Decision for dispute CAC-UDRP-101337

Case number	CAC-UDRP-101337
Time of filing	2016-11-14 09:01:45
Domain names	lunchmail.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Name	Sven Mark Sawatzki

Respondent

Organization	WHOIS PRIVACY PROTECTION SERVICE, INC.

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of the EU trademark “Lunchmail” No. 8274193 (word mark; registration date: 12 January 2010; application date: 30 April 2009; classes 35, 38, 42).

FACTUAL BACKGROUND

The factual background of the dispute can be summarized as follows:

The Complainant owns an EU trade mark “Lunchmail” No. 8274193.

The Complainant provides online services to restaurants since 2008 under the name "Lunchmail". These services include the provision of email newsletters about lunch menus to guests of restaurants. The Complainant provides such services internationally via several domain names, including <lunchmail.net>, <lunchmail.de>, <lunchmail.fr>, <lunchmail.at>, etc.

The disputed domain name (<lunchmail.com>) (hereafter the “Domain Name”) was first registered on 27 September 2000 (this was confirmed by the Registrar) by a third party, Compendium, Inc. (hereafter "Compendium") (the creation date is prior to the registration/application date of Complainant's trademark). The Complainant asserts that it has contacted Compendium several times to acquire the Domain Name, but that its attempts remained unanswered and unsuccessful. The Complainant asserts that Compendium never actively used the Domain Name. The Complainant asserts that Compendium only used the Domain Name to redirect visitors to a different website (at <live-inspired.com>). The Complainant submitted a screenshot of a "Wayback Machine" service (through <archive.org>) evidencing the redirection to <live-inspired.com> on the capture date 13 March 2016. On the capture date 6 October 2016, the Wayback Machine service indicated: "This Domain Name Has Expired".

The Whois history of the Domain Name shows that the original expiration date of the Domain Name for 2016 was 27 September 2016. Compendium did apparently not renew its registration of the Domain Name. It seems that, shortly after the expiration of the Domain Name, the Domain Name was registered by the Respondent (a company using or providing privacy services for domain name registrations). The Respondent indeed confirms that it owns the Domain Name since 1 November 2016. The current expiration date of the Domain Name is 27 September 2017.

The Complainant submitted a screenshot of the website available at the Domain Name. This screenshot bears the date of 1 November 2016. This is the same date as the date the Respondent became the owner of the Domain Name. From this screenshot, it appears that this website only contained the following content: "This domain may be for sale. Backorder this Domain." (with a link to the backorder, and a link to a privacy policy). According to the Complainant, the backorder redirected to the website <namejet.com> where the Domain Name was offered for sale through a public auction. The contact details on the website <namejet.com> are the same contact details as those of the Registrar (eNom, Inc.).

On 3 November 2016, the Complainant sent an email to the Respondent, indicating that it owned trademark rights in the name "Lunchmail" and that it would like to take over the Domain Name <lunchmail.com>. On the same date, the Complainant received an email from a certain Jim York of Gio Media, offering the Domain Name and asking to take contact per email or telephone. On 7 November 2016, the Complainant responded by stating "As trademark owners of Lunchmail we would indeed like to take over this domain name." The same day, Mr Jim York of Gio Media responded: "Our price to sell this domain is $2,500 USD." Subsequent email correspondence was cited by the Complainant (but not submitted as attachments to the claim). From this correspondence, it seems that the Complainant refused to pay this amount and asked to know the current legal owner of the Domain Name. It furthermore seems that Mr Jim York refused to provide such information and informed the Complainant that the Domain Name had been sold to an anonymous purchaser.

According to evidence submitted by the Respondent (declaration by Carolyn Mitchell, Director of Compliance for eNom, Inc, i.e., the registrar of the disputed Domain Name), the Respondent became the owner of the disputed Domain Name on 1 November 2016. This means that the Domain Name was owned by the Respondent at the time of the email correspondence referred to above (correspondence starting on 3 November 2016).

