Decision for dispute CAC-UDRP-101777

Case number	CAC-UDRP-101777
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Domain names	sanabul.com

Case administrator

Name	Iveta Špiclová (Case admin)

Complainant

Organization	Pulse Sports LLC

Complainant representative

Organization	Lewis & Lin, LLC

Respondent

Name	Wasea Qubadi

OTHER LEGAL PROCEEDINGS

As stated in the Complaint, Complainant filed and previously lost a decision under the UDRP regarding the Disputed Domain Name. Sanabul v. Wasea Qubadi, Forum Claim No. 1748693. Complainant has argued that its refiled complaint in this proceeding is appropriate "to address a fundamental error made by the Panelist" in the previous decision. Specifically, Complainant states that, in the previous decision, the Panel "conducted independent research and inaccurately assumed that the Respondent registered the SANABUL.COM domain name on its July 3, 2014 'creation date'," instead of a later date (as explained below) on which the Disputed Domain Name was transferred to Respondent. Complainant further states that "[t]he Panelist wrongly concluded that Complainant lacked 'cognizable trademark rights' because its federal trademark registration issued 'some five months after the disputed domain name was registered.'"

Although the UDRP has no express restriction against it, panels are generally reluctant to review or issue a substantive decision on a refiled case, that is, where a complainant files a second UDRP complaint against the same respondent with respect to the same domain name. As set forth in paragraph 4.18 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"):

"Panels have accepted refiled complaints only in highly limited circumstances such as (i) when the complainant establishes that legally relevant developments have occurred since the original UDRP decision, (ii) a breach of natural justice or of due process has objectively occurred, (iii) where serious misconduct in the original case (such as perjured evidence) that influenced the outcome is subsequently identified, (iv) where new material evidence that was reasonably unavailable to the complainant during the original case is presented, or (v) where the case has previously been decided (including termination

orders) expressly on a 'without prejudice' basis."

Here, Complainant argues that it has been deprived of "natural justice and due process of law." This Panel has reviewed the previous decision between the parties regarding the Disputed Domain Name and is immediately struck by an obvious flaw in the previous panel's decision. Specifically, the previous panel wrote:

"Given that the disputed domain name was registered by Respondent some five months prior to the issuance of Complainant's trademark and given the fact that Complainant alleges no secondary meaning in that mark prior to that time, the Panel has no choice but to find for Respondent…. The Panel finds that the Complainant has failed to carry its most important burden here: to establish cognizable trademark rights."

This conclusion in clearly wrong – although the legal error is unrelated to Complainant's concern about the previous panel's independent research or the date on which the Disputed Domain Name was acquired by Respondent. Rather, the error is simply that the previous panel appears to have misunderstood or misapplied the first element of the UDRP, which requires only that a complainant prove that the "domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights." Paragraph 4(a)(i). This element says nothing about the date on which a domain name was created or acquired or the date on which trademark rights arose. It refers only to the existence of trademark rights (and, of course, whether the domain name is identical or confusingly similar to such trademark). As set forth in section 1.1.3 of WIPO Overview 3.0: "While the UDRP makes no specific reference to the date on which the holder of the trademark or service mark acquired its rights, such rights must be in existence at the time the complaint is filed. The fact that a domain name may have been registered before a complainant has acquired trademark rights does not by itself preclude a complainant's standing to file a UDRP case, nor a panel's finding of identity or confusing similarity under the first element." Further, section 3.8.1 of WIPO Overview 3.0, says that registration of a domain name "before the complainant's trademark rights accrue… would not… impact a panel's assessment of a complainant's standing under the first UDRP element."

Here, it is obvious from reading the previous decision that Complainant's trademark rights existed at the time the complaint in that case was filed. The decision states that "Complainant's trademark, SANABUL, [was] issued on September 30, 2014," and that the complaint was filed on September 12, 2017. There is nothing in the decision to indicate that Complainant's trademark rights were invalid, only that they may have arisen after the Disputed Domain Name was created (on July 3, 2014) – which, as stated above, is irrelevant to the first element of the UDRP.

As a result, the previous panel's conclusion that creation of the Disputed Domain Name prior to the date on which Complainant had shown that its trademark rights arose should not have affected the panel's conclusion under paragraph 4(a)(i) of the UDRP. Unfortunately, having reached that flawed but fatal conclusion, the panel said that it would "forgo a full three-factor analysis of this case," so it is impossible to know how the previous panel would have applied the second and third elements of the UDRP. Had the previous panel more fully examined the case and found that Complainant had failed to prevail on one of the other two required elements, this Panel might be reluctant to accept this refiled case. However, because the previous decision was reached based on an error that determined the outcome, this Panel is compelled to revisit it here.

