Decision for dispute CAC-UDRP-101148

Case number	CAC-UDRP-101148
Time of filing	2016-02-22 10:43:07
Domain names	floatel.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Floatel International AB
Organization	Floatel International Ltd.

Complainant representative

Organization	Awapatent AB

Respondent

Name	DHARSHINEE NAIDU

OTHER LEGAL PROCEEDINGS

No other legal proceedings are known by the Panel.

IDENTIFICATION OF RIGHTS

The Complainant Floatel International Ltd owns Swedish Trademark No. 517311 for FLOATEL registered on February 14, 2014, upon application made on October 29, 2013, and International Trademark No. 1224876 for FLOATEL registered on June 10, 2014, in the European Union, United States of America, Singapore, Norway, China and Australia.

The Complainant Floatel International AB owns the domain name <floatel.se> registered on October, 4, 2006.

FACTUAL BACKGROUND

The complaint is filed on behalf of two Complainants. The first Complainant is Floatel International Ltd which was established in 2006 and is incorporated under the laws of Bermuda. Since its founding in 2006, Floatel International Ltd., through Floatel International AB (the second Complainant), has promoted and used the FLOATEL mark throughout the world to promote its services in the fields of the management of platforms for the offshore industry, as well as related services including the rental, repair, installation and maintenance of platforms for the offshore industry. The first Complainant is the owner of trademark registrations for the FLOATEL mark with effects in Australia, European Community, Norway, Singapore and United States. Floatel International Ltd has established a Swedish subsidiary, Floatel International AB (the second

Complainant), to provide onshore operational support services and onshore supervision of the new flotels on behalf of the owner. The second Complainant registered the domain name <floatel.se> on October 4, 2006, and has used the same domain name in connection with its website to promote its services continuously since 2007.

The Respondent is a physical person who affirms to own and manage around 70.000 domain names.

The domain name in dispute <floatel.com> was registered on June 25, 1997.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS.

COMPLAINANT:

The Complainants submit that the domain name <floatel.com> is confusingly similar to the FLOATEL mark since the <floatel.com> domain name fully incorporates the "FLOATEL" mark, merely adding the generic top level domain identifier ".com". In addition, Complainants affirm that their first use and subsequent acquisition of rights in the FLOATEL mark pre-date Respondent's 2012 registration of the <floatel.com> domain name; actually, in the Complainants view, although the WHOIS record indicates that the creation date for the <floatel.com> domain name is June 25, 1997, Respondent's ownership of the <floatel.com> domain name dates after January 14, 2012. In order to prove this issue, Complainants attach a Domain Tools WHOIS history listing for the <floatel.com> domain name on January 14, 2012, showing that the record owner was at that time Domain Finance Inc. c/o Minakumari Periasamy, Kuala Lumpur, Malaysia. Considering said document, according to Complainants, it was only after January 14, 2012, that the Respondent became the owner of the <floatel.com> domain name, well after the Complainants had established common-law rights in the FLOATEL mark. The Complainants further submit that the Respondent has no rights or legitimate interests in the <floatel.com> domain name and affirm that on December 14, 2015, the <floatel.com> domain name redirected to another of the Respondent's domain names <barges.com> that promotes the goods and services of Intership Ltd, a direct competitor of Floatel International AB in the offshore accommodation market. Considering the above it is clear, according to the Complainants, that the Respondent could not have any legitimate rights in the <floatel.com> domain name in connection with a site that redirects to a web site that promotes the goods and services of a direct competitor of the second Complainant. Furthermore, Complainants underline that the WHOIS record of the domain name in dispute lists Dharshinee Naidu as the registrant for the <floatel.com> domain name and there is nothing in the WHOIS record that would indicate Respondent is or is commonly known as Floatel. The Complainants also claim that the Respondent both registered and is using the <floatel.com> domain name in bad faith. Respondent's registration of a domain name that is confusingly similar to the FLOATEL mark to divert Internet users to a web promoting one of the second Complainant's main competitors evidences a clear intent to trade upon the goodwill associated with the FLOATEL mark. This, in the Complainants view, is classic cybersquatting since Respondent is deliberately using a domain name that is confusingly similar to a mark to attract Internet users by creating a likelihood of confusion with a similar mark as to the source, sponsorship, affiliation or endorsement of his website. Finally, as asserted by Complainants, it should be noted that Respondent has been determined to have registered other domain names in bad faith such as <holdon.com> and <iranianamericaneagle.com>.

