Decision for dispute CAC-UDRP-103014

Case number	CAC-UDRP-103014
Time of filing	2020-04-16 09:22:31
Domain names	hangbird.com

Case administrator

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

Complainant

Name	Dr. Samuel Kutter

Respondent

Organization	Domain Admin

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 name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of German trademark HANGBIRD no. 3020152256916, registered on February 9, 2016 and European Union trademark HANGBIRD no. 016665911, registered on May 4, 2017.

FACTUAL BACKGROUND

The Complainant has developed a drying rack to dry clothes in a space-saving and eco-friendly way. He started to develop technical aspects of his product in 2015 and named his business and product 'Hangbird' in late 2015. In 2016, the 'Hangbird' product became available to the international market.

The Complainant has asserted that he is the owner of the following domain names and is using them for his business:

<hangbird.net, <hangbird.de>, <hangbird.eu>, <hangbird.ch> and <hangbird.at>.

The Complainant is the owner of two trademark registrations for "Hangbird" in Germany and the EU.

The disputed domain name redirects to a parking page offering the disputed domain name for sale.

The disputed domain name <hangbird.com> was registered on March 9, 2011.

The disputed domain name predates the Complainant’s trademarks.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that:

- the disputed domain name <hangbird.com> is identical to the Complainant's Hangbird trademark;

- the Respondent lacks rights or legitimate interests in the disputed domain name; and that

- the Respondent has registered and is using the disputed domain name in bad faith.

In support of these claims, the Complainant contends that the Respondent is not commonly known by the disputed domain name and that the Respondent is not affiliated with nor authorized by the Complainant in any way.

Lastly, the Complainant points out that the disputed domain name redirects to a parking page offering the disputed domain name for sale, thus demonstrating the bad faith use and registration of the disputed domain name.

RESPONDENT:

The Respondent claims that:

The Complainant has failed to provide any evidence which satisfies any of the three elements and therefore this Complaint must be denied. The Respondent then requests that the Administrative Panel deny the remedy requested by the Complainant and requests that the Panel make a finding of Reverse Domain Hijacking by the Complainant.

In support of its claims, the Respondent points out that it has owned the disputed domain name since March 9, 2011 and that it listed this domain name for sale more than 4 and a half years before the Complainant filed its German trademark application, and almost 5 years before the Complainant filed a business registration in Germany.

The Respondent further contends that it has registered and is using the disputed domain name in good faith.

In support of this thesis, the Respondent points out that over the years numerous panels have expressly found that the Respondent, HugeDomains.com, engages in legitimate business practices, and that the Respondent's business of selling generic and descriptive domain names is a bona fide offering of goods and services. See: Clark Equipment Company v. HugeDomanis.com, FA1634156 (Forum, Oct 2, 2015); Virgin Enterprises Limited v. HugeDomains.com, D2017-1961 (WIPO Dec. 11, 2017); Lukáš Bayer v. HugeDomains.com, 102193 (CAC Dec. 10, 2018); Sarah Lonsdale & Stuart Clark v. HugeDomains.com, D2019-1584 (WIPO Sep. 6, 2019); Rayfil Wong v. HugeDomains.com, FA1856257 (Forum, Sep. 20, 2019).

Finally, the Respondent requests a finding of Reverse Domain Name Hijacking, arguing that the Complainant was well aware that the Respondent had registered the disputed domain name well before the Complainant's rights came into existence.

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

In light of the findings under the third element below, the Panel considers this second element unnecessary. The Panel will, therefore, not examine the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

BAD FAITH

The Complainant has failed to show, to the satisfaction of the Panel, that 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

Supplemental filings:

After the Panel was appointed the Complainant filed supplemental arguments, and in response to this supplemental filing the Respondent filed a request to dismiss them.

As also pointed out by the Respondent, in Viacom v. Rattan Singh Mahon, WIPO Case No. D2000-1440, the finding was that supplemental filings should be limited to “exceptional cases” only, as otherwise it would defeat the purpose of the UDRP, which is to provide for expeditious and streamlined dispute resolution with minimal resources being expended.

This Panel has not found any argument and/or document showing any exceptional circumstances.

Therefore this Panel decides not to accept the supplemental filing.

