

ADMINISTRATIVE PANEL DECISION

Intellect Design Arena Limited v. Moniker Privacy Services / David Wieland,
iEstates.com, LLC

Case No. D2016-1349

1. The Parties

The Complainant is Intellect Design Arena Limited of Chennai, Tamil Nadu, India, represented by S Eshwar Consultants, India.

The Respondent is Moniker Privacy Services of Fort Lauderdale, Florida, United States of America (“USA”) / David Wieland, iEstates.com, LLC of Chicago, Illinois, USA, represented by Muscovitch Law P.C., Canada.

2. The Domain Name and Registrar

The disputed domain name <unmail.com> is registered with Moniker Online Services, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 1, 2016. On July 1, 2016, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 4, 2016, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on July 4, 2016 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on July 13, 2016.

The Center verified that the Complaint together with the amended 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 July 14, 2016. In accordance with the Rules, paragraph 5, the due date for Response was August 3, 2016. The Response was filed with the Center on August 2, 2016.

On August 5, 2016, the Complainant notified by email its intention to withdraw the Complaint. On August 6, 2016, the Respondent indicated by email that it did not consent to such withdrawal. On August 8, 2016, the Complainant issued a further email in which it provided its reasons for seeking withdrawal of the Complaint. On August 10, 2016, the Center wrote to the Parties noting the Complainant's request to terminate the proceedings and the Respondent's apparent objection. In such communication, the Center invited the Respondent to submit its comments to the Center regarding the Complainant's termination request by August 12, 2016, noting that if the Respondent confirmed its objections to such termination request the Center would proceed to the appointment of the Panel. On August 12, 2016, in an email to the Center, the Respondent confirmed its objection to the unilateral withdrawal of the Complaint. In such communication, the Respondent also noted that the Complainant's request contained references to "without prejudice" communications which the Respondent indicated that it would wish to be withdrawn from the record or, alternatively, would wish to make submissions regarding the withdrawal request. On August 15, 2016, the Center wrote to the Respondent confirming that all of the Parties' communications received by the Center would be forwarded to the Panel.

On August 15, 2016, the Respondent filed a Supplemental Filing. On August 17, 2016, the Complainant filed a Supplemental Filing.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on August 15, 2016. 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 public limited company incorporated under Indian law and having its registered office in Chennai, Tamil Nadu, India. The Complainant provides financial technology services for banking, insurance and other financial services. As part of its offering, the Complainant has introduced an Enterprise Social Network software solution named "Unmail" which allows employees to communicate and collaborate within an online space. It appears that the software was originally named "Octopus" and the Complainant shows that between 2012 and 2014 an offering by this name was being promoted by an organization named Polaris Financial Technology. The Complainant does not say specifically how it was connected to that organization, although it appears from press reports that the person holding the position of Chief Technology Officer and Chief Information Officer for Polaris in 2012 was holding the same position with the Complainant by 2015. Likewise, on May 11, 2015 the Complainant issued a press release referring to an award received for "Intellect Octopus".

On August 13, 2015, a press report shows that the Complainant's Chief Technology Officer and Chief Information Officer was "in Mumbai for the soft launch of Unmail". An extract from the Complainant's website dated August 11, 2015, produced by the Respondent, shows that the Complainant announced that it was launching "UnMail" to the market as of that date. Photographs apparently related to the launch were posted on the Complainant's "Facebook" page on August 30, 2015. An article dated August 27, 2015 indicates that "UnMail" was "earlier known as Octopus".

On January 6, 2016, the Complainant announced that it had received its 13th consecutive award for "Unmail" at the CeBIT 2015 exhibition held in Bangalore and on February 19, 2016, the Complainant announced a 14th consecutive award for "Unmail" at the IDC Insights Award 2015. The Complainant provides a list of seven awards which it says have been received for "Unmail".

The Complainant provides a list indicating that it has made multiple applications across various jurisdictions for registered trademarks in respect of the mark UNMAIL. None of these marks had proceeded to grant as at the date of filing of the Complaint. The Complainant does not specify when it applied for these marks, however the Respondent provides information showing that the earliest date of any application is August 25,

2015 in respect of the Complainant's Indian trademark applications, which also specify a date of first use of March 16, 2015. The Respondent also notes that the Indian applications have the status "Objected".

The Respondent is the sole member and owner of iEstates, LLC, a limited liability company registered in the State of Iowa, USA. The disputed domain name was created on November 9, 1998 and was acquired by the Respondent on December 2, 2013. The Respondent states that through iEstates, LLC he invests in and develops generic, descriptive and non-trademarked domain names, providing various examples of previously developed online properties.

On March 10, 2015, a member of staff of the Complainant approached the Respondent's registrar indicating that the Complainant was looking to buy the disputed domain name. On the same date, a person representing the Respondent invited the Complainant to make an offer to purchase the disputed domain name. The Complainant duly made an offer on the same date but it was rejected by the Respondent. On March 16, 2015, the Complainant asked if the Respondent could indicate a price for the disputed domain name and the Respondent duly replied as to the approximate level at which it would be prepared to discuss offers. At this point, negotiations between the Parties ceased.

