Decision for dispute CAC-UDRP-102126

Case number	CAC-UDRP-102126
Time of filing	2018-08-15 09:26:32
Domain names	gazellescoaches.com, discovergazellescoaching.com, gazelles7.com, gazellesgroup.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Gazelles, Inc.

Complainant representative

Organization	RODENBAUGH LAW

Respondent

Name	Keith Cupp

OTHER LEGAL PROCEEDINGS

This Panel is aware of two US proceedings between the parties on several general commercial matters that may also concern trademarks and domain names.

IDENTIFICATION OF RIGHTS

“GAZELLES” is a registered trademark registered in the name of Gazelles. Inc, the Complainant of this case. In addition to the registered rights, validly granted on October 20, 2002, the Complainant owns some unregistered trademark rights duly assessed and recognised by the USPTO which established trademark first use in the USA starting from July 27, 1999.
The Complainant has also several domain names formed of the word GAZELLES and, of course, its trade name.

FACTUAL BACKGROUND

The Complainant specializes in global executive education and coaching. Gazelles has over 230 member-coaching partners and operates in six continents. Gazelles was founded in 1991, by Verne Harnish, founder of the world-renowned Entrepreneurs' Organization (“EO”) and its executive programs both at MIT. Gazelles owns the domain <gazelles.com>, and operates the associated website where it provides information about its programs and services (“Complainant's Website”). Gazelles has continuously used the “GAZELLES” mark in global trade since at least 1999 and has registered the “GAZELLES” mark in the United States, reg. no. 2642397, in International Class 41.
Respondent is Servant Ventures Inc. and Mr. Keith Cupp and Ms. Cindy Kraft acted as its agents in registering the disputed domain names. Keith Cupp is the registrant of the disputed domain names containing the word “Gazelles” for Servant

Ventures Inc.
The Respondent does not dispute that Complainant is entitled to use of the mark “Gazelles” but denies that the Complainant is entitled to exclude others from using the word "GI" in relation to business coaching and training services this sentence is included in the Defense Factual Background.
The Respondent is a competitor that initially collaborated with the Complainant in various ways.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:
The Complainant is the owner of the US registered trademark “GAZELLES” and for this reason and based on the Complainant’s use thereof even earlier than the registration date, it has acquired a reputation and value thanks to the word which is contained in four out of five of the disputed domain names. The Respondent has no authorisation and no Licence from the Complainant and this, according to the Complainant's point of view, entails the Respondent’s bad faith in all of the five registered domain names. Complainant argues that the Respondent has registered the disputed domain names and this is equivalent to an infringement of the Complainant's Gazelles trademark.

RESPONDENT:
The Respondent does not dispute that Complainant is entitled to use and register the mark “Gazelles” but denies that the Complainant is entitled to prevent others from using of the word "GI" in relation to business coaching and training services, this sentence being included in the Defense Factual Background. As regards <gicoaches.com>, the Respondent claims that the acronym "gi" stands for “Gravity Impact” that is the trademark for its website which is not linked to “Gazelles International”.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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) except for <gicoaches.com> in relation to which the Complainant has not proven earlier exclusive rights on the acronym “GI”.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii)of the Policy) except for <gicoaches.com>.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy) except for <gicoaches.com>.

PROCEDURAL FACTORS

Procedural Aspects
The Panel has to answer the Respondent’s procedural objections related to the competence of the Czech Court of Arbitration to decide this domain name dispute.

The Uniform Domain Name Dispute Resolution Policy (“Policy”) has been adopted by ICANN and is applicable across all gTLDs (generic top level domains) including the <.COM> domain. The Policy is incorporated by reference into each registration agreement between the respective registrar and its customer (the domain name holder or registrant) and sets forth the terms and conditions of a dispute between the domain name owner and any party other than the registrar on the

registration and use of an Internet domain name registered by the domain name holder.

Proceedings under Paragraph 4 of the Policy (Mandatory Administrative Proceeding) are conducted according to the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the selected administrative-dispute-resolution service provider's supplemental rules.

Therefore, the Respondent is required to appear in a proceeding brought by the Complainant with respect to the Disputed Domain Name. The competence of the Czech Court of Arbitration as the UDRP dispute resolution service provider is therefore based on the registration agreement existing between the Respondent and the registrar of the Disputed Domain Name. The respective proceeding is not the arbitration proceeding within the meaning of any of the rules of arbitration according to the law system of any country of the world.

