Decision for dispute CAC-UDRP-101827

Case number	CAC-UDRP-101827
Time of filing	2018-05-30 08:48:19
Domain names	rabwah.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Name	Ehsan Ahmad Rehan

Respondent

Name	Naseer Ahmed

Respondent representative

Organization	SRM Law

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of U.S. Trademark “RABWAH” with registration no. 5,358,392 (first used in commerce on March 10, 2008; registered on December 19, 2017).

FACTUAL BACKGROUND

The trademark “RABWAH” is used by the Complaint’s independent digital publication hosted on <rabwah.net> by the name of Rabwah Times, the publication is currently registered with the U.S. ISSN Center and holds ISSN no. 2415-5616. The Complainant is the owner of several other domain names which include the domain name <rabwah.pk> which was registered in 2007, the domain name <rabwah.info> which was registered in 2010 and the domain names <rabwahtimes.com> and <rabwah.tv> which were registered in 2011.

The disputed domain name was created on September 14, 1998.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name is identical to the Complainant's "RABWAH" mark.

The Complainant contends that he has reached out to the Responded in good faith in order to ascertain the situation of the disputed domain name, and in response received several lists with domain names for sale by the Respondent.

The Complainant further contends that even though the disputed domain name was registered in 1998, there is no evidence that the respondent was the original registrant or bought the disputed domain name at a later stage, or that that the Respondent registered the disputed domain name to provide a bona fide offering of its own goods and services.

The Complainant also contends that the Respondent was made aware of the Complainant's trademark rights, through an email exchange, however the Respondent continues to misleadingly redirect anyone approaching the disputed domain name to other sites. The Respondent is offering the disputed domain name for sale, which is identical to the Complainant's trademark "RABWAH". The Respondent has in the past redirected the disputed domain name to questionable websites and continues to redirect to websites on whose content he has no control over and continues to allow the use of digital identity to competitors.

For all these reasons, the Complainant requests that the disputed domain name be transferred to him.

Contentions made in Complainant's Nonstandard Communications

The Complainant contends that the Respondent's bad faith is clear from his earlier communication in 2014, in which the Respondent was fully aware of the Complainant's rights in the mark since at least 2014, and even at the time and wanted to profit off the Complainant's popularity and take advantage of his rights. Further, the Complainant states that the Respondent has himself accepted history of registering domain names solely for the purpose of selling them back to the original rights holders.

The Complainant requests that the panel accept the following and earlier Supplemental Submission due to the fact that it responds to information contained in the Response that was unforeseeable at the time Complainant submitted its Complaint. The key reason being the conflict of interest of the Respondent's counsel. According to the Complainant, the Respondent's counsel was actively involved in the filing of the Complainant's mark "Rabwah" which the UDRP refers to in the filing. The Complainant requests the Panel to consider the Complainant's additional filing in this communication due to the late Response by the Respondent despite receiving an extension of 4 days upon, for which the Respondent did not indicate any cause of the late Response.

The Respondent redirected the disputed domain name to pay-per-click websites, even though the Respondent denied it in his response. Additionally, the Complainant contends as evidence of bad faith the hoarding of multiple domains of other rights holders by the Respondent.

The Complainant also strongly rejects the Respondent's reverse domain name hijacking claims within the meaning of Paragraph 15(e) of the Policy, since the Complainant presented substantial evidence of its exclusive use of the mark "RABWAH" in commerce, and it has an understandable interest in seeking to control the use of that name by others.

The Complainant states that there is no evidence as claimed by the Respondent to suggest that he transferred or pointed certain domain names voluntarily.

RESPONDENT:

The Respondent contends that "RABWAH" is geographically descriptive, has meaning in a foreign language, and gives the

impression that it falsely associates with the Ahmadiyya Muslim Community ("AMC"). Rabwah means "high place" in Arabic and is a city in Pakistan. The Respondent states that the Complainant knew or should have known these facts from his own articles in 2008 when he started his site and in 2017, the year he filed his trademark application.

