's website. A screenshot of the current home page of the Respondent's website is provided in Annex 12 to the Complaint.

On April 13, 2016, the Complainant sent a cease and desist letter to the Respondent's email address specified in the Whois record for the disputed domain name (a copy of the letter message appears in Annex 15 to the Complaint). Subsequently, on April 19, 2016, the Respondent replied, by email, stating that it would transfer the name only if it were reimbursed for: (a) its capital costs (capex) specifically "Registration of Premium Domain Cost", and "Incurred Design and Development Cost", (b) "CAPEX Indexation benefit" for two years; and (c) domain transfer fees. Subsequently, on the same day, the Complainant responded, by email stating that it would only reimburse the Respondent for its "reasonable registration costs for transfer of the name". No further message was forthcoming from the Respondent. See Annex 16 for copies of the April 19th correspondence between the parties.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to its DUBIZZLE Marks.

Specifically, the disputed domain name contains an intentional misspelling of the Complainant's mark

DUBIZZLE as “dubyzzle”. This misspelling is incapable of adding sufficient distinctiveness whatsoever to the disputed domain name to mitigate any resulting user confusion between that name and the Complainant’s Marks.

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

(ii) Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

Specifically, the Respondent is not affiliated or connected with the Complainant and has never been licensed or authorized to use any of the Complainant’s Marks.

Further, there is no evidence indicating that the Respondent is commonly known by the mark DUBIZZLE nor could there ever be any by virtue of the exclusive trademark rights residing in the Complainant – rights that existed before the Respondent registered the disputed domain name. In that regard, the Whois record for the disputed domain name suggests that the Respondent is known as an entity having a name, Rana Anabtawi, which is markedly different than and does not resemble that mark in any way. Moreover, the Complainant has never authorized the Respondent to register a domain name containing that mark, or any variation thereof.

In addition, the Respondent is using the disputed domain name to construct a classified advertisement website by copying the Complainant’s trade dress, which features a red and white color scheme widely associated with Complainant (as shown in the webpages provided in Annex 10 to the Complaint), as well as displaying a modified copy of the Complainant’s registered DUBIZZLE type font, with the intent to deceive Internet users into believing that the Respondent’s website is somehow associated with Complainant – when, in fact, it is not. Such a use, through which the Respondent is passing off its website as related in some fashion to the Complainant, is in itself evidence of the Respondent’s lack of rights and legitimate interests in the disputed domain name.

(iii) Registered and Used in Bad Faith

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

There can be no doubt that the Respondent was well aware of the reputation and goodwill inherent in the Complainant’s mark DUBIZZLE when the Respondent intentionally registered the disputed domain name – a name which is confusingly similar to that mark.

Yet, in spite of that knowledge, the Respondent is deliberately creating a likelihood of confusion, in the minds of Internet users, with the Complainant and its marks by using the disputed domain name as an address of its site which, once completed and operational, will offer very similar, if not identical services, as does the Complainant’s site. Moreover, the Respondent is intentionally employing a similar red and white color scheme and similar type fonts on its website as appears on the Complainant’s site, thus exacerbating the likelihood of confusion. Through the Respondent’s conduct, those users will likely be confused into believing that the Respondent’s website somehow emanates from, is sponsored or endorsed by, or is affiliated with the Complainant – when, in fact, it is not. Consequently, the Respondent’s use of the disputed domain name will improperly divert web traffic and its accompanying commercial business away from the Complainant’s site and instead to the Respondent’s site to the Complainant’s ultimate detriment and the Respondent’s eventual profit. Doing so constitutes bad faith registration and use under paragraph 4(b)(iv) of the Policy.

B. Respondent

Beyond requesting an extension for Response, the Respondent has not taken part in these proceedings. In view of the lack of a Response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(f), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed factual representations.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's Marks.

From a simple comparison of the disputed domain name to the Complainant's mark DUBIZZLE, no doubt exists that the disputed domain name is confusingly similar to it. The disputed domain name consists of a misspelled variant of the mark to which the generic Top-Level Domain ("gTLD") ".com" has been appended, with the addition of the gTLD being irrelevant in this case in assessing confusing similarity or identity under paragraph 4(a)(i) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation to a mark is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Here, the Respondent's misspelling of the Complainant's mark DUBIZZLE as "dubyzzle" (substituting a "y" for the "i") clearly resulted in such a minor variation. See, e.g., *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill*, WIPO Case No. D2015-1842; *Cummins Inc. v. Jamie Lent*, WIPO Case No. D2015-0188; *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, WIPO Case No. D2013-1687; *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703; *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099; *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008; *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072; *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505; *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265; *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878; *BlackRock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627; *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359; *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064; *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952; *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334; *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317; *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766; *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531; *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411; *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824; *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836; *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491; and *National Association of Professional Baseball Leagues, Inc., d/b/a Minor League Baseball v. John Zuccarini*, WIPO Case No. D2002-1011.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's Marks. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

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 the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize the Complainant's mark DUBIZZLE nor does the Complainant have any relationship, affiliation or connection whatsoever with the Respondent.

