

Administrative Panel Decision

In the matter of

Between

ADODIS TECHNOLOGIES PRIVATE LIMITED

And

ERIC REAO

Case No: KLRCA/ADNDRC/249-2014

1. The Parties

The Complainant is Adodis Technologies Private Limited of Bangalore, India, represented by Dhanasekar Mani.

The Respondent is Eric Reao.

2. The Domain Name and Registrar

The disputed domain name <adodisfraud.com> (the "**Disputed Domain Name**") is registered with New Dream Network, LLC dba DreamHost Web Hosting ("**DreamHost**").

3. Procedural Background

The Complaint was filed with the Kuala Lumpur Office of the Asian Domain Name Dispute Resolution Centre ("**ADNDRC**") on 7th August 2014. On 8th August 2014, the ADNDRC transmitted by email to DreamHost for registrar verification in connection with the Disputed Domain Name. On 21st August 2014, DreamHost transmitted by email to the ADNDRC its verification response confirming that the Disputed Domain Name is registered with DreamHost and the Respondent is listed as the registrant. ADNDRC 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, paragraph 2(a) and 4(a), the ADNDRC formally notified the Respondent of the Complaint and the proceedings commenced on 22nd August 2014. In accordance with the Rules, paragraph 5(a), the due date for Response was 11th September 2014. The Response was filed with the ADNDRC on 2nd September 2014.

The ADNDRC appointed Chew Kherk Ying as the sole panelist in this matter on 5th September 2014. 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 incorporated on 2nd October 2009 in Bangalore, and deals in software and website development.

The Complainant applied to the Indian Trade Marks Registry to register the trade mark "ADODIS" with the application no. Temp-170580. According to this trade mark application, the Complainant has been using the mark since 1 January 2007. It is unclear from the document submitted as to whether the "ADODIS" trademark has been registered. It is a well-established practice that the Panel has the general powers pursuant to paragraph 10(a) of the Rules to conduct its own factual research. Pursuant thereto, the Panel arranged to conduct a trademark search at the Indian Trademark Registry which results confirmed that the "ADODIS" trademark filed by the Complaint was filed on 9th April 2014 in Class 42 with respect to website designing and development services. The said trademark is pending registration.

The disputed domain name was registered on 12th August 2013.

5. Parties' Contentions

A. Complainant

The Complainant made the following assertions:

The Disputed Domain Name (adodisfraud.com) is a domain name created by the Respondent against the Complainant and is hampering its business. The person who created it has a clear intention to defame the Complainant's position in the market as a leading web development company. As a result of the Disputed Domain Name, the Complainant is losing clients.

The Complainant is a duly registered company under the Indian legal system and has served more than 4000 clients. It is a small company in Bangalore and is facing many issues due to the Disputed Domain Name.

The Complainant has also tried to contact the website owner multiple times by sending emails as the Complainant did not have the Respondent's contact details. The Complainant sent two emails on August 9, 2013 and another on August 21, 2013 but received no reply from the Respondent.

B. Respondent

The Respondent responded as follows :-

Since the creation of the website, the Respondent has received an increasing number of contacts from victims defrauded by the Complainant whose complaints have been submitted to the website against the Complainant. The number of complaints has increased since the creation of the website. The Complainant's claim that business has been hampered is therefore baseless and unsubstantiated. Further, if the alleged business is hampered, it is a direct result of the unfair and deceptive trade practices instituted by the Complainant for which the Respondent is not responsible.

The Disputed Domain Name is a consumer review website that provides honest, straightforward and documented testimonial, commentary, and criticism of services received and lack thereof. The defamation claim implies that the statements made by the website are false but all evidence points to the contrary. Any references to the "ADODIA" trademark is based on actual events for commentary and criticism.

The Respondent has no intention, past, present or future, to :-

- i. engage in the Complainant's business areas;
- ii. sell, rent or transfer the domain;
- iii. disrupt the business of a competitor, i.e. the Complainant; or
- iv. attract users based on confusion with the Complainant's mark.

The Respondent further stated that on 30th May 2013, Respondent entered into a contractual agreement with the Complainant to build a website for USD \$ 2,000 within 25 business days. The Complainant took two months to furnish the contract, which is dated July 27, 2013. Initial payment was made by the Respondent on May 30, 2013. Over the next ten weeks, the Complainant failed to complete the contract. The Complainant has a history of instituting unlawful, unfair and deceptive trade practices with the intention to commit fraud.

