Decision for dispute CAC-UDRP-101331

Case number	CAC-UDRP-101331
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Domain names	gabs.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Gabs S.r.l.

Complainant representative

Organization	Barzanò & Zanardo Roma S.p.A.

Respondent

Organization	DOMAIN ADMINISTRATOR - NAME ADMINISTRATION INC. (BVI)

Respondent representative

Organization	John B. Berryhill LLC

OTHER LEGAL PROCEEDINGS

None of which the Panel is aware.

IDENTIFICATION OF RIGHTS

The Complainant has submitted evidence, which the Panel accepts, showing that it is the registered owner of the following trademark:

GABS (word) – European Intellectual Property Office trademark no. 014428783. That trademark was applied for on July 31, 2015 and registered on December 1, 2015.

FACTUAL BACKGROUND

The Complainant is an Italian company working in the design and production of high quality leather bags and accessories. It was incorporated on 23 February 2000. The Complainant is the registered owner of a large number of trademarks in Italy, the European Union and other international jurisdictions including parts of Asia and Africa.

The Complainant uses its website at www.gabs.it to promote its business.

The Respondent is a company that trades in domain names. It registered the Disputed domain name on June 1, 2001. According to the WHOIS record relating to the Disputed domain name, the Respondent is the registrant and the administrative contact of the Disputed domain name <gabs.com>.

When the Complainant became aware of the registration of the Disputed domain name, it tried to buy it, but the Complainant and the Respondent were unable to reach agreement on the price. As a result the Complainant initiated the present proceeding.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

THE COMPLAINANT:

1. The Complainant is a company incorporated in Italy on 23 February 2000. It specialises in the design and production of high quality leather bags and accessories.
2. The Complainant has registered many trademarks in Italy and around the world.
3. The Respondent registered the disputed domain name on 1 June, 2001, a year after the incorporation of the Complainant.

IDENTICAL OR CONFUSINGLY SIMILAR
4. The disputed domain name is identical or confusingly similar to the Complainant’s GABS trademark and the GABS Company name.
5. The Complainant has always used the Company name and various forms of the trademark GABS, but always including its distinctive portion, i.e. GABS as a de facto trademark and later as a registered trademark in many countries.
6. When the Complainant became aware of this abusive registration of the disputed domain name, it instructed its trademark attorneys to contact the disputed domain name holder to recover the ownership of the domain name.
7. The Complainant’s attorneys initiated a negotiation process that failed due to the Respondent’s demand for a disproportionate price, whereupon the Complainant initiated the present proceeding.
8. At the present time, the domain name resolves to a pay-per-click page and is still for sale.

RIGHTS OR LEGITIMATE INTERESTS
9. The Respondent has no rights or legitimate interest in the disputed domain name. In that regard, a world-wide trademark search reveals that the Respondent has no trademark for GABS or application to register any such trademark.
10. The intention of the Respondent when registering the domain name was to sell it.
11. There is no evidence of the Respondent’s "demonstrable preparations" to market goods and services related to the term GABS.
12. The identity between the IP rights of the Complainant and the disputed domain name is seriously affecting the Complainant's business and its reputation, especially as it leads to a pay-per-click page containing many links to websites for adults and to chat rooms.

BAD FAITH
13. The disputed domain name was registered in bad faith. In fact, it was registered primarily for the purpose of selling, and is still offered for sale today.
14. In that regard, the Complainant relies on previous UDRP decisions that support the proposition that an offer to sell generally is sufficient evidence for a finding of bad faith.
15. That contention is supported by the fact that the price demanded by the Respondent shows that it intended to speculate on domain name registrations.

16. That is also confirmed by the fact that the relevant whois report does not contain any information regarding the owner of the domain name, and the Complainant does not know if the Registrant is an individual or a Company which could have a reasonable interest in the business of domain names.
17. As far as use in bad faith is concerned, the offer for sale to the general public of a domain name reproducing a renowned third party's trademark is an illegitimate use of the domain name that is potentially likely to create serious damages to the Complainant, and that certainly cannot qualify as a use in good faith.
18. Moreover, the Respondent is using the disputed domain name to lead to a parking page containing pay-per-click links of adult contents. These pay-per-click links generate a profit to the Respondent and therefore the disputed domain name is used intentionally to attempt to attract, for commercial gain.
19. The real scope behind the registration and use of the disputed domain name is clear, i.e., that of taking an undue economic advantage from the Complainant's renowned trademarks and name.

