Decision for dispute CAC-UDRP-102727

Case number	CAC-UDRP-102727
Time of filing	2019-10-22 13:32:34
Domain names	ivoryresearchreview.com, ivoryresearchscam.com, ivoryessays.com, ivoryresearchessays.com, theivorywriters.com

Case administrator

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

Complainant

Organization	IVORY RESEARCH CO LTD

Respondent

Name	Peter Ross

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

In this proceeding, the Complainant relies on:

- UK design trademark containing the “Ivory Research” element No.UK00003359657, registered on March 22, 2019;
- UK word trademark application “Ivory Research”, application No. UK00003417470, filing date July 30, 2019;
- common law rights in the “Ivory Research” mark (unregistered trademark).

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

THE DISPUTED DOMAIN NAMES ARE IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant is a licensee of the owner of the UK trademark No. UK00003359657, registered on March 22, 2019 that includes the “Ivory Research” word element. The trademark owner is COREFORCE LTD, Makariou III, 22 MAKARIA CENTER, 4th floor, Flat/Office 403, Larnaca, Cyprus, 6016.

The Complainant alleges that the trademark IVORY RESEARCH is protected as a portion of this design UK trademark.

The trademark protecting the combination of words IVORY RESEARCH is subject to pending trademark application filed to the UK patent Office (Application UK00003417470, pending). The applicant is the same company: COREFORCE LTD, Cyprus.

The Complainant also believes that the trademark IVORY RESEARCH has been protected by the UK doctrine of common law trademark, and Complainant's common law trademark IVORY RESEARCH retains the protection during the earlier period not covered by the actual registration.

The Complainant owns the common law trademark pursuant to the agreement with the Complainant's predecessor in rights and title in and to the common law trademark.

When referring to the use of mark prior to the transfer of right, title and interest to the common law trademark, the Complainant acts its predecessor's assignee. The Complainant provides copies of 2 domain name transfer agreements under which the <ivoryresearch.com> domain name was first transferred from INSTA Research Ltd to Diletix IP (date of the agreement - October 12, 2018) and later from Diletix IP to the Complainant (date of the agreement - December 12, 2018).

According to the Complainant, the mark has been used in commerce since at least 2008. The domain name <ivoryresearch.com> (which is currently used by the Complainant to provide IVORY RESEARCH-branded services) was created on 25 November 2005.

The trademark IVORY RESEARCH continues to be used in commerce by the Complainant in connection with the sale of academic research results and samples of essays.

The Complainant states that the combination of the words IVORY RESEARCH has no additional meaning in English language related to the writing services except as the identifier of Complainant's services.

The Complainant alleges that it has expended considerable time, effort and money in advertising, promoting and selling services in connection with the IVORY RESEARCH mark.

The Complainant believes that the Respondent has been targeting the Complainant's mark, especially in the light of the contents of the websites of the Respondent.

According to the Complainant, the Respondent registered the disputed domain names without the Complainant's authorization, permission or consent, and with full knowledge of the Complainant's common law trademark rights accrued due to Complainant's long-standing presence on the market.

The <ivoryresearchreview.com> domain was registered on October 26, 2018; the <ivoryresearchscam.com> domain was registered on October 26, 2018; the <ivoryessays.com> domain was registered on August 31, 2018; the <ivoryresearchessays.com> domain was registered on August 31, 2018 and the <theivorywriters.com> domain was registered on September 14, 2018.

The Complainant states that all the disputed domain names replicate Complainant's common law trademark "Ivory Research" and the textual portion of the registered UK trademark for Ivory Research logo in general or in part, as well as the Complainant's domain name (<ivoryresearch.com>).

The Complainant believes that the registration of the disputed domain names is in fact an unfair competition practice coming from an unnamed competitor, namely a company offering the services similar to the Complainant's. Thus, provided that the proxy/privacy service has been used to hide the underlying registrant, the bad faith of the Respondent is highly probable.

The Complainant indicates that some of the disputed domain names are registered at the same time and have a similar pattern of providing the information, the <ivoryresearchreview.com> and <ivoryresearchscam.com> websites grant access to the video materials depicting the <ivoryessays.com> website and relying on the information placed on the <ivoryessays.com> website.

