



DECISION

American Chemical Society v. Krzysztof Sienicki / Villa Europa
Claim Number: FA1712001764106

PARTIES

Complainant is **American Chemical Society** (“Complainant”), represented by **Christopher Kelly of Wiley Rein LLP**, Washington D.C., USA. Respondent is **Krzysztof Sienicki / Villa Europa** (“Respondent”), Poland.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**chemarxiv.org**>, registered with **Key-Systems GmbH**.

PANEL

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

David A. Einhorn as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on December 21, 2017; the FORUM received payment on December 27, 2017. The Complaint was received in both Polish and English.

On December 27, 2017, Key-Systems GmbH confirmed by e-mail to the FORUM that the <**chemarxiv.org**> domain name is registered with Key-Systems GmbH and that Respondent is the current registrant of the name. Key-Systems GmbH has verified that Respondent is bound by the Key-Systems GmbH 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 January 5, 2018, the FORUM served the Polish language Complaint and all Annexes, including a Polish language Written Notice of the Complaint, setting a deadline of January 25, 2018 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@chemarxiv.org. Also on January 5, 2018, the Polish language 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 January 30, 2018, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the FORUM appointed David A. Einhorn 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.

Preliminary Issue: Language of the Proceedings

The Panel notes that the Registration Agreement is written in Polish, thereby making the language of the proceedings in Polish.

Pursuant to Rule 11(a), the Panel determines that the language requirement has been satisfied through the Polish language Complaint and Commencement Notification, and, absent a Response, determines that the remainder of the proceedings may be conducted in English.

PARTIES' CONTENTIONS

A. Complainant

Complainant, American Chemical Society, is a non-profit organization chartered by the United States Congress. Complainant is one of the leading sources of authoritative scientific information in the world, and is at the forefront of the chemical industry developing worldwide and is a leading professional home for chemists, and related engineer professions around the world. Complainant is the owner of the CHEMRIXV application filed with the United States Patent and Trademark Office ("USPTO"). (Ser. No. 87/232,607, filed on November 10, 2016.) On December 19, 2017, the USPTO issued a Notice of Allowance. Complainant is preparing its Statement of Use for filing and expects the application to mature to registration in due course. Complainant also holds common law rights in the CHEMRIXV mark based on Complainant's use of the mark which was widely and continuously advertised and promoted throughout the scientific community prior to the registration of Respondent's domain name. Respondent's <chemarxiv.org> is nearly identical and confusingly similar as it contains Complainant's CHEMRXIV mark in its entirety, merely adding the letter "a" and the generic top level domain ("gTLD") ".org."

Respondent does not have rights or legitimate interests in the <chemarxiv.org> domain name. Complainant has not granted respondent permission or license to use the CHEMRXIV mark for any purpose, and sent a cease and desist demand letter to Respondent. Respondent is not using the disputed domain name to make a *bona fide* offering of goods or services or for a legitimate noncommercial or fair use. Rather, Respondent is attempting to divert Internet users to the <chemarxiv.org> domain name in order to pass itself off as being associated with Complainant to financially profit.

Respondent has registered and used the <chemarxiv.org> domain name in bad faith. Respondent is disrupting Complainant's business by contacting Complainant's customers, while using the domain name to attract users to its own webpage for commercial gain. Further, Complainant sent Respondent a cease and desist letter, to which Respondent failed to respond.

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B. Respondent

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Respondent failed to submit a formal Response in this proceeding. Respondent did, however, send various disturbing violent and pornographic unrelated images to the Forum via email correspondence. The Panel notes that the disputed domain name was created on September 16, 2016.

FINDINGS AND 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 that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (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 the 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 it holds common law rights in the CHEMRIV mark and does not currently hold a trademark registration through a governmental agency. Policy ¶ 4(a)(i) does not require a complainant to own a trademark prior to a respondent's registration if it can demonstrate established common law rights in the mark. See *Microsoft Corporation v. Story Remix / Inofficial*, FA 1734934 (FORUM July 10, 2017) (finding that "The Policy does not require a complainant to own a registered trademark prior to a respondent's registration if it can demonstrate established common law rights in the mark."). To establish common law rights in a mark, a complainant generally must prove that the mark has generated a secondary meaning. See *Goodwin Procter LLP v. Amritpal Singh*, FA 1736062 (FORUM July 18, 2017) (holding that the complainant demonstrated its common

law rights in the GOODWIN mark through evidence of “long time continuous use of the mark, significant related advertising expenditures, as well as other evidence of the mark’s having acquired secondary meaning.”). Here, Complainant provides evidence that Complainant’s services using the CHEMRXIV mark were continuously advertised and promoted throughout the scientific community, including to potential users of Complainant’s service, beginning at the time of Complainant’s announcement of the CHEMRXIV service in August 2016. Accordingly, the Panel finds that Complainant holds common law rights in the name for the purposes of Policy ¶ 4(a)(i).