Until this Complaint was submitted by the Complainant, the Respondent states that all previous contacts from the Complainant were intended to perpetuate their fraud. The Respondent admits that a demand letter was sent ordering the transfer of the domain in an attempt to deny the Respondent's rights to document the unlawful, unfair and deceptive trade practices implemented by the Complainant. The Respondent further denies having received any emails from the Complainant on August 9, 2013.

Further, the Complainant has engaged in a hostile, negative SEO attack on the Disputed Domain Name and posted thousands of links advertising pornography and illegal mal-ware linking back to the Disputed Domain Name. The Complainant has also engaged in numerous hostile, unlawful attempts to gain unauthorized access to the Disputed Domain Name.

6. Discussion and Findings

Under paragraph 4(a) of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Complainant must prove that :-

- i. The Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interest in respect of the Domain Name; and
- iii. The Domain Name has been registered and used in bad faith.

A. Identical or Confusingly Similar

In order to satisfy the first element, the Complainant must prove that its rights in the trademark existed prior to the filing of the Complaint and secondly, that the Disputed Domain Name is identical or confusingly similar to that mark.

The Complainant has submitted a copy of its application to the Indian Trade Marks Registry (Temporary Application No. Temp-170580) for the mark "ADODIS" . The status of the mark is currently that of "Formalities Check Pass", which is the stage immediately following the filing of the trade mark application whereby the Indian Trade Marks Registry will be scrutinizing the application for technical defects. As such, the mark currently remains unregistered. A relevant consideration for the Panel therefore arises in the form of whether a trademark application by itself will suffice in satisfying the requirements existing under paragraph 4(a)(i).

It is important to note that the trademark application was made after the Disputed Domain Name has been registered. The consensus view as raised in paragraph 1.4 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("**WIPO Overview 2.0**") is that *"registration of a domain name before a complainant acquires trademark rights in a name does not prevent a finding of identity or confusing similarity under the UDRP. The UDRP makes no specific reference to the date on which the holder of the trademark or service mark acquired rights. However, in such circumstances, it may be difficult to prove that the domain name was registered in bad faith under the third element of the UDRP."*

Previous UDRP decisions have presented conflicting views on whether a complainant is able to successfully assert common law or unregistered trademark rights. Nevertheless, the consensus view as raised in paragraph 1.7 of the WIPO Overview 2.0 is that *"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."*

The trade mark application submitted by the Complainant is therefore considered sufficient to constitute trade mark rights for the purposes of the Policy only if the Complainant has submitted sufficient evidence of use to prove that the mark has acquired secondary distinctiveness (*Continental Casualty Company v Andrew Krause / Domains by Proxy, Inc.*, WIPO Case No. D2008-0672 (August 20, 2008); *Patricia Kelley v Innovation HQ, Inc.*, WIPO Case No. D2009-1723 (February 6, 2010); *Volunteering Travel Solutions Pvt Ltd v Puran Tours*, WIPO Case No. D2011-0865 (July 4, 2011)); *Tiger Media Inc v Leconte Pierre* WIPO Case No. D2011-0670 (May 30, 2011); *Manwin Licensing International S.a.r.l v Aleksey Elin*, WIPO Case No. D2012-0127 (March 6, 2012)).

In this respect, the Panel notes that the Complainant has failed to advance any argument that he owns common law rights in the mark as well as furnish any evidence to show that its mark has acquired secondary distinctiveness. The only evidence submitted relates to an email sent in September 2013 concerning Adodis'a customer care services, which does not serve as evidence of substantial use and publicity for the unregistered ADODIS mark. Further this email was sent in September 2013, after the registration of the Disputed Domain Name. The Panel therefore finds that the Complainant has not asserted that it has common law rights in the "ADODIS" trademark and neither has it adduced any substantial evidence of use of the "ADODIS" trademark. Merely lodging a copy of a document which reflects a trademark application for the "ADODIS" trademark is insufficient to enable the Panel to infer the requisite degree of secondary degree of secondary meaning in relation to a claim of unregistered trade mark rights. The Panel also notes that the date of first use reflected in the trademark document is on 1st January 2007; the Complainant was only incorporated on 2nd October 2009 and any first use could only be after the date of incorporation..