RESPONDENT:

The Respondent is a wholesale domain name holder. It submits that the word FLOATEL in which Complainants have trademark rights is a generic and descriptive term. The Respondent accepts that the disputed domain name is confusingly similar to the Complainants trademark, however it notes that the same Respondent registered the disputed domain name almost ten years in advance of the Complainants coming into existence. In addition the Respondent underlines that the domain name <floatel.com> has been used continuously to market and promote the business activities of a company named Intership Ltd. In this perspective the Respondent submits Internet Archive Wayback Machine entries for <floatel.com> which show that the domain name in dispute has been used for promoting the activity of the company Intership Ltd. since 2001 until now. The Respondent insists that the domain name in dispute was registered in good faith for the use of Intership Ltd in June 1997. It has been in continuous use by Intership Ltd since that time. In the Respondent's view the Complainants argument related to bad faith in registering should not be taken into consideration since there was no way

in 1997, at the time of creation of the domain name, that someone could have contemplated the Complainant's future existence or their future trademark registrations. On the contrary, numerous previous UDRP decisions have held that the Complainant rights must predate the Respondent's domain registration. According to Respondent the complaint at issue constitutes an abuse of the Uniform Domain Name Dispute Resolution administrative process.

In addition, since the Complainants noted that Dharshinee Naidu was involved in previous ADR at WIPO, the Respondent submits that it owns and manages around 70,000 domain names and so would expect to be involved in this kind of disputes.

Finally, with the nonstandard communication dated April 8, 2016, the Respondent has clearly stated that on March 2, 2012, the domain name in dispute was transferred from the previous holder Domain Finance Inc. to the Respondent Dharshinee Naidu.

RIGHTS

The Complainants have, to the satisfaction of the Panel, shown the Domain Name is identical and confusingly similar to the registered trademark "FLOATEL" in which the Complainants have rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

In light of the Panel's decision in relation to bad faith, it is unnecessary to determine whether the Complainants have shown the Respondent to have no rights or legitimate interests in respect of the of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainants have failed to show, to the satisfaction of the Panel, that the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy, which requires a showing of both bad faith registration and bad faith use).

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.

On April 7, 2016, the CAC received an email from the Respondent containing additional submissions, i.e. after the expiration date for filing the response. On April 9, 2016, the Complainants requested this unsolicited filing to be rejected. Pursuant to paragraph 10 (a) of the Rules it is up to the Panel to conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules. Furthermore, pursuant to paragraph 10 (b) of the Rules the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case. In that regard it should be mentioned that the Registrar corrected its error by an email dated March 29, 2016. This error was included by the Respondent in its response to the complaint. Therefore, the Panel is of the opinion that additional submissions of the Respondent shall be accepted for there are exceptional circumstances. Furthermore, the Panel has considered the Respondent’s additional submissions only in the part in which there is a clear confirmation of circumstances already mentioned by Complainants (in particular the change of ownership of the domain name in dispute).

PRINCIPAL REASONS FOR THE DECISION

To succeed, the Complainants must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(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.

The Parties are in agreement that the disputed domain name is confusingly similar to the Complainants FLOATEL trademark. The Panel also agrees since the domain name is clearly identical and therefore confusingly similar to the Complainant's registered FLOATEL trademark, the gTLD ".com" being inconsequential and to be disregarded (Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525; Rollerblade, Inc. v. Chris McCrady, WIPO Case No. D2000-0429; Priority One Financial Services Inc. v. Michael Cronin, WIPO Case No. D2006-1499; Laramar Group, L.L.C. v. XC2, WIPO Case No. D2006-0617; Vitalii Stavropolskyi v. Daniel Shen, CAC Case No. 100651). In these circumstances, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark and that the requirement of paragraph 4(a)(i) of the Policy has been satisfied. The requirements of paragraph 4(a) of the Policy are conjunctive. A consequence of this is that failure on the part of Complainants to demonstrate one element of the Policy, including that the disputed domain name has been registered and is being used in bad faith, will result in failure of the complaint in its entirety. Accordingly, in light of the Panel's finding under the next head, it is unnecessary for the Panel to address the issue of the Respondent's rights or legitimate interests in the disputed domain name. Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, 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 you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location".