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

1. The Domain Name is identical to the EU trademark of the Complainant.

2. The Respondent has no rights or legitimate interests in the Domain Name. The Complainant refers to the following circumstances:
• Domain parking;
• Use of privacy or proxy registration services;
• Inactive website;
• Non use/Passive holding.

3. The Domain Name has been registered and is being used in bad faith. The Complainant referred to the following categories of issues:
• Use of privacy or proxy registration services;
• Deliberate provision of false/misleading Whois data;
• Constructive knowledge/prior knowledge of potential rights;
• Blocking registration;
• Automated registration;
• Speculation in domain names;
• Holding domain name for purposes of selling, licensing or renting (offer to Complainant; offer to public);
• Selling, licensing or renting was the primary purpose;

• Non-use of the Domain Name;
• Other: The selected categories above are difficult to justify without knowing who the actual domain owner is.

In its additional explanations, the Complainant mentioned that the Domain Name was offered for sale by the Respondent (directly or indirectly) for the price of 2.500 USD.

RESPONDENT:

1. As concerns the purported identicalness or confusing similarity of the Domain Name to the trademark of the Complainant: Complainant has merely checked a box stating that the Domain Name is “identical” but did not actively prove such assertion. Complainant has not proved that the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

2. As concerns the Respondent's purported lack or rights or legitimate interests:

The Policy does not affirmatively require a respondent to demonstrate legitimate rights or interests. The overall burden of proof rests with the Complainant. The Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. According to the Respondent in this particular case, the Complainant did not make a single argument that Respondent lacks legitimate rights or interests in the Domain Name. The Complainant has merely checked boxes stating that the following “categories of issues” are involved: “Domain parking”; “use of privacy or proxy registration services”; “inactive website”; and “non use/Passive holding.” The Complainant is obligated to prove such assertion. Because the Complainant has failed to prove such assertion, the Complainant has not made a prima facie case that Respondent lacks rights or legitimate interests, and thus the burden of proof has not shifted to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the Domain Name.

As concerns the purported domain parking: According to the Respondent, the assertions of the Complainant are contradictory, in the sense that a parked domain does not constitute an inactive website, nor a form of non-use or passive holding. Respondent is not operating a parked page using the Domain Name. Complainant has not produced evidence that Respondent has engaged in domain parking. Even if Complainant had produced such evidence, such evidence would not demonstrate that Respondent lacks rights or legitimate interests, since click-through services are common business practices and constitute legitimate use of a domain name.

As concerns the purported use of a privacy or prosy registration service: The Respondent claims that the Respondent is not using a privacy or proxy service: while the Respondent happens to operate a proxy service, the Respondent is the registrant of the Domain Name.

As concerns the purported inactive website or non use or passive holding: An inactive website/non use/passive holding have no relevance in determining whether the Respondent lacks rights or legitimate interests in the Domain Name. If anything, an inactive website/non use/passive holding could establish that Respondent has not gained rights or legitimate interests in the Domain Name via use of the Domain Name.

3. As concerns the purported bad faith at registration and use of the domain name:

The Respondent has no affiliation with, or knowledge of, one “Jim York” or one “Gio Media”. This concerns an unaffiliated third party who had no right to offer the Domain Name for sale to the Complainant. The Respondent has never had any correspondence with the Complainant.

The Respondent is not using a privacy service. While Respondent happens to operate a proxy service, Respondent is the registrant of the Domain Name. Thus, Complainant’s argument is not applicable and cannot lead to any finding of bad faith. Furthermore, the use of a privacy or proxy registration service is not in itself an indication of bad faith.

The Respondent, in registering the Domain Name, was motivated by an independent intent, unrelated to the Complainant.

The Respondent had no knowledge of the Complainant at the time it registered the Domain Name. The Complainant offers no facts, evidence, or case support that the Respondent, a United States company, would have had either actual or constructive knowledge of the Complainant at the time it registered the Domain Name.

