

Decision for dispute CAC-UDRP-104315

Case number CAC-UDRP-104315

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Domain names thumpstar.com

Case administrator

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

Complainant

Organization Hornet Industries Pty Ltd

Complainant representative

Organization Dimov Internet Law Consulting

Respondent

Name Rastislav Brodsky

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 the U.S. trademark registration no. 4,742,076 "Thumpstar", registered on May 26, 2015. The trademark registration covers goods in class 12 and claims first use in commerce in the U.S. on June 1, 2010 (hereinafter referred to as the "THUMPSTAR Mark"). Furthermore, the previous owner of the Complainant's business had registered trademark rights in "Thumpstar" in New Zealand, which has been registered on May 17, 2005 but revoked in 2011 due to non-use during a continuous period of 3 years or more under section 66(1)(a) of the Trade Marks Act of New Zealand. In addition, the Complainant claims unregistered trademark rights in the trademark "Thumpstar", which according to the Complainant's allegations, was used in commerce since at least February 5, 2005.

FACTUAL BACKGROUND

The Complainant is a manufacturer of motorcycles located in Australia, which offers its products online at www.thumpstar.com.au. The Complainant states that it purchased all registered and unregistered trademarks "Thumpstar" in 2012 from their previous owner and alleges that the trademark "Thumpstar" has been used since at least February 5, 2005.

The disputed domain name was first registered on November 20, 2004, and has been acquired by the Respondent, a former dealer of the Complainant, between December 11, 2007 and February 11, 2008. The disputed domain name is used in connection with a website, which includes a link to the website available at <http://omicronmotors.com/> which contains information about motorbikes and other products which are similar to the products sold by the Complainant.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name is identical to the THUMPSTAR Mark as the disputed domain name includes it in its entirety and as the gTLD ".com" is to be disregarded.

The Complainant also states that the Respondent does not have any rights or legitimate interest with regard to the disputed domain name. The Complainant argues that the Respondent did not use the disputed domain name in connection with a bona fide offering of goods or services, that the Respondent is not commonly known by the disputed domain name, and that he is not making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

With regard to bad faith, the Complainant states that the disputed domain name was registered and is being used in bad faith. With regard to bad faith registration, it argues that the Respondent is a former dealer of the Complainant and was certainly aware of the Complainant's unregistered trademark rights when acquiring the disputed domain name. With regard to bad faith use, the Complainant contends that the disputed domain name is used in connection with a website advertising competing products, that the Respondent acquired the disputed domain name without the permission of the Complainant, and that the Respondent registered the disputed domain name to prevent the Complainant from registering it and to disrupt the Complainant's business.

RESPONDENT:

No administratively compliant Response has been filed.

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

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 name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has not shown 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

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

Under paragraph 4(a) of the Policy, the Complainant must prove that each of the following three elements is present:

- (i) the disputed domain name is identical or confusingly similar to the Complainant's trademark; 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.

1.

The Panel accepts that the disputed domain name is identical to the THUMPSTAR Mark. It is well established that a domain name generally is to be considered as confusingly similar under the Policy where the trademark is recognizable within the disputed domain name.

With regard to the asserted unregistered trademark rights of the Complainant, Section 1.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") provides the following consensus view of what needs to be shown by a complainant in this regard: "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. Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys. [...] Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning. [...] As noted in section 1.1.2, for a number of reasons, including the global nature of the Internet and Domain Name System, the fact that secondary meaning may only exist in a particular geographical area or market niche does not preclude the complainant from establishing trademark rights (and as a result, standing) under the UDRP."

The Complainant has, absent the statements, that it used the trademark "Thumpstar" in commerce since at least February 5, 2005, only provided nine screenshots of the website accessible under the domain name "thumpstar.com.au" in the period 2005 – 2008. No claim of secondary meaning of the trademark "Thumpstar" has been made by the Complainant and absolutely no evidence in support of such claim has been presented to the Panel. The Complainant has not even submitted any information on the extent of use of the trademark "Thumpstar" in Australia or New Zealand, let alone made any statements as to whether and to what extent the trademark was used in the USA, where the Respondent has its registered office. In the Panel's view, the mere availability of a website at "thumpstar.com.au" over a period of three years is not in itself sufficient to establish unregistered or common law rights under the UDRP. The Panel therefore cannot but find that on the record in these Policy proceedings the Complainant failed to establish unregistered trademark rights predating the acquisition of the disputed domain name by the Respondent.

