Decision for dispute CAC-UDRP-101261

Case number	CAC-UDRP-101261
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Domain names	onde.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Multi Brains LLC

Complainant representative

Organization	AAA LAW

Respondent

Organization	Azeras LLC

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings.

IDENTIFICATION OF RIGHTS

According to the evidence submitted by Complainant, Complainant is the owner of the following trademark: Benelux wordmark ONDE number 0999318, registration date 27 July 2016.

FACTUAL BACKGROUND

According to the information provided Complainant is in preparation to use the trademark ONDE in its business activities. Complainant asserts that it created a new business branch which will use the ONDE mark in its services. According to Complainant this is evidenced by the registration of the Benelux trademark, the engagement of a branding agency to develop the brand strategy which concentrates on the ONDE mark and the registration or acquisition of the domain names <onde.eu> and <onde.ee>.

According to the public Whois information the date of first registration of the disputed domain name <onde.com> is 17 September 1996. According to the information provided by the Registrar it is uncertain at what time Respondent became the current registrant. According to Respondent Respondent's registration or acquisition of the disputed domain name was in 2009; Complainant did not contest this information submitted by Respondent. It is thus likely that the trademark registration of Complainant has been issued after the registration or acquisition of the disputed domain name.

PARTIES' CONTENTIONS:

COMPLAINANT:

According to Complainant the disputed domain name is identical to Complainant's Benelux trademark ONDE with an addition of the gTLD prefix .com. Complainant also submits that it relies on a European Union Trademark application for ONDE and the domain names <onde.eu> and <onde.ee>. Complainant asserts that it is in preparation to use the trademark ONDE. According to Complainant it submitted extensive evidence that it hired a branding agency to develop a brand and is in genuine preparations to launch a SaaS service and a website using the disputed domain name <onde.com>. Registrations of other domain names with the ONDE mark (i.e. <onde.eu> and <onde.ee>) also serve as an additional evidence of this preparation. This shows Complainant’s genuine interest in the disputed domain name as opposed to Respondent’s lack of such.

According to Complainant, Respondent has no rights or legitimate interest in the disputed domain name as Respondent does not use the website; the website contains only links to other websites. The Respondent is also hidden under a Whois registration anonymization service.

According to Complainant Respondent failed to demonstrate any legitimate interest in the disputed domain name. Respondent claims that the word “ONDE” is “generic and is the Portuguese word for 'where'. Respondent claims, while living in Brazil in 2009, that it purchased the disputed domain name for development as a Portuguese real estate site and because it was an inherently valuable descriptive term. The project has been put on hold. Complainant argues that these arguments of Respondent are not based on any evidence in the case.

According to Complainant Respondent failed to show any of the three circumstances under Paragraph 4(c) of the Uniform Domain Name Dispute Resolution Policy (“the Policy”).

First, Respondent did not use and demonstrated no intentions to use the disputed domain mane <onde.com> in connection with a bona fide offering of goods or services. On the contrary, the disputed domain name (i) is offered for sale and (ii) is not used in a genuine website manner.

Second, the Respondent is not known by the mark ONDE.

Lastly, the Respondent is not making any legitimate noncommercial or fair use of the domain name. On the contrary, the disputed domain name is offered for sale.

These facts clearly demonstrate that the Respondent has no legitimate interest in the disputed domain name.

According to Complainant the disputed domain name is registered and used in bad faith. Respondent registered and uses the disputed domain name for the sole purpose of selling it. Complainant's communication with Respondent via a messaging platform available at DomainNameSales.com - the portal where the disputed domain name was listed for sale – clearly shows Respondent's intent to sell the disputed domain name for a price in excess of the out-of-pocket costs directly related to the domain name. Additionally, the representative of Complainant contacted Respondent regarding the transfer of the disputed domain name. Respondent offered to sell the disputed domain name for USD 76.000.

This demonstrates Respondent's bad faith as described in Paragraph 4(b)(i) of the Policy.