“Lunch Mail” is a descriptive term. The Complainant does not have exclusive, worldwide rights to the “Lunch Mail” term. The Complainant is not the only party using “Lunch Mail” in a trademark sense.

The Complainant did not provide evidence that Respondent is using the Domain Name for a free ride upon the rights of Complainant.

The Respondent registered the Domain Name on 1 November 2016. The Complaint was filed on 22 November 2016. It would be unreasonable to find bad faith use of the Domain Name by non use/passive holding over such a short period of time.

4. Reverse domain name hijacking

The Respondent requests that the Panel issue a decision of Reverse Domain Name Hijacking.

The Respondent mentions the following circumstances of Complainant's bad faith:
(1) Complainant does not make one single argument that the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
(2) Complainant does not make one single argument that Respondent lacks legitimate rights or interests in the Domain Name;
(3) Complainant asserts that it is “difficult to justify” that Respondent registered and/or is using the Domain Name in bad faith;
(4) Complainant checked a box stating that “domain parking” is involved in this matter, but Complainant does not furnish any evidence of Respondent’s domain parking;
(5) Complainant attempts to argue bad faith based on the alleged actions of (i) the registrar of the domain name, and (ii) “Mr. York,” where Complainant must show bad faith on the part of Respondent;
(6) Complainant checked a box stating that “constructive knowledge/prior knowledge of potential rights” is involved in this matter, but Complainant offers no facts, evidence, or case support that Respondent, a United States company, would have had either actual or constructive knowledge of Complainant at the time it registered the Domain Name;
(7) Complainant checked a box stating that “use of privacy or proxy registration services” is involved in this matter, but that is obviously not the case;
(8) Complainant checked a box stating that “deliberate provision of false/misleading Whois data” is involved in this matter, but that is obviously not the case;
(9) Complainant checked a box stating that “speculation in domain names” is involved in this matter, but Complainant offers no facts or evidence that that is the case; and
(10) Complainant checked a box stating that “holding domain name for purposes of selling, licensing or renting...to Complainant” is in involved in this matter, but that is not the case.

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).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has not, 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).

BAD FAITH

The Complainant has not, 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).

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

1. As regards paragraph 4(a)(i) of the UDRP, it is well established that the generic TopLevel Domains (“gTLDs”) may typically be disregarded in the assessment under paragraph 4(a)(i) of the Policy (e.g., Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D20000003). While accordingly ignoring the gTLD “.com”, the Panel finds that the Domain Name is identical to the Complainant's EU trademark "Lunchmail". The fact that the Respondent is based in the US is not relevant in this regard. The first prong of paragraph 4(a) of the UDRP requires that the disputed domain name should be identical or confusingly similar to “a trademark or service mark in which the complainant has rights” and does not limit these trademarks to the location of the respondent. Consequently, the first requirement of paragraph 4(a) of the UDRP is met.

2. As regards paragraph 4(a)(ii) of the UDRP, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often impossible task of proving a negative. Therefore, numerous previous Panels have found that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP. If the respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the panel then has to weigh all the evidence, with the burden of proof always remaining on the complainant.

In the current case, the Complainant limited itself to simply referring to the following so called “categories of issues”: “Domain parking”, “use of privacy or proxy registration services”, “inactive website” and “non use / passive holding”. The Complainant did not provide much additional information or evidence of these so called “categories of issues”.

In particular, the Complainant did not provide any additional explanation or argumentation with regard to the purported “domain parking”, “inactive website” or “non use / passive holding”. Although the Complainant did provide a screen shot of the website available at the Domain Name (from which it seems that the website only contained the following content: "This domain may be for sale. Backorder this Domain."), the Panel notes that this screen shot dates from 1 November 2016, i.e. the very same date as the date the Respondent became the registered owner of the Domain Name. The Panel believes that the Respondent should be given a reasonable period of time to make use of the Domain Name. Therefore, given the chronology of the facts and the argumentation and evidence submitted by the parties, the Panel does not find that the Complainant has made a prima facie case that the Respondent’s use of the Domain Name constituted so called “domain parking”, “inactive website” or “non use / passive holding”.