The Respondent's registration of the disputed domain name in 1998 predates the Complainant's by approximately 10 years before the Complainant's site had been created, and the Respondent can show the registrant historical information showing the Respondent as the registrant since at least 2005, which was only as far back as the DomainTools report would allow.

The Respondent has used the disputed domain name to provide information on a not-for-profit religious entity (AMC) and/or the geographical location that is the mark. Additionally, the Respondent contends that the bona fide use can be shown over several years prior to Respondent's notice of Complainant's dispute. The Respondent states it has used the site for a noncommercial use, no revenue has been produced over the 20-year history by virtue of this ownership, since the Respondent has used the site to provide information on the not-for-profit religious entity associated with the name of the disputed domain name.

The Respondent states that the Complainant alleges that Respondent was holding the disputed domain name for purposes of selling, licensing or renting by making an offer to Complainant, competitor of Complainant, and to an offer to public even though Respondent's response was simply "No way" after Complainant describing his intent of reaching out to Respondent for the purpose of purchasing the disputed domain name.

Finally, the Respondent is also claiming that the Complainant has shown behavior consistent with reverse domain hijacking.

Contentions made in Respondent's Nonstandard Communication

The Respondent contends that the Complainant, in an Nonstandard Communication, has attempted to conjure up reasons for the Panel to reject Respondent's Response including (i) falsely alleging that Respondent's counsel has a conflict of interest without showing a legitimate basis for such a claim; and (ii) incorrectly arguing that the Response was not filed timely despite it being filed timely per Rule 3(e) of the Supplemental Rules.

The Respondent states that there is no conflict of interest regardless of Respondent submitting a letterhead from a non-party to this arbitration. As the two emails reflect, there was no direct communication between the Respondent's counsel and the Complainant but only between Respondent's counsel and Complainant's counsel. The Respondent's counsel did not file the Complainant's trademark application, and there was no attorney-client agreement entered into between Respondent's counsel and the Complainant.

The Respondent further contends it registered the disputed domain name 10 years prior to the Complainant's website being created and 19 years prior to the Complainant filing for its service mark. The Complainant cannot allege nor provide proof that the Respondent registered the disputed domain name with the Complainant in mind nor register the disputed domain name in order to sell to the Complainant or its competitor.

The Respondent states it intends to continue the use of the disputed domain name in relation to the origin of the disputed domain name, AMC (also known as "Jamaat" and its followers "Ahmadis"), and the location that is "Rabwah". The Respondent is not required to obtain a license from the Complainant for several reasons including that their uses are completely different and the Respondent's use pre-dates that of the Complainant's use.

Finally, the Respondent contends that the present case, the Complainant was the first to initiate contact between the Respondent and the Complainant to make an offer almost 8 years after the Complainant alleges it started using its mark and before the Complainant even filed for his trademark application.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed 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

Resulting from the above conclusion on the first element of paragraph 4(a) of the Policy, and coupled with the findings under the third element as set out below; the Panel, from a judicial economy perspective and in order to be procedurally efficient, determines not necessary to analyze the second element. Therefore, the Panel will not examine the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainant has not satisfied the requirement under 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. On June 16 and then again on June 29, the Complainant, respectively, submitted two unsolicited Nonstandard Communication; the Respondent submitted an unsolicited Nonstandard Communication on July 23 and the Complainant submitted a final unsolicited Nonstandard Communication on July 26.

PRINCIPAL REASONS FOR THE DECISION

A. Admissibility of the Parties' subsequent unsolicited Nonstandard Communications

In accordance with the Rules, paragraph 12, "the Panel may request, in its sole discretion, further statements or documents from either of the Parties". This has to be read in conjunction with the Rules, paragraph 10, which state that the Panel shall conduct the proceeding "with due expedition" and shall "determine the admissibility, relevance, materiality and weight of the evidence".

Further to this, and in order to clarify the procedural issue of unsolicited Nonstandard Communications, section 4.6 of the WIPO Overview 3.0 state that for the sake of procedural efficiency, UDRP panels are generally reluctant to accept such unsolicited filings, unless there are "exceptional circumstances" requiring their admission into evidence.