The fact that (i) Respondent offers the domain name for sale, (ii) the asked price for the disputed domain name is in excess of the out-of-pocket costs directly related to the domain name, (iii) Respondent did not establish a website corresponding to the registered domain name, clearly shows that Responded had no intention to genuinely use the registered domain and registered and uses it in bad faith (Paragraph 4(a)(iii) and 4(b)(i) of the Policy).

Respondent's arguments that he (NB, the Respondent is a company and not a natural person) "purchased the domain name for development as a Portuguese real estate site" are not based on any evidence in the case.

Additionally, the long period of time which passed from the registration until the current dispute during which Respondent could started using the disputed domain name in a genuine manner also demonstrates that Respondent did not have any intentions to use the disputed domain name and registered and uses it for the sole purpose of sale.

It should be also noted, that Respondent failed to reply to the Complainant's Paragraph 4(b)(i) of the Policy based argument (i.e. registration and use primarily for the purpose of selling) and did not refute it in its Response.

Finally, Complainant argues that Respondent hides her/his identity under the Whois proxy service company Whois Privacy Services Pty Ltd and publicly may be identified only by a customer number 76460521999240-73e4ea. This should be considered as an additional argument of Respondent's bad faith.

Complainant concludes that Respondent registered and uses the disputed domain name in bad faith.

RESPONDENT:

According to Respondent the word "Onde" is generic and is the Portuguese word for 'where'. Respondent, while living in Brazil in 2009, purchased the disputed domain name for development as a Portuguese real estate site and because it was an inherently valuable descriptive term. The project has been put on hold. Respondent submits that Complainant does not only have to demonstrate a similarity between the disputed domain name and the claimed mark; Complainant must adequately demonstrate that it has rights in the claimed mark. Complainant has not and cannot demonstrate such rights. While the domain name matches Complainant's trademark registration, Complainant is not using the mark that appears in its registration as a source identifier for goods and services. Complainant obtained a trademark registration by paying a filing fee, not by use of the mark. Complainant has shown no use of its alleged mark or that Respondent's domain name that will lead to confusion or dilution.

According to Respondent Complainant filed their Benelux Trademark application on 22 July 2016 and it was registered only 5 days later, on 27 July 2016, which means they must have filed an Accelerated Trademark registration, which can be completed in a couple of days and holds much less protection for the trademark holder. Since there is less Due Diligence during an Accelerated registration, the registration is still open to cancellation.

Respondent adds that the trademarks of Complainant were only registered to make a claim against Respondent for the disputed domain name. Respondent asserts that the trademark applications were made soon after Complainant made an inquiry for the disputed domain name and learned that price was higher than they hoped. Respondent submits that in an attempt to show actual trademark usage, Complainant is manufacturing additional evidence to support their claims. As one can see in the screenshot of the Onde App in the Apple App Store, the app was just release on 14 October 2016 during this proceeding, and after Respondent's response. Further, the app is not unique in any way, and is simply a copy of Complainant's 'Saytaxi' app. In a similar fashion, the domains <onde.ee> and <onde.eu> were not developed at the time of Respondent's response on 11 October 2016, so Complainant put a quick site up to use for evidence of use.

Respondent submits that it has rights and/or legitimate interest in the disputed domain name. According to Complainant the disputed domain name was registered by Respondent in 2009, 7 years before Complainant claims any rights. Respondent has simply acquired a domain name that incorporates a generic or descriptive phrase and is using in a manner which does no more than take advantage of that generic or descriptive meaning. There has been no capitalization on the trademark value of Complainant because Complainant has not sufficiently established their trademark.

According to Respondent Respondent's registration of the disputed domain name in 2009 predates Complainant's alleged rights in the mark. Respondent submits that Complainant has not obtained any significant distinctiveness, as ratified by

Complainant's plans instead of real world usage. Respondent asserts that Complainant does not have sufficient rights in its mark that predate the registration of the disputed domain name, therefore Respondent necessarily lacked the requisite intent to register the disputed domain name in bad faith under the Policy, paragraph 4(a)(iii). Respondent submits that this is a clear attempt at Reverse Domain Hijacking.