Notwithstanding the finding on the first issue, the Panel will deal with the second issue of whether the Disputed Domain Name is identical or confusingly similar to the "ADODIS" trademark. The general rule is that a user of a mark "may not avoid likely confusion by appropriating another's entire mark and adding descriptive or non-distinctive matter to it" (*The Argento Wine Company Limited v Argento Beijing Trading Company*, WIPO Case No. D2009-0610 (July 1, 2009)). The issue is not whether the domain name causes confusion as to source, but instead whether the mark and domain name, when directly compared, have confusing similarity (*Wal-Mart Stores, Inc. v Richard MacLeod d/b/a For Sale*, WIPO Case No. D2000-0662 (September 19, 2000). Similarly in *Ryanair Limited v Michael Coulston*, WIPO Case No. D2006-1194 (December 12, 2006), it was held that because the Domain

Name incorporates the mark in its entirety and adds an additional word ("fraud"), the Domain Name is confusingly similar to the Complainant's trademark for the purposes of the Policy.

The addition of the word "fraud" is taken to mean that the Disputed Domain Name falls within the category of so-called "sucks" cases (where a trade mark is joined with a negative term) (*MIG Banque SA (MIG Bank Ltd) v Akram Mohammad Khalid*, WIPO Case No. D2011-0159, May 18, 2011).

Furthermore, the consensus view at paragraph 1.3 of the WIPO Overview 2.0 is that "*generally, a domain name consisting of a trademark and a negative or pejorative term (such as [trademark]sucks.com) would be considered confusingly similar to the complainant's trademark for the purpose of satisfying the standing requirement under the first element of the UDRP (with the merits of such cases typically falling to be decided under subsequent elements). Panels have recognised that inclusion of a subsidiary word to the dominant feature of a mark at issue typically does not serve to obviate confusion for purposes of the UDRP's first element threshold requirement, and/or that there may be a particular risk of confusion among Internet users whose first language is not the language of the domain name*".

While a minority of panels have previously argued that a domain name consisting of a trademark and a negative term is not confusingly similar because Internet users are not likely to associate the trademark holder with a domain name consisting of the trademark and a negative term, this Panel would accept the majority view that a domain name which wholly incorporates a trademark may be confusingly similar to such trademark for the purposes of the Policy in spite of the addition of common or generic words, even if they have a pejorative meaning. This applies in particular as the Complainant is located outside English speaking countries, where people are often not fluent in the English language and may not recognise the negative connotation of the word attached to the trademark.

The Panel also notes that this is the recent approach favoured by Panels particularly when considering domain names that have the additional word "fraud" (*AlgaeCal Inc. v AlgaeCal Fraud* Case No. D2013-1248, September 12, 2013; *MIG Banque SA (MIG Bank Ltd) v Akram Mohammad Khalid*, WIPO Case No. D2011-0159, May 18, 2011; *Streamtel Corporation SRL v Ton Kamminga* Case No. D2010-0423, May 13, 2010).

Accordingly, the Panel finds that while the Disputed Domain Name is found to be identical or confusingly similar, the Complainant has ultimately failed the first element given the absence of any evidence to establish the presence of secondary acquired distinctiveness of the "ADODIS" trademark.

B. Rights or Legitimate Interests

To succeed on the second element, the Complainant must make out a *prima facie* case that the Respondent lacks rights or legitimate interests in the domain name. If such a *prima facie* case is made out, then the burden of production shifts to the Respondent to demonstrate rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy identifies several circumstances, in particular but without limitation, in which a respondent might demonstrate rights or legitimate interests in a domain name. In this instance, the Panel finds that the Respondent has a legitimate interest in using the Disputed Domain Name as a site critical of the services being offered by the Complainant pursuant to paragraph 4(c)(iii), which specifically states that "*a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue*".

The Respondent asserts that it does not have any intention to engage in the Complainant's business areas; sell, rent or transfer the domain; disrupt the business of a competitor, i.e. the Complainant; or to

attract users based on confusion with the Complainant's mark. There has been no evidence submitted by either parties to prove otherwise. Neither has there been any evidence submitted or allegations made by the Complainant that the Respondent has knowingly and deliberately made statements that are false, misleading and unsupported regarding the Complainant and its services.

Whilst the Complainant alleges that the Respondent is hampering its business and has a clear intention to defame the Complainant's position in the market as a leading web development company, the Complainant has failed to put forward any evidence to support this stance. On the contrary, emails from the Complainant to the Respondent sent in September 2013 appear to admit that there is basis to the complaint made by the Respondent with regard to the services rendered by the Complainant. In an email dated 11th September 2013, the Complainant's client relationship manager made no denial to the complaints made by the Respondent and further said, *inter alia*, that "*it is clear by auditing this project that many things had gone wrong in this project. Mainly due to not following up the process setup by our team.*"

The Panel has also exercised its general powers pursuant to paragraph 10(a) of the Rules to conduct its own factual research, including the review of the parties' websites (*Ryanair Limited v Michael Coulston*, WIPO Case No. D2006-1194 (December 12, 2006); *Société des Produits Nestlé SA v Telmex Management Services*, WIPO Case No. D2002-0070 (April 2, 2002)).