Therefore, the Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why a decision would be inappropriate. The parties have asserted, in different ways, that the Proceeding before US Courts covers “nothing more than general business issues” (as stated by the Complainant), mainly an infringement of contract provisions. These proceedings do not address the issue of ownership and validity of Complainant’s trademarks Gazelles or disputed domain names.
As regards the “Gazelles” mark, the Respondent does not dispute that Complainant is entitled to use of the mark “Gazelles”, on the contrary it challenges the Complainant’s exclusive right on the acronym “GI”.

The Respondent hereof has not made any claim on the validity of Complainant’s marks or the ownership of any disputed domains within the framework of the proceedings under the laws of Florida (one of the two cases, the other one has been brought before the Court of Washington) and the only domain name mentioned in this case is <gicoaches.com>.

Furthermore, it seems to this Panel that an arbitration decision may be issued despite the existing pending proceedings. In any case, the parties may challenge this decision also before the Competent US Court and there is no impediment preventing such decision from being examined under the laws of the US. This panel has indeed jurisdiction on the case at issue, given that this Court of Arbitration can decide UDRP proceedings between US entities, either physical or legal persons.

PRINCIPAL REASONS FOR THE DECISION

This proceeding was suspended so that the Parties could have come back and inform this Panel if such a decision has been issued or is about to be issued in the short term.
It would have been also important to know whether the Parties have ever entered into a License agreement by virtue of which the Defendant had the right to use the subject-matter domain name. However for the reasons explained here below this circumstance is not conclusive.
Upon suspension of the case, the parties did not agree on whether the pending cases concern the validity of the Complainant’s trademark, or the ownership of the disputed domain names or the License scope.
The proceeding having been resumed and no document on the above points having been filed by the parties, the Panel is willing to issue a decision on the case.
The Respondent declared to be available to transfer the disputed domain names comprising the word Gazelles to the Complainant and it is not clear why this free-of-charge transfer does not take place.
In the light of the above, given that no decision was issued on the parties and no decision is expected to be issued in the short term, this Panel intends to issue its own decision.
Considering the above, the Panel would like to assess the usual three elements of any UDRP proceeding: (1) Confusing similarity or identity with the Complainant’s trademarks, (2) legitimate interest, (3) bad faith.

(1) CONFUSINGLY SIMILARITY OR IDENTITY WITH THE COMPLAINANT’S TRADEMARKS
In relation to the first element, it is undisputable that the Complainant is the owner of the trademark GAZELLES in class 41 for training services. Some of the Defendant’s affiliates used to work for the Complainant organization but no one was a Licensee, but rather contractors of the subsidiary Company Gazelles Inc.. However the real existence of a Licence shall not have changed the outcome of this decision as it will be explained in the following argumentations

The identity or the confusing similarity with <GAZELLESCOACHES.CO>, <GAZELLES7.COM>, <GAZELLESGROUP.COM> and <DISCOVERYGAZELLESCOACHING.COM> is self-evident.
As far as <GICOACHES.COM> is concerned, the evidence produced by the Complainant is not sufficient to recognize a common law right. At least in this proceeding, in which the subject-matter of the dispute is not determining whether common law rights validly exist or not. “GICOACHES” is not a Complainant’s registered trademark and no evidence of its reputation as a trademark was produced within this proceeding.
For this reason, the first element is proved to exist in connection with the first four trademarks, but not for <GICOACHES.COM>.

(2) LEGITIMATE INTEREST
This Panel does not share the view that if a company name is used as a domain name, then the Legitimate Interest in that name may be considered as automatically proved. In fact, the unlawful use of a trademark can never represent a legitimate interest even if the Registrant has become known for a while under the name “GAZELLES” that coincides with the four domain names at issue. The same can be said in case a Licence existed but it was ended unless in the Licence was expressly established the right of the Licensee to register a trademark or a domain name.
Passive holding of the disputed domain names, except for <gicoaches.com>, supports the Panel’s finding that the Respondent is lacking the legitimate interest in those domain names containing the word Gazelles
In relation to <GICOACHES.COM>, on the contrary, “GI” could be the abbreviation of “GRAVITY IMPACT”, considering that the Complainant has no trademark rights on the acronym “GI” or on “GICOACHES”. It seems to the Panel that the Respondent can have a legitimate interest in using an acronym of its website.