The question to be analyzed in order to state whether or not the requirement of paragraph 4(a)(iii) of the Policy has been satisfied is examining if the Complainants have established both (i) bad faith registration and (ii) bad faith use. The Panel determines that they have not done so. In this respect it should be noted that Complainants are generally expected to show both (i) the Respondent's knowledge of the relevant mark at the time of registration of the subject domain name and (ii) the Respondent's intent to target or benefit in some way from inclusion of the complainant's mark in the subject domain name (China Care Foundation, Inc. v. Choi Yun Gul, WIPO Case No. D2010-1208; Validas, LLC v. SMVS Consultancy Private Limited, WIPO Case No. D2009-1413). There are previous decisions supporting the view that a trademark, or a company name, that did not exist at the time the disputed domain name was registered cannot serve as the basis for a claim under the ICANN Policy, since it is impossible for the domain name to have been registered in bad faith (Duction, Inc. v. Zuccarini, WIPO Case No. D2000-1369; Open Systems Computing AS v. Alessandri, WIPO Case No. D2000-1393; VBW Kulturmanagement & Veranstaltungs GmbH v. Ohanessian M, WIPO Case No. D2000-0675; Magic Software Enterprises Ltd. v. Evergreen Technology Corp., WIPO case No. D2000-0746; Highlight Communications AG v. Auto Systems Inc., WIPO Case No. 2000-0512; Meteor Mobile Communications v. Dittmar, WIPO Case No. D2000-0524; Telaxis Communications Corp. v. Minkle, WIPO Case No. D2000-0005). Applying these principles to the present facts, when the domain name was registered on June 1997, the Complainants were not doing any business under the FLOATEL name, so that the domain name could not have been registered in bad faith. According to the evidence submitted by Complainants, although the WHOIS record indicates that the creation date for the <floatel.com> domain name is June 25, 1997, Respondent's ownership of the <floatel.com> domain name dates after January 14, 2012. In order to prove this issue, Complainants attach a Domain Tools WHOIS history listing for the <floatel.com> domain name on January 14, 2012, showing the record owner was at that time Domain Finance Inc. c/o Minakumari Periasamy, Kuala Lumpur, Malaysia. This circumstance has been fully confirmed by the Respondent with the nonstandard communication dated April 8, 2016, in which it is clearly stated that on March 2, 2012, the domain

name in dispute was transferred from Domain Finance Inc. to the Respondent Dharshinee Naidu. According to Complainants view this domain name acquisition made by Respondent is relevant since, at that time, Complainants had common-law rights on FLOATEL. In other words Complainants assume that the reason of the domain name acquisition (or at least one of the reasons) is the intent of the Respondent to target or benefit in some way from inclusion of the Complainants company name in the domain name acquired. This in consideration of the fact that at that time the Respondent had full knowledge of the Complainants identity and rights on FLOATEL. In this respect it must be underlined that for the purposes of the Policy common-law rights are sufficient and a complainant thus need not hold a registered trademark to establish rights in a mark. The Policy is thus broad in scope in that the reference to a trademark or service mark in which complainant has rights means that ownership of a registered mark is not required and unregistered or common law trademark or service mark rights will suffice to support a domain name complaint under the Policy; (British Broad. Corp. v. Renteria, WIPO Case No. D2000-0050; Jeffrey Archer v. Alberta Hotrods tda CELEBRITY 1000, WIPO Case No. 2006-0431). The Panel has duly considered the possible fraudulent nature of the domain name acquisition made by the Respondent and from the evidence submitted by the parties it seems quite clear than no speculative intention aimed the Respondent in carrying out this operation. The Respondent has submitted Internet Archive Wayback Machine entries for <floatel.com> which show that the domain name in dispute has been always used for promoting the activity of the company Intership Ltd. since 2001 until now. According to the above it is clear that the ownership of the domain name has changed but, on the other hand, the use of the domain name has always been the same which is promoting the business of the company Intership Ltd which was incorporated before the Complainants started any business.The evidence submitted by the parties shows:

a) on June 25, 1997, the domain name in dispute was registered;

b) from 2001 until now the website corresponding to the domain name in dispute has been used to promote the business activity of a company named Intership Ltd. which is a competitor of the Complainants;

c) on 2006 Complainants commenced their activities;

d) on 2012 Complainants, in consideration of the intensive use of the term FLOATEL in connection with their business activity, already had common-law rights on the word FLOATEL even if the first trademark application was filed in Sweden only on October 2013;

e) on March 2, 2012, the company Domain Finance Inc. transferred the domain name in dispute to the Respondent;

f) the domain name in dispute, after the change of ownership, has been still used in connection with the business activity of Intership Ltd.;

g) the Respondent never attempted to contact the Complainants in order to sell them the domain name <floatel.com>.

In consideration of the above mentioned circumstances the Panel believes that the acquisition made by the Respondent is not a bad faith acquisition. Even if one should consider that the Respondent at the time of the domain name acquisition already had full knowledge of Complainants and of their business activity carried out with the unregistered trademark FLOATEL nothing was done by the Respondent in order to change the destination of the website corresponding to <floatel.com> or to have a benefit from the possible transfer of said domain name to the Complainants. According to the Panel's view, in case of acquisition of a domain name, the use in bad faith of the same domain name, with the meaning of paragraph 4(a) (iii) of the Policy, should necessarily resolve in positive acrtions or behaviours by the new owner, in order to create a prejudice or damage to the owner of rights which predate the domain name acquisition (i.e. changing a passive holder into a website dedicated to competitors or contacting the owner of the above mentioned rights in order to sell him the domain name for a particularly high amount of money). Since the Respondent, once becoming the owner of the disputed domain name, has not changed the destination of the domain name nor has had any contact with Complainants, in the Panel's view the use made by the Respondent of the domain name in dispute may not be considered as an use in bad faith with the meaning of paragraph 4(a) (iii) of the Policy.

In addition the Respondent believes to be the victim of an attempted reverse domain name hijacking by the Complainants.

Reverse domain name hijacking means using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name. To establish reverse domain name hijacking, a respondent would typically need to show knowledge on the part of the complainant of the complainant's lack of relevant trademark rights, or of the respondent's rights or legitimate interests in, or lack of bad faith concerning, the disputed domain name (Personal Communication System, Inc. v. CDU Properties Incorporated, WIPO Case No. 2014-0664). The Respondent notes that the registration of the disputed domain name far predates Complainants rights on the term FLOATEL. The Complainants of course knew this because they produced the WHOIS record for the disputed domain name as an attachment to its complaint. The evidence submitted by the Respondent clearly demonstrates that the disputed domain name has always been used since 2001 in order to promote the business of a Complainants competitor. Accordingly, it is clear that Complainants, when chose FLOATEL as their company name, knew or ought to have known, that the correspondent domain name <floatel.com> was unavailable because used for a website related to one of their competitors. The fact that the disputed domain name was transferred on 2012 to the Respondent does not alter this scenario as Complainants were never contacted by the new owner of <floatel.com> in order to sell them the domain name at issue nor the website connected with <floatel.com> changed its goal which is promoting the business activity of the company Intership Ltd. This circumstance should have been clearly known by Complainants which, in the Panel's view, used the change of ownership in the domain name in dispute as a mere pretext to launch the complaint. According to the above it is clear that the Complainants knew or clearly should have known, at the time that they filed the complaint, that they could not prove one of the essential elements required by the UDRP which is the bad faith.
Consequently, the Panel finds that the complaint was submitted in an attempt to hijack the Respondent's domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

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

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2016-04-12

Publish the Decision