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

In order for the Complainant to obtain a transfer of the disputed domain name, paragraphs 4(a)(i) – (iii) of the Policy require that the Complainant must demonstrate to the Panel that:

(i) The disputed 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 disputed domain name; and

(iii) The disputed domain name has been registered and is being used in bad faith.

The disputed domain name is identical to the Complainant’s registered trademarks HANGBIRD, but for the generic TLD .com.

Therefore, the Panel finds the disputed domain name to be confusingly similar to the HANGBIRD trademarks in which the Complainant has rights.

It should be noted that the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

In fact, it is well established that the Complainant’s rights do not need to precede the registration of the disputed domain name when assessing the existence of confusing similarity. The existence of prior rights does however have great relevance when assessing the existence of bad faith registration.

In the present case it is quite clear that the Complainant has satisfied paragraph 4(a)(i) of the Policy, but has failed to show the existence of bad faith registration and use of the disputed domain name.

In fact the Respondent registered the disputed domain name well before (i.e. more than 4 years before) the Complainant acquired any rights on the HANGBIRD name.

Consequently, the Respondent could not have been aware of the registered trademarks of the Complainant or of its very existence, and therefore could not have targeted and/or had in mind the Complainant's trademarks when it registered the disputed domain name.

On the contrary, it appears that the Respondent has acted within the framework of its regular commercial domain business, i.e. to register and to offer domains for money without targeting the Complainant's trademarks.

Owing to the above finding, relating to the registration and use in bad faith, there is no need to discuss whether or not the Respondent has rights or legitimate interests in respect of the disputed domain name.

In this matter, the Respondent has requested that the Panel make a finding of Reverse Domain Name Hijacking.

Paragraph 15(e) of the Rules provides that "if after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking … the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding." Reverse Domain Name Hijacking ("RDNH") is defined in paragraph 1 of the Rules as "using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name."

As also explained in GWG Holdings, Inc. v. Jeff Burgar, Alberta Hot Rods WIPO Case No. D2016-1420, the burden of proving a complainant's bad faith is generally on the respondent and, consequently, the mere lack of success of the complaint is not by itself sufficient grounds for a finding of RDNH. Indeed, even if a complainant were over-optimistic in filing the complaint, that would not by itself necessarily justify a finding of RDNH. What must be shown, as paragraph 1 of the Rules makes plain, is that the Complainant was motivated by bad faith in bringing the complaint. In Jazeera Space Channel TV Station v. AJ Publishing aka Aljazeera Publishing, WIPO Case No. D2005-0309, the majority of the panel stated that: "Allegations of reverse domain name hijacking have been upheld in circumstances where a respondent's use of a domain name could not, under any fair interpretation of the facts, have constituted bad faith, and where a reasonable investigation would have revealed the weaknesses in any potential complaint under the Policy (see Goldline International, Inc v. Gold Line, WIPO Case No. D2000-1151). See also Deutsche Welle v. DiamondWare Limited, WIPO Case No. D2000-1202, where an allegation of reverse domain name hijacking was upheld in circumstances where the complainant knew that the respondent used the at-issue domain name as part of a bona fide business, and where the registration date of the at-issue domain name preceded the dates of the complainant's relevant trademark registrations."
Applying those principles to the facts of the present case, the Panel's view is that there are several reasons why a finding of RDNH should be made.

There is a complete absence of evidence or any facts from which an inference could reasonably be drawn that the Respondent registered the disputed domain name to tarnish the HANGBIRD trademark of the Complainant, to prevent the Complainant from reflecting its HANGBIRD trademark in a corresponding domain name, or for any other improper reason. No inference could be drawn that the Respondent was targeting the Complainant or was minded to do so when it registered the disputed domain name.

This is due to the fact that the Respondent registered the disputed domain name some four and a half years before the Complainant was incorporated and/or acquired trademark rights to the HANGBIRD name, making it impossible for the Respondent to have known of the Complainant or to have been motivated by bad faith towards an as-yet non-existent company when it registered the disputed domain name.

The Panel's conclusion therefore is that the Complainant was motivated to make a claim that it knew, or should have known after reasonable inquiries, was baseless and that, in making the claim, it could not succeed.

For the above reasons, the Panel finds that there has been RDNH in this case.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

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

PANELLISTS

Name	**Dr. Fabrizio Bedarida**

DATE OF PANEL DECISION 2020-05-28

Publish the Decision