(3) BAD FAITH
This Panel does not share the majority view that if a domain name is registered during a work relationship or a License with the Complainant, then the Registrant is in good faith. The Panel is led to think that bad faith is a state of mind both at the time of registration and that only a subsequent use can prove bad faith through actual behavior taken on thereafter. In other words, initial bad faith is impossible to be proven at the time of the domain names registration, but has to be assessed through the registrant’s behavior over time.
Perhaps, a uniform interpretation of the two occasions of assessment of bad faith – upon registration and after the agreement expires – could be upheld, especially when even the initial registration was not “expressly authorised”.
A license must not be seen as an objective evidence of good faith but as a contractual bad faith in breach of the License provisions or outside the scope of the said Licence.
We thus need to harmonise the sphere of the rules applicable to domain names with those of licensed trademarks in order to avoid contradictory outcomes. This Panels refers to a case of some years ago in which the existence of Licence was not enough to assess the lack of bad faith and the existence of the Respondent’s legitimate interest. At least one of the three Members of the Panel agreed with this point of view which I also share: In fact Mr Scott Donaheyn in case D2010-0800 of August 31, 2010 Natterman vs Watson <Ferrlecit.com> provided a convincing argument that can be applied in this case too.
A License to use the Trademark “FERRLECIT” for pharmaceuticals was granted by Nattermann to Watson. The Three-Member Panel found that there was no evidence of bad faith at the time of registration because of this Licence. Mr. Scott Donahey’s dissenting opinion was the following:
“Purposive Approach (in Canada is called “modern interpretation”) is the usual way of interpretation in civil law countries and therefore bad faith registration and use should be considered as a Unitary concept”.
“The only way to assert that a registration is in bad look at subsequent conduct.” This is the position of this Panel: bad faith is a subjective mental element faith is to and can be proved by external circumstances that may be present at the time of the registration but are likely to be detected later on.
A licensee using the trademark after Licence termination could be imposed a sanction even under the criminal law and, therefore, this condition could not be seen as a maximum illicit behaviour (under the traditional trademark law interpretation) in one case and as an evidence of the existence of a legitimate interest in another situation (i.e. in the domain name regulation).
In the case at issue, there are many doubts on the existence of the License itself and in any case the maintained existence of such License has been rejected by a decision.
All of all (1) the Respondent’s recognition of the Complainant’s trademark rights on “GAZELLES”, (2) the passive holding of the disputed domain name containing the word “Gazelles” and (3) the previous work relationship with Gazelles Inc. are all

proofs of bad faith in relation to the Gazelles domain name registrations and use (or actual non-use of them).
The panel firmly believe that the Respondent is in bad faith in relation to the disputed domain names containing the word "GAZELLES-".
As to <GICOACHES.COM>, this is not the best venue for issuing a decision on the existence of the Complainant's "GI" unregistered trademark and on the consequent infringement thereof. It seems that the Complainant has not filed any conclusive evidence to such respect. This Panel deems that the Respondent's bad faith on <gicoaches.com> has not been held, considering that the Complainant's reputation and the recognised commercial use of "GI" before the Respondent's <GICOACHES.COM> registration have not been satisfactorily proved.

Reverse Hijacking
There are no indications of reverse hijacking of the Complainant against the Respondent and the latter's request has to be rejected.

In the light of the above the panel
• accepts the Complainant's arguments in relation to <GAZELLESCOACHES.COM>, <GAZELLES7.COM>, <GAZELLESGROUP.COM> and <DISCOVERYGAZELLESCOACHING.COM> and order that this four domain names are transferred to the Complainant
• reject the complaint relation to <GICOACHES.COM> and also
• reject the reverse hijacking request advanced by the Respondent

Massimo Cimoli

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Partially Accepted/Partially Rejected

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

1. **GAZELLESCOACHES.COM**: Transferred
2. **GICOACHES.COM**: Remaining with the Respondent
3. **DISCOVERGAZELLESCOACHING.COM**: Transferred
4. **GAZELLES7.COM**: Transferred
5. **GAZELLESGROUP.COM**: Transferred

PANELLISTS

Name	**Massimo Cimoli**

DATE OF PANEL DECISION 2019-02-07

Publish the Decision