



**CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE**  
**DOMAIN NAME DISPUTE**  
**ADMINISTRATIVE PANEL**  
**DECISION**

CIIDRC case number:	<b>18538-UDRP</b>	Decision date: <b>December 27, 2022</b>
Domain Name:	<b>Deeded.com</b>	
Panel:	<b>David Kreider</b>	
Complainant:	<b>Deeded Inc.</b>	
Complainant's representative:	<b>John H. Simpson</b>	
Respondent:	<b>Eric Rabkin/ ICSID Lawyers LLC</b>	
Respondent's Representative:	<b>Scott Miller</b>	

## 1. PROCEDURAL HISTORY

The procedural history of this case was set out in a letter from the Canadian International Internet Dispute Resolution Centre to the Panel:

On October 27, 2022, the Complainant, Deeded Inc., filed a Complaint under the UDRP and the UDRP Rules.

On October 27, 2022, the Registrar of the disputed domain name was notified of this proceeding.

On October 28, 2022, the Registrar transmitted by email to CIIDRC its verification response informing who is the Registrant, Respondent, in this administrative proceeding. The Registrar also confirmed that the <**deeded.com**> domain ("Domain Name") was placed on a Registrar LOCK.

On October 28, 2022, CIIDRC, as Service Provider, confirmed the compliance of the Complaint and commencement of the dispute resolution process.

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Under UDRP Rule 4 and Supplemental Rule 5, CIIDRC notified the Respondent of this administrative proceeding and forwarded a Notice to the Respondent on October 28, 2022 via email.

On November 1, 2022, Mr. Scott Miller, counsel for the Registrant, sent a letter to CIIDRC requesting an extension of the deadline to file a response until December 21, 2022. The extension was granted on November 2, 2022.

The Respondent filed its response timely on December 21, 2022.

The Complainant and the Respondent in this administrative proceeding have elected for a Panel consisting of a single-member.

On December 23, 2022, CIIDRC appointed the undersigned, David L. Kreider, Chartered Arbitrator (UK), as a single-member Panel.

The Domain Name <**deeded.com**> was registered on May 18, 2003.

This matter is conducted under the Uniform Domain Name Dispute Resolution Policy (the Policy) and the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules) of the Internet Corporation for Assigned Names and Numbers (ICANN).

## **2. FACTS ALLEGED BY THE PARTIES**

The Complainant alleges that the Domain Name was registered in bad faith by the Respondent to misdirect internet traffic intended for the Complainant's website to its own website competing for the same consumers. The Domain Name incorporates the entire Complainant's trademark DEEDED which the Complainant has been using extensively for three and a half years and is the subject of a pending application in the Canadian Intellectual Property Office, filed in May 2021.

The Respondent avers that the Complainant is seeking to unjustly deprive the Respondent of its right to use a common dictionary word "DEEDED". The Complainant has not demonstrated the requisite distinctive character of its alleged trademark DEEDED and is not the holder of a trademark registration in Canada. The Respondent has a legitimate interest in using the Domain Name in its plain English language meaning as a tool to legitimately drive traffic to its associated real estate law firm website, which has been in operation since before the creation of the Complainant.

## **3. CONTENTIONS OF THE PARTIES**

- **Complainant**

The Complainant submits that it was incorporated under the name Deeded Inc., on October 8, 2019, and provides a technology platform connecting customers looking to buy, sell or refinance a home in Ontario,

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Alberta and British Columbia, Canada, with real estate lawyers, to simplify the experience of closing real estate transactions. The Complainant describes itself as “the owner of Canadian trademark applications 2108628 and 2108629 for DEEDED and GETDEEDED”.

The Complainant alleges that it launched a website at the domain <deeded.ca> in January 2020, and has at all time since operated under the trade name DEEDED using the DEEDED mark as well as a stylized logo, which are displayed on its website.

The Complainant alleges it has invested over \$1,000,000 in promoting and advertising its services, including its website, social media accounts and other marketing initiatives and that since commencing operations, the Complainant has received “considerable public recognition in respect of its services in Canada. In this regard, the Complainant adduces a number of press articles from local real estate and mortgage trade publications.

The Complaint avers that the Respondent operates a website at the domain <realestatelawyers.ca> using the names Parnes Rothman LLP and Real Estate Lawyers LLP, and that: “Upon investigation, in or around August 2022, the Complainant became aware that the Respondent was using the Domain Name to redirect internet traffic from the Domain Name to the Respondent’s Website at <realestatelawyers.ca>”. The Complaint explains, “Customers seeking the Complainant’s <deeded.ca> website had accidentally entered the Domain Name”, <deeded.com>.

