

ADMINISTRATIVE PANEL DECISION

Whispering Smith Limited v. Domain Administrator, Tfourh, LLC

Case No. D2016-1175

1. The Parties

The Complainant is Whispering Smith Limited of Manchester, United Kingdom of Great Britain and Northern Ireland (“United Kingdom”), represented by Enrique Antonio Delgado Carravilla, Spain.

The Respondent is Domain Administrator, Tfourh, LLC of Cayman Islands, Overseas Territory of the United Kingdom, represented by Muscovitch Law P.C., Canada.

2. The Domain Name and Registrar

The disputed domain name <bravesoul.com> (the “Domain Name”) is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 10, 2016. On June 10, 2016, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 11, 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. In response to a notification by the Center, the Complainant filed an amendment to the Complaint on June 20, 2016.

The Center verified that the Complaint together with the amendment to 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”).

On June 15, 2016, the Center notified the Parties in both English and Spanish that the language of the Registration Agreement in this case was English. The Complainant requested Spanish to be the language of the proceedings on June 17, 2016. The Respondent requested English to be the language of the proceedings on June 20, 2016. Following the Center’s request on June 24, 2016, the Complainant filed a translation into English of the Complaint on June 29, 2016.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 8, 2016. In accordance with the Rules, paragraph 5, the due date for Response was July 28, 2016. The Response was filed with the Center on July 28, 2016.

The Center appointed Willem J. H. Leppink, Luis Miguel Beneyto Garcia-Reyes and Paul M. DeCicco as panelists in this matter on September 14, 2016. The Panel finds that it was properly constituted. Each member of 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 following facts are undisputed.

The Complainant, Whispering Smith Company Limited, originally called Rajan Imports Limited, was established on September 6, 1985. The Complainant is a wholesale importer, exporter and distributor of fashion clothing in several countries. The Complainant operates its main websites at “www.bravesoul.es” and “www.bravesoul.co.uk”.

The Complainant owns an international portfolio of registered trademarks for BRAVE SOUL (hereinafter together referred to as “Trademark”), including European Union Trade Marks and national trademarks in various countries in the world. For instance, United Kingdom Trademark no. 3,230,479 BRAVE SOUL, registered on August 12, 2003 for clothing, footwear and headwear in International class 25.

The Domain Name was registered on April 18, 2001. The Domain Name resolves to a parking webpage.

5. Parties' Contentions

A. Complainant

The Complainant has submitted a lengthy Complaint. Insofar as relevant, the Complainant contends the following.

The Domain Name is identical to Complainant's Trademark.

The Respondent has no rights or legitimate interests in the Domain Name, as the Respondent has not registered any trademark which consists of or includes the term “brave soul”. The Complainant has not granted, licensed or authorized the Respondent to use the Trademark. When registering the Domain Name, the Respondent was fully aware of the existence of the Trademark and registered the Domain Name in order to take advantage of Internet traffic generated by the use of the Trademark in the Domain Name.

The use of the Domain Name is causing damage to the distinctive character or the reputation of the Trademark. The fact that the website to which the Domain Name resolves is a parking webpage which harms the value of a dynamic, current and innovative brand of Complainant.

B. Respondent

The Respondent has submitted a lengthy Response. Insofar as relevant for this matter, the Respondent contends the following.

The Domain Name was registered by the Respondent on April 18, 2001, over 15 years ago and long before the Complainant adopted BRAVE SOUL as its clothing brand in 2003, at the very earliest. As such, the registration of the Domain Name in bad faith is an impossibility. The Respondent has never used the Domain Name to infringe the Complainant's Trademark and there is no evidence of bad faith use

whatsoever. The Complainant's allegations of purported trademark dilution are wholly outside the jurisdiction of the UDRP and as such are misplaced. In any event, the term "brave soul" purportedly is an extraordinarily common term in everyday usage all over the English speaking world. The Complainant is merely looking to "upgrade" its existing <bravesoul.co.uk> and <bravesoul.es> domain names to the Domain Name, at the expense of the Respondent, whose rights predate those of the Complainant. This Complaint was brought in bad faith in an attempt at Reverse Domain Name Hijacking.

The Respondent acknowledges that the Complainant has various Trademarks for BRAVE SOUL. However, the Complainant's Trademarks all postdate the Respondent's Domain Name registration. Nevertheless, by merely having any Trademark registration which corresponds to the Domain Name, the Respondent acknowledges that the Complainant has met this preliminary first part of this three-part UDRP test.

At the time the Domain Name was registered on April 18, 2001, the Complainant itself did not have rights in the Trademark (since it did not exist as a brand), and as such, the Complainant cannot make out a case against the Respondent. Upon registration of the Domain Name, the only one who had any rights or legitimate interests in the Domain Name, was the Respondent, and although those rights may have been subsequently been somewhat limited by the coming into existence of a Trademark in connection with limited goods, namely clothing, years later, the Respondent's original rights and legitimate interests in the Domain Name, were never extinguished.

The Respondent's use of the Domain Name for general advertisements – prior to the Complainant even obtaining any Trademark rights – and its continuation of same for non-infringing advertising subsequently, is a lawful and appropriate use of the Domain Name constituting a legitimate interest.