According to Respondent Complainant is very careful not to mention the fact that the Complainant initiated the discussions to purchase the disputed domain name, and began making offers to buy the disputed domain name for far more than the usual costs of registering a domain. It was only after Complainant's offer that Respondent offered the domain for an even larger sum.

RIGHTS

Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Panel decides that Complainant has not proven that Respondent registered and uses the Domain Name in bad faith.

PROCEDURAL FACTORS

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

Procedure - Late and additional submissions by Parties.

Respondent filed his Response on 11 October 2016 after expiry of the deadline set by the Case Administrator. On 17 October 2016 Complainant submitted a Nonstandard Communication/Rebuttal to the Response filed.

After submission of the Rebuttal the Panel decided on 17 October 2016 the following:

a. The Panel decides in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), paragraphs 10 (b) and 12, that Respondent is allowed to submit an additional Response to the Rebuttal submitted by Complainant within ten (10) days, thus before 28 October 2016.

b. In view of these exceptional circumstances the Panel decides in accordance with the Rules, paragraph 10 (c), that the Projected Decision Date is extended and will now be fourteen (14) days after receipt of the additional Response or 11 November 2016 if no additional Response is received, whichever date is earlier.

Respondent submitted an additional Response (Rebuttal to Claimant's Response) on 28 October 2016.

In accordance with the Rules, paragraphs 10 (b) and (d), on behalf of a comprehensive consideration and examination of the case the Panel sees it appropriate to decide to admit Respondent's delayed Response, the additional Nonstandard Communication/Rebuttal filed by Complainant on 17 October 2016, and the additional Response filed by Respondent on 28 October 2016.

On 8 November 2016 Complainant filed another Nonstandard Communication entitled "Claimant's Additional Explanations". The Panel decides that this Communication is not admitted as it is filed much too late.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15(a) of the Rules instructs the Panel to “decide a complaint on the basis of the statements and documents submitted and 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 the complainant proves each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
(ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
(iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied in this proceeding.

In the opinion of the Panel the disputed domain name is identical to Complainant's ONDE Benelux trademark (Policy, paragraph 4 (a)(i)). Many decisions under the Uniform Domain Name Resolution Policy (“UDRP”) have found that a disputed domain name is identical or confusingly similar to a complainant’s trademark where the disputed domain name incorporates the complainant’s trademark or the principal part thereof in its entirety. The addition of the generic Top-Level-Domain (“gTLD") “.com” is insufficient to avoid a finding of identity.

The registration of a domain name before a complainant acquires trademark rights does not prevent a finding of identity or confusing similarity under the UDRP as the UDRP makes no specific reference to the date on which the holder of a trademark acquired rights (see paragraph 1.4 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 2.0”)).

There is no need to show actual use of the trademark or preparation to use the trademark, to show confusion or to prove so-called secondary meaning. Paragraph 4 (a)(i) of the Policy is only a standing requirement which is satisfied if the disputed domain name is identical or confusingly similar to a trademark of Complainant. In view of this there is no need for the Panel to discuss all arguments submitted by Complainant and Respondent with respect to actual or intended usage, nor the fact that the Benelux ONDE trademark was acquired in an accelerated procedure. The Panel adds that even in an accelerated procedure the trademark becomes a valid trademark.

In the opinion of the Panel Complainant has made a prima facie case that Respondent lacks rights or legitimate interest in the disputed domain name. Based on the evidence provided by Complainant, the disputed domain name resolves to a pay-per-click parking website on which it is stated “This domain has recently been listed in the marketplace at domainnamesales.com. Click here to inquire.”. In addition the parking website to which the disputed domain name resolves contains links to various websites including websites completely unrelated to the generic and descriptive meaning of the disputed domain name as asserted by Respondent. Such use cannot be considered a bona fide offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name. Respondent is also not commonly known by the disputed domain name nor has it acquired any trademark rights.

Under these circumstances, the Panel finds that Respondent has no rights or legitimate interests in the disputed domain name (Policy, paragraph 4 (a)(ii)).

Pursuant to paragraph 4(b paragraph 4(a)(iii) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that Respondent registered or acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant (the owner of the trademark or service mark) or to a competitor of that Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the Domain Name; or

(ii) circumstances indicating that Respondent 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) circumstances indicating that Respondent registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that Respondent intentionally is using the Domain Name in an attempt to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on its website or location.