The Complaint alleges that the Respondent has been aware of the Complainant and its DEEDED trademark “since at least as early as July 2021”, and “was therefore aware of the Complainant, the Complainant’s company and the Complainant’s trademark DEEDED when it registered the Domain Name and began using the Domain Name to misleadingly redirect internet traffic to its own website”.

- **Respondent**

The Respondent asserts that the Complainant’s evidence supporting its trademark rights is lacking. The Complainant does not hold a trademark registration in Canada and seeks to unjustly deprive the Respondent of its right to use a common dictionary word, DEEDED. The Respondent has a legitimate interest in using the Domain Name in its plain English meaning as a tool to legitimately drive traffic to its real estate law firm website. The Respondent observes, the Complainant faces a greater onus to present evidence of acquired distinctiveness/secondary meaning since the alleged trademark, DEEDED, is an unregistered trademark comprised solely of a descriptive term not inherently distinctive.

- **Remedy Sought**

The Complainant requests the Domain Name be transferred to it.

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## 4. DISCUSSION AND FINDINGS

### 4.1 Requirements

Under Policy Paragraph 4, the onus is on the Complainant to prove:

1. That the Domain Name is Identical or Confusingly Similar to a trademark or service mark in which the Complainant has rights;
2. That the Registrant has no rights or legitimate interests in the Domain Name; and
3. That the Domain Name has been registered and being used in bad faith.

The Panel will consider each requirement.

### 4.2 Analysis

#### 4.2.1 That the Domain Name is Identical or Confusingly Similar to a Mark in which the Complainant has Rights

That the Domain Name <deeded.com> is identical or confusingly similar to the DEEDED mark in which the Complainant claims to have rights is apparent. The applicable Top Level Domain (“TLD”) in a domain name, e.g., “.com”, is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See, *WIPO Jurisprudential Overview 3.0* at Par. 1.11.1. To satisfy the first element of Paragraph 4, however, the onus is on the Claimant to additionally prove that it enjoys rights in the DEEDED trademark.

The Complaint alleges that the Complainant is “the owner of Canadian trademark applications 2108628 and 2108629 for DEEDED and GETDEEDED”, which were filed concurrently on May 20, 2021. It is well-accepted in UDRP jurisprudence that a trademark application alone cannot establish rights in a mark. *PRGRS, Inc. v. Pak*, D2002-0077 (WIPO April 24, 2002).

As for the Complainant’s claim to common law rights in the DEEDED mark, Paragraph 1.3 of the WIPO Jurisprudential Overview 3.0 provides guidance:

“To establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant’s goods and/or services.

Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys”.

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The WIPO Overview cautions that naked allegations alone will not establish a common law trademark right. Rather, the burden lies with the Complainant to adduce evidence:

“Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning. In cases involving unregistered or common law marks that are comprised solely of descriptive terms which are not inherently distinctive, there is a greater onus on the complainant to present evidence of acquired distinctiveness/secondary meaning”.

The Panel notes at the outset that the term “DEEDED”, in connection with real estate related services, is entirely descriptive, and is a transitive verb in the English language, meaning the act of conveyance or transfer by a signed instrument containing a legal transfer, bargain, or contract, e.g., ‘they deeded the house to her son’. Accordingly, there is a greater onus on the Complainant to present evidence of acquired distinctiveness/secondary meaning.

The Complainant’s evidence consists of an undated screenshot of the Complainant’s website, which it describes as “current” and “representative”, at <deeded.ca>. The Panel notes that, although the Complaint alleges the Complainant’s website at <deeded.ca> was established in January 2020, a search of the internet archive (“Wayback Machine”) reflects that the earliest record (bot crawl) of the Claimant’s website occurred on June 29, 2020, a date six months later. In the event, no evidence is provided to show how the Complainant’s website appeared before the Respondent’s purchase of the Domain Name on April 13, 2022, or how it looked in the period leading to the filing of the Complaint. The Response notes:

“Without evidence demonstrating the use of the Alleged Trademark on the Complainant’s website from its launch until the day the Complaint was filed, the Complainant’s website analytics are of no assistance to the Complainant. For instance, the number of “clicks” alone does not speak to what the users saw on the Complainant’s website, or if they otherwise engaged with the content on the Complainant’s website. Additionally, the date range at the bottom of the chart in the **Complaint Annex I** has been cropped out, as such it is unclear when these clicks or impressions occurred”.

The Panel notes the Complainant’s unsubstantiated allegation it “invested over \$1,000,000 in promoting and advertising its services, including its website, social media accounts and other marketing initiatives ...”. The Complainant has produced no records, receipts, books or accounts, contracts, invoices, tax returns or other documentary or affidavit evidence to support this significant allegation.