The Respondent came up with and registered the Domain Name, believing that it may in the future be of interest to a new entity who would in good faith, acquire it from the Respondent, or the Respondent would use it itself. As such, the Respondent was engaged in legitimate speculation and the Complainant can only fault itself for not contacting the Respondent prior to adopting its brand.

It is an obvious factual impossibility for the Domain Name to have been registered in bad faith for the simple reason that the Domain Name was registered before the Trademark existed. It is well-established that in general, a finding of bad faith registration cannot be made with respect to a Trademark that did not exist at the time of registration of the Domain Name.

The Complainant has failed to make out any case for bad faith use of the Domain Name. The Complainant did not allege, nor is it in fact the case, that the Respondent even once, over the course of its 15 years history of ownership of the Domain Name, ever solicited the Complainant.

The Complainant did not allege that the Domain Name was ever used to infringe the Trademark. The Complainant alleges that the Domain Name is likely to cause confusion, but does not allege that any ever occurred. Moreover, the Complainant has not provided a scintilla of evidence to support its allegation, and even if there were any evidence that people exclusively identified the Domain Name with the Complainant instead of the common term that dates back (according to the Respondent) hundreds of years before the Complainant's existence, it would not mean that the Respondent engaged in any bad faith use of the Domain Name.

This is a Complaint which should never have been launched. It is obvious that this case was brought simply because the Complainant covets the Respondent's domain name. It never had any legitimate complaint.

It is respectfully submitted that the Complainant, who is represented by intellectual property counsel, and who cited a number of UDRP decisions, must be taken to have at least known of the fundamental importance of establishing Trademark rights which predate the Domain Name registration, but proceeded headlong without regard of same, or despite regard of same.

Furthermore, the Complainant knew or ought to have known that its argument that the mere registration and

existence of the Domain Name, without any bad faith use, could somehow result in the transfer to itself, was bound to fail. The Complainant knew or ought to have known that its broad arguments of purported entitlement to the Domain Name just by virtue of having a Trademark, grossly exaggerated its rights and in any event were arguments outside the scope of the Policy. By proceeding without regard for the absence of any reasonable prospect of success, the Complainant has effectively harassed the Respondent and put the Respondent to unnecessary expense.

In this case, the complaint was totally unjustified and Reverse Domain Name Hijacking should be found.

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove each of the following three elements:

- (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.

The Panel has noted that Complainant submitted many arguments alleging trademark infringement, with extensive references to European trademark law and related case law. The Panel would like to remind the Complainant that the case at hand has to be decided in accordance with the Policy.

A. Identical or Confusingly Similar

The Complainant must demonstrate that it has rights in a trademark and, if so, the Domain Name must be shown to be identical or confusingly similar to the trademark.

The Panel agrees with both Complainant and Respondent that requirement of the first element is met. The Domain Name includes the Trademark in its entirety and is therefore identical to the Trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

In light of the considerations under section 6.C below, the Panel is not required to give its considerations in relation to the second element.

C. Registered and Used in Bad Faith

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

The Complainant has failed to make out a case about on the third element. The Complainant failed to provide evidence that Respondent could have, or should have, anticipated Complainant's Trademark rights in advance of the BRAVE SOUL Trademark's registration. In other words, the Complainant has simply failed to argue why the registration and use of the Domain Name have been in bad faith. Importantly, Respondent's pre-Trademark Domain Name registration also precludes a finding of bad faith since the Domain Name registration was made at a time when Complainant had no rights in the Trademark.

The Respondent could not have known about the Trademark and could not have been aware of the Complainant and its business when the Respondent registered the Domain Name. Therefore, the Panel finds that there is no evidence that the Respondent actually knew the Complainant or knew of Complainant's intentions to use the Trademark when Respondent registered the Domain Name. The Panel also takes into

consideration that the two elements of which the Trademark consist, *i.e.*, “brave” and “soul” are a usual combination and as such a normal expression.

In these circumstances, the Panel finds that the Complainant has not established the third requirement under paragraph 4(a) of the Policy. Again, it is not needed to discuss the second element of the Policy

Reverse Domain Name Hijacking

The Panel finds that the Complainant in fact knew or at least should have known at the time that it filed the Complaint that it could not prove one of the essential elements required by the UDRP, namely is very clear that Respondent registered the Domain Name many years before Complainant filed and registered the Trademark.

Furthermore, the Panel also finds that the Complainant (or rather, its attorney) has tried to mislead the Panel by mischaracterizing its trademark rights along with having made unsupported arguments under the third element of the UDRP Policy.

To conclude, the Panel finds that, based on the above, the Complaint was filed in a bad faith attempt to deprive the Respondent of the Domain Name. These facts justify a finding of Reverse Domain Name Hijacking.

7. Decision

For the foregoing reasons, the Complaint is denied.

Willem J. H. Leppink

Presiding Panelist

Luis Miguel Beneyto Garcia-Reyes

Panelist

Paul M. DeCicco

Panelist

Date: September 27, 2016