Further, the Respondent is not actively using the disputed domain name to resolve to an operational website, as the site is presently under construction. Moreover, the record before this Panel does not reflect that the Respondent is making any demonstrable preparations to use the disputed domain name, prior to receiving notice of the dispute, in conjunction with a *bona fide* offering of goods or services.

There can simply be no question that the Respondent was well aware of the Complainant, its DUBIZZLE Marks and the Complainant's exclusive rights in those Marks, and the reputation of and the goodwill inherent in those Marks when the Respondent registered the disputed domain name. Yet, in spite of that knowledge, the Respondent intentionally registered the disputed domain name and will, based on the text on the "coming soon" page, be using it as an address of his website which will offer what will likely be the same or highly similar services as does the Complainant. The only plausible reason for doing so which the Panel can conclude, based on the present record before it, is that the Respondent will deliberately cause confusion with the Complainant's mark DUBIZZLE and, in so doing, attempt to deceive Internet users into believing they will be transacting with the Complainant or an entity which is somehow affiliated, related or connected with the Complainant – when, in fact, they are not – and thus divert business away from the Complainant to its likely detriment. This conduct does not, in any manner, constitute a *bona fide* offering of goods or services.

Accordingly, the Respondent's use of the disputed domain name does not qualify under paragraph 4(c)(i) of the Policy.

The record before the Panel is simply devoid of any evidence which proves that the Respondent actually acquired any recognition in the marketplace to become commonly known by the disputed domain name or a name similar to it. Given the exclusive trademark rights that reside in the Complainant and the substantial reputation now inherent in its DUBIZZLE Marks both through registration and prior use, the Respondent could not legitimately acquire any public association between itself and the Complainant's Marks or even any mark similar thereto, at least for the goods and services provided by the Complainant under its marks. This is so in light of the Complainant's exclusive trademark rights which predate the date, December 31, 2014, when the Respondent registered the disputed domain name. See, e.g., *Philip Morris USA Inc. v. Daniele Kanai, iKiss LLC*, WIPO Case No. D2015-1527; *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; *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill, supra*; *Cummins Inc. v. Jamie Lent, supra*; *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen, supra*; *Forideas Pty Limited v. Movember Organization, supra*; *National Westminster Bank plc v. Steve Mart, supra*; *Tommy Bahama Group, Inc. v. Berno Group International, supra*; *Space Needle LLC v. Erik Olson, supra*; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro, supra*; *Burberry Limited v. Domain Admin, supra*; *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown, supra*; *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc., supra*; and *General Motors LLC v. Carol Schadt, supra*. As such, the Respondent could not likely become commonly known by the disputed domain name or any of the Complainant's Marks for any of the goods and services which are either identical or sufficiently similar to those listed on the Complainant's trademark registrations or with which the Complainant uses its marks without infringing on the exclusive trademark rights of the Complainant. Hence, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Lastly, as the Respondent's illicit use of the disputed domain name clearly does not constitute either a noncommercial or fair use under paragraph 4(c)(iii) of the Policy.

As such, based on the evidence presently before the Panel, the Respondent does not fall within any of

paragraphs 4(c)(i)-(iii) of the Policy. Also, there is simply no evidence that the Respondent has acquired, through any other means, any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

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

It is indisputable that the Respondent was well aware of the Complainant, its reputation and its DUBIZZLE Marks and the exclusive rights which the Complainant then had in those Marks when the Respondent registered the disputed domain name. Yet, in spite of that knowledge and in the absence of any authority to do so from the Complainant, the Respondent intentionally chose and registered the disputed domain name, which is a misspelled variant of the mark DUBIZZLE, for its potential to cause confusion with those Marks.

To opportunistically exploit that confusion, the Respondent then uses the disputed domain name to address its website, though presently under construction, which will offer services that are highly similar, if not identical, to those currently offered on the Complainant's site. To purposely heighten the amount of confusion and increase its illicit exploitation, it appears to the Panel that the Respondent will utilize a rather similar color and type scheme on its website as the Complainant does on its existing website. Consequently, the Panel finds, beyond any reasonable doubt, that the Respondent, through its conduct here, would be deliberately deceiving Internet users into believing they were transacting with the Complainant or a website that would, in some fashion, be affiliated with, or sponsored or endorsed by the Complainant when, in actuality, they were not, to the Complainant's commercial detriment and the Respondent's own pecuniary gain. This conduct is a clear violation of paragraph 4(b)(iv) of the Policy. .

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, 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 disputed domain name <dubyzzle.com> is to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: June 22, 2016