On July 16, 2016, within two days of notification of the Complaint, the Respondent's counsel wrote to the Complainant asserting that the Complaint had no prospect of success due to the fact that the disputed domain name pre-dated any trademark rights that the Complainant might have acquired, providing a copy of the Respondent's registration receipt dated December 2, 2013. The Respondent's counsel indicated that if the Complainant were to insist in its Complaint, the Respondent would seek a finding of Reverse Domain Name Hijacking ("RDNH").

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to a trademark in which it owns rights; that the Respondent has no rights or legitimate interests in the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

The Complainant narrates the terms of the trademark applications which it has made and provides a corresponding list. The Complainant states that its "Unmail" enterprise social network software has been well-received by corporates and has received multiple awards due to its uniqueness and sophistication. The Complainant provides a list of awards which it says relate to "Unmail". The Complainant claims that due to its extensive and exclusive use of the unregistered mark UNMAIL it has garnered goodwill and reputation and has acquired secondary meaning among the general public and prospective customers such that the mark has become a distinctive identifier associated only with the Complainant's goods and services.

The Complainant asserts that it has not licensed or otherwise permitted the Respondent to use or to apply for or use any domain name incorporating the UNMAIL mark, that the Complainant has no relationship with the Respondent and has not authorized the Respondent to use the disputed domain name, that there is no evidence to suggest that the Respondent is commonly known by the disputed domain name and that, as the disputed domain name uses the domain parking services of "Sedo", it is not being used for any *bona fide* offering of goods or services.

The Complainant submits that the Respondent is using the disputed domain name in bad faith because it has become a distinctive identifier of the Complainant's goods and services, that the Complainant has acquired strong business reputation and goodwill "as the Complainant", that the Respondent has intentionally attempted to confuse Internet users and to attract them to its online location for commercial gain by way of the disputed domain name and that the disputed domain name has merely been used as a parked domain and website, thus demonstrating that it was created primarily to sell it to some third party, which the

Complainant asserts is cybersquatting. The Complainant concludes that use of the disputed domain name by the Respondent will cause prejudice to the business and interests of the Complainant and that the only objective of the Respondent is to trade off the goodwill, reputation and popularity of the Complainant's UNMAIL trademark.

B. Respondent

The Respondent contends that the Complaint should be denied and requests that the Panel find the Complainant to be a Reverse Domain Name Hijacker.

The Respondent notes that the Complainant does not have a single registered trademark for the UNMAIL mark and submits that mere trademark applications for registration do not prove any protectable right under the Policy. The Respondent acknowledges that a complainant can establish common law trademark rights under the Policy but argues that the evidence in the present case shows that such trademark rights arose no earlier than August 2015. The Respondent addresses each of the press articles produced by the Complainant in turn and points out that there is no reference to the UNMAIL mark until the fourth article dated August 13, 2015. With reference to the Complainant's own press release relative to the launch of "UnMail" to the market, the Respondent notes that the Complainant did not adopt this name until on or about August 11, 2015. The Respondent submits that prior to such date the evidence shows that the Complainant's "UnMail" product was known as "Octopus". The Respondent contends that any common law rights vesting in the Complainant could not have arisen prior to August 11, 2015 and that this is long after the Respondent's acquisition of the disputed domain name.

The Respondent states that it has invested in domain names since 2008, converting many of these into robust developed websites on the Internet. The Respondent provides examples of such previous projects. The Respondent submits that it takes care to register only generic, descriptive, or non-trademarked coined terms for investment and development. The Respondent states that as at the date of acquisition of the disputed domain name there was no "UnMail" branded product owned by the Complainant and that, if anything, the corresponding product was named "Octopus" at the time. The Respondent submits that it was not and could not have been aware of the Complainant's use of "UnMail" as the Complainant did not launch such use until over one and a half years after the Respondent acquired the disputed domain name.

The Respondent asserts that it needed no particular reason for acquiring the disputed domain name but adds that at the time, the Respondent was the registrant of a domain name <spamfree.com> and planned to use the disputed domain name as an alternative domain name for a business plan to provide an email spam-filtering software application. The Respondent provides a screenshot of a presentation prepared for investors in 2013 for <spamfree.com> and submits that this shows that the Respondent had undertaken preparations in furtherance of such business plan, constituting rights and legitimate interests in the disputed domain name. The Respondent adds that it has not yet commenced active use of the disputed domain name but wishes to retain it for potential future development.

The Respondent states that upon registration, the DNS for the disputed domain name was set to the nameservers of "Sedo" but notes that the disputed domain name was never included in the Respondent's "Sedo" account, which it contends probably resulted in visitors to the website associated with the disputed domain name viewing general advertisements, from which the Respondent has not earned anything. The Respondent adds that to its knowledge and belief the disputed domain name has never shown any advertisements that would infringe upon any of the Complainant's rights, noting that general, non-infringing advertisements appear on the screenshots.