THE RESPONDENT:

I. Introduction

This is a dispute which should not have been brought. The word "gabs" is a common English word which as a verb means "to engage in idle chat" and also is a plural noun referring to idle chat sessions. The domain name is used by the Respondent to earn revenue by displaying paid search advertising for "Chat Rooms", "Chat Server Software" and "Chats" and so forth. The Respondent's use of the domain name is consistent with the dictionary meaning of the word constituting the domain name, which has nothing to do with the Complainant's alleged mark for clothing. Moreover, the Complainant presents no evidence whatsoever of any trade or service mark in GABS senior to the Respondent's registration and use of the domain name.

II. Identical or Confusingly Similar

Complainant's tendered documents are not evidence of "trade or service mark rights" under the Policy. They are company registrations that are cancelled, revealing that the corporate name "GABS DI FRANCO GABBRIELLI" was changed in 2010 to "GABS S.R.L." and a domain name and website located at <gabs.it>, neither of which confers a trade or service mark right.

In any event, the Complainant’s <gabs.it> domain name was not registered until 24 January 2002. Thus the Respondent was the earliest to register and use a "gabs" domain name, as the disputed name was registered by the Respondent in 2001.

Complainant's first applications for a textual GABS mark appears to date from 2015. This will become important on considering the issue of bad faith.

The Complainant has failed to establish "common law" rights in GABS, as it relies on only one invoice, dating from March 2001, which does not establish a reputation among consumers sufficient to recognize a trade or service mark right.

The Complainant provides none of the usual indicia under which common law rights could be established, such as length and amount of sales under the name, advertising, consumer surveys and media.

III. Legitimate Rights and Interests

The Complainant has not proved that the Respondent has no legitimate rights or interests in the domain name. First, Respondent registered and has used the domain name since 2001 and the Complainant has not shown any trademark rights to GABS prior to that year. None of the Complainant's trademark applications or registrations appear to have been filed prior to 2005, and the Complainant's own <gabs.it> domain name registration data shows that the Complainant had not established an online presence until 2002.

Secondly, insofar as use of a domain name is concerned, the Respondent is also the senior party. Panels under the UDRP have consistently recognized priority as a legitimate right under the policy. See. Webanywhere Ltd. v. Marchex Sales, LLC /

Brendhan Hight NAF Claim Number: FA1303001491617.

Thirdly, the Respondent is very well known as a trader in domain names consisting of dictionary words, short common phrases, and other non-distinctive terms. The domain name here consists of the English word "gabs", meaning idle chats or the act of engaging in idle chat. The Respondent has then populated the resolving website with search terms such as "Chat Rooms", "Chat Server Software" and "Chats". This gives the Respondent a legitimate right and use of the domain name. See Walk the Walk Worldwide v. Name Administration Inc. (BVI) WIPO Case No. D2013-0731; and Manga Films, S.L. v. Name Administration, Inc. WIPO Case No. D2005-0730, Snowboards-for-sale.com, Inc. v. Name Administration Inc., WIPO Case No. D2002-1167, Fluke Corporation v. Name Administration Inc. (BVI), NAF Case No. 430650 and Angstrom Corporation v. Name Administration Inc , NAF Case No. 281591.

There is not, and there has not been, any use of the domain name by the Respondent to trade in clothing on the basis of the claimed reputation of an Italian clothing company of which the Respondent had never heard prior to this dispute.

Nor is the Respondent’s legitimate interest in the domain name negated by whether or not the Respondent is interested in selling the disputed domain name or the preferred price; see Personally Cool Inc. v. Name Administration Inc. (BVI), NAF Claim Number: FA1212001474325.

The Respondent is therefore using an English dictionary word as a domain name in association with its primary generic meaning, which is well established as a legitimate use.

IV. Registered and Used in Bad Faith

Under this element the Complainant must prove that the Respondent's registration and use of the domain name was aimed at the Complainant's claimed mark.

There is no reason for the Respondent to have known of or been aware of the Complainant when the domain name was registered. The Complainant did not have an online presence when the domain name was registered in 2001, and it would not register gabs.it as its own domain name until 2002.