The Complainant added a document to its Complaint, entitled “Arguments in detail”. In this document, the Complainant mentioned – between others – that the Respondent used a Whois privacy service and that the registrar did not reveal the entity behind the Whois privacy protection. Between the lines, the Complainant also referred to “incomplete contact information” by the Respondent. In response, the Respondent claimed that it did not use a privacy protection service, and that the mere fact that it happens to operate a privacy protection service does not prevent it from registering domain names in its own name (i.e., the Respondent is the true registrant of the Domain Name; there is no underlying or hidden registrant). The Panel finds that the Complainant has not made a prima facie case that the Respondent lacks legitimate rights or interests in the Domain Name just by referring to the fact that the Respondent operates a proxy service. The Panel did take into account the fact that the Respondent seems to be the true registered owner of the Domain Name, and that the Complainant failed to provide evidence of incomplete contact information or other additional elements of fact proving or indicating that the Respondent tried to conceal its true identity.

The Panel concludes that the Complainant has not made a prima facie case that the Respondent lacks rights or legitimate interests to the Domain Name. The Panel refers in particular to the fact that only very few days lapsed between the date of Respondent's registration of the Domain Name (1 November 2016) and the date of Complainant's lodging of the complaint (8 November 2016; the amended Complaint was lodged on 16 November 2016). The Panel finds that this time period is too short to blame the Respondent for not having made demonstrable preparations for using the Domain Name, for not being commonly known by the Domain Name or for not making a legitimate noncommercial or fair use of the Domain Name. The Panel notes in this regard that the Complainant does not even make such claims and merely referred to so called "categories of issues", namely "domain parking", "use of privacy or proxy registration services", "inactive website" and "non use / passive holding". The Panel finds that the Complainant did not provide sufficient argumentation or evidence that the circumstances of paragraph 4(c) of the UDRP are absent. The Panel notes that the Complainant did not provide argumentation or evidence that the Respondent had knowledge or should have had knowledge of its trademark rights (for instance, the Complainant did not argue that its trademark is a well-known trademark), or that the Respondent is engaged in a pattern of registration of domain names without using them (which might, in particular circumstances, constitute evidence of a lack of rights or legitimate interests).

In conclusion, the Panel finds that the Complainant has not satisfied the requirements of paragraph 4(a)(ii) of the UDRP.

3. Given the fact that the Complainant has failed to satisfy the burden of proof of paragraph 4(a)(ii) of the UDRP, the Panel does not need to inquire into the Respondent's registration or use of the Domain Name in bad faith (paragraph 4(a)(iii) of the UDRP).

Nevertheless, the Panel notes the following:

In its complaint, the Complainant limited itself to referring to the following so called "categories of issues":
• Use of privacy or proxy registration services
• Deliberate provision of false/misleading Whois data
• Constructive knowledge/prior knowledge of potential rights
• Blocking registration
• Automated registration
• Speculation in domain names
• Holding domain name for purposes of selling, licensing or renting (offer to Complainant; offer to public)
• Selling, licensing or renting was the primary purpose
• Non-use of the Domain Name
• Other: The selected categories above are difficult to justify without knowing who the actual domain owner is.

In its additional explanations (a document entitled "Additional explanations"), the Complainant mentioned that the Domain Name was offered for sale by the Respondent (through a Mr Jim York of Gio Media) for the price of 2.500 USD.

The Complainant argued that the Respondent tried to conceal its identity through use of a privacy or proxy service, whereas in reality the Respondent registered the Domain Name in its own name (there does not seem to be another underlying registrant). On the one hand, the Panel finds that the Complainant cannot be blamed for a possible confusion caused by the Respondent's offering of proxy services. On the other hand, the Panel finds that the mere fact that the Respondent offers such services does not constitute sufficient evidence of bad faith. The Panel finds that there is no sufficient evidence that the Respondent tried to conceal its true identity or deliberately provided incomplete, false or misleading Whois information. The Panel also notes that conducting a business of privacy/proxy services is not in and of itself an indication of bad faith.

