

ADMINISTRATIVE PANEL DECISION

Obero Inc. v. Domain Manager, eWeb Development Inc.
Case No. D2016-2591

1. The Parties

The Complainant is Obero Inc. of Vaughan, Ontario, Canada, internally represented.

The Respondent is Domain Manager, eWeb Development Inc. of Richmond, British Columbia, Canada, represented by Muscovitch Law P.C., Canada.

2. The Domain Name and Registrar

The disputed domain name <obero.com> is registered with Alpine Domains Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 21, 2016. On December 21, 2016, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 23, 2016, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 3, 2017. In accordance with the Rules, paragraph 5, the due date for Response was January 23, 2017. The Response was filed with the Center on January 19, 2017.

The Center appointed Christopher J. Pibus as the sole panelist in this matter on February 1, 2017. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a company located in Vaughan, Ontario, Canada and is the owner of the trademark OBERO in Canada under Registration No. TMA 940,331, registered on June 8, 2016. The Complainant provides corporate performance management software to assist its clients with budgeting, forecasting and reporting processes. The Complainant was incorporated in 2010, and claims a date of first use of its trademark and trade name of September 23, 2010.

The disputed domain name <obero.com> was registered by the Respondent on July 28, 2008. The disputed domain name resolves to a website displaying a form allowing customers to contact the Respondent to inquire about the disputed domain name.

5. Parties' Contentions

A. Complainant

The Complainant submits that it owns a Canadian trademark registration for the mark OBERO under Registration No. TMA 940,331 dated June 8, 2016. The Complainant also relies on a United States of America application for the mark OBERO under serial No. 87,241,574 filed November 18, 2016. The Complainant contends that the trademark OBERO is confusingly similar to the disputed domain name <obero.com> because it replicates the Complainant's trademark in its entirety, except for the ".com" url designation.

The Complainant states that there is no evidence that the Respondent has used, or is making any demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. The Complainant further states that the Respondent is not commonly known by the disputed domain name, and has not been authorized by the Complainant to use the Complainant's registered trademark.

The Complainant further alleges that the Respondent has registered and used the disputed domain name in bad faith because it has registered and used the disputed domain name for purposes of selling, renting or otherwise transferring the disputed domain name to the registered owner of the trademark for more than the Respondent's out-of-pocket costs.

B. Respondent

The Respondent submits that the disputed domain name was registered more than eight years prior to the date the Complainant's trademark was registered in Canada. The disputed domain name was registered in July, 2008, and at that time the Respondent could not have been aware of the Complainant's registered trademark rights because those rights did not then exist. The Respondent also notes that the Complainant's claimed date of first use of the OBERO trademark is September 23, 2010, which is two years after the disputed domain name was registered by the Respondent. Accordingly, even the Complainant's possible common law rights do not pre-exist the Respondent's rights in the disputed domain name. Accordingly, the Respondent has senior rights and entitlement to the disputed domain name <obero.com>.

The Respondent also states that the Complainant has not submitted any actual evidence to support a lack of legitimate rights or interests, or bad faith on the part of the Respondent. The Respondent argues that the Complainant has only filed allegations and claims that mirror the language of the WIPO model complaint, without any factual support.

In terms of its evidence, the Respondent has submitted a corporate profile of the Complainant's business, which reveals a date of first use of the trade name and trademark OBERO in 2010. The Respondent identifies itself as a company located in Richmond, British Columbia, Canada, and provides website development, hosting and a branding business. The Respondent registers many domain names that are

surnames, descriptive, geographic, unique and coined words or acronyms. The Respondent's business then offers its customers the ability to purchase those domain names, along with website development and brand development packages. Examples of similar domain names within the Respondent's portfolio are:

<patero.com>
<tanero.com>
<hobero.com>
<obeon.com>
<obemo.com>
<obema.com>
<nabero.com>

The Respondent claims that it has used the disputed domain in connection with its domain name registration and branding business for many years, and notes that the Complainant waited six years before raising any complaint.

The Respondent submits that it sent a letter on January 9, 2017 to the Complainant demanding that the Complainant withdraw the Complaint because of the Respondent's senior rights in the disputed domain name. The Respondent contends that the failure of the Complainant to withdraw the Complaint in these circumstances is evidence of an abuse of the UDRP process.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, in order to succeed, the Complainant must establish each of the following elements:

- (i) The disputed domain name is identical or confusingly similar to the 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.

A. Identical or Confusingly Similar

The Panel finds that the Complainant does have registered trademark rights in the mark OBERO by virtue of its trademark registration TMA 940,331.

The Panel further finds that the disputed domain name <obero.com> is confusingly similar to the Complainant's registered trademark OBERO. The Panel finds that the addition of the generic Top-Level Domain ".com" does not serve to distinguish the disputed domain name from the Complainant's registered trademark.

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

B. Rights or Legitimate Interests

Further to the comments made in section 6(C) below, the Panel will not make a finding with respect to rights or legitimate interests.

C. Registered and Used in Bad Faith

The Complainant has filed a *pro forma* complaint, which is entirely bereft of substantive evidence aside from the existence of its Canadian trademark registration for OBERO. That trademark registration states that the OBERO mark was registered on June 8, 2016, with a date of claimed first use of September 23, 2010. This date of first use is supported by the corporate profile filed by the Respondent in the Response. Accordingly, the Panel finds that the Respondent could not have been aware of the Complainant's rights in the trademark OBERO when it registered the disputed domain name <obero.com> on July 28, 2008. The Panel therefore finds that there is a critical absence of bad faith at the time the Respondent registered the disputed domain name.

The Complainant has made only a token attempt to establish bad faith in its submissions. It pleads the conclusion it desires without any supporting evidence, and virtually no arguments. In these circumstances, there is no good reason to depart from well-established practice to the effect that reliance on a trademark that did not exist at the time of registration of the disputed domain name will not constitute bad faith (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), paragraph 3.1).

The Panel finds that the Complainant has not satisfied the third requirement under paragraph 4(a) of the Policy.

D. Reverse Domain Name Hijacking

Paragraph 15(e) of the Rules states the following:

"(e) ... If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding."

On its face, this Complaint was fatally flawed, due to the absence of trademark rights in the hands of the Complainant at the relevant date.

The Complainant ought to have noticed that the Respondent's registration of the disputed domain name pre-dated the Complainant's registered trademark rights by eight years. If the Complainant had done even a cursory investigation it would have determined that its Complaint was without proper foundation. Upon review of the Complaint, the Panel agrees with the conclusions reached in *SK Lubricants Americas v. Andrea Sabatini, Webservice Limited*, WIPO Case No. D2015-1566 and *NetDeposit, Inc. v. NetDeposit.com*, WIPO Case No. D2003-0365, which found in similar circumstances that those complaints were improperly launched because the registrations of the disputed domain names pre-dated the complainants' respective trademark rights in each case.

The Panel finds that the Complainant's conduct constitutes an abuse of this administrative proceeding, and that this Complaint has engaged in the act of Reverse Domain Name Hijacking under the Policy.

7. Decision

For the foregoing reasons, the Complaint is denied.

Christopher J. Pibus

Sole Panelist

Date: February 10, 2017