Likewise, the Complainant did not file or pursue any trademark registration activities until 2005. The Respondent had not heard of the Complainant prior to this dispute, and the Respondent's use of the domain name has had nothing to do with the Complainant's trade in clothing.

The Complaint claims "the domain was registered primarily for the purpose of selling, and still nowadays is offered for sale." The Policy does not forbid buying and selling domain names in general. The Complainant must therefore show that the Respondent registered the domain name, in 2001, for the purpose of selling it to the Complainant or someone else in the clothing business which it cannot do.

The evidence shows that there was no way for the Respondent to know that the inquiry to buy the domain name was made on behalf of the Complainant or a competitor of the Complainant or that the Respondent was trying to do so. See.BERNINA International AG v. Name Administration Inc.,WIPO Case No. D2016-1811.

These events show that this is a classic Plan B case, which has been used by prior panels as a ground for finding Reverse Domain Name Hijacking which the Panel might consider.

There is nothing illegal, immoral, infringing, or otherwise ill intended by using the English word "gabs" to advertise chat services.

Accordingly, the Complainant has failed to show how the Respondent's registration of the domain name in 2001 could have been undertaken with any intent whatsoever based on the Complainant's non-existent trade mark.

The Complainant has 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

The Complainant has not 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 Complainant has not shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)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

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”) of the Internet Corporation for Assigned Names and Numbers (“ICANN”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the Czech Arbitration Court (“CAC”) Supplemental Rules.

A. Administrative deficiency

By notification dated 30 December, 2016 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that:

The Complaint did not specify to which Mutual Jurisdiction the Complainant would submit with respect to any challenges to a decision in a UDRP proceeding, being either the principal office of the Registrar or the Disputed domain name holder‘s address as provided in the registration of the Disputed domain name under Registrar’s WHOIS database at the time the complaint was submitted to the CAC.

In accordance with Paragraph 4 (d) of the Rules, the Complainant was requested to correct the above-mentioned deficiency and submit an amended Complaint within five (5) days of receiving the notification. The amended Complaint had to be submitted using the Form "Amend Complaint" available on the CAC’s on-line platform in the left-hand menu of the Case File.

The Complainant was required to submit its Amended Complaint through the CAC’s on-line platform within five (5) days of the date of the notification.

If the Complainant failed to meet the deadline stated, the administrative proceeding was to be deemed withdrawn without prejudice to the Complainant’s submission of a new Complaint.

On 3 January 2017 the Complainant filed an Amended Complaint and the CAC determined on 4 January 2017 that in view of the amendments so made, the Complaint should proceed.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiencies have been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents

submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In that regard, the Panel also notes that the onus is on the Complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:
(i) The 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 domain name; and
(iii) The domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

A. Identical or Confusingly Similar

To prove this element, the Complainant relies on a series of registered trademarks and also on what it refers to as “de facto” trademarks which the Panel takes to be a submission that it has common law or unregistered trademark rights.

The registered trademarks are contained in the Complainant’s Annex B to the Complaint. That Annex is headed “GABS trademark registrations” and it contains a summary of a large number of Italian and international trademark registrations and applications of which the Complainant is the registered owner or the applicant in those cases where the marks are not yet registered. Most of the registrations are for marks that are not for the single word GABS, but are for a combination of GABS together with other words and devices. The Panel’s view of those marks is that the Complainant would have difficulty in showing that the Disputed domain name was identical or confusingly similar to any of those trademarks. However, the Annex also includes two word trademarks for GABS, which are as follows:

(a) GABS (word) – Italian trademark no. 302015000040738. The record shows that this trademark was applied for on July 31, 2015. However, the record does not show that it has been registered; and
(b) GABS (word) – European Intellectual Property Office trademark no. 014428783. That trademark was applied for on July 31, 2015 and registered on December 1, 2015. The Complainant’s Annex D also contains details of the registration history of that trademark (“the GABS trademark”.).

The Complainant has therefore satisfied the requirements of paragraph 4(a)(i) of the Policy as it has shown a registered trademark, namely the European trademark. The Disputed domain name consists of the entirely of the GABS trademark without any alteration apart from the addition of the gTLD “.com” which is disregarded for the purposes of the comparison with the trademark. It is therefore clear that the Disputed domain name is identical to the GABS trademark.