Finally, the Panel notes that Complainant said it was "pro se" (that is, that it represented itself without the assistance of counsel) in the previous proceeding. This has no bearing on the Panel's decision here to accept this refiled case, as the Panel sees no reason to grant a complainant a second opportunity simply because it did not avail itself of appropriate resources in the first instance. Further, it appears (but is unclear from the sparse decision in the first case) that Complainant may have failed to fully explain in its first complaint that the Disputed Domain Name had been transferred to the Respondent after the creation date set forth in the whois record. This also has no bearing on the Panel's decision here to accept this refiled case, as this is not "new material evidence that was reasonably unavailable to the complainant during the original case." However, because the Panel has decided to accept the refiling solely due to an apparent error in the previous decision, Complainant is free to make whatever arguments and provide whatever evidence it deems appropriate here, and the Panel will not exclude anything simply because it may not have been a part of the original complaint – something that, in any event, the Panel is in no position to ascertain.

IDENTIFICATION OF RIGHTS

Complainant states, and provides evidence to support, that it is the owner of two U.S. trademark registrations that consist of or contain the mark SANABUL (the "SANABUL Trademark"):

U.S. Reg. No. 4,615,019 for SANABUL (registered September 30, 2014), for use in connection with, inter alia, "Sports equipment for boxing and martial arts"

U.S. Reg. No. 4,884,997 for SANABUL & Design (registered January 12, 2016), for use in connection with, inter alia, "Sports equipment for boxing and martial arts"

FACTUAL BACKGROUND

Complainant states that, "[s]ince launching in 2013, Complainant has achieved revenues in the millions of dollars, primarily from sales on its website located at <SanabulSports.com>, and in several prominent combat gyms in the Los Angeles area"; that "[t]he SanabulSports.com Web site receives close to 100,000 visitors, annually"; and that "Complainant sells a wide range of sporting goods products to tens of thousands of customers across the United States, with millions of dollars worth of products sold over time."

The Disputed Domain Name was created on July 3, 2014. However, Complainant states that the Disputed Domain Name was obtained by Respondent "on or about June 3, 2017" – a statement supported by historical whois records provided by Complainant and not contradicted by Respondent.

Complainant states, and Respondent has not disputed, that Respondent "owns and operates <ProFightShop.com>, a business in direct competition with Complainant"; that "Respondent Wasea Qubadi's business is based in Hollywood, California, the same city where Complainant is located"; and that "Respondent acquired the <Sanabul.com> domain name fully aware of Complainant's competing business and solely to profit from or otherwise disrupt that business." The Disputed Domain Name is not being used in connection with an active website.

Complainant contends, in relevant part, as follows:

Paragraph 4(a)(i): Complainant has rights in and to the SANABUL Trademark as a result of both common law rights as well as the registrations cited above. The Disputed Domain Name is identical and confusingly similar to the SANABUL Trademark because "[t]here is no legally significant difference between" the domain name and trademark; and the domain name contains the trademark "in its entirety and merely adds" the ".com" top-level domain.

Paragraph 4(a)(ii): Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, "Respondent cannot claim and does not own any common law trademark rights to the SANABUL Trademark or the SANABUL.COM domain name"; "[t]he WHOIS information for the disputed domain name does not indicate that Respondent is commonly known by the SANABUL.COM name"; "Respondent registered the SANABUL.COM domain name earlier this year to disrupt Complainant's business, of which Respondent is a competitor"; and "Respondent is not licensed or authorized to register or use a domain name incorporating Complainant's mark."

Paragraph 4(a)(iii): The Disputed Domain Name was registered and is being used in bad faith because, inter alia, "Respondent registered the disputed domain name at some point in 2017, after Complainant had been offering goods and services for more than four (4) years, and nearly three (3) years after Complainant was granted registered trademark rights to the SANABUL mark"; "Respondent's registration of the SANABUL.COM domain name, unassociated with a bona fide offering of goods/services, was solely to create a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of Respondent's website in order to disrupt Complainant's business"; "[b]y registering the domain name, Respondent diverted potential and actual SANABUL customers"; and "Respondent's clear intent in registering the domain name was to prevent Complainant from registering it, and to divert customers trying to find and utilize Complainant's goods/services – either directly or indirectly" because "Respondent Wasea Qubadi competes directly with Complainant and stands to gain financially when customers do not purchase goods on the SANABUL website and instead seek competing goods at <ProFightShop.com>."

PARTIES CONTENTIONS

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 UDRP).

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 UDRP).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the UDRP).

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

Identical or Confusingly Similar

Based upon the trademark registrations cited by Complainant, it is apparent that Complainant has rights in and to the SANABUL Trademark. As previously noted, it is irrelevant for purposes of paragraph 4(a)(i) when these registrations were issued.