While the Complainant has adduced several articles from real estate and mortgage industry publications, and social media screenshots, which refer to the Complainant, Deeded, Inc., and its co-founder and director, Reuven Gorsht, the Panel finds the evidence provided by the Complainant insufficient to establish that the Complainant enjoys unregistered trademark rights under the UDRP in the term “DEEDED”. The Complainant has neither provided any information on actual or former sales under the DEEDED mark, nor any evidence showing how the \$1,000,000 was purportedly spent on promoting and advertising its services in relation to the mark. See, e.g., *Emirates v. Zain Ul Abidin/Peshawar Jobs*, D2013-1353 (WIPO, September 28, 2013).

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As the Complainant has failed to adduce sufficient and credible evidence of any rights in the mark “DEEDED” under the first element of Paragraph 4, which deals with the Complainant’s standing to pursue these administrative proceedings, there is no reason to discuss the second and third elements. The Complainant’s claim fails.

### **4.3 Reverse Domain Name Hijacking**

Under Rule 15(e), based on the evidence and the submissions, the Respondent requests in its Response that the Panel declare that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

The Panel observes in connection with Complainant’s May 20, 2021 trademark applications referable to the DEEDED and GETDEEDED marks, that the column headed “Action History” reflects that the Canadian Intellectual Property Office had issued a “Pre-Assessment Letter” to the Complainant on July 5, 2022. The column headed “Comments” recites “Goods or Services Not Acceptable”. No subsequent entries appear in the “Action History” columns in the official printouts submitted by the Complainant. The Complainant did not mention in its submission having received a “Pre-Assessment Letter”, or any other indication from the Canadian authority in relation to its trademark applications lodged some twenty (20) months ago.

However, the Respondent submitted more recent copies of the Complainant’s same trademark applications, which reflect that the Complainant had subsequently removed any reference to “legal services” as a class of goods or services it provides. The Respondent avers:

“The assertion of bad faith as against the Respondent is ironic given that the Complainant has continuously and unlawfully held itself out as a law firm offering legal services. For example, the Complainant wrongly filed for its Trademark Applications (DEEDED, and GETDEEDED) in association with “legal services” [...], and thereafter, presumably as a result of the Respondent’s taking issue with the Complainant’s deceit, modified the Trademark Applications to remove reference to “legal services”. [...] Moreover, it does not correct third parties when it is wrongly referred to as a law firm, e.g., “Deeded is a technology-focused law firm”.

Because of the Complainant’s failure to submit the complete record of its trademark registration applications to the Canadian authority, the Panel finds the Complainant’s evidence incomplete and misleading.

Finally, the Complainant acknowledges that the Creation Date of the Domain Name was May 18, 2003, which is 16 years before the Complainant’s purported date of incorporation, October 8, 2019. The Complaint recites that the Domain Name was available for purchase on the open internet “at various times after the Creation Date, including specifically on August 1, 2015; January 10, 2016; March 2, 2017; and November 30, 2021 – the latter date being well after the Complainant had secured its <deeded.ca> website to which the Complainant’s official website resolves.

The Respondent has adduced evidence it purchased the Domain Name from the original registrant for the sum of C\$17,158.65 on April 13, 2022, and that the Complainant, at various times, had acquired the domains

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<deeded.homes>; <deeded.vip>; <deeded.net>; <deeded.info>; <deeded.live>; <deeded.ai>; and <deeded.to>, which the Complainant always directed to its website at <deeded.ca>. The Respondent asserts:

“The elevated cost of securing the “.com” domain may have been a deterrent for the Complainant. The cost of securing the Domain [Name] was \$17,158.65 [ ]. [The Complainant] cannot now seek to indirectly acquire the Domain [Name] through a frivolous UDRP proceeding”.

The Panel concurs that the Complainant should rightly be faulted for subjecting the Respondent to the expense and burden of a UDRP proceeding based on a bare-bones Complaint, lacking supporting evidence, and for adducing incomplete and misleading evidence (including, but not limited to, relevant but redacted email correspondence), especially when represented by counsel. The Respondent should have recognized that its Complaint could not succeed on any of the three requisite elements of Policy Paragraph 4.

The Panel finds that the Complainant brought the Complaint in bad faith, within the meaning of Rule 15(e), in an attempt at Reverse Domain Name Hijacking.

## 5. DECISION and ORDER

Under Paragraph 4 of the Policy, Paragraph 15 of the Rules, and Rule 10 of the Supplemental Rules, the Complaint is denied.

Made as of December 27, 2022.

DAVID L. KREIDER



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