It will be noticed that the Disputed domain name was registered on 1 June, 2001, many years before the GABS trademark was registered. That is not fatal to the Complainant’s case under paragraph 4(a)(i) of the Policy, as that provision requires the Complainant to show only that it “has“ the requisite trademark and not that it had such a trademark when the Disputed domain name was registered. It is now well established, however, that that issue may be relevant when the Panel comes to consider the later and separate issues of rights and legitimate interests and bad faith.

In addition to relying on its registered trademarks, the Complainant seeks to establish that it also has a common law or unregistered trademark for GABS from a time prior to the registration of the Disputed domain name. There is no doubt that unregistered trademark rights are adequate for the purposes of UDRP proceedings and it remains in every case a question whether, on the evidence, a complainant has shown that it has such rights.

The Complainant seeks to establish such rights by adducing in evidence “the invoices listed in ANNEXES A and A2, and by

the Complainant's certified company name registration GABS di Franco Gabrielli dated February 23, 2000 and subsequent GABS company names up to the Complainant GABS S.r.l. and all related to same holders as listed in ANNEX A3."

The Panel can only locate one invoice, which has not been translated into the language of the proceeding, namely English, and the full effect of which is therefore unclear. What is clear, however, and more important, is that the onus is on the Complainant to show, by evidence, that the name GABS has come exclusively or at least substantially to be associated by consumers with the complainant or its goods and services. This can be, and regularly is shown by evidence of sales under the mark in some quantity and over a significant period of time, advertising of the brand and recognition of its association with the complainant in the mind of the community by surveys or in the media. In the present case, there is little such evidence, although some advertising materials were submitted under the Complainant's Annex H, which were at least an attempt to show notoriety of the trademark; they were not persuasive, however, as they did not predate the registration of the domain name. The evidence of the Complainant was mainly confined to the history of its company name and the registration of its own domain name, <gabs.it>, none of which is accepted in UDRP proceedings as evidence of the secondary meaning required to show the link between the alleged mark and the Complainant and how that link is perceived by the public.

The Panel therefore finds that the Complainant has not made out a case for an unregistered or common law trademark in GABS and that its trademark rights are limited to the registered trademark already specified.

The Complainant has thus made out the first of the three elements that it must establish.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to you [the respondent] 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 [the respondent] (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 [the respondent] are making a legitimate noncommercial 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.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

The Respondent submits that it has a legitimate interest in the Disputed domain name because it consists of an ordinary English word which the Respondent, like any other registrant, was entitled to register as a domain name, provided that it is genuinely used for purposes coming within the ordinary meaning of the word and not to copy or trade off the complainant's trademark and provided also that it is not being used to target or do damage to the complainant.

That general principle is now well accepted. It is acknowledged, for example, in the Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), where it is said:

"Normally, in order to find rights or legitimate interests in a domain name based on the generic or dictionary meaning of a word or phrase contained therein, the domain name would need to be genuinely used or at least demonstrably intended for such use in connection with the relied-upon meaning (and not, for example, to trade off third-party rights in such word or phrase)."

There are also many prior UDRP decisions where panellists have applied it, such as the decision cited by the Respondent, Manga Films, S.L. v. Name Administration, Inc.,WIPO Case No. D2005-0730, where the Panel observed:

“The Respondent points out that other panels have found that using a domain name in connection with the dictionary meaning of the words found therein is sufficient to constitute a legitimate interest under the Policy and cites in particular decisions relating to the present Respondent: Snowboards-for-sale.com, Inc. v. Name Administration Inc.,WIPO Case No. D2002-1167, Fluke Corporation v. Name Administration Inc. (BVI),National Arbitration Forum Case No. 430650 and Angstrom Corporation v. Name Administration Inc ,National Arbitration Forum Case No. 281591. While this Panel is not bound by those decisions, there are obvious reasons why similar situations should be treated in like fashion. In any event, this Panel accepts that there may be a legitimate interest in a domain name where that domain name incorporates a descriptive term and is used in connection with the subject matter that term describes, where there is no obvious intention to trade on the rights or reputation of a trade mark owner in another part of the world.”

The Panel accepts that principle as stated, but is mindful of the fact that its application must be based on evidence of facts in the particular case that bring it within the principle.

The Panel has concluded that the facts of the present case bring it squarely within the principle. The word “gabs” is a common English word based on “gab”, meaning “talk, prattle, twaddle” (Concise Oxford Dictionary) and it is used to invoke notions such as “the gift of the gab” and in colloquial words such as “gabfest” and “gabble”. It does not strain the language at all to accept that it is used interchangeably as a verb, as in “talks” or “prattles.”

