



## DECISION

Gerben Perrott PLLC v. assaf ghalib / gltrvler  
Claim Number: FA2208002006775

### PARTIES

Complainant is **Gerben Perrott PLLC** ( “Complainant” ), represented by **Josh Gerben** of **Gerben Perrott PLLC**, District of Columbia, USA. Respondent is **assaf ghalib / gltrvler** ( “Respondent” ), Michigan, USA.

### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<ggerbenlaw.com>**, registered with **GoDaddy.com, LLC**.

### 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.

Debrett G. Lyons as Panelist.

### PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on August 2, 2022; the FORUM received payment on August 2, 2022.

On August 3, 2022, GoDaddy.com, LLC confirmed by e-mail to the FORUM that the **<ggerbenlaw.com>** domain name is registered with GoDaddy.com, LLC and that Respondent is the current registrant of the name. GoDaddy.com, LLC has verified that Respondent is bound by the GoDaddy.com, LLC 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 August 5, 2022, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of August 25, 2022 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@ggerbenlaw.com. Also on August 5, 2022, 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 August 30, 2022, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the FORUM appointed Debrett G. Lyons as Panelist (the "Panel").

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 asserts trademark rights in **GERBEN** and submits that the domain name is confusingly similar to its trademark.

Complainant alleges that Respondent has no rights or legitimate interests in the disputed domain name.

Complainant alleges that Respondent registered and used the disputed domain name in bad faith.

##### **B. Respondent**

Respondent failed to submit a Response in this proceeding.

#### **FINDINGS**

The factual findings pertinent to the decision in this case are that:

1. Complainant provides legal services by reference to, *inter alia*, the registered trademark **GERBEN**;
2. Complainant also uses the trademark **G GERBEN LAW FIRM PLLC** registered with the United States Patent & Trademark Office ("USPTO") as Reg. No. 4,098,954, registered February 14, 2012;
3. there is no relationship between the parties and Complainant has not authorized Respondent to use its **GERBEN** trademark, or any trademark including the word **GERBEN**, or register any domain name incorporating that trademark; and

4. the disputed domain name was registered on May 4, 2022, and presently resolves to Complainant's website.

## **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 the domain name be 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 based on 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<sup>i</sup>.

### **Identical and/or Confusingly Similar**

Paragraph 4(a)(i) of the Policy requires a two-fold enquiry—a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark.

Paragraph 4(a)(i) of the Policy does not distinguish between registered and unregistered trademark rights. It is well established by decisions under this Policy that a trademark registered with a national authority is evidence of trademark rights<sup>ii</sup>. For the purposes of the following comparison, the Panel relies upon Complainant's proof of its USPTO registration for **G GERBEN LAW FIRM PLLC** and finds that Complainant has established trademark rights.

Complainant states that it “offers legal services to consumers, particularly intellectual property law services”, and so the Panel was surprised by the submission that “[t]he Infringing Domain Name registered by Respondent is confusingly similar to the GP Website through the practice known as ‘typo-squatting.’” To be clear, the required comparison is that of the disputed domain name with the trademark, not Complainant's website address or content. Further, consideration of “typo-squatting” is more appropriate to the remaining

elements of the Policy and pertinently, 'bad faith'; properly understood, paragraph 4(a)(i) of the Policy concerns only the question of whether the compared terms are confusingly similar, not Respondent's intention behind the choice of the domain name.

In this case, the analysis is elementary. The disputed domain name deletes the descriptive word "FIRM" and the corporate abbreviation "PLLC" from the trademark and adds the gTLD, ".com". Those alterations do not carry any distinctive value and the trademark remains the recognizable part of the disputed domain name. It follows that the Panel finds the disputed domain name to be confusingly similar to the trademark for the purposes of paragraph 4(a)(i) of the Policy<sup>iii</sup>.

Accordingly, Complainant has satisfied the first element of the Policy.

#### **Rights or Legitimate Interests**

Paragraph 4(c) of the Policy states that any of the following circumstances, in particular but without limitation, if found by the Panel to be proved, based on its evaluation of all evidence presented, shall demonstrate rights or legitimate interests to a domain name for purposes of paragraph 4(a)(ii) of the Policy:

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Complainant need only make out a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain name, after which the onus shifts to Respondent to rebut that case by demonstrating those rights or interests<sup>iv</sup>.