The Respondent describes the contact received from the Complainant commencing on March 10, 2015 and states that the Complainant's marketing department may have been in the process at that time of selecting a new brand to replace "Octopus" and realized that it was important to have the disputed domain name if it was to adopt "UnMail" as a brand. The Respondent notes that the Complainant was thus well aware that the Respondent was not a cybersquatter. The Respondent adds that upon notification of the Complaint it was

immediately aware that this had no prospect of success as registration in bad faith was a chronological impossibility. The Respondent states that it pointed this out to the Complainant by letter dated July 16, 2016, thus putting the Complainant on notice that it intended to seek a finding of RDNH if the Complainant proceeded with the case.

The Respondent points out that the Complainant did not state when it purportedly acquired common law trademark rights, nor did it address the fact that it adopted the UNMAIL mark well after the disputed domain name was acquired by the Respondent. The Respondent argues that the Complainant cannot make out a *prima facie* case on rights and legitimate interests without evidence of trademark rights at the time of the Respondent's acquisition of the disputed domain name, adding that if there were no pre-existing rights at the time of such acquisition, it could not be anything but legitimate. The Respondent asserts that its rights and legitimate interests stem from being the first to register the disputed domain name at a time when it was not subject to any trademark rights whatsoever, on the "first come, first served" basis of the system of domain name registration.

The Respondent notes that the Policy requires both bad faith registration and use, pointing out that the Complainant has not even alleged bad faith registration and that such allegations as it has made are directed purely to use. The Respondent adds that it is a factual impossibility for the disputed domain name to have been registered in bad faith where the disputed domain name was acquired before the Complainant's brand even existed. The Respondent submits that the Complainant has also failed to prove any bad faith use, noting that it is immaterial to the bad faith analysis whether the Complainant's mark has acquired a secondary meaning or that the Complainant has acquired strong business reputation and goodwill, that the Respondent has done nothing to confuse Internet users and that the allegation that the disputed domain name was created for the purpose of selling it to "some third party" misstates the Policy. The Respondent asserts that it is entitled to offer its business asset for sale at a market price and that this is not bad faith, pointing out that at no time did the Respondent solicit the sale from the Complainant. The Respondent adds that it had no obligation to use the disputed domain name or to begin operating it at the time of acquisition.

With regard to RDNH, the Respondent asserts that the Complainant's conduct meets all necessary criteria therefor, adding that the Complainant knew when it launched the Complaint or at least when put on express notice by the Respondent that its case was fatally weak and fell short of advancing a colorable right. The Respondent notes that the Complainant continued to press its case, thus compounding its bad faith.

The Respondent asserts that it may be sufficient to show bad faith on the part of a complainant where such complainant has misled the panel by mischaracterizing its trademark rights together with making unsupported arguments under the second and third factors of the Policy. The Respondent focuses on the fact that the Complainant relied on unregistered trademark rights yet did not address the fact that applications do not confer any rights under the Policy and that the Complainant failed to disclose that its Indian trademark registrations were subject to objections and contained erroneous dates of first use. The Respondent submits that the Complainant's claim of the Respondent's bad faith intent at the time of acquisition of the disputed domain name was flagrantly unsupportable. The Respondent adds that it was particularly egregious that the Complainant did not disclose to the Panel that it had previously tried to purchase the disputed domain name, asserting that this approach, characterized as "Plan B" constitutes RDNH.

The Respondent concludes that a proceeding under the Policy puts the Parties to considerable expenditure of time and cost and should not be used where a complainant does not have a reasonable and credible belief that it is entitled to succeed, contending that in the present case the Complaint was totally unjustified, which should lead to a finding of RDNH.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed 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.

A. Preliminary Issue: Parties' Supplemental Filings

The Respondent's Supplemental Filing addresses the terms of the Complainant's email of August 8, 2016 in which the Complainant requested termination of the administrative proceeding. In essence, the Respondent argues that the request for termination should be refused as being without merit and also objects to the disclosure by the Complainant of what the Respondent says were confidential settlement negotiations between the Parties. The Complainant's Supplemental Filing seeks to reply to the issues raised in the Respondent's Supplemental Filing and to add further background to the Complainant's decision to request termination of the proceedings.

Panels have discretion whether to accept an unsolicited supplemental filing from either party, bearing in mind the need for procedural efficiency, and the obligation to treat each party with equality and ensure that each party has a fair opportunity to present its case (see paragraph 4.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0")).

In the present case, the Panel notes that the Complainant has already provided its reasons for its request to terminate the administrative proceeding. These were supplied in the Complainant's email of August 8, 2016 which expanded upon the original request to terminate in the Complainant's email of August 5, 2016. The Respondent was invited by the Center to submit any comments regarding such termination request and addressed the issue in its email of August 12, 2016. The Parties' respective Supplemental Filings were made following that exchange of email. In the Panel's opinion, the Parties have already received a fair opportunity to make representations regarding the Complainant's request for termination and both took that opportunity by way of their respective emails. Accordingly, given the need for procedural efficiency, there seems no reason, far less any "exceptional circumstances", to admit the Supplemental Filings of either of the Parties.

