Decision for dispute CAC-UDRP-100364

Case number	CAC-UDRP-100364
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Domain names	eleader.com

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	eLeader Sp. z o.o.

Respondent

Name	Hyunjong Lee

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any pending or decided proceeding related to the disputed domain name.

FACTUAL BACKGROUND

Complainant, eLeader, is a software vendor focused on mobile applications. eLeader was founded in the year 2000 and currently employs about 100 staff. eLeader sells its software internationally, and has projects in over 50 countries worldwide.

The disputed domain is ‘eleader.com’, which was registered by Respondent in 2003.

Complainant’s eLeader trademark registrations postdate Respondent’s registration of the disputed domain name.
While Complainant’s eLeader company name and trademark use predate Respondent’s registration of the disputed domain name.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

Complainant contends that:

1. The domain name is identical or confusingly similar to a trademark or service mark in which they have rights for the following reasons:

a. The Domain Name is identical to the company name ‘eLeader’ (Full name ‘eLeader Sp. z o.o.’ equivalent of ‘eLeader Ltd.’), which was registered in the year 2000. The company has been using the name ‘eLeader’ in its commercial engagements since the very beginning.

b. The Domain Name is identical to the trademark ‘eLeader’ which has been used internationally in relation to eLeader’s products and services (relating to mobile software), in advertising articles and other forms of publicity since the year 2000.

c. Although the mark eLeader was not registered until later, it has been a distinctive identifier of all eLeader’s products and services, internationally, since the inception of the company (year 2000), and as such eLeader asserts that, before the date of Domain Name registration, eLeader had established common law rights to the mark and that the mark had acquired secondary meaning.

Evidence of this are the following facts:

i. The mark ‘eLeader’ is contained in all of eLeader’s products (e.g. eLeader Mobile Banking, eLeader Mobile Sales, eLeader Mobile Visit, eLeader Mobile Service etc.). This product naming convention has been used since the year 2000.

ii. eLeader has publicised itself online (in multiple languages including English) since the year 2000, including in international, publically accessible product and partner directories (such as the Microsoft Global Partner Directory), since 2002.

iii. 100% of eLeader’s revenue since the year 2000 has been related to services or products carrying, and identified by, the ‘eLeader’ mark.

iv. In 2001 eLeader won the Microsoft ‘Most interesting application for Mobile Devices – 2001’ award and in 2002 eLeader won a Compaq/Microsoft award for best mobile application.

d. The disputed domain name is identical to the Registered Trade mark ‘eLeader’ Registered in Poland since 2004.

e. eLeader’s products are used in over 50 countries including South East Asian countries, and distributed in over 12 languages.

f. eLeader regularly promotes its brand, products, and services by exhibiting at international trade fairs.

g. eLeader owns the following ‘eLeader’ domains:
eleader.pl (since 2000)
eleader.com.pl (since 2000)
eleader.biz (since 2005)
eleader.eu (since 2006)
eleader.us (since 2011)

h. Website of eLeader Sp. z o.o. is the number one result in Google searches for the term ‘eLeader’, and has been since 2002.

2. As concerns Respondent's rights or legitimate interests in respect of the domain name the Complainant affirms that:

a. the Respondent has never made any use of and has not demonstrated preparations to use the domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services. This domain name has only ever contained a message regarding the domain being for sale and some unrelated advertising.

b. there is no evidence that the Respondent has ever been commonly known by the domain name. The term ‘eleader’ is in no way connected with the Respondent’s business or activities. The Respondent has not been known by the domain name, has no trademark or service mark rights to it, and is not authorised to use Complainant's marks.

c. the Respondent is not making a legitimate non-commercial or fair use of the domain name. The domain has only ever contained a message regarding the domain being for sale and some unrelated advertising.

3. Complainant then contends, that the disputed domain name has been registered and is being used in bad faith for the following reasons:

a. the disputed domain name has been registered speculatively, with the primary purpose being the sale of the domain for an amount far in excess of out-of-pocket expenses. Evidence for this includes:

i. The page shown on the Domain Name has listed this domain name as 'For Sale' at all times since its initial registration.
ii. Other than the 'for sale' message, and unrelated advertising, the domain has been parked and held passively for the duration of the registration. It has never contained any real content.
iii. In November 2005, Respondent demanded 75.000,00 EUR for the domain.

