



## DECISION

TechSmith Corporation v. John Edwards

Claim Number: FA1606001679106

### PARTIES

Complainant is **TechSmith Corporation** (“Complainant”), represented by **James R. Duby** of **DUBY LAW FIRM**, Michigan, USA. Respondent is **John Edwards** (“Respondent”), California, USA.

### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<screencast.live>**, registered with **Uniregistrar Corp.**

### PANEL

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

Richard Hill as Panelist.

### PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on June 12, 2016; the FORUM received payment on June 12, 2016.

On June 14, 2016, Uniregistrar Corp confirmed by e-mail to the FORUM that the **<screencast.live>** domain name is registered with Uniregistrar Corp and that Respondent is the current registrant of the name. Uniregistrar Corp has verified

that Respondent is bound by the Uniregistrar Corp 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 June 15, 2016, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of July 5, 2016 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@screenecast.live. Also on June 15, 2016, 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.

On June 16, 2015, and again on July 7, 2016, Respondent sent E-Mails to the Forum, copying Complainant.

Having received no formal response from Respondent, the FORUM transmitted to the parties a Notification of Respondent Default.

On July 13, 2016, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the FORUM appointed Richard Hill 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 uses the SCREENCAST.COM mark in connection with computer services, namely hosting online web facilities and applications for others for the sharing of digital screenshots and digital audio, video, textual, and multimedia content. Complainant registered the SCREENCAST.COM mark in the USA in 2008.

According to Complainant, the disputed domain name is confusingly similar to Complainant's mark as it fully incorporates the significant part of the SCREENCAST.COM mark and merely adds the generic top-level domain ("gTLD") ".live." Complainant cites UDRP precedents to support its position.

Complainant alleges that Respondent has no rights or legitimate interests in the disputed domain name. Respondent is not commonly known by the domain. Further, Respondent has failed to use the disputed domain name in connection with a *bona fide* offering of goods or services, or for a legitimate noncommercial or fair use. Rather, the webpage that resolves from the disputed domain name features unauthorized links to Complainant's products and services and links to competitors of Complainant, which divert Internet users seeking Complainant's website to Respondent's website. Some of the links are to free downloads to

Complainant's computer programs and competing products. Complainant cites UDRP precedents to support its position.

Further, says Complainant, Respondent has engaged in bad faith registration and use of the disputed domain name. Respondent's use of the domain to display competing hyperlinks disrupts and competes with Complainant's business. Respondent intentionally attracts, for commercial gain, Internet users to its website by creating a likelihood of confusion with Complainant's mark. Finally, Respondent registered the disputed domain name with actual knowledge of Complainant's rights in the SCREENCAST.COM mark. This is demonstrated by the fact that the web site at the disputed domain name displays a link to Complainant's services in connection with Complainant's Jing® computer services. Complainant cites UDRP precedents to support its position.

#### B. Respondent

In his E-Mails of June 16, 2016 and July 7, 2016, Respondent states that he was not aware of the trademark issues when he registered the disputed domain name and that he would be happy to transfer the disputed domain name in exchange for reimbursement of the registration fees.

### **FINDINGS**

Complainant owns rights in the mark SCREENCAST.COM with rights dating back to 2008.

The disputed domain name was registered in 2016.

Complainant has not licensed or otherwise authorized Respondent to use its mark.

Respondent is using the disputed domain name to resolve to a web site that contains commercial links to products and services which compete with those 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 substantive 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.").

Prior to dealing with the three elements of the Policy, the Panel will consider whether in light of Respondent's E-Mails, he has consented to transfer the disputed domain name so that the Panel may forego the traditional UDRP analysis and order an immediate transfer of the disputed domain name.

While Respondent has consented to transfer the disputed domain name, he has not done so unconditionally: he requests payment of the registration fees. Complainant has not indicated that it is willing to pay the requested registration fees. Therefore the Panel finds that the Parties do not request identical remedies and so it would not be appropriate to order the transfer without analysing the three elements of the Policy.

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

The disputed domain name is confusingly similar to Complainant's SCREENCAST.COM mark as it fully incorporates the significant part of the mark and merely adds the ".live" gTLD. Panels have decided that the affixation of a gTLD to a domain is inconsequential with regard to a Policy ¶ 4(a)(i) analysis. *See Gardline Surveys Ltd. v. Domain Fin. Ltd.*, FA 153545 (FORUM May 27, 2003) ("The addition of a top-level domain is irrelevant when establishing whether or not a mark is identical or confusingly similar, because top-level domains are a required element of every domain name."). Therefore, the Panel finds that the disputed domain name is confusingly similar to Complainant's mark under Policy ¶ 4(a)(i).