The Panel notes in passing that had the Complainant's Supplemental Filing sought to reply to the Respondent's request in the Response for a finding of RDNH, the Panel might have been prepared to admit it, but to that extent only (see, for example the discussion in *Puls Elektronische Stromversorgungen GmbH v. NetIdentity*, WIPO Case No. D2002-0205, as recently considered with approval in *Impossible BV v. Joel Runyon, Impossible Ventures*, WIPO Case No. D2016-0506). However, in the present case, the Complainant's Supplemental Filing was confined to matters arising from its request to terminate the administrative proceeding and did not deal with the topic of RDNH.

B. Preliminary Issue: Termination of Proceedings

The Complainant has requested that the administrative proceeding be terminated. Paragraph 17(b) of the Rules provides:

If, before the Panel's decision is made, it becomes unnecessary or impossible to continue the administrative proceeding for any reason, the Panel shall terminate the administrative

proceeding, unless a Party raises justifiable grounds for objection within a period of time to be determined by the Panel.

An application for voluntary termination, such as has been made in this case, does not in the Panel's view render it impossible to continue the administrative proceeding. In some circumstances, it might render it unnecessary to do so, for example if the other party is prepared to agree to such termination, although in that situation the terms of paragraph 17(a) regarding agreed settlement would be engaged, whereby the panel is directed to terminate the proceeding and the settlement shall follow the steps in paragraphs 17(a)(i) to 17(a)(vii). Paragraph 17(b) of the Rules appears to the Panel to be designed as a "catch-all" provision to cover any circumstances where it might be appropriate to order termination in the absence of an agreed settlement. In order to ensure that neither of the Parties is disadvantaged by any such termination, the paragraph also contemplates either Party raising justifiable grounds for objection thereto.

In the present case, the Respondent has objected to the Complainant's request for voluntary termination. It is clear from the provisions of the Response, read with the Respondent's emails of August 6 and 12, 2016 that the Respondent's objections lie in the fact that the Respondent has been put to the time and expense of preparing a Response to a Complaint which the Respondent considers to be wholly lacking in merit, entitling the Respondent to a finding of RDNH. Thus, terminating the proceedings at this stage would result in the Complainant avoiding consideration of the merits in general and the issue of RDNH in particular, leaving the Respondent in a disadvantaged position. These seem to the Panel to be entirely justifiable grounds for objection to the Complainant's request.

Turning the matter on its head, the net effect of refusing an objection in these terms would be to allow any complainant to avoid the only form of sanction which the Policy provides for the making of a complaint in bad faith merely by applying for voluntary termination of the proceeding once it becomes aware that a response has been filed. If such response requests the panel to make a finding of RDNH and, as in the present case, provides suitable grounds for this request such that it may not be dismissed out of hand, it would be unfair to a respondent to deny it the right to have the merits determined and such RDNH request addressed. In reaching this view, the Panel makes particular reference to the requirements of paragraph 10(b) of the Rules, namely that the Panel shall treat the Parties with equality and ensure that each is given a fair opportunity to present its case.

The Panel turns briefly to review the background to the Complainant's termination request as set out in its email of August 8, 2016. The focus of this communication is that the Complainant has taken a business decision to withdraw the Complaint, in the course of possible settlement negotiations, independent of any averments made in the Response. The communication also asserts that the Complainant is entitled to withdraw the Complaint pursuant to paragraph 4(e) of the Rules notwithstanding the Respondent's objection.

The mere fact that the Complainant may have taken a "business decision" to withdraw a complaint under the Policy cannot be a valid consideration for the Panel in the face of an objection of the kind taken by the Respondent in the present case. Arguably any decision taken by the Complainant will be a "business decision", including the decision to bring the complaint in the first place. The fact that such decision is taken for business reasons does not have any particular significance for the Panel which would inform its deliberations on whether or not to terminate the proceeding. Equally, the fact that such decision is expressed to be independent of the terms of the Response does not incline the Panel in the Complainant's direction where the Respondent has already been put to the time and trouble of answering the Complaint by the time that the Complainant has communicated its request for termination.

In the Panel's opinion, the Complainant's reference to paragraph 4(e) of the Rules does not assist it. This provision provides direction of a procedural nature to the Center and the Registrar upon the dismissal of a complaint due to an administrative deficiency or upon the voluntary withdrawal of a complaint by the Complainant. While this provision may indicate that a complainant has the ability to withdraw a complaint voluntarily prior to the commencement of the administrative proceeding, in the Panel's opinion it can neither be read to the exclusion of the provisions of paragraph 17(b) which sets out the manner in which a panel,

once appointed, may terminate the proceeding, nor may it be read to the exclusion of the general powers of a panel as set out in paragraph 10 of the Rules which confer a wide discretion to conduct the administrative proceeding as the panel considers appropriate.