The above clearly shows that the intention of the Respondent has been to sell the Domain Name, and not use it in any bona fide way. It has been established in previous UDRP decisions that registering a domain name for the primary purpose of offering to sell, rent, or otherwise transfer the domain name for an amount in excess of the registration cost is evidence that a domain name was registered and is being used in bad faith.

b. According to a reverse WHOIS search using the Respondent's email address (hostmaster@newmall.com), the Respondent has registered 516 other domains, almost all of which seem to have been registered speculatively, are not used for any legitimate purpose, and are 'for sale' in the same way (examples: ibmco.com, porncable.com, dvdsky.com, savestore.com, amcom.com, cinemaya.com, ibiskm.com, sex161.com, eserv.com, accessoires.com)

c. Respondent has a history of registering domains containing, or similar to, established trade marks of third parties. Examples : ibmco.com [IBM], amcom.com [Amcom/Amcom Software], cinemaya.com [Cinemaya – popular international film magazine http://en.wikipedia.org/wiki/Cinemaya], dvdsky.com [Sky Tv] , eserv.com [Dell engineering services, formerly eServe]).

As stated in paragraph 4(b)(ii) of the URDP, a 'pattern of such conduct' can be considered evidence of bad faith registration and use.

d. As further evidence of Respondent's pattern of bad faith conduct, Respondent has repeatedly been challenged via the URDP and lost. Examples:

i. dadanet.com (see DADA S.p.A vs. Hyunjong Lee, 2007, WIPO Case No. D2007-1663).
ii. julbo.com (See Julbo vs. Hyunjong Lee, 2008, WIPO Case No. D2008-0525).

B. Respondent

Respondent contends that:

I. The disputed domain name is neither identical nor confusingly similar to the protected mark for the following reasons:

a. Complainant's Trademark Rights are not Identical nor Confusingly Similar to the domain name since when the disputed domain name was registered (i.e. April 28 2003), the complainant's trademark did not exist.
b. As a common word domain, eleader.com was subject to registration by virtually anyone on a "first-come first-served" basis. "leader" is a generic or common word. As shown in a dictionary, "leader" is a common word used to refer to "One who leads", "Something that leads." Moreover, the word "leader" is widely used by the general public and "e-" is a very common and popular prefix.
c. "eleader" (and also "e-leader") is a widely used term designating a leader which is related to online or electronically.

II. The Respondent has rights and/or legitimate interest in the domain name because:

a. The registration of a common word domain name, in and of itself, can establish a respondent's legitimate interest. There can be no doubt that "eleader" is a generic term with a very common and popular prefix subject to substantial third-party use. Generic term domain names are subject to registration by virtually anyone on a "first-come first-served" basis.
b. Moreover, it is well established that the hosting of a domain at a Domain Parking Site that displays PPC links is a bona fide use of the domain name that further supports a legitimate interest.
c. The links related to "leadership or leader" that have appeared on Respondent's web site do not make its interest illegitimate. The links were not put there by Respondent and thus they do not constitute an action taken by Respondent. They were auto-generated by the technology of the Domain Parking Sites.

III. Respondent contends that the domain name has not been registered and used in bad faith for the following reasons:

a. The meaning of the registration;
b. The registration date of the domain name anticipates Complainant's trade mark right;
c. Complainant's bad faith trade mark/business name registration;
d. Complainant's failure to meet the standard of proof;
e. Complainant has not demonstrated that the domain name was registered and is being used in bad faith;

In support of these claims Respondent affirms that since "eleader" is a generic term with a common prefix, which is equivalent to a common word, under the policy, Complainant must offer direct evidence that the Disputed Domain was registered in bad faith. In addition, Respondent affirms that there is no such evidence here and that he had a right to register the Domain because it incorporated the generic term "leader," with a common prefix "e-" which is available to be registered on a first-come first-served basis like any common word. Nor is there any basis to infer that the Disputed Domain was registered in bad faith.

Finally the Respondent requests that the Complaint be denied and that the Panel issue a decision of Reverse domain name hi-jacking.

RIGHTS

Discussion and findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."
Paragraph 4(a) of the Policy lists three elements that Complainant must prove to merit a finding that the domain name registered by the Respondent be transferred to the Complainant:
1) the domain name is identical or confusingly similar to a trademark or service mark ("mark") in which the Complainant has rights; and
2) the Respondent has no rights or legitimate interests in respect of the domain name; and
3) the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar
Complainant has established that it has rights in a registered trademark that is identical to the disputed domain name. Complainant has also proved to have used the <eleader> trademark since the year 2000 in such a way to acquire common law rights on the name since the very beginning of its use, namely (at least) since the year 2001 when eLeader won the Microsoft 'Most interesting application for Mobile Devices – 2001' award.