Complainant next claims that Respondent’s <chemarxiv.org> is identical or confusingly similar to CHEMRXIV mark as it includes the entirety of the CHEMRXIV mark, simply adding the letter “a”. The addition of a letter is generally insufficient to distinguish a domain name from a mark per Policy ¶ 4(a)(i). *See OpenTable, Inc. v. Above.com Domain Privacy*, FA 1626187 (FORUM Aug. 10, 2015 (“Respondent’s <oipentable.com> domain name is confusingly similar to the OPENTABLE mark under Policy ¶ 4(a)(i) because the disputed domain merely adds the letter ‘i’ . . .”). As such, the Panel finds that the disputed domain name is confusingly similar to Complainant’s mark for the purposes of Policy ¶ 4(a)(i).

Rights or Legitimate Interests

Complainant contends that Respondent has no rights or legitimate interests in the <chemarxiv.org> domain name. Where a response is lacking, relevant information includes the WHOIS and any other assertions by a complainant regarding the nature of its relationship with a respondent. *See Braun Corp. v. Loney*, FA 699652 (FORUM July 7, 2006) (concluding that the respondent was not commonly known by the disputed domain names where the WHOIS information, as well as all other information in the record, gave no indication that the respondent was commonly known by the domain names, and the complainant had not authorized the respondent to register a domain name containing its registered mark). The Panel notes that while Complainant does not argue whether Respondent is commonly known by the domain name at issue, the WHOIS identifies “Krzysztof Sienicki / Villa Europa” as the registrant. Complainant further alleges that Respondent has never been legitimately affiliated with Complainant, and Complainant has not given Respondent permission to use the mark for any purpose. Accordingly, the Panel agrees that Complainant never authorized Respondent to use the mark, and that Respondent is not commonly known by the <chemarxiv.org> domain name under Policy ¶ 4(c)(ii).

Next, Complainant argues that Respondent’s lack of rights and legitimate interests is demonstrated by its attempts to pass itself off as Complainant in Respondent’s efforts to contact potential users of Complainant’s service and confuse them into believing that Respondent and Complainant are related. Use of a domain name to pass off as a complainant generally is not a use indicative of rights or legitimate interests in the name per Policy ¶ 4(c)(i) or (iii). *See Emerson Electric Co. v. Adilcon Rocha*, FA 1735639 (FORUM July 11, 2017) (finding that respondent’s attempt to pass off as complainant through emails does not constitute a *bona fide* offering of goods or services and, as such, respondent lacked rights or legitimate interests in the disputed domain name); *see also Mortgage Research Center LLC v. Miranda*, FA 993017 (FORUM July 9, 2007) (“Because [the] respondent in this case is also attempting to pass itself off as [the] complainant, presumably for financial gain, the Panel finds the respondent is not using the <mortgageresearchcenter.org> domain name for a *bona fide* offering of goods or services pursuant to Policy ¶ 4(c)(i), or a legitimate noncommercial or fair use pursuant to Policy ¶ 4(c)(iii).”). Complainant provides copies of emails sent by Respondent to Complainant

potential customers with the <chemarxiv.org> domain name, which show that Respondent makes use of the American Chemical Society” name in connection with encouraging users to visit Respondent’s webpage. The Panel agrees that Respondent’s use of the domain name indicates that it lacks rights and legitimate interests in the name per Policy ¶¶ 4(c)(i) and (iii).

Thus, Complainant has also satisfied Policy ¶¶ 4(a)(ii).

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Registration and Use in Bad Faith

Complainant argues that Respondent registered and uses the <chemarxiv.org> domain name in bad faith by disrupting Complainant’s business and using the domain name to attract users to its own website for commercial gain. Using a disputed domain name that disrupts a complainant’s business and trades upon the goodwill of a complainant for commercial gain can evince bad faith under Policy ¶¶ 4(b)(iii) & (iv). *See Microsoft Corporation v. Terrence Green / Whois Agent / Whois Privacy Protection Service, Inc.*, FA 1661030 (FORUM Apr. 4, 2016) (finding the Respondent’s use of the disputed domain names to send fraudulent emails supported a finding of bad faith registration and use under Policy ¶ 4(b)(iii)); *see also Clark Equipment Company v. Namase Patel / Mumbai Domains*, FA1566288 (FORUM July 30, 2014) (“The Panel observes that the Respondent’s disputed domain name leads to a website that features links to products that directly compete with Complainant’s products. The Panel determines that Respondent is attempting to mislead consumers as to Complainant’s affiliation with the disputed domain name, and Respondent likely profits from the resulting confusion. Therefore, the Panel finds evidence of bad faith pursuant to Policy ¶ 4(b)(iv).”). Complainant provides an email by Respondent to Complainant’s customers while using Complainant’s company name, which Complainant claims disrupts its business by diverting customers away from Complainant’s webpage. Complainant also provides a copy of the resolving webpage for the disputed domain name, which appears to display the message “Welcome to ChemArxiv Repository” and features various links, such as “Latest Additions” and “Search Repository.” Accordingly, the Panel agrees that Respondent disrupts Complainant’s business and attempted to commercially benefit off Complainant’s mark in bad faith under Policy ¶¶ 4(b)(iii) & (iv).

Thus, Complainant has also satisfied Policy ¶4(a)(iii).

DECISION

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

Accordingly, it is Ordered that the <chemarxiv.org> domain name be **TRANSFERRED** from Respondent to Complainant.

David A. Einhorn, Panelist
Dated: February 12, 2018

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