The Respondent has also used the Disputed domain name only within its ordinary meaning, as is seen from the Complainant’s Annex F, where the links are to Chat Rooms, Chat Server Software, Chat Servers, Chat Software, Chats, Cheap Internet, Christian Chat Rooms, Internet Phones, Java Chat Servers and Video Chats. Some of the links lead to further links of a salacious nature, but even they are, for better or worse, little more than contemporary internet offerings.

More importantly, none of them lead to goods and services offered by the Complainant and there is no evidence that they ever did. The website to which the Disputed domain name resolves does not mention the Complainant or its goods or services, there is no attempt to pass off the site as the site of the Complainant or to copy its get- up or presentation and no attempt at all to do any harm to the Complainant or, indeed, to do anything with the site other than to promote activities that fit easily within the meaning of the word “gabs” but which have nothing to do with the Complainant.

The history of the Disputed domain name also makes it highly unlikely that the Respondent could ever have heard of the Complainant and it states unequivocally that it had not.

Moreover, it must be remembered that the Disputed domain name was registered on 1 June 2001; the Complainant did not have an online presence until after it registered its own domain name, < gabs.it>, on 24 June 2002; the Complainant’s registered Italian trademark for GABS was not applied for until 31 July 2015; and its European trademark for GABS on the same date. This history makes it highly unlikely that the Respondent had the Complainant in mind when it registered the Disputed domain name or at any subsequent time. It has evinced a willingness to sell the Disputed domain name, but that is its avowed business model and it was entitled to do so.

The Panel’s conclusion, therefore, is that the Respondent had and has a legitimate interest in the Disputed domain name.

The Complainant has thus not established the second of the three elements that it must establish.

C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the Disputed domain name was registered in bad faith and that it is being used in bad faith: Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a

domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. 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 the 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, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the 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.

As the Panel has found that the Respondent had every right to register the Disputed domain name and to use it in an appropriate manner, it will clearly be difficult for the Complainant to show that the Respondent registered and used the Disputed domain name in bad faith. Nevertheless, the Complainant has presented an argument that the Respondent both registered and used the domain name in bad faith. Its principal argument is that, from the beginning, the Respondent intended to buy the Disputed domain name primarily for the purpose of reselling it and that this is seen to be the case because the Respondent put the Disputed domain name up for sale and tried to sell it and that, indeed, it is still for sale at a higher price than the Complainant is prepared to pay. From the way the argument is developed it is clear that the Complainant is aware that the proposition just made is inconsistent with the plain words of Paragraph 4(b)(i) of the Policy. The Policy provides that if it is to be argued that a domain name was registered in bad faith because of an intention to sell it at a profit, it must be shown or inferred from the evidence that the registrant's intention was to sell the domain name to the complainant, i.e. to the trademark owner or a competitor of the trademark owner and that it is not sufficient simply to offer it for sale to the world at large. It is not improper or in violation of the Policy to sell a domain name and it would require the strongest and clearest language to make it illegal to acquire private property and then sell it at a profit. That language is not to be found in the Policy. Indeed, those who drafted the Policy clearly went out of their way to decree the opposite, namely that it is only where a registrant intends to do harm to a trademark owner by buying a domain name with the intention of selling it to a corresponding trademark owner or a competitor, at a profit, that such a purchase can be said to be in bad faith.

The Panel is aware that there are prior UDRP decisions that suggest that a mere intention to sell to the world at large rather than to the trademark owner or a competitor shows bad faith by itself. It is also true that there may well be individual fact situations where such a conclusion may be justified, but the present case is not one of them. That is so because it is unlikely that the Respondent had the Complainant in mind or had ever heard of it when registering the Disputed domain name on 1 June 2001; moreover, at that time the Complainant did not have a registered trademark for the word in question, it did not register its <gabs.it> domain name until 24 June 2002 and did not, until then, have an internet presence that could have alerted the Respondent to its existence. More importantly, the Panel's role is to apply the Policy, not to re-write it. Applying the Policy, it is an essential element required to be proved by Paragraph 4(b)(i) that when the registrant registered the domain name it not only intended to make money out of the trademark owner by trying to sell it the domain name at a profit but that this was its primary intention. That conclusion is not open on the evidence in the present case.