In Mille, Inc. v Michael Burg, WIPO Case No. D2010-2011, the following was stated:

“The Policy, paragraph 4(a)(iii), obliges the Complainant to establish that the Domain Name “has been registered and is being used in bad faith.” The consensus view since the Policy was implemented in 1999 has been that the conjunctive “and” indicates that there must be bad faith both at the time of registration and subsequently. Apart from unusual cases of a respondent’s advance knowledge of a trademark, it is not logically possible for a respondent to register a domain name in bad faith contemplation of a mark that does not yet exist or of which the respondent is not aware. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, paragraph 3.1, and cases cited therein (“Normally speaking, when a domain name is registered before a trademark right is established, the registration of the domain name was not in bad faith because the registrant could not have contemplated the complainant’s non-existent right.”) By contrast, the dispute resolution policies for some top-level domains, such as “.eu” and “.uk”, state the requirement disjunctively, expressly providing that a complainant may prevail by establishing bad faith in the registration “or” use of the domain name. The current Panel recognizes the value, in appropriate cases, of inferences of original intent based on subsequent conduct. But the Panel does not find a compelling Policy or legal basis for retroactively characterizing later abuses as bad faith in the “registration” of a domain name. This Panel is unwilling to overlook the plain language of paragraph 4(a)(iii) of the Policy requiring a conclusion that the domain name has been “registered” and “used” in bad faith. See, e.g., Validas, LLC v. SMVS Consultancy Private Limited, WIPO Case No. D2009 1413; Eastman Sporto Group LLC v. Jim and Kenny, WIPO Case No. D2009-1688. In the Panel’s opinion, reading “registered” as a continuous act that can be abused at any time would appear to make it essentially synonymous with “use” and deprive the conjunctive phrase of its full meaning.“

This Panel accepts the reasoning of the Panel in Mille, Inc. v Michael Burg, WIPO Case No. D2010-2011. Although it is uncertain in which year Respondent acquired the disputed domain name, it is not disputed that Respondent registered or acquired the disputed domain name before the registration of the Benelux trademark by Complainant in July 2016. Since it is not asserted by Complainant that Respondent at the time of registration or acquisition of the disputed domain name knew or should have known of the existence of the ONDE trademark there is no evidence suggesting that the disputed domain name has been chosen by Respondent with the intent to profit from or otherwise abuse Complainant’s trademark rights.

Even if it is obvious that Respondent is making an offer to the general public to sell the disputed domain name and is prepared to sell the disputed domain name to Complainant for an excessive price, it is unlikely that at the time of registration or acquisition Respondent registered or acquired the disputed domain name with Complainant in mind and/or for the purpose of selling the disputed domain name to Complainant, as mentioned in paragraph 4(b)(i) of the policy, in particular as Complainant at the time of registration or acquisition did not own the ONDE trademark and had made no preparation to use the ONDE mark in its business. In the opinion of the Panel this means that on the balance of probabilities Complainant has not proven that Respondent registered the disputed domain name in bad faith.

The Panel adds that the fact that Respondent has been using a privacy registration service and that the website to which the domain name resolves is not actively used, are not in and of itself conclusive indications of bad faith, nor circumstances which could refute the opinion of the Panel that there is no bad faith registration of the disputed domain name.

Under these circumstances the Panel finds that Complainant has not proven that the disputed domain name has been registered and is being used in bad faith (Policy, paragraph 4(a)(iii)).

Respondent seeks a finding of attempted 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.” Paragraph 15 of the Rules permits a finding to this effect only where the complaint as a whole was brought in bad faith or primarily to harass the domain-name holder. In the present case, it is clear that on the basis of the facts alleged, there was an arguable basis for bringing the Complaint. The Panel can therefore not find that Complainant’s actions or behaviour are such that a finding of reverse domain name hijacking is justified.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

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

PANELLISTS

Name	**Dinant T.L. Oosterbaan**

DATE OF PANEL DECISION 2016-11-08

Publish the Decision