Decision for dispute CAC-UDRP-100760

Case number	**CAC-UDRP-100760**
Time of filing	**2014-02-21 11:31:31**
Domain names	**ikase.com**

Case administrator

Name	**Lada Válková (Case admin)**

Complainant

Name	**Yvan Taieb**

Complainant representative

Organization	**Cabinet d'Avocats Tahar & Associés**

Respondent

Organization	**21562719 Ont Ltd**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of the existence of other legal proceedings concerning the <www.ikase.com> domain name (the "Disputed Domain Name").

IDENTIFICATION OF RIGHTS

The Complainant is the proprietor of the following French trade marks:

Registration No. 4009400 for IKASE (word) in Class 18, registered on 3 June 2013.
Registration No. 4013982 for IKASE. (device) in Class 18, registered on 14 June 2013.

The Complainant is the proprietor of the following Community trade mark:

Registration No. 012229977 for IKASE (word) in Classes 16, 18 and 35, registered on 17 October 2013.

The Complainant also asserts that there is a substantial reputation attaching to the IKASE trade mark through its use in France and in other European countries in relation to the sale and distribution of personalised luggage.

The Complainant is also the registered owner of the following domain names: <www.ikase.fr>, <www.icase.fr>, <www.theikase.com>, <www.myikase.com>, <www.ikaseshop.com> and <www.ikasedesign.com>.

FACTUAL BACKGROUND

FACTUAL BACKGROUND

The Complainant, Mr Yvan Taieb, is a French-based individual in the business of selling and distributing personalised luggage. The Complainant owns trade mark rights in the mark IKASE as set out above.

The Respondent, 21562719 Ont Limited, is a Canadian-based limited company which describes itself as a wholesale domain name holder. The Respondent registered the Disputed Domain Name on 14 June 2007.

The Complainant is seeking the transfer of the Disputed Domain Name.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS

COMPLAINANT:

The Complainant submits that the Disputed Domain Name is identical to its registered trade marks and domain names.

The Complainant further submits that the Respondent does not have any rights or legitimate interest in the Disputed Domain Name. The Complainant alleges that the Disputed Domain Name is not seriously exploited by the Respondent. In particular, the Complainant alleges that the Respondent (who has, up until now, remained anonymous through a privacy service affiliated with the registrar <www.fabulous.com>) is using the Disputed Domain Name in bad faith as it is being used as a parking page and is offered for sale through <www.parklogic.com>. The Complainant claims that he has made several attempts to contact the Respondent with a view to purchasing the Disputed Domain Name, but has received no response.

RESPONDENT:

The Respondent is a wholesale domain name holder. It submits that the Complainant's IKASE mark is a generic and descriptive term and that the Complainant has failed to provide sufficient evidence to show that the mark has a substantial reputation. The Respondent claims that it acquires domain names such as <www.ikase.com> for their generic and descriptive potential but takes adequate measures to ensure that it does not infringe trade mark rights by carrying out automated scans against global trade mark databases and "manual eyeballing". The Respondent states that it uses privacy services as a means of protecting it from unsolicited communication.

The Respondent confirms that it parks its domain names with domain parking services and offers them for sale. The Respondent claims that it has not attempted to sell the Disputed Domain Name to the Complainant and that it only become aware of the Complainant through the UDRP process.

The Respondent submits that it could not have registered the Disputed Domain Name in bad faith as it registered the Disputed Domain Name on 14 June 2007 and the Complainant only secured its earliest trade mark registration on 3 June 2013. Accordingly, the Disputed Domain Name was registered approximately six years before the Complainant had any trade mark rights in the word IKASE. The Respondent describes this Complaint as an attempt at reverse domain name hijacking.

The Respondent also claims that the Complainant is using its ex post facto trade mark rights to "phish" for the Disputed Domain Name.

RIGHTS

The Complainant has, to the satisfaction of the Panel, met the requirements of paragraph 4(a)(i) of the Policy. At the date that the Complaint was filed, the Complainant was the owner of a French registered trade mark for IKASE (word) (Registration No. 4009400) and a Community trade mark for IKASE (word) (Registration No. 012229977). As the substantive element of the Disputed Domain Name is identical to these marks (except for the top level domain designation ".com") the Panel finds that the Complainant succeeds under this element of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Panel notes that in view of its findings in relation to bad faith as set out below it is unnecessary to consider this element of the Policy.