The Complainant did not argue or substantiate that its trademark is a well-known trademark or has a particular name, fame or reputation. The Panel finds that the Complainant did not succeed in substantiating that the Respondent had constructive or prior knowledge of the Complainant's trademark rights.

The Complainant did not provide any detailed argumentation or evidence of its claims of so called "blocking registration",

“automated registration” or “speculation in domain names”. In particular, the Complainant did not provide any evidence of a so called pattern of abusive registrations of domain names by the Respondent.

The Complainant claims that the Respondent holds the Domain Name “for purposes of selling, licensing or renting (offer to Complainant; offer to public)”. The Complainant also claims that “selling, licensing or renting was the primary purpose” for registering the Domain Name. The Complainant submitted a document, entitled “Arguments in detail”. In this document, the Complainant cites – between others – email correspondence with a certain Jim York of Gio Media who, on 3 November 2016, offered the Domain Name for sale for the price of 2.500 USD. The Complainant argues: “it is quite obvious that his email was triggered by my email from just eight hours earlier” (i.e. an email sent by the Complainant to the Respondent via the contact details published in the whois information of the Domain Name; in this email, the Complainant identified himself as the trademark owner of the trademark “Lunchmail” and mentioned that he would like to take over the Domain Name). The Complainant claims that the Domain Name “has been taken over in bad faith and captured for the sole purpose of selling it to us as trademark holder”. The Complainant concludes: “To me, knowing what I described above, it appears to have been registered or at least deliberately extended in bad faith, the registrar is attempting to make money with an expired 17-year-old domain name - by offering it publicly at Namejet.com (same company as registrar) and personally by email by Mr. York.” However, (i) given the lack of any evidence of a connection between this Mr. Jim York or Gio Media and the Respondent; (ii) given the fact that the Respondent explicitly denies any connection with such parties; and (iii) given the very short time frame between the Respondent’s registration of the Domain Name and the lodging of the Complaint, the Panel cannot conclude that the Respondent registered or used the Domain Name solely or primarily for the purpose of selling, licensing or renting the Domain Name to the Complainant or to the public.

Furthermore, given the very short time frame between the Respondent’s registration of the Domain Name and the Complainant’s lodging of the complaint, the Panel cannot conclude that the Respondent’s purported “non-use” of the Domain Name constitutes bad faith.

The Panel notes that the Complainant does not provide convincing argumentation or evidence that any of the circumstances of paragraph 4(b) of the UDRP are present. The Panel notes that the Complainant does not provide sufficient convincing argumentation or evidence that any other circumstances of bad faith at registration or during use of the Domain Name are present.

The Panel also notes that the Respondent argued that his registration of the Domain Name was motivated by an “independent intent”, unrelated to the Complainant. The Panel deplores that the Respondent did not provide further explanation of this “independent intent”, nor evidence for his reasons to register this particular domain name. However, this circumstance does not in itself entails that the Complainant has made a sufficient case in proving bad faith of the Respondent at the time of registration and during use of the Domain Name.

In conclusion, the Panel finds that the Complainant has not satisfied the requirements of paragraph 4(a)(iii) of the UDRP.

4. Finally, the Panel finds that the Complaint was not brought in bad faith and did not constitute an abuse of the administrative procedure. The Panel notes that lack of success of a complaint is not itself sufficient for a finding of Reverse Domain Name Hijacking. Although the Complainant's arguments under paragraphs 4(a) (ii) and (iii) of the UDRP failed, they did not fail by such an obvious margin that the Complainant must have appreciated that this would be the case at the time of filing the Complaint.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

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

PANELLISTS

Name	**Bart Van Besien**

DATE OF PANEL DECISION 2017-01-03

Publish the Decision