2.

The Complainant has substantiated that the Respondent has no rights or legitimate interests in the disputed domain name. The Panel finds that the Complainant has fulfilled its obligations under paragraph 4(a)(ii) of the Policy.

The Respondent did not deny these assertions in any way and therefore failed to prove any rights or legitimate interests in the disputed domain name. Based on the evidence on file, the Panel cannot find any rights or legitimate interests of the Respondent either. In particular, the Respondent's use of the disputed domain name to forward Internet users to a website offering competing products does not lead to own rights or legitimate interests in the disputed domain name. In this context, it is also noteworthy, that the Respondent acquired the disputed domain name without the Complainant's permission and therefore can also not rely on any rights or legitimate interests derived from the Complainant.

Accordingly, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in respect of the disputed domain name under paragraphs 4(a)(ii) and 4(c) of the Policy.

3.

The Panel is not sufficiently convinced that the requirements for a bad faith registration of the disputed domain name are

met. The following points play a role in the Panel's decision in this context:

- The disputed domain name was acquired at a time when the Complainant had no registered trademark rights.
- With regard to the use of the trademark "Thumpstar" prior to the acquisition of the disputed domain name by the Respondent, the Complainant submits only nine screenshots of the website available under the domain name <thumpstar.com.au> in the period 2005 - 2008.
- The New Zealand trademark of the former owner of the Complainant's business, which was also introduced into the proceedings by the Complainant, was cancelled in the summer of 2011 due to nonuse for a period of three or more years. At the time the Complainant acquired the business in 2012, this trademark had already been cancelled.

Regarding the THUMPSTAR Mark, the Panel finds that the Respondent could not possibly have been aware of the non-existing trademark when acquiring the disputed domain name.

With regard to the trademark rights in "Thumpstar" of the Complainant's legal predecessor in New Zealand, which (still) existed at the time of the domain acquisition, the Panel assumes that, based on the Complainant's submission, it was not used, at least at the time of the acquisition of the disputed domain name. In the absence of use, the Respondent could not have become aware of this trademark as well.

Unregistered trademark rights have not been established by the Complainant in the Panel's view.

Finally, the Complainant further pleads that in the present case there was also registration in bad faith with respect to the Complainant's upcoming rights. Section 3.8.2 of WIPO Overview 3.0 provides a number of exemplary circumstances that may support such a presumption: "Such scenarios include registration of a domain name: (i) shortly before or after announcement of a corporate merger, (ii) further to the respondent's insider knowledge (e.g., a former employee), (iii) further to significant media attention (e.g., in connection with a product launch or prominent event), or (iv) following the complainant's filing of a trademark application." In the present case, there is a period of more than 5 years between the acquisition of the domain name and the Complainant's U.S. trademark application, which has been filed on April 15, 2014. All scenarios that rely on a close temporal connection between domain registration and acquisition of trademark rights are obviously not applicable in the present case. The Panel also assumes that the Complainant has not proven other circumstances supporting a registration in bad faith with respect to the Complainant's upcoming rights. The Complainant does claim that the Respondent was a dealer of the Complainant. However, the Complainant itself argues that the Respondent registered the disputed domain name in 2008, three years after the Complainant's website launch, and during that time "had plenty of time to become aware of the Complainant's Unregistered Trademark." Based on this statement, the Panel assumes that the Respondent was not yet a dealer of the Complainant's products at the time of the acquisition of the disputed domain name, as otherwise it would have had certain knowledge of the Complainant's products from this position. The Complainant has not submitted any other circumstances that could give rise to knowledge on the part of the Respondent, such as active use of the trademark in the U.S. or any kind of advertising there.

The Panel therefore finds that on the record in these Policy proceedings the Complainant failed to prove that the Respondent acquired the disputed domain name having the Complainant or its trademark in mind. Therefore, bad faith registration was not established.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

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

PANELLISTS

Name	Peter Müller
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DATE OF PANEL DECISION 2022-04-01

Publish the Decision