In the case at hand, the Panel did not request any additional communications from the parties, nevertheless, both parties submitted subsequent unsolicited Nonstandard Communications. The Panel has reviewed these subsequent unsolicited Nonstandard Communications, as enumerated and summarized under the relevant elements of this decision, and the Panel notes that none of the circumstances present in these communications can be considered to be "exceptional circumstances" as per section 4.6 of the WIPO Overview 3.0. The information provided appears to be a continuation of the original arguments contained in the Complaint and the Response and offer no new information relevant to the UDRP procedure.

Furthermore, these additional communications from the parties would normally not be considered by this Panel, since they appear to be more relevant to a larger dispute between the parties that falls outside of the limited scope of the UDRP. In this case however, out of completeness, the Panel reviewed the subsequent unsolicited Nonstandard Communications and the Panel notes that they do not affect the outcome of this Decision, and is therefore not necessary to ask for a subsequent and final reaction from the Respondent.

The Panel will now proceed with the examination of the substance in this dispute.

B. Identical or Confusingly Similar

For the Complaint to succeed in relation to the disputed domain name, the Complainant must first prove that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

In this case, the Complainant has established its rights in the trademark "RABWAH", and the Panel notes that the disputed domain name is identical to the trademark, as it incorporates it in its entirety.

Furthermore, the Panel notes that the arguments put forward by the parties regarding the merits of the trademark as granted by the USPTO, or by any Patent and Trademark Office for that matter, fall outside of the scope of the UDRP and for that reason will not be considered for the purposes of this decision.

The Panel therefore finds that the Complaint has satisfied the first element set under paragraph 4(a) of the Policy.

C. Rights or Legitimate Interests

Resulting from the above conclusion on the first element of paragraph 4(a) of the Policy, and coupled with the findings under the third element as set out below; the Panel, from a judicial economy perspective and in order to be procedurally efficient, determines not necessary to analyze the second element. Therefore, the Panel will not examine the requirement under paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

As per the evidence on record, the disputed domain name was created on September 14, 1998. The Respondent has not only not disputed this, and in fact has further confirmed this through several assertions, namely: “since 1998 the respondent has been sitting on the domain…” and “[e]ven though the domain was registered in 1998, there is no evidence that the respondent… bought the domain at a later stage”. These facts indicate that the disputed domain name predates the trademark by around nineteen years. Even if the Panel were to consider the Complainant’s first use of “RABWAH” as a common law trademark since 2008, as per the Complainant, the Respondent’s registration of the disputed domain name still predates the registration of the trademark by several years.

Therefore, the Complainant’s own submissions make clear that the disputed domain name was created before the Complainant’s trademark rights arose, and there is nothing to indicate that the Registrant acquired the disputed domain name at a later date. This, along with the evidence on record appears to indicate that the disputed domain name has not been registered or used in order to capitalize on the registered/unregistered trademark rights of the Complainant (WIPO Overview 3.0 section 3.8.2.).

Accordingly the Panel concludes, as per section 3.8.1. of WIPO Overview 3.0, that “[w]here a respondent registers a domain name before the complainant’s trademark rights accrue, panels will not normally find bad faith on the part of the respondent”.

As a result of the above conclusions, the Panel finds that the Complainant has not satisfied the requirement under paragraph 4(a)(iii) of the Policy.

E. Reverse Domain Name Hijacking

The Respondent requested that the Panel should find against the Complainant that it engaged in Reverse Domain Name Hijacking. After carefully examining the evidence on record, the Panel determines that the Complainant pursued the case on what it perceived as legitimate grounds rather than an intention to harass the Respondent or attempt to mislead the Panel that would justify such finding.

Therefore, the Panel does not find that the Complainant’s conduct constitutes Reverse Domain Name Hijacking within the meaning of the Policy.

F. Decision

For all the foregoing reasons, and as indicated above, the Complainant is dismissed.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

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

PANELLISTS

Name	**Rodolfo Carlos Rivas Rea, Douglas M. Isenberg, Dietrich Beier**

DATE OF PANEL DECISION 2018-08-07

Publish the Decision