Decision for dispute CAC-UDRP-102207

Case number	CAC-UDRP-102207
Time of filing	2018-10-26 10:05:13
Domain names	options.events

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	PLAINWELL OVERSEAS CORP.

Complainant representative

Organization	CABINET BEAU DE LOMENIE

Respondent

Organization	NameTrust, LLC

Respondent representative

Organization	The IP & Technology Legal Group, P.C.

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant owns several trademarks for OPTIONS in France, registered since 1984, along with trademarks for the same registered in the European Union, and in several other jurisdictions such as Brazil, Hong Kong, China, the Russian Federation, Singapore, and Switzerland, registered between 2008 and 2011.

In particular, the Complainant's trademarks include but are not limited to the following:

- French trademark OPTIONS S.A. (semi-figurative), No. 1287277, registered on August 1, 1984 and duly renewed since then;

- European Union Trade Mark OPTIONS (word), No. 8970162, registered on March 22, 2010 for services in International Class 41 concerning party planning; rental of stage scenery; rental of event decor and in International Class 43 for rental of equipment for receptions, namely: rental of tents, furniture, rental of chairs, tables, tableware, table linen and glassware;
- European Union Trade Mark OPTIONS (figurative), No. 007375512, registered on June 10, 2009; and
- European Union Trade Mark E-OPTIONS.NET (figurative), No. 010489061, registered on May 11, 2012.

FACTUAL BACKGROUND

The Complainant is a company incorporated in the British Virgin Islands, Overseas Territory of the United Kingdom, Great Britain and Northern Ireland. The Complainant is active in marketing and promotional activities to offer services connected with the preparation and mise en scène of events and parties. The Complainant states that it enjoys a high degree of recognition in France and elsewhere in the European Union in connection with its events-organization activities. In addition to its trademark rights (as outlined above), the Complainant owns several domain names used in connection with its business, including <options.fr>, <options.ch>, <options.net>, <optionsfrance.fr>, and others. The Complainant markets its services via its main website at "www.options.fr".
The Respondent, Name Trust LLC, is a company incorporated in Delaware, United States of America. The Respondent is part of the Donuts Inc. family of companies ("Donuts"). Donuts operates as an ICANN-accredited registry for various new generic Top-Level Domains ("gTLDs"), including the ".events" gTLD.
In 2017, the Respondent acquired BudURL, a link-management platform providing services related to URL link shortening. In June 2018, BudURL was re-launched as BL.INK, which offered a pool of domain names comprising dictionary terms that could be used for the purposes of link shortening.
The disputed domain name was registered on March 3, 2018. The disputed domain name redirects Internet users to the Respondent's website at "www.app.bl.ink/login/", which is a login page for users of the Respondent's link-shortening services offered via its domain name <bl.ink>.
On July 17, 2018, the Complainant sent a cease-and-desist letter to the Respondent requesting transfer of the disputed domain name. The Respondent did not reply to the Complainant's letter.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant, in its Complaint submission, asserts the following:
I. The Complainant submits that the disputed domain name is identical to a trademark in which the Complainant has rights. The Complainant provides evidence of its ownership of trademark registrations for OPTIONS in various jurisdictions around the world. The Complainant submits that its trademarks were applied for and registered before the registration of the disputed domain name. Furthermore, the Complainant asserts that its trademarks enjoy a high degree of recognition in France and the European Union in the field of event organization. The Complainant states that it has built its reputation in the OPTIONS name and trademark through its continuous use over nearly 30 years. The Complainant submits that the disputed domain name includes the highly distinctive verbal element of the Complainant's trademarks, OPTIONS, and that its registration under the ".events" gTLD refers to the Complainant's exact field of business activity.
II. The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant argues that the Respondent cannot justify any prior right on the term “OPTIONS”. In addition, the Complainant did not license, permit or authorize the Respondent to use the “OPTIONS” name in any way whatsoever. According to the Complainant, the registration of the disputed domain name clearly affects the earlier rights held by the Complainant. The Complainant states that it is clear that the registration of the disputed domain name was made illegitimately being aware of the reputation of the earlier trademarks.
III. The Complainant submits that the Respondent registered the disputed domain name in bad faith. It states that given the

reputation and the very high degree of recognition enjoyed by the Complainant's trademarks, the registration of the disputed domain name cannot be the result of chance. The disputed domain name is composed of the term "options", which is strictly identical to the Complainant's trademark. The Complainant argues that the Respondent added the letter "s" to the word "option", although this "s" is not necessary. The Complainant argues that this reflects the bad faith willingness of the Respondent to take unfair advantage of the reputation of the Complainant's trademarks. The Complainant asserts that by using the disputed domain name, the Respondent will create confusion with the Complainant's trademarks and domain names, noting that the disputed domain name was registered under the ".events" gTLD, which refers directly to the Complainant's activities. The Complainant makes reference to paragraph 2 of the Policy, noting that when one registers a domain name, he or she represents and warrants that to his or her knowledge the registration of the domain name will not infringe the rights of others. The Complainant states that when registering the disputed domain name, the Respondent should have checked for the prior trademarks, that is, in the unlikely event that the Respondent was not already aware of the Complainant's rights. The Complainant cites the Respondent's failure to reply to the Complainant's cease-and-desist letter as further evidence of the Respondent's bad faith.