The Panel is of the opinion that it is fortified in its approach to the question of voluntary termination by previous decisions taken by multiple panels under the Policy which make particular reference to, and seek to interpret, the provisions of paragraph 17(b) of the Rules. The Panel notes for completeness that paragraph 17(a) of the Rules has been amended since some of the earlier cases were decided in order to provide a defined and staged process for the mechanism of agreed settlement but in the present case no such agreement between the Parties has been reached and accordingly nothing turns on this for the purposes of the Panel's analysis. It should also be recorded that no changes have been made over the same period to paragraph 17(b) of the Rules.

In both *Deutsche Telekom AG v. Janaslani Enterprises, LLC*, WIPO Case No. D2008-0219 and *Sanofi-Aventis v. Demand Domains, Inc.*, WIPO Case No. D2008-1484 the panel observed that it could readily imagine a panel declining to accede to a complainant's request to terminate a proceeding if the complaint was entirely without merit, to the point that the panel felt that it was bound to consider the possibility of RDNH. That is the position of the Panel in the present case, as will be addressed during consideration of the merits below.

In *Donald J. Trump v. Point Pub Liquors*, WIPO Case No. D2011-1946, the panel considered that paragraph 17 of the Rules was inapplicable to applications for voluntary termination but that due to the requirement to treat the parties with equality in paragraph 10(b) of the Rules, it would be unfair to allow the complainant to withdraw after the respondent had invested significant time and money defending its position. The panel in that case was faced with a request to withdraw which was expressed to be "without prejudice", in other words, a termination which might allow the complainant to reinitiate the complaint at some point in the future, and this was therefore the primary focus of the panel's consideration. The panel took the view that allowing the complainant's request to terminate would provide no finality to the dispute and the respondent would be left without protection against opportunistic and unmeritorious re-filing.

It is worth recording that in the present case, the Complainant's Supplemental Filing, but not its original request for termination, indicated that it would be content for the administrative proceeding to be terminated "with prejudice" and provided an undertaking that it would not refile the Complaint. In the Panel's view, however, the question of whether or not to allow voluntary termination does not turn exclusively upon whether a complainant qualifies such request as "termination with prejudice" or "termination without prejudice". The issue is also bound up with the fact that, if a panel considers that a complaint may be opportunistic, unmeritorious or brought in bad faith, it will often be fairer to deal with the matter there and then in the context of the live administrative proceeding, in particular addressing any question of RDNH which arises, rather than simply to "sweep the issue under the carpet" on the ground that this accords with the complainant's wishes.

In *Comité Interprofessionnel du vin de Champagne v. Steven Vickers*, WIPO Case No. DCO2011-0026, the complainant requested to withdraw its complaint "at this stage", which request was rejected by the respondent. The panel noted that it was uncertain whether "at this stage" meant the complainant was reserving the right to refile the complaint. The panel also noted that the position might have been different if the complainant had sought to withdraw the complaint at an early stage after filing, but added that the respondent had put in a significant amount of work responding to the complaint. In the panel's view, that factor pointed strongly in favor of allowing the proceeding to continue and also provided a justifiable objection by the respondent to the termination of the proceeding on the complainant's request. It is worth pausing here to note that in the present case the Complainant's request for termination was first made on August 5, 2016, in other words after the Response had been filed. It is clear to the Panel that the Respondent in the present case has put in a significant amount of work in responding to the Complaint, similar to the respondent in *Comité Interprofessionnel du vin de Champagne v. Steven Vickers, supra*.

The panel in *Comité Interprofessionnel du vin de Champagne v. Steven Vickers*, *supra* went on to note the fact that the respondent in that case had requested RDNH and considered that where such an allegation was not so clearly untenable that it could be dismissed out of hand this factor would also point in the direction of refusing to allow termination, commenting that to do otherwise would mean that the issue would never be resolved. This approach again strikes a similar chord with the Panel in the present case. Finally, the panel discussed two further issues, namely the question of a complainant seeking to refile successive complaints and the prospect on the particular facts of that case that there might be wider issues which would benefit from a panel decision. These latter two points are not relevant to the present case. In the first place, the Complainant subsequently qualified its request for termination with an undertaking not to refile a further complaint in respect of the disputed domain name, albeit in the Complainant's Supplemental Filing rather than when making the original request, and secondly, there do not appear to be any wider issues of a similar nature to be found in the facts of the present case.

In *Dead Sea Premier Cosmetics Laboratories Ltd. v. Maysan Jeunesse GmbH / Gal Yana*, WIPO Case No. D2013-2114, the panel denied the complainant's request to voluntarily terminate the proceedings without prejudice on the basis of the line taken by the panel in *Donald J. Trump v. Point Pub Liquors*, *supra*. The complainant in that case also requested that, absent any possibility to terminate, it be allowed to file a supplemental filing. The panel declined to allow the complainant to file a supplemental filing on the grounds that under the expedited process provided under the Policy and Rules, each party is given one opportunity to put forward all the material on which it wishes to rely and is expected to do so, and that the complainant had already clarified the circumstances leading to a request to terminate the proceedings in a declaration by the complainant's counsel which had already been received. On this last point, in the present case as outlined above, the Complainant has already received the opportunity to clarify the background to its request to terminate by way of the email exchange between the Parties and the Center.

