



DECISION

TechSmith Corporation v. WAYNE DIXON / FIVE STAR IMPACT LLC

Claim Number: FA1511001647296

PARTIES

Complainant is **TechSmith Corporation** (“Complainant”), represented by **James R. Duby** of **DUBY LAW FIRM**, Michigan, USA. Respondent is **WAYNE DIXON / FIVE STAR IMPACT LLC** (“Respondent”), Panama.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<mediasnagit.com>**, registered with **eNom, Inc.**

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.

Paul M. DeCicco, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on November 16, 2015; the FORUM received payment on November 16, 2015.

On November 18, 2015, eNom, Inc. confirmed by e-mail to the FORUM that the **<mediasnagit.com>** domain name is registered with eNom, Inc. and that Respondent is the current registrant of the name. eNom, Inc. has verified that Respondent is bound by the eNom, Inc. 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 November 18, 2015, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of December 8, 2015 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@mediasnagit.com. Also on November 18, 2015, the 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 December 14, 2015 pursuant to Complainant's request to have the dispute decided by a single-member Panel, the FORUM appointed Paul M. DeCicco 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.

PARTIES' CONTENTIONS

A. Complainant

Complainant contends as follows:

Complainant has rights in the SNAGIT mark through its registration with the United States Patent and Trademark Office ("USPTO") (Reg. No. 2,104,800, registered on October 14, 1997). Respondent's **<mediasnagit.com>** domain name is confusingly similar to the SNAGIT mark because it contains the entire mark, combined with the generic or descriptive term "media" and the generic top-level domain ("gTLD") ".com."

Respondent is not commonly known by the **<mediasnagit.com>** domain name as evidenced by the available WHOIS information. Respondent fails to provide a *bona fide* offering of goods or services or a legitimate noncommercial or fair use because the **<mediasnagit.com>** domain name resolves to a webpage containing pay-per-click links to unauthorized sources of Complainant's products as well as links to competitors of Complainant.

Respondent uses the **<mediasnagit.com>** domain name in bad faith because the resolving webpage contains pay-per-click links to unauthorized sources of Complainant's products as well as links to competitors of Complainant. Respondent registered the **<mediasnagit.com>** domain name in bad faith because it did so with actual knowledge of Complainant's rights in the SNAGIT mark.

B. Respondent

Respondent failed to submit a Response in this proceeding.

FINDINGS

Complainant has rights in the SNAGIT mark through its registration of such mark with the USPTO.

Respondent is not affiliated with Complainant and had not been authorized to use Complainant's trademark in any capacity.

Respondent registered the at-issue domain name after Complainant acquired rights in its relevant trademark.

Respondent uses the **<mediasnagit.com>** domain name to address a webpage containing pay-per-click links to unauthorized sources of Complainant's products as well as links to competitors of Complainant.

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(e), 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 (Nat. Arb. 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

The at-issue domain name is confusingly similar to a trademark in which Complainant has rights.

Complainant's registration of its SNAGIT mark with the USPTO establishes Complainant's rights in such mark for the purposes of Policy 4(a)(i). *See Paisley Park Enters. v. Lawson*, FA 384834 (Nat. Arb. Forum Feb. 1, 2005) (concluding that the complainant had established rights in the PAISLEY PARK mark under Policy ¶ 4(a)(i) through registration of the mark with the USPTO). Such rights exist notwithstanding that Respondent may reside outside the jurisdiction of the trademark's registrar. *See Williams-Sonoma, Inc. v. Fees*, FA 937704 (Nat. Arb. Forum Apr. 25, 2007) (finding that it is irrelevant whether the complainant has registered its trademark in the country of the respondent's residence).

The at-issue **<mediasnagit.com>** domain name contains Complainant's entire SNAGIT trademark prefixed with the generic term "media." The domain name

concludes with the top-level domain name “.com.” However the trivial differences between Respondent’s domain name and Complainant’s SNAGIT trademark are insufficient to distinguish one from the other for the purposes of the Policy.

Therefore, the Panel finds that the <mediasnagit.com> domain name is confusingly similar to Complainant’s SNAGIT mark under Policy ¶ 4(a)(i). See *Am. Express Co. v. MustNeed.com*, FA 257901 (Nat. Arb. Forum June 7, 2004) (finding the respondent’s <amextravel.com> domain name confusingly similar to Complainant’s AMEX mark because the “mere addition of a generic or descriptive word to a registered mark does not negate” a finding of confusing similarity under Policy ¶ 4(a)(i)); see also *Jerry Damson, Inc. v. Tex. Int’l Prop. Assocs.*, FA 916991 (Nat. Arb. Forum Apr. 10, 2007) (“The mere addition of a generic top-level domain (“gTLD”) “.com” does not serve to adequately distinguish the Domain Name from the mark.”).

Rights or Legitimate Interests

Under Policy ¶ 4(a)(ii), Complainant must first make out a *prima facie* case showing that Respondent lacks rights and legitimate interests in respect of an at-issue domain name and then the burden, in effect, shifts to Respondent to come forward with evidence of its rights or legitimate interests. See *Hanna-Barbera Prods., Inc. v. Entm’t Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006).