RESPONDENT:

The Respondent requests that the Panel deny the remedies requested by the Complainant.

I. The Respondent accepts that the Complainant has established rights in its trademark OPTIONS. Noting that the evaluation under the first element would disregard the ".events" gTLD, the Respondent acknowledges that the disputed domain name is identical, at least in terms of sight and sound, to the Complainant's OPTIONS trademark. Nevertheless, the Respondent submits that a finding for the Complainant on the first element cannot change the ultimate outcome that the Complaint cannot succeed.

II. The Respondent claims to have rights or legitimate interests in the disputed domain name. First, the Respondent notes that the word "options" is a dictionary term, and that when viewed in isolation, the word "options" does not convey an association with the Complainant. The Respondent states that the UDRP expressly recognizes the public's rights or legitimate interests in using common dictionary words on the Internet without facing legal proceedings. The Respondent says that the appeal of the word "options" as a dictionary term is precisely what led the Respondent to acquire the disputed domain name. The Respondent states that the Complainant has not put forward any meaningful evidence showing an attempt on the part of the Respondent to target the Complainant or to take advantage of its trademark. The Respondent states that it had no affirmative duty to seek permission from the Complainant to register a domain name containing the dictionary term "options". The Respondent asserts that the Complainant's unsupported allegations do not suffice to support the Complainant's case, and that the Complainant has failed to make out the second element of the Policy.
III. The Respondent submits that the Complainant has failed to prove that the disputed domain name was registered or is being used in bad faith. The Respondent asserts that the Complainant has provided no evidence to demonstrate any of the circumstances envisaged by paragraph 4(b) of the Policy, and the Respondent denies having acted in such a manner. Noting the perceived likelihood of confusion on the part of the Complainant, the Respondent examines the factors relevant to determining the existence of a likelihood of confusion, and notes the following:
- The Complainant's OPTIONS trademark makes for a "weak" trademark based on a common word with multiple meanings in a variety of contexts.

- The Complainant cites no incident of actual consumer confusion, nor does it provide evidence of other things that could create a likelihood of confusion, such as mark placement, business sector overlap, similarity of goods and services etc.
By registering the disputed domain name, the Respondent claims to have acted in accordance with its business plan to promote open Internet access by utilizing generic names through which Internet users can access services to enhance their experience.
The Respondent denies knowledge of the Complainant, and states that the Complainant cannot assert an argument of bad faith on the basis of constructive notice where the Complainant is not known in the Respondent's location.
The Respondent denies having received the Complainant's cease-and-desist letter, and denies that its non-response is indicative of the Respondent's bad faith. The Respondent states that is not a cybersquatter, but that it is a link shortening service that leverages generic domain names to provide Internet users with more meaningful ways of communicating online.

In light of the abovementioned flaws in the Complainant's case, the Respondent requests that the Panel make a finding of Reverse Domain Name Hijacking ("RDNH").

THE COMPLAINANT'S SUPPLEMENTAL FILING:
On December 17, 2018, the Complainant submitted an unsolicited supplemental filing in reply to the Response. To the extent that the supplemental filing contained new argumentation to that already submitted in the Complaint, the Complainant contended as follows:
The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services. The Complainant points to several domain names registered by the Respondent in connection with its link-shortening service, including <cokeurl.com>, <pat.ag>, and <abnb.co>, arguing that the Respondent is engaged in registering domain names that consist of registered trademarks, and that the Respondent has provided no evidence of its registration of so-called "generic" domain names. The Complainant submits that "options" in the plural is not "generic" and that it has no relevance for the Respondent's link-shortening service.
The Complainant submits that the Respondent is a professional domainer whose activity consists of registering domain names that are linked with registered trademarks, therefore the Respondent necessarily knew about the Complainant's rights when the disputed domain name was registered. The Complainant submits that domainers have a positive duty to avoid the registration of trademark-abusive domain names, and that the Respondent has not even done the minimum verification to avoid misuse or misappropriation of the Complainant's trademark.
THE RESPONDENT'S SUPPLEMENTAL FILING:
On February 11, 2019, the Respondent, having consent from the Panel to do so, submitted a reply to the Complainant's supplemental filing.
While not reproduced in full detail here, the Respondent's reply rebuts the Complainant's arguments raised in its supplemental filing. In particular, the Respondent's reply serves to provide evidence of the Respondent's registration of other dictionary terms as domain names for use in connection with its link-shortening services. The Respondent also states that it takes trademark infringement seriously, noting that "[t]o protect against illegitimate usage, BL.INK has a dispute mechanism of its own to address such problems, as it specifically reserves the right to 'reclaim' names if used to facilitate trademark infringement."