The Policy makes no specific reference to the date on which the holder of the trademark or service mark acquired rights, for this reason the registration of a domain name before a complainant acquires trademark rights in a name does not prevent a

finding of identity or confusing similarity under the UDRP.
The Panel is therefore satisfied that the Complainant has established that it has rights in a registered trademark which is identical to the disputed domain name. The fact that the registration of this trademark was granted after the disputed domain name was registered does not prevent a finding of identity or confusing similarity.
This Panel finds that the first requirement of paragraph 4(a) of the Policy is satisfied.
Whether the Complainant's rights to the trademark are prior to the registration of the disputed domain name or not, is relevant to prove that the domain name was (or was not) registered in bad faith under the third element of the UDRP. Therefore, this specific issue will be dealt when discussing the existence of bad faith registration.

The Complainant has, to the satisfaction of the Panel, shown that 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).

NO RIGHTS OR LEGITIMATE INTERESTS

B. Rights or Legitimate Interests

Complainant must show that Respondent has no rights or legitimate interests in respect of the disputed domain name. Respondent in a UDRP proceeding does not assume the burden of proof, but may establish a right or legitimate interest in a disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy:
a) that before any notice to the respondent of the dispute, he or she used or made preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;
b) that the respondent is commonly known by the domain name, even if he or she has not acquired any trademark rights; or
c) that the respondent is making a legitimate, non-commercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

Respondent has no connection or affiliation with Complainant, which has not licensed or otherwise authorised Respondent to use or apply for any domain name incorporating Complainant’s trademark. Respondent does not appear to make any legitimate use of the domain name for non-commercial activities. On the contrary, it appears that Respondent used the disputed domain name to direct consumers to a presumed Pay Per Click (PPC) parking page suggesting general links to websites that offered goods and/or services of different nature. Respondent does not appear to have been commonly known by the domain name.
Respondent's claim that: “it is well established that the hosting of a domain at a Domain Parking Site that displays PPC links is a bona fide use of the domain name that further supports a legitimate interest”, is incorrect. Indeed, «Panels have generally recognized that use of a domain name to post parking and landing pages or PPC links may be permissible in some circumstances, but would not of itself confer rights or legitimate interests arising from a "bona fide offering of goods or services" or from "legitimate non commercial or fair use" of the domain name, especially where resulting in a connection to goods or services competitive with those of the rights holder» (see WIPO Overview of WIPO Panel Views).
In addition, Respondent's argument that the links related to “leadership or leader” that have appeared on Respondent’s web site do not make its interest illegitimate due to the fact that they were auto-generated by the technology of the Domain Parking Sites, is not sufficient to escape Respondent's responsibilities for the contents displayed on the web site.
It is in fact true the opposite, namely in the case of advertising links appearing on an "automatically" generated basis, Panels have generally found that a domain name registrant is normally deemed responsible for the content appearing on its website, even if it is not exercising direct control over such content.
Thus the claim of the Respondent that the content is auto generated reinforces Complainant's thesis that Respondent is passively holding the disputed domain name and that it has been registered speculatively, with the primary purpose being the sale of the domain for an amount far in excess of out-of-pocket expenses.
Therefore, Respondent has not shown any facts or elements to justify prior rights and/or legitimate interests in the disputed domain name in accordance with the UDRP Policy . Respondent did not provide any elements to demonstrate, as requested by the Policy, that he used or made preparations to use the disputed domain name or a name corresponding to it in connection with a bona fide offering of goods or services.

In fact the Policy requires the Respondent to show, before any notice to him of the dispute, his use of, or demonstrable

preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services.
It is the Panel's view that the mere detention of the disputed domain name does not demonstrate any preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services.

Accordingly, the Panel finds that Complainant has satisfied the burden of proof with respect to paragraph 4(a)(ii) of the Policy.

BAD FAITH

C. Registered and Used in Bad Faith

For the purpose of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:
i) circumstances indicating that the holder has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the holder's documented out-of-pocket costs directly related to the domain name; or
ii) the holder has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or
iii) the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
iv) by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's web site or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the holder's web site or location or of a product or service on the holder's web site or location.
Accordingly, for a Complainant to succeed, the Panel must be satisfied that the domain name has been registered and is being used in bad faith.