Consequently on September 10, 2014, the Panel visited the Respondent's website, www.adodisfraud.com, to determine whether any evidence could be found with regard to the Respondent's rights or legitimacy of interest of the Respondent in the disputed domain name. The Panel found and is of the view that the Respondent's website consists entirely of criticisms and commentaries on the Complainant and its business practices, without any indication of commerce or other commercial activity. The main heading of every page of the Disputed Domain Name also contains the words "Documenting the Adodis Technologies Scam", which clearly describes the sole purpose of the existence and use of the Disputed Domain Name.

Reference is made to *Alsace Croisieres SA v John Livingstone / Write Place Publications Inc*, WIPO Case No. D2013-2025 (January 11, 2014), where the Panel held that the Respondent was operating a genuine noncommercial website based on a domain name containing an appendage ("sucks"), which has become well-known as an identifier of criticism sites. As the Respondent was using the mark to identify the Complainant for the purposes of operating a criticism website, such use was described as "fair use" of a trade mark. Similarly in this instance, the Panel finds that this Respondent has made "fair use" of the mark "ADODIS" as there is no evidence that the Respondent is, *inter alia*, operating the website for any commercial purpose, a competitor of the Complainant, or attempting to impersonate the Complainant or divert customers away.

Dealing with the Complainant's assertion that the Respondent has "defamed the Complainant's position", it is trite that the primary concern of the Policy is that of cybersquatting. Tarnishment in this context refers to "*such unseemly conduct as linking unrelated pornographic, violent or drug-related images or information to an otherwise wholesome mark*". (*Britannia Building Society v Britannia Fraud Prevention*, WIPO Case No. D2001-0505 (July 6, 2001)). As such, the Complainant's assertion that the Respondent was intending to defame the Complainant's position in the market reflects a misunderstanding of the nature of tarnishment prohibited by the policy. Fair-use criticism, even if libelous, in contrast does not constitute tarnishment and is not prohibited by the Policy. The Complainant can pursue such assertions via other more appropriate legal venues (*Frank Weinberg & Black P.L. v Allison D'Andrea*, WIPO Case No. D2013-1578, October 18, 2013).

Referring specifically to *Ryanair Limited v Michael Coulston*, WIPO Case No. D2006-1194 (December 12, 2006), the Panel had held that the Respondent's site criticized the Complainant and its business practices, sometimes in harsh terms, but did not associate the RYANAIR mark with any unwholesome activity. The Panel thus found that the Complainant had failed to show that the Respondent had used the Domain Name in a manner that tarnished the Complainant's trademark.

In light of the above, the Panel finds that the Respondent has legitimate interest in the Disputed Domain Name pursuant to paragraph 4(c)(iii) of the Policy due to the absence of any evidence indicating a competitive intention in the use.

C. Registered and Used in Bad faith

Paragraph 4(b) of the Policy states that any of the circumstances below, in particular but without limitation, 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 [the Respondent has] have registered or 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 documented out-of-pocket costs directly related to the domain name; or
- ii. [the Respondent 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 it has engaged in a pattern of such conduct; or
- iii. [the Respondent has] have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. by using the domain name, [the Respondent has] have intentionally attempted to attract, for commercial gain, Internet users to its 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 has considered the Complainant's allegations that the creation of adodisfraud.com has hampered their business and that the person who created the aforementioned website has a clear intention to defame the Complainant's position in the market as a leading web development company, which clearly relates to paragraph 4(b)(iii) of the Policy.

The Panel takes the view that the Respondent is not a "competitor" of the Complainant. The Panel agrees with the holding in *Britannia Building Society v Britannia Fraud Prevention*, WIPO Case No D2001-0505, 6th July 2001, that "a competitor for purposes of the Policy is a person or entity in competition with the complainant for the provision of good or services, and not, merely any person or entity with an interest oppositional to that of a mark holder. To rule otherwise would render so many parties "competitors" as to dilute the Policy's bad faith requirement beyond recognition".

The Respondent appears to be a disgruntled customer of the Complainant and the Complainant thus failed to establish bad faith under paragraph 4(b) (iii).

As such, the Panel finds that the Respondent did not register and use the domain name at issue in bad faith.

7. Decision

For the foregoing reasons, the Complaint is denied.

Dated September 19, 2014

CHEW KHERK YING
Sole Panelist