RIGHTS

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

The Complainant has not, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has not, 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).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP have been met and there is no other reason why it would be inappropriate to provide a decision.
Regarding the admissibility of the Complainant's unsolicited supplemental filing, the UDRP was designed as a time- and cost-effective means for resolving domain name disputes. The Rules contemplates the submission of one complaint and one response. Paragraph 12 of the Rules provides that the Panel may request, in its sole discretion, further statements or documents from the Parties that it may deem necessary to determine the case, however, there is no express provision for the submission of supplemental filings from either side. Generally speaking, supplemental filings should provide statements to the effect of demonstrating why the information contained therein was unable to be provided at the time of the original

complaint or response submission. The Panel notes with some concern that much of the Complainant's supplemental filing consists of rearguing its case, which is likely to be the result of closer examination of reference materials referred to in the Response, and does not necessarily reflect information that was unavailable to the Complainant at the time of filing. Nevertheless, in the interests of fairness, the Panel has determined to accept the Complainant's supplemental filing and has taken note of the contentions therein. The Panel has also carefully considered the statements of the Respondent in reply to the Complainant's supplemental filing.

PRINCIPAL REASONS FOR THE DECISION

1. The First Element: Identity or Confusing Similarity

It is well established that where a complainant holds nationally or regionally registered trademark rights, this prima facie satisfies the threshold requirement of having trademark rights for the purposes of standing under the Policy. The Complainant has established that it holds registered trademark rights in OPTIONS as detailed in the "Rights" section above. The perceived strength of the Complainant's mark, or the goods or services for which it has been registered are not relevant for the purposes of determining identity or confusing similarity under the first element Policy.
The disputed domain name reproduces the Complainant's OPTIONS trademark without alteration or addition under the ".events" gTLD. While the applicable gTLD may have bearing on the Panel's assessment under the second and third elements, it is disregarded for the purposes of comparison under the first element, being a technical requirement of domain name registration.
The Panel therefore concludes that the disputed domain name is identical to a trademark in which the Complainant has rights and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

2. The Second Element: Rights or Legitimate Interests

As a preliminary matter, the Panel wishes to note that while the overall burden of proof is on the complainant, prior UDRP panels have noted that to prove that a respondent has no rights or legitimate interests in a domain name may involve the impossible task of "proving a negative". As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating its rights or legitimate interests in the domain name. In this regard, the Panel notes that the Complainant states, in its unsolicited supplemental finding, "[w]here an applicant has alleged that the defendant has no legitimate right or interest in the domain name, it is for the defendant to establish to the contrary, since he alone has the necessary information to do so." This approach appears to be misguided. Paragraph 4(a) of the Policy clearly states that "the complainant must prove that each of these three elements [is] present." It is incumbent on the Complainant to provide evidence to the effect that the Panel may determine on the balance of probabilities that this element has been satisfied. Here, the Respondent has come forward with arguments and supporting evidence to rebut the Complainant's case. As such the Panel has proceeded to carefully weigh the arguments and evidence of each side in determining whether the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.
Paragraph 4(c) of the Policy provides circumstances, if proved, shall demonstrate a respondent's rights or legitimate interests in a domain name for the purposes of paragraph 4(a)(ii) of the Policy. The thrust of the Panel's finding of this element is determined under paragraph 4(c)(i) of the Policy, which reads that a respondent may demonstrate rights or legitimate interests in a domain name by showing that:
"before any notice to you [the Respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a domain name corresponding to the domain name in connection with a bona fide offering of goods or services."
The question therefore becomes: Does the Respondent's use of the disputed domain name in connection with its link-shortening services amount to a bona fide offering of goods or services?
The Complainant asserts that the Respondent is engaged in the practice of registering domain names comprising third-party trademarks, and makes reference to the domain names <cokeurl.com>, <pat.ag>, and <abnb.co>. The Panel finds that this argument carries little weight, as it is evident from the Respondent's website at "www.bl.ink/features/" that companies Coca Cola, Patagonia and Airbnb are all users of the Respondent's services, and appear to have consented to the registration and use of such short-form domain names. On the same page, the Respondent makes available a "smart link" generator, which provides examples of shortened URLs that are available for use by users of the Respondent's services. When inputting long URLs into the generator, the results consist of varying combinations of dictionary terms as short, easy-to-read links. Despite