## Rights or Legitimate Interests

Respondent has not been given permission to use Complainant's mark. Further, Respondent is not commonly known by the disputed domain name: the WHOIS information for the domain lists "John Edwards" as the registrant of record. Accordingly, the Panel finds, based on the lack of information contained in the record to the contrary, that Respondent is not commonly known by the domain under Policy ¶ 4(c)(ii). *See State Farm Mutual Automobile Insurance Company v. Dale Anderson*, FA1504001613011 (FORUM May 21, 2015) (concluding that because the WHOIS record lists "Dale Anderson" as the registrant of the disputed domain name, the respondent was not commonly known by the <statefarmforum.com> domain name pursuant to Policy ¶ 4(c)(ii)).

The web site at the disputed domain name features hyperlinks offering products and services which compete with those of Complainant, thus diverting Internet users seeking Complainant's website to Respondent's website. Some of the featured hyperlinks include "ScreenCast" and "Service Desk Overwhelmed?" Panels have found that a respondent's use of competing hyperlinks is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use. *See McGuireWoods LLP v. Mykhailo Loginov / Loginov Enterprises d.o.o.*, FA1412001594837 (FORUM January 22, 2015) ("The Panel finds Respondent's use of the disputed domain names to feature parked hyperlinks containing links in competition with Complainant's legal services is not a *bona fide* offering of goods or services pursuant to Policy ¶ 4(c)(i), and it is not a legitimate noncommercial or fair use pursuant to Policy ¶ 4(c)(iii)."). As such, the Panel finds that Respondent's use of competing hyperlinks is not a *bona fide* offering of goods or services under Policy ¶ 4(c)(i). The Panel finds that, as Respondent here presumably attempts to profit through click-through fees, there can logically be no noncommercial or fair use pursuant to Policy ¶ 4(c)(iii).

## Registration and Use in Bad Faith

As noted above, Respondent uses the disputed domain name to host competing hyperlinks, which disrupt and compete with Complainant's business. Past Panels have decided that a respondent's use of a domain to display links to products and/or services that are in direct competition with a complainant's business constitutes bad faith registration and use pursuant to Policy ¶ 4(b)(iii). *See Univ. of Texas Sys. v. Smith*, FA 1195696 (FORUM July 7, 2008) (finding that using the resolving website to divert Internet users to the complainant's competitors constituted bad faith registration and use under Policy ¶ 4(b)(iii)). For this reason, the Panel finds that Respondent has engaged in bad faith per Policy ¶ 4(b)(iii).

Further, Respondent intentionally attracts, for commercial gain, Internet users to its website by creating a likelihood of confusion with Complainant's mark. Respondent presumably receives referral fees through the use of its domain, and registered the disputed domain name to attract and mislead consumers for its own profit. Prior panels have found that hyperlinks are typically associated with "click-through" fees, and that a respondent's use of such hyperlinks is evidence of bad faith registration and use under Policy ¶ 4(b)(iv). *See Staples, Inc. and Staples the Opffice Superstors, LLC v. HANNA EL HIN / DTAPLES.COM*, FA1404001557007 (FORUM June 6, 2014) ("Therefore, the Panel finds that Respondent registered and is using the <dtaples.com> domain name in bad faith under Policy ¶ 4(b)(iv) because the Respondent is using the disputed domain name to host third-party links to Complainant's competitors from which Respondent is presumed to obtain some commercial benefit."); *see also Pfizer, Inc. v. Suger*, D2002-0187 (WIPO Apr. 24, 2002) (finding that because the link between the complainant's mark and the content advertised on the respondent's website was obvious, the respondent "must have known about the Complainant's mark when it registered the subject domain name"). Therefore, the Panel finds

that Respondent has engaged in bad faith registration and use under Policy ¶  
4(b)(iv).

## 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 <screenecast.live> domain name be **TRANSFERRED** from Respondent to Complainant.



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Dr. Richard Hill  
Arbitrator

Richard Hill, Panelist

Dated: July 14, 2016