It is the Panel's opinion that, in order to establish the existence of Respondent's bad faith registration, the following contentions of the Respondent need to be discussed:

1) Complainant's trademark rights are not Identical nor Confusingly Similar to the domain name since when the disputed domain name was registered (i.e. April 28 2003), the complainant's trademark did not exist.
2) « "eleader" is a generic term with a very common and popular prefix subject to substantial third-party use and therefore subject to registration by virtually anyone on a "first-come first-served" basis».

While it is true that the first registration of the trademark <eleader> was granted for 'eLeader' in 2004, Complainant has proved to have used the term eleader as a distinctive sign (i.e. as a trademark) since the very beginning of its activity and the establishment of the company that bears the same name i.e. 'eLeader Sp. z o.o.' (equivalent of 'eLeader Ltd.'), a company which was registered in the year 2000. Complainant has also proved widespread use of the trademark and to have been known (at least in its own field) with the trademark <eLeader> which was used to mark Complainant's products since its establishment. This is proven by the fact that in 2001 eLeader won the Microsoft 'Most interesting application for Mobile Devices – 2001' award and in 2002 eLeader won a Compaq/Microsoft award for best mobile application. Complainant has also shown that the website of eLeader Sp. z o.o. is the number one result in Google searches for the term 'eLeader', and has been since 2002.

As concerns Respondent's contention that « "eleader" is a generic term with a very common and popular prefix subject to substantial third-party use and therefore subject to registration by virtually anyone on a "first-come first-served" basis», the Panel notes that, while there is no doubt that the word "leader" is a generic term, the same is not so true for the term "eleader" which is a combination of two distinct terms. In addition, Respondent has not asserted nor documented that the term eleader is (and even less that at the time Complainant started its use eleader was) a "widely used term designating a leader which is related to online or electronically". It is this Panel's opinion that the combination of two generic terms does not in itself determine that the result of this combination will also be a generic term. No one can doubt that the terms "i" and

“phone” as well as “e” and “bay”are generic terms . However, things are quite different when these terms are combined to create the words “Iphone” or “ebay”, which nowadays are quite renowned trademarks.
Nevertheless, this Panel, considering the abundant use, especially on the Internet, of the letter “e” as an abbreviation for “electronic” and the generic term “leader”, should the circumstances described here below be different, would have been ready to accept the hypothesis that the disputed domain name was registered as a mere coincidence and without any bad faith intention.
However, having considered:
a) that Respondent offered to sell the disputed domain name to Complainant for the amount of 75.000,00 Eur;
b) the “domain for sale” message displayed on the Respondent's web site;
c) that Respondent uses the disputed domain name for a parking site with commercial ads and sponsored links redirecting to websites offering goods and services of various types;
d) the amount of domain names registered by the Respondent (i.e. more than 500);
e) the registration of many domain names containing and or corresponding to third parties' registered trademarks such as: lamborghini.net, linuxhome.com, linuxtime.com, dvdsky.com, amcom.com, cinemaya.com and many others;
f) the passive holding of the disputed domain name for such a long period (i.e. 9 years);
g) the fact that Respondent did not deny knowledge of Complainant's name, products and/or activity at the time he registered the disputed domain name; and
h) the fact that this same Respondent has already been involved in at least two UDRP proceedings for having abusively registered domain names corresponding to third parties' registered trademarks.

This Panel finds that, on the balance of probability, Respondent knew of the complainant's rights when he registered the disputed domain name and that he chose to register the disputed domain name having in mind Complainant's unregistered trademark.
It is the Panel’s opinion that all the above has shown Respondent's bad faith registration and use of the Domain Name that clearly falls within the example given in paragraph 4 of the Policy.

Considering the foregoing, the Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

Furthermore, Respondent's request for a finding of reverse domain name hijacking is denied.

PROCEDURAL FACTORS

Procedural aspect – language of the proceeding

The language of the registration agreement is Korean, therefore the language of the proceeding should have been Korean too. However, given Complainant's request for English to be the language of the proceeding, the absence of any opposition to this request, Respondent's good command of the English language and the provision underparagraph 11 of the UDRP Rules that gives the panel discretion to determine the appropriate language of proceedings, this Panel, considers appropriate and of no prejudice to the parties to accept English as the language of this proceeding.

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.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ELEADER.COM**: Transferred

PANELLISTS

Name	**Dr. Fabrizio Bedarida**

DATE OF PANEL DECISION 2012-05-04

Publish the Decision