Respondent lacks both rights and legitimate interests in respect of the at-issue domain name. Respondent is not authorized to use Complainant’s trademark in any capacity and, as discussed below, there are no Policy ¶ 4(c) circumstances from which the Panel might find that Respondent has rights or interests in respect of the at-issue domain name.

WHOIS information for the at-issue domain name lists “WAYNE DIXON” and “FIVE STAR IMPACT LLC” as the domain name’s registrant and registrant

organization and there is nothing in the record that otherwise suggests that Respondent is commonly known by the **<mediasnagit.com>** domain name. Therefore, the Panel finds that Respondent is not commonly known by the at-issue domain name pursuant to Policy ¶ 4(c)(ii). See *Compagnie de Saint Gobain v. Com-Union Corp.*, D2000-0020 (WIPO Mar. 14, 2000) (finding no rights or legitimate interest where the respondent was not commonly known by the mark and never applied for a license or permission from the complainant to use the trademarked name).

Respondent's **<mediasnagit.com>** domain name addresses a webpage containing pay-per-click links to unauthorized sources of Complainant's products as well as links to competitors of Complainant. The **<mediasnagit.com>** website, displays links such as "Special Snagit Promo Code," "All-New Adobe Captivate 9," "Record Screen Free," and, "Snagit Screen Capturing." Using the confusingly similar domain name in this manner suggests neither a *bona fide* offering of goods or services under Policy ¶ 4(c)(i), nor a legitimate noncommercial or fair use under Policy ¶ 4(c)(iii). See *Disney Enters., Inc. v. Kamble*, FA 918556 (Nat. Arb. Forum Mar. 27, 2007) (holding that the operation of a pay-per-click website at a confusingly similar domain name was not a *bona fide* offering of goods or services under Policy ¶ 4(c)(i) or a legitimate noncommercial or fair use under Policy ¶ 4(c)(iii)); see also, *Microsoft Corp. v. BARUBIN*, FA 1174478 (Nat. Arb. Forum May 6, 2008) ("Respondent maintains a website at <msnmessenger2008.com> which appears to sell Complainant's products and services and contains links to other third-party websites. Such use of the domain name is neither a *bona fide* offering of goods or services under Policy ¶ 4(c)(i) nor a legitimate noncommercial or fair use under Policy ¶ 4(c)(iii).").

Given the forgoing and without any contrary evidence from Respondent to overcome the evidence set forth by Complainant, Complainant satisfies its

burden under Policy ¶ 4(a)(ii) and conclusively demonstrates Respondent's lack of rights and lack of interests in respect of the at-issue domain name.

Registration and Use in Bad Faith

The domain name was registered and used in bad faith. As discussed below, Policy ¶4(b) specific bad faith circumstances as well as other circumstance are present which compel the Panel to conclude that Respondent acted in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

As discussed above with regard to Policy ¶ 4(a)(ii), Respondent's **<mediasnagit.com>** domain name addresses a webpage containing pay-per-click links to unauthorized sources of Complainant's products as well as links to competitors of Complainant. Such use of the confusingly similar domain name demonstrates Respondent bad faith pursuant to Policy ¶ 4(b)(iv). *See Associated Newspapers Ltd. v. Domain Manager*, FA 201976 (Nat. Arb. Forum Nov. 19, 2003) ("Respondent's prior use of the <mailonsunday.com> domain name is evidence of bad faith pursuant to Policy ¶ 4(b)(iv) because the domain name provided links to Complainant's competitors and Respondent presumably commercially benefited from the misleading domain name by receiving 'click-through-fees.'"); *see also AltaVista Co. v. Krotov*, D2000-1091 (WIPO Oct. 25, 2000) (finding bad faith under Policy ¶ 4(b)(iv) where the respondent's domain name resolved to a website that offered links to third-party websites that offered services similar to the complainant's services and merely took advantage of Internet user mistakes).


Additionally, Respondent registered the **<mediasnagit.com>** domain name knowing that Complainant had trademark rights in the SNAGIT trademark. Respondent's prior knowledge is evident from the notoriety of Complainant's trademark along with the fact that the mark was brashly displayed on Respondent's **<mediasnagit.com>** webpage. Given the forgoing, it is clear that

Respondent intentionally registered the at-issue domain name to exploit its trademark value, rather than for some benign reason. Respondent's prior knowledge of Complainant's trademark further indicates that Respondent registered and used the <mediasnagit.com> domain name in bad faith pursuant to Policy ¶ 4(a)(iii). See *Minicards Vennootschap Onder Flrma Amsterdam v. Moscow Studios*, FA 1031703 (Nat. Arb. Forum Sept. 5, 2007) (holding that respondent registered a domain name in bad faith under Policy ¶ 4(a)(iii) after concluding that respondent had "actual knowledge of Complainant's mark when registering the disputed domain name").

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 <mediasnagit.com> domain name be **TRANSFERRED** from Respondent to Complainant.



Paul Michael DeCicco, Esq.
Arbitrator

Paul M. DeCicco, Panelist

Dated: December 14, 2015