# Decision for dispute CAC-UDRP-103981

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| Case number | **CAC-UDRP-103981** |
| Time of filing | **2021-08-17 09:21:27** |
| Domain names | **itjpsl.org** |

## Case administrator

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| Organization | **Denisa Bilík (CAC) (Case admin)** |

## Complainant

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| Organization | **The International Truth and Justice Project** |

## Respondent

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| Name | **Edward Ferdinand President SLCA** |

## Respondent representative

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| Organization | **Hewage Law Group** |

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 asserts that it owns common law rights through use since 2015 of the name “The International Truth And Justice Project, SL” and in its combined word and logo mark that contains the words," The International Truth And Justice Project". The Complainant has made a United Kingdom trade mark application under UK00003667995 for a logo mark including the words "International Truth And Justice Project", but it has not yet reached the point of registration.

FACTUAL BACKGROUND

The Complainant is an NGO based in the United Kingdom that is focused on Human Rights in Sri Lanka. It collects and stores audio-visual as well as other evidence for use in judicial process and intervenes where it can assist victim communities in Sri Lanka in seeking accountability. The disputed domain name resolves to a website that features the Complainant's International Truth And Justice Project logo. It has operated at that website and held that domain name since 2015 as shown by the internet archive, the Wayback Machine.

The disputed domain name was registered on 13 September 2020 by the Respondent and resolves to a website that includes a logo that appears to be identical or similar to the Complainant's logo. The website at the disputed domain name appears to be

soliciting information concerning activists which the Complainant asserts are the same people that it is attempting to support.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant submits that it owns common law rights for its name “The International Truth And Justice Project, SL” and for a combined word and logo mark containing the words "The International Truth and Justice Project" and that the disputed domain name is identical or confusingly similar to it.

It says that it has not permitted the Respondent to use its name or mark and that there is no evidence that the Respondent is known by it or is using it for a bona fide purpose. The Complainant submits that the Respondent is using the disputed domain name for a website that impersonates the Complainant and solicits information concerning "LTTE" activists and which therefore amounts to "phishing" which is not bona fide. It says that the Complainant had ample opportunity to respond to the Complainant's correspondence or to the Registrar's correspondence following an abuse complaint but has failed to explain itself and in addition notes the Complainant, there are no fair or non-commercial uses of the disputed domain name based on what is on the home page.

As far as bad faith is concerned, the Complainant says essentially that the use of its name and logo by the Complainant purposefully creates the deception and illusion that it is the Complainant's actual website in order to "phish" for information about sources and activists in the local conflict and this amounts to bad faith within paragraph 4(b) (iv) of the Policy. The Complainant says that the use of its logo on the website to which the disputed domain name resolves is clear evidence that the Respondent knew of the Complainant and its name and logo and has sought to deceive and confuse the public. On this basis the Complainant submits that the disputed domain name has not only been registered but has been used in bad faith.

The Respondent made procedural submissions in its Response as outlined below but did not make submissions upon the merits.

RIGHTS

The Complainant has not 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

Not considered.

BAD FAITH

Not considered.

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. In this regard the Panel notes that it has reviewed the Respondent's procedural submissions concerning the current registrar and ownership of the disputed domain name and whether the Complaint is now properly brought against the Respondent. The Respondent also made submissions as to the appropriateness of the Complainant's counsel acting for it whilst the said counsel is also a panelist from time to time on the CAC's roster of panelists. Although these procedural submissions were filed late as supplementary filings, the Panel will admit them because of the important nature of the procedural matters with which they are concerned.

The Panel notes that the verification received from the registrar by the CAC on September 13, 2020 confirmed that the Respondent owned the disputed domain name and that it was registered with the registrar as indicated in the Complaint. In these circumstances it is proper for these proceedings to continue against the Respondent as currently noted.