The Complainant points out that the <ivoryresearchessays.com> and <theivorywriters.com> website is also intended to

mislead the customer by suggesting without evidence that the employees of the Complainant have switched the employer and persuading the customer that the quality of the Complainant's service is to become poor.

The confusing similarity may also be based on the fact that the Respondent has registered a bunch of domain names containing Complainant's trademark or a portion thereof.

The Complainant points out that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) might not prevent a finding of confusing similarity under the first element.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAMES

The Complainant contends that it did not grant the right or entitlement to use the IVORY RESEARCH trademark to the Respondent nor did give permission or consent to use the Complainant's trademark IVORY RESEARCH.

The Complainant is not aware and has not been notified of any rights to the trademark the Respondent is or may be granted with. Also, the Respondent is not (either as an individual, business or other organization) commonly known by the name IVORY RESEARCH.

The Complainant's other arguments may be summarized as follows:

- the <ivoryresearchessays.com> and <ivoryessays.com> might be created and set up to suggest falsely affiliation with the Complainant;

- the <ivoryresearchreview.com> and <ivoryresearchscam.com> might be created in order to uphold and endorse the contents of <ivoryresearchessays.com> and <ivoryessays.com>, as the websites are referring and depicting the <ivoryessays.com> webpage in the content;

- the Respondent also targeted the consumers who might access the disputed domain names during the search process conducted by a potential customer of the Complainant using the trademark IVORY RESEARCH as a search parameter;

- the Respondent may be tarnishing the trademark and at the same time offering the services of the competitor in a way that precludes the customer from exploring other options;

- according to the website contents of the links to the competitors, namely offering the same services, the Complainant assumes the Respondent is a direct competitor in the same line of business and in the same geographical location and competitor status waives Respondent's right to use the trademark in the disputed domain names or make any bona fide use of it;

- the Complainant believes that considering the pattern of parallel registration of the disputed domain names and contents of the websites, the disputed domain names were registered by the Respondent with the intent to create impression and notion of a so-called "criticism sites".

However, evidence supporting its non-commercial, genuinely, fair and not misleading or false use is absent;

- the websites somewhere comprise the link to a competitor's website with some advertisement-like information able to persuade the customer to follow the link. The Complainant also notices that the Respondent may be a disguise used by the real registrant seeking to mask their identity to avoid being contactable.

THE DISPUTED DOMAIN NAMES WERE REGISTERED AND BEING USED IN BAD FAITH

According to the Complainant, the Respondent acts in bad faith, as registration of disputed domain names constitutes the following scenario: the Respondent has registered the disputed domain names primarily for the purpose of disrupting the business of a competitor and by using the disputed domain names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its websites by creation likelihood of confusion with the Complainant's mark as to the source of Complainant's services. The Respondent uses the disputed domain names for its own commercial benefit, as it clearly sells writing services on the sites.

The Complainant believes such Respondent's use may not be associated with a bona fide offering of services or making endorsements or references to the competitors.

Respondent's behavior is not compliant with the English law doctrine of fair use or a legitimate non-commercial use of the domain name, as well as unfair competition, as such actions may be construed as Respondent's intent for commercial gain to misleadingly divert consumers to take commercial advantage of the potential for confusion; as the services are to be provided by the qualified writers, the Complainant assumes the Respondent should have known of the Complainant's trademark at the time of the registration of the disputed domain names.

According to the Complainant, the following circumstances serve as evidence that the Respondent's intent in registering the disputed domain names was in fact to profit from the Complainant's goodwill:

- Respondent's likely knowledge of the Complainant's rights to the trademark associated with writing services in the light that the Complainant and the Respondent are operating on the same market;

- Respondent's pattern of bad behavior: a scenario where the Respondent, on separate occasions, has registered trademark-abusive domain names, directed at the same brand owner;

- Website content targets the Complainant's trademark;

- Absence of any conceivable good faith use, rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain names or disclaimer explaining Respondent's good faith and rights to use the trademark;

- The close proximity between services offered by the Complainant and the Respondent;

- The nature of the disputed domain names in question (namely, coupling the trademark or portion thereof with a pejorative or service-related word) aiming at tarnish the Complainant's goodwill;

- The Complainant is afraid that the Respondent benefits commercially by attempting to divert Internet users for commercial gain by attracting them to its website through a likelihood of confusion with the Complainant's mark;

- As all the four domain names in question somehow solicit or redirect the potential customer to the website 15writers.com there is strong indicia to believe that the true registrants are or are under control of Complainant's competitors.