In *Remy Cointreau Luxembourg S.A. v. Panagiotis Metaxas and Tetnet Internet Promotions Inc.*, WIPO Case No. D2014-0535, the three member panel determined that while it might be arguable in terms of paragraph 17(b) of the Rules that it was unnecessary to consider the proceeding given the complainant's request for termination, in view of the respondent's clear desire for the panel to render a definitive resolution of the dispute the panel did not find it unnecessary or impossible to continue to render a decision. The panel considered that an exchange of email between the parties relative to the request for termination and the respondent's objection thereto, described as "supplemental communications" could be admitted. The panel also admitted a supplemental filing from the Complainant which appears to have been directed to the merits rather than to the issue of termination. In the present case, the Panel has decided to admit the Parties' communications on the subject of termination but not their supplemental filings for the reasons already given and the Respondent has expressed a clear desire for a definitive resolution by way of its objection to the request for termination.

In light of the above analysis, and in the circumstances of the present case, the Panel declines to terminate the proceedings on the Complainant's request and will proceed to a Decision on the merits of the Parties' submissions.

C. Identical or Confusingly Similar

Under this head, the Complainant is required to show that it has UDRP-relevant rights in a trademark and secondly that such trademark is identical or confusingly similar to the disputed domain name. The Complainant relies upon rights in respect of applications for registered trademarks and an unregistered trademark for the UNMAIL mark.

Turning first to the Complainant's applications for registered trademarks, the Panel agrees with the Respondent that it is the preponderant view of panels under the Policy that unless such applications have proceeded to grant they do not constitute trademarks in which a complainant has UDRP-relevant rights. As the Panel noted recently in *The Coca-Cola Company v. Whois Privacy Protection Service, Inc. / Thien Le Trieu, Le Trieu Thien*, WIPO Case No. D2015-2078, this topic has received comprehensive treatment in

Fashiontv.com GmbH v. Mr. Chris Olic, WIPO Case No. D2005-0994 and the more recent cases of *Tiger Media, Inc. v. Leconte Pierre*, WIPO Case No. D2011-0670 and *Jetgo Australia Holdings Pty Limited v. Name Administration Inc. (BVI)*, WIPO Case No. D2013-1339. In these circumstances, the Panel finds that the Complainant does not have UDRP-relevant rights in respect of its various applications for registered trademarks.

The Panel therefore turns to the question of whether UNMAIL may be considered to be a common law trademark of the Complainant. Paragraph 1.7 of the WIPO Overview 2.0 addresses the question of what needs to be shown for a complainant to successfully assert unregistered or common law trademark rights and provides the following consensus view:

“The complainant must show that the name has become a distinctive identifier associated with the complainant or its goods or services. Relevant evidence of such ‘secondary meaning’ includes length and amount of sales under the trademark, the nature and extent of advertising, consumer surveys and media recognition. The fact that the secondary meaning may only exist in a small geographical area does not limit the complainant’s rights in a common law trademark. For a number of reasons, including the nature of the Internet, the availability of trademark-like protection under passing-off laws, and considerations of parity, unregistered rights can arise for the purposes of the UDRP even when the complainant is based in a civil law jurisdiction. However, a conclusory allegation of common law or unregistered rights (even if undisputed) would not normally suffice; specific assertions of relevant use of the claimed mark supported by evidence as appropriate would be required. Some panels have also noted that in cases involving claimed common law or unregistered trademarks that are comprised of descriptive or dictionary words, and therefore not inherently distinctive, there may be a greater onus on the complainant to present compelling evidence of secondary meaning or distinctiveness. Some panels have noted that the more obvious the viability of a complainant’s claim to common law or unregistered trademark rights, the less onus there tends to be on that complainant to present the panel with extensive supporting evidence. However, unless such status is objectively clear, panels will be unlikely to take bald claims of trademark fame for granted.”

In the present case, there is some information provided by the Complainant along the lines anticipated by the consensus view, although this might be described as patchy at best. Based on the date of launch of the Complainant’s “UnMail” product as referred to in one of the press articles which it has produced, coupled with the additional material from the Complainant’s website unearthed by the Respondent, it appears that the product has been in the market under that name since August 2015, a period of one year. This is not a particularly long period of time and this information has not been supplemented with evidence of the amount of sales, extent of advertising or consumer surveys.

Furthermore, the Complainant’s submissions do not make it clear why it has produced a number of press articles and referenced awards relating to a product named “Octopus”. The explanation is left to a press article unearthed by the Respondent which indicates that “UnMail” was “earlier known as ‘Octopus’”. This does not however explain the relevance of “Octopus” material to the establishment of a common law mark in respect of the “UnMail” product name. Perhaps, if “UnMail” is indeed the successor to “Octopus”, the Complainant intended to show that existing customers of “Octopus” have been migrated to use an “UnMail” branded product and thus now recognize this new name. However, that is mere speculation on the part of the Panel. In the absence of any suitable submissions as to its actual relevance to the question of the Complainant’s UDRP-relevant rights, the “Octopus” material is at best of no support to the Complainant’s case and at worst is extremely misleading, given that the Complainant presented all of the press articles in its Annex E as evidence of wide coverage by popular media of its services under the UNMAIL mark.

