Decision for dispute CAC-UDRP-100191

Case number	CAC-UDRP-100191
Time of filing	2010-09-07 19:57:43
Domain names	folderlock.com

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Name	Mr. Salman Ashraf

Complainant representative

Organization	Marcus Stephen Harris LLC

Respondent

Organization	Internet Commerce Services, Inc.

FACTUAL BACKGROUND

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

This Complaint is based on the following factual and legal grounds: UDRP Rule 3(b)(ix).

[a.] Likelihood of Confusion

Respondent's domain name is confusingly similar to Complainant's registered trademark because they are identical. Complainant is the owner of United States Federal Trademark Registration No. 2,831,988 for FOLDER LOCK used with computer security software that can password protect personal computer files and folders from others. Respondent is the registrant of the domain name folderlock.com. (Exhibit to Complaint B) The domain name folderlock.com is identical to Complainant's registered trademark, FOLDER LOCK. The only difference between Complainant's trademark and Respondent's domain name is the inclusion of .com. However, Panelists have routinely ignored the inclusion of generic top level domains because they are a required component of domain names. See Am. Int'l Group, Inc. v. Domain Admin. Ltd., FA 1106369 (Nat. Arb. Forum Dec. 31, 2007). "[I]t is a well established principle that generic top-level domains are irrelevant when conducting a Policy ¶ 4(a)(i) analysis." Isleworth Land Co. v. Lost in Space, SA, FA 117330 (Nat. Arb. Forum Sept. 27, 2002)

The domain name is clearly identical to the Complainant's mark, since it consists of the mark plus the generic top-level domain name ".com". See Little Six, Inc. v. Domain For Sale, FA 96967 (Nat. Arb. Forum Apr. 30, 2001) (finding that

<mysticlake.net> is plainly identical to the complainant's MYSTIC LAKE trademark and service mark); see also Honeywell Int'l Inc. v. r9.net, FA 445594 (Nat. Arb. Forum May 23, 2005) (finding the respondent's <honeywell.net> domain name to be identical to the complainant's HONEYWELL mark). Therefore, even with the addition of .com, Respondent's domain name remains identical to Complainant's registered trademark, which makes Respondent's domain name confusingly similar to Complainant's registered trademark.

[b.] Rights or Legitimate Interest

Complainant has used the FOLDER LOCK trademark in interstate commerce since February 15, 2001. Respondent first registered the domain name folderlock.com on December 10, 2002. Complainant was using the trademark FOLDER LOCK one year before Respondent registered the domain name. Further, Respondent doesn't appear to have ever made any legitimate use of the website folderlock.com. In the past, Respondent's domain name consisted of one page that featured sponsored hyperlinks to third party websites. (Exhibit to Complaint C) Respondent obtained these hyperlinks by parking the domain with Namebargain.com. Complainant has not found any evidence that Respondent ever offered any goods or services through this website, other than posting the sponsored hyperlinks. The operation of a pay-per-click website at a confusingly similar domain name does not constitute a bona fide offering of goods or services or a legitimate noncommercial or fair use, regardless of whether or not the links resolve to competing or unrelated websites or if the respondent is itself commercially profiting from the click-through fees. Vance Int'l, Inc. v. Abend, FA 970871 (Nat. Arb. Forum June 8, 2007)

Further, previous panels have held that it does not matter whether the domain name is parked or whether respondent retains complete control of the disputed domain name, respondent is ultimately responsible for the website's content. See St. Farm Mutual Auto. Insr. Co. v. Pompilio, FA 1092410 (Nat. Arb. Forum Nov. 20, 2007) ("As a rule, the owner of a parked domain name does not control the content appearing at the parking site. Nevertheless, it is ultimately [the] respondent who is responsible for how its domain name is used.")

Respondent has stopped posting hyperlinks or any other content on the website, however, the registration remains in force. After almost 8 years of holding a domain registration for folderlock.com, Respondent continues to make no bona fide offering of goods or services or any demonstrable attempt to do so through this website.

Respondent holds no trademark registrations to the name FOLDER LOCK. Respondent is not commonly known by the domain name folderlock.com nor does Respondent operate a business under this name. The Whois information for the domain name forlderlock.com identifies Internet Commerce Services, Inc. as the registrant. As such Respondent has no legitimate rights or interest to the domain name folderlock.com. See IndyMac Bank F.S.B. v. Eshback, FA 830934 (Nat. Arb. Forum Dec. 7, 2006) (finding that the respondent was not authorized to register the domains containing complainant's mark and failed to provide any evidence to show that respondent was known by the domain name.); see also Reese v. Morgan, FA 917029 (Nat. Arb. Forum Apr. 5, 2007) (finding that the evidence did not establish that respondent was commonly known by the <lilpunk.com> domain name, including the WHOIS information as well as the complainant's assertion that it did not authorize or license the respondent's use of its mark in a domain name). Further Respondent is not associated with Complainant in any way.

In addition, Respondent appears to be in the business of registering domain names that are identical or confusingly similar to registered trademarks. See Mailmark Enterprises LLC v Joe Lackey a/k/a Internet Commerce Services Inc. FA 96817 (Nat. Arb. Forum April 16, 2001). (Exhibit to Complaint D)

Respondent has never made any legitimate noncommercial or fair use of the domain name folderlock.com. Respondent registered the domain name one year after Complainant began to make use of his FOLDER LOCK trademark in interstate commerce. Upon registering the domain name, Respondent enrolled folderlock.com in a domain parking service offered by Namebargain.com. As a result, hyperlinks to third party began to appear on folderlock.com. Displaying hyperlinks which

advertise third party products does not constitute a legitimate noncommercial or fair use of a domain name, where the domain name consists of another's registered trademark. See Skyhawke Techns., LLC v. Tidewinds Group, Inc., FA 949608 (Nat. Arb. Forum May 18, 2007). Here the Panel found "[r]espondent used the <skycaddy.com> domain name to display a list of hyperlinks, some of which advertise Complainant and its competitors' products." The Panel concluded that "this use of the disputed domain name does not constitute a bona fide offering of goods or services under Policy ¶ 4(c)(i), or a legitimate noncommercial or fair use under Policy ¶ 4(c)(iii)."); see also Zee TV USA, Inc. v. Siddiqi, FA 721969 (Nat. Arb. Forum July 18, 2006) (finding that the respondent engaged in bad faith registration and use by using a domain name that was confusingly similar to the complainant's mark to offer links to third-party websites that offered services similar to those offered by the complainant).