The Panel finds that there is nothing improper in the Complainant's counsel representing it in these proceedings in circumstances that she is on the CAC's roster of independent panelists and is acting independently in this case. In particular there is no suggestion that she has any conflict with the Respondent or other evidence of abuse and the Panel sees no possible conflict or procedural abuse arising from the mere fact that she is representing a party while also being on a roster of independent panelists, of which this panelist is also a member.

The Panel also notes that while the Respondent itself filed the Response within the required time frame that further submissions concerning the merits were filed late as a supplementary filing. As these submissions do not appear to raise any matters of fact that could not have been addressed in the Response and as there is no other justification submitted by the Respondent's counsel for late filing, the Panel will not admit these submissions to this proceeding.

## PRINCIPAL REASONS FOR THE DECISION

The Complainant has submitted that while it does not own registered trade mark rights for its mark "The International Truth And Justice Project" as it only has a pending United Kingdom trade mark application for its combined word and mark logo, that it does own common law rights both in its name and in the combined logo mark.

In support of this assertion the Complainant has provided the following evidence:

1. Printouts from the Wayback machine that show that it has operated its website and domain name since 2015; and
2. Printout from Twitter showing that since 2017, 1328 people are following the Complainant and that there are 3049 followers and a total of 8068 "tweets" to that point, including a re-tweet by a UK cabinet minister.

The onus upon the Complainant under this element of the Policy is to show that its name or “The International Truth And Justice Project” mark as incorporated into its combined word and logo mark, has become a distinctive identifier which consumers associate with its services. Although the level of evidence required will vary depending upon the circumstances of the particular case, there must be sufficient evidence to demonstrate that by the date of filing the Complaint the name or mark is or will be associated by a reasonable section of the public as being distinctive of the Complainant (see section 1.3 of the WIPO Jurisprudential Overview 3.0).

In a case like the present one, involving the name or mark of an NGO, this could reasonably be expected to include not only evidence of use on a complainant's website and sole social media page as has been submitted, but also relatively substantial evidence of use or reputation on the internet, in news media reports, in public documents such as governmental reports, in activity reports of the organisation as sent to its members or supporters or to members of the public and evidence of any other possible forms of public recognition of the name or mark. Although the standard of evidence required for a non-commercial organisation's name and mark may be lower in the particular circumstances than for the mark of a commercial product or service, there is a threshold evidential requirement which the Panel does not consider has been met in this case.

The evidence submitted in this case, framed at its best, amounts to use of the Complainant's name and mark on its own website since 2015 and that it has 3049 followers on Twitter who could be located anywhere in the world. Contrary to the Complainant's submission this Panel doubts that this level of evidence on its own would support a finding of goodwill for the purposes of a passing-off action in a common law jurisdiction and in any events notes that conclusory allegations of unregistered or common law rights such as those made in the Complaint and even if undisputed, do not normally suffice to show secondary meaning (see section 1.3 of the WIPO Jurisprudential Overview 3.0).

The Panel also notes that in its view the Complainant's name and mark, "The International Truth And Justice Project" is at least in part descriptive and is not in the panel’s view highly distinctive. In general and as noted again at section 1.3 of the WIPO Jurisprudential Overview 3.0, where unregistered or common law marks are comprised solely of descriptive terms which are not inherently distinctive, there is a greater onus on the complainant to present evidence of acquired distinctiveness/secondary meaning.

For these reasons, the Panel finds that the Complainant has not met the evidential bar for demonstrating that it owns

unregistered trade mark rights in "The International Truth And Justice Project" name or mark and that the Complaint fails for this reason under this element of the Policy However, noting that the Complainant has a pending UK trade mark application ( UK00003667995) for its logo mark that incorporates the words " International Truth And Justice Project", the Panel directs that when and if this application, or any corresponding trade mark application in any another jurisdiction, is registered, then the Complainant may refile the Complaint based upon its newly registered trade mark rights.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **ITJPSL.ORG**: Remaining with the Respondent

## PANELLISTS

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| Name | **Alistair Payne** |

DATE OF PANEL DECISION 2021-10-04

Publish the Decision