Leaving the “Octopus” material aside, it is clear that the Complainant’s renamed “UnMail” product has received some press coverage and a number of awards in its own right which might indicate that it has become a distinctive identifier associated with the Complainant’s goods or services. The Panel notes however that the Complainant has simply provided a small selection of articles and a listing of awards,

apparently combining awards for “UnMail” with at least one award from 2013, which therefore appears to predate the product’s launch under its new name in August 2015. Furthermore, at least one of the awards was apparently made to the Complainant’s Chief Information Officer and it is unclear to the Panel whether such latter award has anything to do with the “UnMail” product *per se*. Absent any explanation, this material is unhelpful at best and misleading at worst.

In any event, given the Panel’s finding on the question of registration and use in bad faith below, it is unnecessary for the Panel to answer with finality the question of whether the evidence before it is sufficient to support the existence of a secondary meaning in the UNMAIL mark and thus that suitable UDRP-relevant rights are vested in the Complainant arising from the claimed unregistered trademark.

D. Rights or Legitimate Interests

The requirements of paragraph 4(a) of the Policy are conjunctive. A consequence of this is that failure on the part of a complainant to demonstrate one element of the Policy will result in failure of the complaint in its entirety. Accordingly, in light of the Panel’s finding under the subsequent head regarding 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 in detail.

E. Registered and Used in Bad Faith

On this topic, the Complainant must prove the conjunctive requirement that the disputed domain name has been registered and is being used in bad faith. Failure to prove one or other of the elements of registration or use in bad faith would be fatal to the Complainant’s case. The Panel notes in passing that where, as here, the disputed domain name has been acquired by the Respondent during the existence of a previous registration, the assessment of registration in bad faith is typically made as at the date of the Respondent’s acquisition rather than at any other date. In particular, the creation date of such domain name is not the relevant date for the assessment, unless such date has been reset to the date of acquisition, which is not the case here.

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 Panel notes that the examples listed in paragraph 4(b) of the Policy are not exhaustive of all circumstances from which bad faith registration and use may be found. The critical issue is that there must be a degree of targeting of the Complainant or its mark, or at very least the Respondent must have had the

Complainant or its trademark in mind when selecting the disputed domain name (*The Perfect Potion v. Domain Administrator*, WIPO Case No. D2004-0743).

In the present case, the Respondent acquired the disputed domain name approximately one and a half years before the earliest date on which the Complainant appears to have commenced use of its “UnMail” brand. Any unregistered trademark rights that may have arisen through use of the mark by the Complainant must necessarily post-date the acquisition of the disputed domain name by the Respondent. The Respondent argues that in such circumstances there can be no finding of registration in bad faith. This is not strictly correct, as some previous panels under the Policy have made such a finding provided it can also be shown that the aim of the registration was to take advantage of the confusion between the domain name and any potential complainant rights, such as in the case of a publicized merger between companies or where the respondent is privy to some special knowledge regarding the complainant’s plans. However, in the present case, there is no suggestion in the record before the Panel that in registering the disputed domain name the Respondent was in some way anticipating potential rights which might vest in the Complainant at some point in the future. For example, there is no evidence that the Respondent was an “informed source” which was privy to the Complainant’s plans.

The Respondent explains that it chose the disputed domain name on a wholly independent basis as a possible substitute name for a business venture which it was developing. While the evidence presented in support of this assertion is rather scant, consisting of the Respondent’s declaration together with a single screenshot of a presentation, which screenshot does not mention the disputed domain name, the Panel accepts the Respondent’s contention that in any event it does not require to satisfy the Panel as to the reason for its acquisition of the disputed domain name, given that this predates the Complainant’s adoption of the UNMAIL mark by a reasonable period. Furthermore, the Panel accepts the Respondent’s contention that it first heard of the Complainant’s intentions in this respect when it was approached by the Complainant’s employee to discuss a possible purchase of the disputed domain name. This happened some fifteen months after the Respondent had acquired the disputed domain name.

The Respondent has explained the use to which the disputed domain name was put to the Panel’s satisfaction, namely that the disputed domain name was placed on “Sedo” nameservers but was not configured within the Respondent’s account and was not used in any way to target the Complainant, its products or any rights which it may have acquired in the UNMAIL mark. The lack of targeting is supported by the screenshot evidence before the Panel.

In these circumstances, the Panel is satisfied that the Complainant has failed to prove that the disputed domain name has been registered and is being used in bad faith and the Complaint therefore fails.

F. Reverse Domain Name Hijacking

Paragraph 15(e) of the Rules provides that, 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”. Paragraph 1 of the Rules defines RDNH as “using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name”. Mere lack of success of the Complaint is not itself sufficient for a finding of RDNH (see paragraph 4.17 of the WIPO Overview 2.0). In the Panel’s opinion the whole circumstances must be reviewed, on an objective basis, to determine whether the Complaint was brought in bad faith.