the Complainant's assertions, the Panel finds that the term "options" is a dictionary term, and that its plural form does not exclusively connote the Complainant. The notion that the word "options" in plural in and of itself denotes the Complainant simply does not hold water. As such, the evidence on record indicates that it is more likely than not that the domain name was registered in light of its dictionary meaning, for use in connection with the Respondent's link-shortening services forming part of the Respondent's domain name portfolio. There is nothing in the record to suggest that the Respondent's business model is a pretext to mask a pattern of bad-faith domain name registration, nor is there anything to suggest that the Respondent registered the disputed domain name with the Complainant in mind. The Panel considers it entirely plausible that users of the Respondent's shortened links may wish to promote events using short domain names registered under the ".events" gTLD.

In light of the above, the Panel finds that the Complainant has failed to establish the requirements of paragraph 4(a)(ii) of the Policy, and therefore the Complaint fails.

3. The third Element: Bad faith

Notwithstanding the fact that the Complaint fails on the second element, for completeness, the Panel has included analysis on the third element.

At a minimum, in order to reach a finding of bad faith, the Complainant should be able to put forward evidence that the Respondent "knew or should have known" of the Complainant and its trademarks when it registered the disputed domain name. The Complainant has not provided evidence in support of its contention that it is well known, while the Respondent denies knowledge of the Complainant, noting that the Complainant is not active in the Respondent's jurisdiction. In light of the lack of evidence from the Complainant in this regard, the Panel is unable to infer any awareness of the Complainant on the part of the Respondent at the time of registration of the disputed domain name. The lack of registered trademark rights and their reputation in the Respondent’s jurisdiction are further evidence that the Respondent did not know of the Complainant’s trademark OPTIONS.

There has been discussion from both sides about the Respondent's duty to carry out searches of relevant trademark databases in order to determine whether the registration of the disputed domain name would interfere with the Complainant's rights. Indeed, prior UDRP panels have noted that domainers undertaking bulk purchases or automated registrations have an affirmative obligation to avoid the registration of trademark-abusive domain names, nevertheless, noting that trademarks may be inherently descriptive in one context and generic in another, the mere fact of certain domain names being identical or confusingly similar does not mean that such registrations cannot as such be undertaken or would automatically be considered to be in bad faith. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 3.2.3 and cases cited therein. Notwithstanding the Complainant's registered trademark rights for OPTIONS, the domain name simultaneously consists of a dictionary term, even in its plural form. The Respondent's business model displays no appreciable risk of creating a likelihood of confusion with the Complainant's business, as the two Parties operate in distinct areas of commerce. As such, even if the Respondent were to carry out a trademark search on the dictionary term "options", the Complainant's trademark registered in connection with its catering service would not bar the Respondent from reflecting a generic term in a domain name used in connection with its link-shortening services. The Panel has considered the impact of the ".events" gTLD, and does not find that it alters the Panel's findings under this element. In fact, noting that the parent company of the Respondent is the registry operator of the ".events" gTLD, it seems only natural that the Respondent would seek to register and use domain names in that namespace comprising dictionary terms in connection with its services.

For reasons set out above, the Panel finds that the Complainant has also failed to establish that the disputed domain name was registered in bad faith; therefore the Complaint also fails on the third element of the Policy.

REVERSE DOMAIN NAME HIJACKING

The Respondent submits that the Complainant has engaged in RDNH. RDNH is defined under the UDRP Rules as "using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name."

The Panel has carefully considered the Complainant's approach to this proceeding, and notes that its claim appears to align more closely with that of a claim for trademark infringement, rather than what is typically argued in domain name disputes. By filing a Complaint alleging bad faith registration on the part of the Respondent with no evidence of the Complainant's reputation, the Complainant risks crossing the line at which a finding of RDNH may apply. Nevertheless, notwithstanding the malalignment of the Complaint with the substantive requirements of the Policy as well as the lack of certain evidence that

have proved fatal to its case, the Panel does not consider that the Complainant knowingly used the Policy in an attempt to deprive the Respondent of the disputed domain name.
Accordingly, the Panel declines to make a finding that the Complainant has engaged in RDNH.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **OPTIONS.EVENTS**: Remaining with the Respondent

PANELLISTS

Name	**Massimo Cimoli, David Taylor, Alexandre Nappey**

DATE OF PANEL DECISION 2019-02-22

Publish the Decision