The Complainant contends that despite the fact that all the disputed domain names were registered before the UK trademark registration, the Complainant relies on the common law trademark protection which had been accrued long before the disputed domain names were registered.

The Complainant believes the Respondent knew and intended to register the disputed domain names to unfairly capitalize on the Complainant's then nascent (not yet registered) trademark rights.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Panel finds that the present dispute falls outside UDRP scope and believes there is no need to consider each element separately for the reasons explained below.

NO RIGHTS OR LEGITIMATE INTERESTS

The Panel finds that the present dispute falls outside UDRP scope and believes there is no need to consider each element separately for the reasons explained below.

BAD FAITH

The Panel finds that the present dispute falls outside UDRP scope and believes there is no need to consider each element separately for the reasons explained below.

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

Scope of UDRP and the present dispute

Since this dispute involves various complex issues the Panel feels the need to address them altogether instead of analysing each UDRP element separately.

The Panel believes that overall complexity of this case puts it outside the UDRP scope.

The Complainant provided lengthy submissions in support of its position.

However, many of the Complainant's statements and assumptions are either incomplete and require additional research or inconsistent and conflicting (i.e. there are 5 disputed domain names but often the Complainant refers to "domain name" only or once mentions "all the four domain names in question", the Complainant also calls itself assignee of common law trademark but provides no evidence of such assignment other than domain name transfer agreements).

Under paragraph 15 (a) of the Rules a panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable. Under paragraph 10(a) of the Rules the Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and the Rules and the Panel shall be able to independently visit the Internet in order to obtain additional information (see Société des Produits Nestlé SA v. Telmex Management Services, WIPO Case No. D2002-0070).

A. Trademark rights of the Complainant and confusing similarity with the disputed domain names

In support of its trademark rights the Complainant submits a copy of the license agreement with the UK trademark owner (trademark No.UK00003359657), information about the UK word trademark application (application No. UK00003417470) and claims common law trademark rights to the mark "Ivory Research".

The Panel notes that a pending trademark application would not by itself establish trademark rights within the meaning of UDRP paragraph 4(a)(i) (see par. 1.1.4 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition - "WIPO Overview 3.0").

The Complainant, therefore, proves its rights as a licensee under the exclusive license to the UK trademark No.

UK00003359657, design mark with the “Ivory Research” word element as confirmed by WIPO Overview 3.0 (see par. 1.4.1: “an exclusive trademark licensee, is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint”).

The Complainant provides some evidence to prove its common law rights (including reviews of the “ivoryresearch.com” web site, facebook page, twitter page, analytics and facebook ads information in respect of the “ivoryresearch.com” web site, google search results, screen shot from web archive relating to the “ivoryresearch.com” web site from 2009, agreements for the “ivoryresearch.com” domain name transfer).

However, the Complainant does not explain its relations with the previous owners of the “ivoryresearch.com” web site and how it had obtained “common law” trademark along with its goodwill.

It appears that the “ivoryresearch.com” web site had been used for quite some time, at least since 2009. However, it is unclear who was the owner (or owners) of the web site and who actually provided services via this web site.

The Complainant provided copies of the domain name transfer agreement between the Complainant and Diletix IP dated December 12, 2018 and a copy of the domain name transfer agreement between Diletix IP and INSTA Research Ltd. (who appears to be one of the previous owners of the “ivoryresearch.com” web site) dated October 12, 2018.

However, these two agreements are related to transfer of the <ivoryresearch.com> domain name and do not cover any transfer of trademarks, goodwill and business as such.

The agreements deal with technical issues, including providing account details and password, access to the facebook page and Voip UK phone number, however there is nothing in the agreements that could be seen as business transfer and transfer of any unregistered trademark rights.

Besides, the owner of the UK trademark No. UK00003359657 is a company from Cyprus, COREFORCE Ltd .

It is unclear how this company is related to the business previously operated under the “ivoryresearch.com” web site and under the possible “Ivory Research” unregistered mark.

The Complainant is right that unregistered (common law) trademark rights may be sufficient for the purpose of UDRP as confirmed by WIPO Overview 3.0, par. 1.3.

