

Decision for dispute CAC-UDRP-104897

Case number CAC-UDRP-104897

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Domain names globist.com

Case administrator

Organization Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization Globist Ltd

Respondent

Organization Globist DMCC

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the registrant of the following trademarks:

- EU trademark registration No. 017171737 "Globist", registered on June 12, 2018, for goods and services in classes 16, 35, 38 and 41;
- EU trademark registration No. 017958624 "Globist", registered on January 9, 2019, for goods and services in classes 9, 39, 42 and 43;
- UK trademark registration No. UK00917171737 "Globist", registered on June 12, 2018, for goods and services in classes 16, 35, 38 and 41;
- UK trademark registration No. UK00917958624 "Globist", registered on January 9, 2019, for goods and services in classes 9, 39, 42 and 43;
- United States trademark registration No. 6771229 "GLOBIST", registered on June 28, 2022, for goods and services in class 16;
- United States trademark registration No. 6777900 "GLOBIST", registered on July 5, 2022, for goods and services in class 35;
- United States trademark registration No. 6697566 "GLOBIST", registered on April 12, 2022, for goods and services in class 39;
- United States trademark registration No. 6959918 "GLOBIST", registered on January 24, 2023, for goods and services in class 41.

The disputed domain name was registered on December 27, 2007.

FACTUAL BACKGROUND

The Complainant is a company based in London, United Kingdom.

The Complainant is the owner of the registered trademark GLOBIST.

The Complainant has provided evidence that the disputed domain name was registered on December 27, 2007.

The Complainant submits that since years the disputed domain name redirects to the registrar's parking webpage.

The Complainant notes that the registrant was a company based in Dubai, United Arab Emirates. The Complainant adds that the Respondent's license expired on March 4, 2019 and its registration status is "Dissolved".

The Complainant has provided evidence of the fact that on May 2, 2023, it notified to the registrar the existence of the registered trademarks "GLOBIST" and requested the transfer of the disputed domain name. On the same date, the registrar replied that it was not the owner of its customers' domains, therefore it could not transfer them to anybody unilaterally, and informed the Complainant about the Policy.

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 Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Panel has based its determination in this proceeding on the Complainant's failure to establish that the Respondent registered and is using the disputed domain names in bad faith. Given that the criteria set out in the Policy are cumulative, for reasons of administrative efficiency the Panel does not address the issue of rights or legitimate interests.

BAD FAITH

The Complainant has not, 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 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. The Respondent did not request the additional time set out in Article 5(a) of the Rules for Uniform Domain Name Dispute Resolution Policy in which to respond to the complaint, but replied to the complaint after the deadline using a non-standard communication. In these circumstances, the Panel has considered that it is appropriate to disregard the non-standard communication and to decide the dispute based upon the complaint.

PRINCIPAL REASONS FOR THE DECISION

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the disputed domain name, the Complainant has to demonstrate that:

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

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark or service mark.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademark "GLOBIST", identified in section "Identification of rights" above.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain name itself to the Complainant's trademark.

The disputed domain name differs from the Complainant's trademark only by the addition of the top-level domain ".COM".

It is well established that merely adding a top-level domain to a trademark is not sufficient to distinguish a domain name from a trademark (see, for example, CAC Case No. 100831).

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The requirements of paragraph 4(a) of the Policy are cumulative. Consequently, the Complainant's failure to demonstrate one element of the Policy results in failure of the Complaint in its entirety. Accordingly, in light of the Panel's finding in connection with registration and use in bad faith, it is unnecessary for the Panel to address the issue of the Respondent's rights or legitimate interests in the disputed domain name.

BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

(i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] 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 Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or

(ii) [the Respondent] [has] registered the [disputed] 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 Respondent] [has] engaged in a pattern of such conduct; or

(iii) [the Respondent] [has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel notes that the Complainant has developed no arguments as regards registration and use in bad faith.

Indeed, the Complainant refer to "Relevant decisions e.g.: CAC-UDRP-104622", to the fact that it is the owner of registered trademarks and that the Respondent's licence has expired.

The decision cited as example is not relevant because it concerns the case of a well-known trademark, registered long before the disputed domain name. In the present case, the trademark is not well-known and was registered after the registration of the disputed domain name.

The Panel notes that the trademark is registered in EU, UK and USA, while the Respondent is based in the United Arab Emirates.

Even if the registration of the Complainant's trademark predated the registration of the disputed domain name, quod non, in the Complaint there is no evidence of the Respondent's knowledge of the Complainant's rights in the trademark "GLOBIST" at the time of registration of the disputed domain name.

In the light of the fact that there is no evidence that the Complainant's trademark was registered or used in the United Arab Emirates at the time of the registration of the disputed domain name, the Panel takes the view that, on the balance of probabilities, the Respondent did not have the Complainant in mind when it registered the disputed domain name.

Other panels considered that if the Respondent is unaware of the existence of the trade mark owner, it cannot be regarded as having any bad faith intentions directed at the Complainant (see for example CAC Case No. 104559). The Panel shares this view.

As clarified by other panels (see WIPO Case No. D2002-0757), having a trademark registration is not sufficient, per se, to establish

bad faith under the Policy.

As regards the fact that the Respondent's licence has expired, and that the disputed domain name redirects to the registrar's webpage, other panels observed that the fact that a registrant wishes to keep its domain name even after its business has come to an end and the domain name redirects to the registrar's webpage, does not constitute, as such, evidence of bad faith (see WIPO Case No. D2015-1216). The Panel agrees with this view and considers that the same reasoning applies to the present case.

In view of all the above, and without prejudice to the right of the Complainant to submit the dispute to the courts of competent jurisdiction, the Panel finds that the Complainant has failed to carry its burden in terms of paragraph 4(a)(iii) of the Policy in that it has not proved to the Panel's satisfaction that the disputed domain name was registered and has been used in bad faith. The Complaint accordingly fails.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **globist.com**: Remaining with the Respondent

PANELLISTS

Name	Michele Antonini
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DATE OF PANEL DECISION **2023-06-10**

Publish the Decision