The Complainant uses the same argument to show that the Respondent used the Disputed domain name in bad faith. That argument fails for the same reasons and also because, even on the Complainant's own evidence, the Respondent has properly used the domain name only to advertise goods and services coming squarely within the genus of "gabs", such as chat rooms.

The other grounds relied on by the Complainant have already been dealt with under Rights and Legitimate Interests and there is no need to repeat them here. The Panel has given careful attention to all that has been put on behalf of the Complainant and finds that none of it shows that the Disputed domain name was either registered or used in bad faith.

The Complainant has thus not established the third of the three elements that it must establish.

REVERSE DOMAIN NAME HIJACKING

The Respondent has raised the issue of whether the Complainant may have engaged in Reverse Domain Name Hijacking (RDNH).

On this issue there is a division of opinion between members of the Panel. The Presiding Panelist, who is in the minority, would make a finding of RDNH. A majority of the Panel would not make such a finding.

Majority View

A majority of the Panel, Panelists Ivett Paulovics and Douglas M. Isenberg, do not find RDNH. The following explanation of this finding, written by Panelist Paulovics, is joined by Panelist Isenberg.

In the Complaint the Complainant has also asserted that "...it entrusted its trademark attorneys to contact the disputed domain name holder..." and, as affirmed by the Respondent in its Response, the negotiation between the parties about the possible purchase of the Disputed domain name was initiated by the Complainant (through its domain broker) by submitting the online form available on the website to which the Disputed domain name resolves and at which the Disputed domain name is offered for sale ("Click here to buy Gabs.com for your website name!"). Soon after the submission of the inquiry, the Complainant's broker received an e-mail from of the Respondent's broker with the initial sale offer price. While the Complainant has provided an extract of the e-mail correspondence exchanged between the parties, the Respondent has submitted a record of such communications made by the Respondent's internal online domain brokerage system with some of its notes. However, the Panelists retain that neither the further communications between the parties are relevant, nor the Complainant's intent was to mislead the Panel or misrepresent the case by submitting a partial record of the parties' communications.

The Respondent has cited UDRP decisions which found RDNH. The Panelists considered the WIPO Case No. D2016-0653, but found that it presented several different and additional elements from the present dispute. To the contrary of the dispute WIPO Case No. D2015-0202, in the present case, neither the Complainant threatened UDRP proceedings in its communications, nor there has been any correspondence between the parties concerning the Disputed domain name since the commencement of the present administrative proceeding, which could have been intended "to increase bargaining leverage in the sale negotiations".

The Panelists do not find that the Complainant has acted in bad faith when it initiated the proceeding relying on its asserted prior rights (unregistered trademark and company name) and senior registered trademarks (the GABS trademark) in various countries (amongst which some English-speaking countries), which consist of a generic term in the English language. Senior registrations were certainly not filed for the purpose to deprive the Respondent from the Disputed domain name by initiating this proceeding. Notwithstanding the Complainant's affirmation that the trademarks had become renown, it has failed to prove that the asserted prior rights were widely known by the public and/or by the Respondent at the time of registration of the Disputed domain name and that the Respondent targeted the Complainant's marks when it registered the Disputed domain name <GABS.COM>. In front of all the relevant circumstances of this case its arguments that the Disputed domain name has been used in bad faith and the Respondent lacks rights and legitimate interests are erroneous, but were not brought in bad faith (see WIPO Case No. 2009-1279). The Panelists do not find any harassment or similar conduct of the Complainant.

The Panelists retain that the affirmation of the Respondent that "the UDRP runs on the principle that complainant may freely make whatever accusations they please against the reputation of anyone who has a domain name they want, and may simply omit to state facts that they find inconvenient" is inappropriate, since pursuant to Paragraph 3(b)(xiii) and 5(c)(viii) of the Rules each party undertakes that the information contained in the Complaint or the Response is to the best of their

knowledge complete and accurate and that the Complaint or the Response is not presented for any improper purpose.

Moreover, the Complainant has nothing to do with the fee structure adopted by the UDRP Provider CAC, nor such fee structure has any relevance in this administrative proceeding.

Minority View

The reasons of the Presiding Panelist, The Honourable Neil Anthony Brown QC, for making an order of RDNH are as follows.