Enrolling a domain name in a parked page service that shares advertising revenue generated through pay-per-click hits does not constitute a legitimate noncommercial or fair use. Although Respondent's website no longer contains links to third party websites, Respondent has yet to make any type of legitimate noncommercial or fair use of the domain name.

[c.] Bad Faith

Respondent's registration of the domain was in bad faith. Respondent is in the business of registering domain names in bad faith, as Respondent's company and the principal individual behind the company are known cypbersquatters. Respondent has previously registered many domain names containing the trademarks or misspellings thereof of unrelated third parties. A UDRP complaint was previously filed against Respondent for the registration of confusingly similar domain names. See Mailmark Enterprises LLC v Joe Lackey a/k/a Internet Commerce Services Inc. FA 96817 (Nat. Arb. Forum April 16, 2001). There the panelist concluded that Respondent is a cybersquatter. Id. A determination of bad faith can be reached where a respondent had been subject to UDRP proceedings in which panels ordered the transfer of disputed domain names containing the trademarks of the complainants. See Westcoast Contempo Fashions Ltd. v. Manila Indus., Inc., FA 814312 (Nat. Arb. Forum Nov. 29, 2006), see also Arai Helmet Americas, Inc. v. Goldmark, D2004-1028 (WIPO Jan. 22, 2005) (finding that "Respondent has registered the disputed domain name, <aria.com>, to prevent Complainant from registering it" and taking notice of another UDRP proceeding against the respondent to find that "this is part of a pattern of such registrations").

It is clear that Respondent's registration of folderlock.com was done in bad faith. Respondent has actively attempted to profit from Complainant's trademark by registering an identical domain name and parking it with Namebargain.com. Even after Complainant informed Respondent of his trademark rights (Exhibit to Complaint E), Respondent did not take any action to repair the harm to Complainant. Rather, Respondent continues to hold the registration for the domain name folderlock.com. As such Respondent continues to prevent Complainant from acquiring the domain name folderlock.com. Further Respondent is a known cybersquatter. As such, the Panel has the liberty to find bad faith simply from the fact that Respondent is well aware that the domains it seeks to register must not violate another party's trademark rights, but continues to ignore this fact. As such it is clear that Respondent acted in bad faith when it registered the folderlock.com domain name.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the 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). Complainant has a US trademark registration for FOLDER LOCK, alleging a date of first use in February, 2001. However the application was not filed until February, 2003, three months after the Domain Name was registered by Respondent. This fact is relevant to the analysis of bad faith, below.

NO RIGHTS OR LEGITIMATE INTERESTS

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 Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy). Complainant at minimum shifted the evidentiary burden to the Respondent, who did not contest the allegations of the Complaint. The Domain Name was registered in December, 2002, and does not appear to have been used by the Respondent for any purpose other than to display a registrar's advertising page, which also stated the Domain Name was available for sale.

BAD FAITH

The Complainant has not, to the satisfaction of the Panel, shown that the Domain Name has been registered and used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy). The Complainant has only pointed to Respondent's passive holding of the domain name for eight years, and one prior UDRP complaint resulting in transfer of two domains from Respondent, in 2001. The Respondent has not appeared to contest the allegations of bad faith, nor the prior UDRP precedents cited in support of the Complaint.

Yet the Complainant's trademark application was not filed until three months after the Domain Name was registered, and Complainant has not provided any evidence that its trademark was in use prior to that time. Thus Complainant has not proved that Respondent had any opportunity to know of Complainant or its mark at the time the Domain Name was registered. Moreover, Complainant has not proved any behavior by Respondent that could be considered bad faith. Thus Complainant has failed to prove Respondent's bad faith registration of the Domain Name.

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements of the UDRP were met and there seems no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

It is Complainant's burden to prove, at least, "common law" trademark rights at the time the Domain Name was registered, in order to support an allegation of bad faith registration of a confusingly similar name. See, e.g., Tuxedos By Rose v. Nunez, FA 95248 (Nat. Arb. Forum Aug. 17, 2000) (finding common law rights in a mark where its use was continuous and ongoing, and secondary meaning was established); Stellar Call Ctrs. Pty Ltd. v. Bahr, FA 595972 (Nat. Arb. Forum Dec. 19, 2005) (finding that the complainant established common law rights because the complainant demonstrated that its mark had acquired secondary meaning). Alternatively, under some UDRP authorities, evidence of subsequent 'bad faith' might support a UDRP Complaint. But the Complainant provided no evidence of bad faith registration, other than the prior date of first use alleged (but unsupported) in its trademark application, and one prior UDRP decision against the Respondent in 2001. None of the typical indicia of bad faith registration have been demonstrated in this case, such as behavior targeting the Complainant and/or its mark, an offer of sale to the Complainant, an ongoing pattern of cybersquatting registrations, etc. Therefore, the third element of the Policy has not been proved, and the Complaint is denied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

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

PANELLISTS

Name	**Mike Rodenbaugh**

DATE OF PANEL DECISION 2010-10-06

Publish the Decision