In the present case, the Panel finds multiple independent grounds which are individually capable of leading to a finding of RDNH. First, the fact that a complainant must or at least ought to have appreciated at the outset that its complaint could not likely succeed is often regarded as an important consideration on the question of RDNH (see the discussion on this topic in *Jazeera Space Channel TV Station v. AJ Publishing aka Aljazeera Publishing*, WIPO Case No. D2005-0309). Previous panels under the Policy have found complainant’s bad faith and an abuse of the administrative proceeding where the complainant or its representative knew at the

time of filing the complaint that the complainant could not prove the respondent's bad faith registration (see for example *New Forests Asset Management Pty Limited v. Kerry Schorsch, Global Advertizing, LLC*, WIPO Case No. D2015-1415). That is likewise the position here. The Complainant knew that the disputed domain name had been created some considerable time before the Complainant conceived and launched its "UnMail" brand. It is of no consequence that the period during which the Respondent had held the disputed domain name was only one and a half years, dating from the Respondent's acquisition, rather than the entire 17 year duration of its existence as it would have appeared to the Complainant from the WhoIs record. There was in any event an absence of any possibility that the Complainant or its rights were being targeted by the Respondent's registration of the disputed domain name and thus an absence of any possibility that the Respondent was engaging in cybersquatting within the ambit of the Policy.

Secondly, it is not unreasonable for the Panel to expect and require that the Complainant and its counsel will be familiar with Policy precedent and will neither ignore nor gloss over matters on which well-established Policy precedent weighs directly against the Complainant's contentions (see *Spy Optic, Inc. v. James Lee*, WIPO Case No. D2013-1411). Here, the Complainant has entirely disregarded established Policy precedent regarding the need to prove registration in bad faith in that its submissions on that topic exclusively relate to the use of the disputed domain name. The Complainant also disregarded such precedent in its extensive citation of registered trademark applications, which it ought to have known would not provide the necessary foundation for UDRP-relevant rights.

The failings in the Complaint are compounded by the fact that the Complainant delayed making any attempt to withdraw it notwithstanding the Respondent's counsel's letter of July 16, 2016 which specifically pointed out, together with supporting evidence, that the Respondent's acquisition of the disputed domain name on any view must have pre-dated the use of the UNMAIL mark by the Complainant by a reasonable period. The Respondent's counsel also pointed out that it would seek a finding of RDNH if the Complainant were to insist in the Complaint. Even in the face of these clear warnings, the Complainant only sought termination of the proceeding on August 5, 2016 after the Respondent had been put to the time and expense of preparing its Response (see *Coolside Limited v. Get On The Web Limited*, WIPO Case No. D2016-0335 for a similar example where the complainant was warned that its case was baseless in prior correspondence between the parties, leading to a finding of RDNH).

Thirdly, the present case has features which might be described as those of a "Plan B Reverse Domain Name Hijacking case" (see the discussion of this aspect of RDNH in the recent case of *Patricks Universal Export Pty Ltd. v. David Greenblatt*, WIPO Case No. D2016-0653). It is clear to the Panel that the Complaint was commenced only after the Complainant's negotiations to purchase the disputed domain name from the Respondent on an open market basis had proved to be unsuccessful. Previous cases indicate that proceedings under the Policy should not be commenced in an unjustifiable attempt to pressure a domain name owner into releasing a legitimately held domain name that pre-dates any trademark rights held by the complainant (see *Sustainable Forestry Management Limited v. SFM.com and James M. van Johns 'Infa dot Net' Web Services*, WIPO Case No. D2002-0535 and *Proto Software, Inc. v. Vertical Axis, Inc/PROTO.COM*, WIPO Case No. D2006-0905). In particular, use of the Policy to increase leverage in negotiations to purchase a domain name has been described as "a highly improper purpose", and contradicts the Complainant's undertaking (paragraph 21 of the Complaint and paragraph 3(b)(xiii) of the Rules), that "the information contained in this Complaint is to the best of Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass" (*Patricks Universal Export Pty Ltd. v. David Greenblatt, supra*).

Finally, the materials produced by the Complainant in its Annex E to support the averment that the Complainant's services under the UNMAIL mark had been widely covered by popular media were grossly misleading to the extent that at least four of the articles, which might have been of considerable significance to the establishment of a common law mark, referred exclusively to "Octopus", apparently the former name of the product. Annex G, containing a list of awards allegedly received by the Complainant's product in its "UnMail" incarnation was also misleading as one of the citations appears to relate to an award to the Complainant's Chief Information Officer and, more significantly, one of the awards dates from 2013, yet the

"UnMail" incarnation did not launch until August 2015.

In all of these circumstances, the Panel finds that the Complaint was brought in bad faith in an attempt at RDNH and constitutes an abuse of the administrative proceeding.

7. Decision

For the foregoing reasons, the Complaint is denied.

Andrew D. S. Lothian

Sole Panelist

Date: August 29, 2016