BAD FAITH

For paragraph 4(a)(iii) to apply, the onus is on the Complainant to prove, to the satisfaction of the Panel, that the Respondent registered the Disputed Domain Name in bad faith and continues to use it bad faith.

It is well established that, for the purposes of paragraph 4(a)(iii), a domain name that is registered before a trade mark right has been established cannot be found to have been registered in bad faith. In such circumstances, the registrant could not have been aware of the complainant's rights because those rights did not then exist (see John Ode d/ba ODE and ODE – Optimum Digital Enterprises v Internship Limited D2001-0074 and the list of decisions cited therein).

It is clear from the evidence that the earliest the Complainant can claim to have rights in the IKASE trade mark is 3 June 2013 (ie, the registration date of French Registration No. 4009400). The Complainant has provided no evidence of any rights in the IKASE mark prior to this registration. The Disputed Domain Name was registered on 14 June 2007, approximately six years before the Complainant's registration. Further, there is no evidence that the Complainant had used the mark before registration of the Disputed Domain Name in such a way that the Respondent knew, or should have known, of any such use. Therefore the Complainant has failed to established bad faith registration.

As the Complainant has not proved bad faith registration it is not necessary to consider whether the Disputed Domain Name is also being used in bad faith. However, for the sake of completeness, the Panel has considered whether use of the Disputed Domain Name to resolve to a parking site constitutes bad faith. In Laboratoires Thea v DNS Administrator, Domain Spa, LLC D2010-1138 the panel stated that parking pages can be a legitimate use of a domain name if the domain name was registered due to its attraction as a common or generic word. In this case, the Respondent claims that it acquires domain names such as <www.ikase.com> for their generic and descriptive potential. The Panel accepts the Respondent's assertion that there is nothing inherently wrong in this practice. In Deutsche Welle v DiamondWare Limited D2000-1202 the Panel refused to interpret the Policy to mean that a mere offer for sale of a domain name is, of itself, proof of cybersquatting. In circumstances where there is no other indicia of registration or use in bad faith and in particular where the Disputed Domain Name was registered long before the Complainant first used the IKASE mark, a domain name holder, such as the Respondent, should be able to use a generic, descriptive or newly coined term in a domain name which resolves to a parking site with impunity.

Consequently, the Panel finds that the Complainant has not proved that the Respondent registered the Disputed Domain Name in bad faith or that it is being used in bad faith. Therefore the cumulative requirements of paragraph 4(a)(iii) of the Policy have not been met and the Complainant fails under this element of the Policy.

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Complainant has not provided any evidence of bad faith registration or bad faith use of the Disputed Domain Name. The purpose of the Policy is to deter cybersquatting which characterised by bad faith registration and use. In these circumstances, the Panel finds that there is no evidence of bad faith registration and use and therefore the Complainant fails under the third element of the Policy.

Reverse Domain Name Hijacking

Paragraph 1 of the Rules defines reverse domain name hijacking as "using the Policy in bad faith to attempt to deprive a

registered domain-name holder of a domain name." See also paragraph 15(e) of the Rules. For this Panel to find attempted reverse domain name hijacking, the Respondent must show that Complainant knew or must have known of Respondent's "unassailable right or legitimate interest in the disputed domain name or the clear lack of bad faith registration and use, and nevertheless brought the Complaint in bad faith." See Sydney Opera House Trust v. Trilynx Pty. Ltd., D2000-1224.

The Complainant must have or at the least should have known that the Respondent had registered the Disputed Domain Name approximately six years prior to its trade mark registrations. However, the Panel notes that the Complainant tried several times to contact the Respondent in order to purchase the Disputed Domain Name but received no response (the Panel notes that the only evidence to this effect before it is an email dated 28 November 2013 from Mr Taibe's lawyer to support@fabulous.com and a letter from Mr Taibe's lawyer dated 16 January 2014 to WHOIS Privacy Services).

In these circumstances there is, in the Panel's view, nevertheless a reasonable explanation for the Complainant filing its complaint, as it most probably seemed to the Complainant to be the only way that it could contact the Respondent. In these particular circumstances, the Panel is therefore prepared to give the Complainant the benefit of the doubt and considers that, on balance, the Complaint was made in frustration at not having received a response to the Complainant's attempts to contact the Respondent and therefore the requirements for reverse domain name hijacking have not been made out.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **IKASE.COM**: Remaining with the Respondent

PANELLISTS

Name	**Alistair Payne**

DATE OF PANEL DECISION 2014-04-10

Publish the Decision