However, to establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant’s goods and/or services.

It appears from all the facts and circumstances of this case that the “ivoryresearch.com” web site had been used by different entities unrelated to the Complainant and in the absence of any business and mark transfer agreements between the Complainant and previous owners of the business, it is unclear how the Complainant can claim unregistered trademark rights.

The registered trademark in the name of a company from Cyprus is a relatively new (March 22, 2019) and all the Complainant’s activities are also very recent. According to the public information the Complainant was incorporated on November 13, 2018 (see www.beta.companieshouse.gov.uk).

The Complainant refers to itself as to “predecessor’s assignee” of the common law trademark rights, however fails to provide any evidence confirming the assignment. The domain name agreements provided by the Complainant do not mention any trademark rights, transfer of business and goodwill and are not related to mark’s assignment.

On the issue of similarity of the disputed domain names with the Complainant’s trademark the Panel notes that 3 out of 5 disputed domain names can be considered confusingly similar, namely: <ivoryresearchreview.com>,

<ivoryresearchscam.com> and <ivoryresearchessays.com>. The test of similarity is a standing requirement and involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name.

This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name (see par. 1.7 of WIPO Overview 3.0).

The "Ivory Research" word elements of the UK design trademark are clearly recognizable in these 3 domain names.

This is not the case with the two other domain names: <ivoryessays.com> and <theivorywriters.com>. These two domain names only contain the word "ivory" coupled with the two other dictionary words "essays" and "writers". The word "ivory" itself is a dictionary word (see www.dictionary.cambridge.org) and is used in many different contexts.

Clearly, it is not exclusively associated with the Complainant or the trademark owner. Therefore, these 2 domain names are not confusingly similar with the Complainant's UK trademark No. UK00003359657.

B. Other issues

The Complainant also makes some allegations as to the Respondent, registration and use of the disputed domain names by the Respondent, in particular referring to unfair competition practice by the Respondent offering the services similar to the Complainant's; misleading the customers by suggesting without evidence that the employees of Complainant have switched the employer and persuading the customers that the quality of the Complainant's service is to become poor.

In addition to that the Complainant refers to Respondent's behavior as not being compliant with the English law doctrine of fair use or a legitimate non-commercial use of the domain name, as well as unfair competition.

The Complainant, however, does not address the issue of business transfer and change of owners of the "Ivory Research" business and it unclear if any business was actually transferred to the Complainant except the <ivoryresearch.com> domain name and technical contacts.

It is also unclear whether the "ivoryresearch.com" web site was indeed about to shut down in 2018 due to plans of a previous owner (owners) to sell its domain name and/or business.

The Panel had to conduct additional Internet research to obtain clearer picture and found out that some Internet review sites indeed mention that the "ivoryresearch.com" web site was undergoing some changes and was probably about to stop operating, including the web site cited by the Complaint in its complaint in support of its claims www.uk.trustpilot.com.

In one of the reviews dated November 9, 2018 it was mentioned: "I was a little bit concerned when ivory was shut down, but recently they started to make orders again". On the November 8th, 2018 there is a comment made by someone from the "ivoryresearch.com" that "On the 15th of October 2018 Ivoryresearch.com has changed ownership. Due to GDPR we have no access to the database of clients or past orders".

The same comments were made by Ivory Research Support Team on February 12, 2019 ("However, on the 15th of October 2018, Ivoryresearch.com has changed ownership. Due to GDPR, we have no access to the database of clients or past orders") – this information is available on www.uk.trustpilot.com, last visited on December 4, 2019.

There is another comment on the same web site suggesting that there was at least some interruption of operations: "Top-notch service as always, glad that you are accepting orders again" (date of this review is November 16, 2019).

On September 25, 2019 another user wrote: "They were doing my assignments for over 2 years - very good work I would say. Real shame they closed down".

On the date of this decision none of the web sites under the disputed domain names contained any information relating to the Complainant.

The Complainant provided screen shots from the web site under the disputed domain names indicating that they indeed contained statements about the “ivoryresearch.com” web site shutting down.

However, it appears that such statements may not be completely unfounded, at least in August-October 2018.