First, the Complainant's case was particularly weak; it lost on two of the major issues and almost lost a third. More importantly, the Complainant must have known the case would fail before it filed the Complaint. That should have been apparent after a moment's reflection that it was impossible to prove the Disputed domain name was registered in bad faith when it was registered before the relevant trademark. Likewise, it must have been appreciated that it would be impossible to prove that the Respondent had no rights or legitimate interests in the Disputed domain name.

Secondly, the Presiding Panelist has grave doubts as to whether the Complainant has been completely open with the Panel with respect to the negotiations to buy the Disputed domain name. The Complainant's proposition was that "... the disputed domain name was offer (sic) for sale to the Complainant...", which can only mean that it was offered by the Respondent to the Complainant and at the instigation of the Respondent; and yet there is nothing in the evidence to show that the negotiations commenced with an offer from the Respondent, which they did not.

Moreover, presumably this issue was promoted by the Complainant to show that the Respondent knew or should have known it was dealing with the Complainant, making it more likely that it had bought the Disputed domain name to sell to the Complainant. But the initial approach was made by email from "Brett Lalonde" rta@register.it" and to suggest that the Respondent must have known this to be an offer from the Complainant is unpersuasive.

Moreover, the Complainant did not tender in evidence the whole of the correspondence between the parties, despite the fact that it has certified that its Complaint is "complete". This in turn must cast doubt about the veracity of the Complainant's case.

In general, this is a classic Plan B case where a party tries, but fails, to buy a domain name and then makes a claim for the same domain name under the UDRP. This practice has been described as "a highly improper purpose" and, as the Respondent has contended, has contributed to findings of RDNH in some cases, citing Patricks Universal Export Pty Ltd. v. David Greenblatt, WIPO Case No. D2016-0653 (holding "Plan B" approach as a basis for a finding of RDNH) and Nova Holdings Limited, Nova International Limited, and G.R. Events Limited v. Manheim Equities, Inc. and Product Reports, Inc., WIPO Case No. D2015-0202 (use of UDRP proceeding to increase bargaining leverage in sale negotiations called "a highly improper purpose"). The Presiding Panelist has the same disposition as is reflected in those decisions.

For those reasons the Presiding Panelist would make a finding of RDNH.

ANNEX

Annex: Summary of the Panel Decision

The Complainant, Gabs S.r.l. is an Italian company engaged is the business of the design and production of high quality leather bags and accessories. It was incorporated on February 23, 2000.

The Complainant is the registered owner of a series of Italian and international trademarks consisting of or including the expression GABS.

The Respondent is a company that buys and sells domain names. It registered the Disputed domain name <gabs.com> on

June 1, 2001. The Disputed domain name resolves to a website containing links, most of which are for chat rooms and related services, but not for goods or services connected with the Complainant's business which is clothing.

The Complainant contended that it has registered and unregistered trademark rights in the GABS mark, that the Disputed domain name is identical or confusingly similar to that trademark, that the Respondent has no rights or legitimate interests in the Disputed domain name and that it was registered and is being used in bad faith.

The Respondent replied that at best the Complainant owned one registered trademark for GABS, that it has no common law or unregistered trademarks for GABS and that the totality of its evidence failed to establish the "trade or service mark rights" that the Complainant is required to show under the Policy.

The Panel found that the Complainant had shown one registered word trademark for GABS, that the Disputed domain name was identical to the GABS trademark, but had failed to establish common law or unregistered trademark rights in the name.

The Panel then found that the Complainant had failed to show that the Respondent had no rights or legitimate interests in the domain name, as the domain name comprised a generic word, namely "gabs" and that the Respondent had used it only to promote goods and services that come within the generic meaning of "gabs".

The Panel then found that the Respondent had not registered the Disputed domain name in bad faith, as the domain name had been registered before the Complainant's only trademark for GABS had been registered and because the evidence showed that the Respondent had not acted in bad faith.

For the reasons set out in the Decision, the Complaint was denied and the Disputed domain name <gabs.com> was ordered to remain with the Respondent.

The Panel also, by a majority, declined to make a finding of Reverse Domain Name Hijacking.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

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

PANELLISTS

Name	**The Hon. Neil Brown, QC, Douglas M. Isenberg, Avv. Ivett Paulovics**

DATE OF PANEL DECISION 2017-02-26

Publish the Decision