As to whether the Disputed Domain Name is identical or confusingly similar to the SANABUL Trademark, the relevant comparison to be made is with the second-level portion of the Disputed Domain Name only (i.e., “sanabul”) because “[t]he applicable Top Level Domain (‘TLD’) in a domain name (e.g., ‘.com’, ‘.club’, ‘.nyc’) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.” WIPO Overview of WIPO Overview 3.0, section 1.11.1.

Here, the Disputed Domain Name contains the SANABUL Trademark – and only the SANABUL Trademark – in its entirety. As stated in WIPO Overview 3.0, section 1.7, “in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.”

Accordingly, the Panel finds that Complainant has proven the first element of the UDRP.

Rights or Legitimate Interests

Complainant has argued that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, “Respondent cannot claim and does not own any common law trademark rights to the SANABUL Trademark or the SANABUL.COM domain name”; “[t]he WHOIS information for the disputed domain name does not indicate that Respondent is commonly known by the SANABUL.COM name”; “Respondent registered the SANABUL.COM domain name earlier this year to disrupt Complainant’s business, of which Respondent is a competitor”; and “Respondent is not licensed or authorized to register or use a domain name incorporating Complainant’s mark.”

WIPO Overview 3.0, section 2.1, states: “While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often

impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

The Panel finds that Complainant has established its prima facie case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the UDRP.

Registered and Used in Bad Faith

Whether a domain name is registered and used in bad faith for purposes of the UDRP may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the UDRP: (i) circumstances indicating that the registrant has registered or the registrant 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 registrant's documented out-of-pocket costs directly related to the domain name; or (ii) the registrant 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 registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's website 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 registrant's website or location or of a product or service on the registrant's website or location.

Here, Complainant has specifically argued that bad faith exists pursuant to paragraph 4(b)(iii) of the UDRP: "Respondent registered the disputed domain name at some point in 2017, after Complainant had been offering goods and services for more than four (4) years, and nearly three (3) years after Complainant was granted registered trademark rights to the SANABUL mark. Respondent's registration of the SANABUL.COM domain name, unassociated with a bona fide offering of goods/services, was solely to create a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of Respondent's website in order to disrupt Complainant's business. Such use is evidence of bad faith use and registration under UDRP Policy paragraph 4(b)(iii)."

It is unclear from the record whether Complainant had rights in the SANABUL Trademark when the Disputed Domain Name was created on July 3, 2014. However, it is clear from the record that Complainant had rights in the SANABUL Trademark when Respondent obtained its registration of the Disputed Domain Name, which appears to have occurred on or about June 3, 2017, as shown by historical whois records provided in the Complainant and not contradicted by Respondent. As set forth in section 3.1.8 of WIPO Overview 3.0: "Merely because a domain name is initially created by a registrant other than the respondent before a complainant's trademark rights accrue does not… mean that a UDRP respondent cannot be found to have registered the domain name in bad faith. Irrespective of the original creation date, if a respondent acquires a domain name after the complainant's trademark rights accrue, the panel will look to the circumstances at the date the UDRP respondent itself acquired the domain name." Therefore, the Panel examines whether Respondent acted in bad faith when it acquired the Disputed Domain Name on or about June 3, 2017 – nearly three years after Complainant obtained its first registration for the SANABUL Trademark on September 30, 2014.

As previously noted, Complainant has stated, and Respondent has not disputed, that Respondent "owns and operates <ProFightShop.com>, a business in direct competition with Complainant." Therefore, Respondent's registration and use of a domain name that is identical or confusingly similar to Complainant's trademark clearly can disrupt the Complainant's business, even if the Disputed Domain Name is, as here, associated with a "suspended" web page because, as Complainant has argued, such "use of the Domain Name gave prospective customers who searched for Complainant at www.Sanabul.com, the false impression that Complainant's website was down and its domain was suspended."

Numerous previous UDRP decisions have found bad faith under similar circumstances. See, e.g., The Dow Chemical

Company v. dowaychemical eva_hwang@21cn.com +86.7508126859, WIPO Case No. D2008-1078 (“[t]he Respondent was clearly specifically targeting the Complainant’s trademark and attempting to divert Internet users searching for the Complainant’s product to the Respondent’s website”); LinkedIn Corporation v. Direct Privacy, Domain Name Proxy Service, Inc., WIPO Case No. D2014-0494 (finding bad faith where “the Respondent was acting in competition with the Complainant”); and Pancil, LLC v. Jucco Holdings, WIPO Case No. D2006-0676 (“[t]he only explanation of what has happened is that the Respondent’s motive in registering and using the [domain name] seems to be… simply to disrupt the Complainant’s relationship with its customers or potential customers or attempt to attract Internet users for potential gain”).

Accordingly, the Panel finds that Complainant has proven the third element of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SANABUL.COM**: Transferred

PANELLISTS

Name	**Douglas M. Isenberg**

DATE OF PANEL DECISION 2018-02-22

Publish the Decision