Even a person (persons) writing on behalf of <ivoryresearch.com> confirmed change of owner of the web site and the fact that they no longer have access to clients’ database and past orders.

All the disputed domain names appear to have been registered during time period when the future of the “ivoryresearch.com” web site and business was unclear, there is also a possibility that some former employees, contractors or persons relating to the business were involved in the registration of the disputed domain names.

The domain name transfer agreements provided by the Complainant confirm the timing (October-December 2018).

Therefore, overall picture in this case is quite complex and requires analysis of various circumstances, including those relating to the transfer of the <ivoryresearch.com> domain name, understanding what else was transferred along with this domain name and understanding of what was going on between August and December 2018 with the business and the web site of “ivoryresearch.com”. This could also be significant for the second and the third UDRP elements.

However, it is not for this Panel to deal with that sort of issues.

There is a clear consensus of the previous panels that the jurisdiction of this Panel is limited to providing a remedy in cases of “the abusive registration of domain names”, also known as “cybersquatting” and the Policy was adopted to deal with the problem of cybersquatting – that is, the registration of domain names consisting of, including, or confusingly similar to marks belonging to another for the purpose of profiting from the goodwill associated with the mark. The questions that the Panel has jurisdiction to address under the Policy are relatively simple and straightforward (see e.g. Family Watchdog LLC v. Lester Schweiss, WIPO Case D2008-0183 and CAC Case No. 101587 – “it is clear to the Panel that the dispute is not entirely a domain name dispute but a much wider commercial dispute which cannot be resolved within the limited scope of the UDRP, which is for clear cases of abusive domain name registration and use”).

As was noted in one of the recent UDRP decision “the Policy is designed to address clear cases of cybersquatting, and the streamlined process accompanying a dispute under the Policy is ill-equipped to address cases where there are gaps in the record and conflicting accounts which cannot be cured or reconciled through the process of discovery, cross-examination, credibility assessment, and so forth. Whether Complainant has any sort of viable legal cause of action against Respondent outside the narrow confines of the Policy is not for this Panel to consider” (see Buffalo-Erie Marathon Association, Inc. ("BEMA") v. John Elliott, WIPO Case No. D2019-0638).

In the present dispute, there may be a number of relevant points to consider:

1) Relations (including a possible conflict) between employees, contractors (writers) or perhaps someone else relating to the previous business owner and the Complainant currently operating the “ivoryresearch.com” web site;

2) Indications that the old business of the “ivoryresearch.com” was undergoing certain changes precisely at the time the disputed domain names were registered and probably was not operating and not taking orders for some time. Evidence provided by the Complainant demonstrates that the <ivoryresearch.com> domain name was transferred twice during period between October and December 2018;

3) It is unclear what exactly was transferred to the Complainant other than the <ivoryresearch.com> domain name and technical contacts. Has the Complainant received something more than just domain name, technical contacts and access?

4) There may also be issues of unfair competition, fair use and other issues of English law the Complainant referred to in its complaint.

However, all these issues require additional thorough analysis and this is not something this forum is suitable for.

This case involves issues other than domain name registration and use and as was highlighted by one of the previous panels "the Policy's purpose is to combat abusive domain name registrations and not to provide a prescriptive code for resolving more complex trade mark disputes ….The issues between the parties are not limited to the law of trade marks. There are other intellectual property issues. There are serious contractual issues… So far as the facts fit within trade mark law, there may be arguments of infringement, validity of the registrations, ownership of goodwill, local reputation, consent, acquiescence, and so on" (see Luvilon Industries NV v. Top Serve Tennis Pty Ltd., WIPO Case No. DAU2005-0004).

The present dispute is more of a business dispute and UDPR is not an appropriate instrument to resolve this.

The Panel holds that this complaint shall be rejected as this dispute falls outside the UDRP scope.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **IVORYRESEARCHREVIEW.COM**: Remaining with the Respondent
2. **IVORYRESEARCHSCAM.COM**: Remaining with the Respondent
3. **IVORYESSAYS.COM**: Remaining with the Respondent
4. **IVORYRESEARCHESSAYS.COM**: Remaining with the Respondent
5. **THEIVORYWRITERS.COM**: Remaining with the Respondent

PANELLISTS

Name	**Igor Motsnyi**

DATE OF PANEL DECISION 2019-12-04

Publish the Decision