The publicly available Whois information shielded the name of the underlying domain name registrant by a privacy service provider but in consequence of these proceedings the Registrar disclosed the name of the actual holder as **assaf ghalib / gltrvler**. Neither name provide any *prima facie* evidence that Respondent might be known by the disputed domain name. There is nothing

else to suggest that Respondent is commonly known by the domain name and there is no evidence it has trademark rights of its own.

Complainant states that “[w]hile [the disputed domain name is] now redirecting to the Complainant’s website, Respondent’s Infringing Domain Name offered advertisements to third-party websites, as evidenced by the Google cached information in **Exhibit E.**” Although not entirely clear, Exhibit B seems to suggest that, at earlier times, an Internet user who entered some or all of the disputed domain name into a browser may have been misled to the website of a Taiwanese homeware business. In any case, the Panel has verified for itself that, presently, the disputed domain name redirects Internet users to Complainant’s homepage, a use which UDRP panelists agree by consensus does not give rise to rights or a legitimate interest under this aspect of the Policy.

The Panel finds that Complainant has made a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain name since the use is not a *bona fide* offering of goods or services or legitimate noncommercial or fair use under the Policy.

The onus shifts to Respondent to establish a legitimate interest and, absent a Response, that *prima facie* case is not rebutted. The Panel finds that Respondent has no rights or interests and so finds that Complainant has satisfied this second limb of the Policy.

### **Registration and Use in Bad Faith**

Complainant must prove on the balance of probabilities both that the disputed domain name was registered and used in bad faith.

Guidance is found in paragraph 4(b) of the Policy which sets out four circumstances, any one of which is taken to be evidence of the registration and use of a domain name in bad faith if established.

The four specified circumstances are:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent’s documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from

reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or

- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, respondent has intentionally attempted to attract, for commercial gain, Internet users to respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the site or location.

Complainant states that "Respondent has clearly intended to capitalize upon the goodwill associated with GERBEN Marks, and this conduct falls squarely within the conduct described in ICANN Policy ¶ 4 (b) (iii) and (iv)." Complainant goes on to state that:

"... the one-letter change does not alter the overall commercial impressions of the Infringing Domain Name and is intended to capture business from Internet users who make a typographical error. Internet users may often accidentally type the first letter of a domain name twice and will usually correct the error when notified of their mistake. However, the Respondent takes advantage of this commonplace error, deceiving consumers and preying on their mistake to attract business for their gain and to the detriment of the Complainant. This deception will lead potential GP customers to believe that they are accessing the genuine Gerben Website, leading to confusion and irreparable harm to the GERBEN Marks. Consumers will incorrectly believe that the Infringing Domain Names and the websites operated under or otherwise related to the domain names are associated, affiliated with, sponsored, or endorsed by GP."

There being only the use described, it makes no sense to this Panel to characterise the parties as 'competitors'. The Panel does not find that the use is likely to either capture (Complainant's) business or be to the gain of Respondent and detriment of Complainant in the sense of business lost to a competitor by reason of some deception or confusion. The Panel is not convinced that subparagraph 4(b)(iii) is apt.

On the other hand, there is an argument that paragraph 4(b)(iv) has application by reason of the historical use of the domain name, apparently redirecting

Internet users to an online location having no association with Complainant's business.


The Panel has already found the disputed domain name to be confusingly similar to the trademark. In terms of the Policy, the Panel finds that Respondent has, in the past, intentionally used the domain name to attract, for commercial gain in some form or another, Internet users to the resolving website by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of that website.

The Panel finds registration and use in bad faith and so finds that Complainant has satisfied the third and final element of the Policy.

## DECISION

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

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

  
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Debrett Gordon Lyons, Esq.  
Arbitrator

Debrett G. Lyons, Panelist  
Date: September 6, 2022

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<sup>i</sup> See, for example, *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; *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.")

<sup>ii</sup> See, for example, *State Farm Mut. Auto. Ins. Co. v. Periasami Malain*, FA 705262 (FORUM June 19, 2006) ("Complainant's registrations with the United States Patent and Trademark Office of the trademark, STATE FARM, establishes its rights in the STATE FARM mark pursuant to Policy, paragraph 4(a)(i).")

<sup>iii</sup> See, for example, *Bloomberg Finance L.P. v. Nexperian Holding Limited*, FA 1804001782013 (FORUM June 4, 2018) holding: "Where a relevant trademark is recognisable within a disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element."); see also,

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*Twitch Interactive, Inc. v. Antonio Teggi*, FA 1626528 (FORUM Aug. 3, 2015) finding <twitcch.tv> confusingly similar to the TWITCH TV trademark for obvious reasons.

<sup>iv</sup> See, for example, *Do The Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000).