

## **ADMINISTRATIVE PANEL DECISION**

Deep Focus Inc. v. Doman Admin, Abstract Holdings International LTD  
Case No. D2018-0518

### **1. The Parties**

The Complainant is Deep Focus Inc. of New York, New York, United States of America (“United States”), represented by Hayes, Scott, Bonino & Ellingson, LLP, United States.

The Respondent is Domain Admin, Abstract Holdings International LTD of Worthing, Christ Church, Barbados, represented by Muscovitch Law P.C., Canada.

### **2. The Domain Name and Registrar**

The disputed domain name <cassandra.com> is registered with Uniregistrar Corp (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 7, 2018. On March 8, 2018, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 8, 2018, 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 March 15, 2018, 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 March 16, 2018.

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 March 19, 2018. In accordance with the Rules, paragraph 5, the due date for Response was April 8, 2018. Upon request of the Respondent, the due date for Response was automatically extended until April 12, 2018, in accordance with the Rules, paragraph 5(b). The Response was filed with the Center April 12, 2018.

On May 1, 2018, the Complainant filed an unsolicited supplemental filing. On May 4, 2018, the Respondent filed an unsolicited supplemental filing.

The Center appointed Steven A. Maier, Adam Taylor, and Kimberley Chen Nobles as panelists in this matter on May 23, 2018. 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.

The Panel has considered the admissibility of the parties' supplemental filings referred to above. No supplemental filings were requested by the Panel in this case. As contemplated by the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), an unsolicited supplemental filing should be admitted only if exceptional circumstances can be shown or if there is some other compelling reason to admit the filing. In the view of the Panel, the only element of the Complainant's supplemental filing that should properly be admitted is that part of that filing which replies to a claim by the Respondent in its Response that the Complainant has engaged in "reverse domain name hijacking." The Panel does not consider that any part of the Respondent's supplemental filing requires to be admitted, save to note that the Respondent maintains that claim.

#### **4. Factual Background**

The Complainant is a corporation registered in New York, United States. It operates a cultural strategy and business intelligence firm which currently trades under the name "Cassandra".

The Complainant is the owner of United States trademark number 2804326 for the mark THE CASSANDRA REPORT registered on January 13, 2004. The trademark includes the disclaimer that it includes no exclusive right to use the term REPORT apart from the trademark as shown.

The Respondent is a company located in Barbados. It is an investor and trader in Internet domain names.

The disputed domain name <cassandra.com>, acquired by the Respondent on or about April 5, 2012, was first registered on January 11, 2000.

The disputed domain name appears at all material times to have resolved to a website stating that the disputed domain name may be for sale.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant refers to its registered trademark rights in the mark THE CASSANDRA REPORT and states that it has used that trademark since 1996. It claims also to have unregistered rights in the name "Cassandra". It states that it has used the domain name <cassandra.co> as its primary domain name since 2010 and exhibits pages from its website which include the name "Cassandra", and also media coverage dated August 2017 and October 2017 which refers to both "Cassandra" and "The Cassandra Report".

The Complainant submits that the disputed domain name is identical or confusingly similar to trademarks in which it has rights. In the case of its registered trademark THE CASSANDRA REPORT, it contends that the Respondent has merely removed the terms "The" and the "non-dominant, disclaimed element 'Report'". It also claims that the disputed domain name is effectively identical to the name "Cassandra" in which it claims unregistered rights, and that the Respondent has adopted that name in full with only the addition of the Generic Top-Level Domain ("gTLD") ".com", which is insufficient to distinguish the disputed domain name from the Complainant's name.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant says that the Respondent is unable to demonstrate any of the circumstances set out in paragraph 4(c) of the Policy which may be evidence of rights or legitimate interests. It contends that prior to the date of its Complaint, the disputed domain name was used only for the purpose of announcing that the disputed domain name was for sale and that is not a legitimate purpose. The Complainant states that after the date of its Complaint, the disputed domain name was additionally used for the purpose of a parking page and pay-per-click links, which again does not constitute legitimate use.

The Complainant provides evidence that its representative approached the Respondent in October 2017 with an offer to buy the disputed domain name for USD 2,500. The Complainant states that this offer was flatly refused and that the Respondent insisted on a price of USD 200,000, even after it had been stated that the Complainant was the owner of relevant trademark rights.

The Complainant alleges that the Respondent has used a "robots.txt" file or some similar device which has prevented the Complainant from fully reviewing its archived web pages.

The Complainant submits that the disputed domain name was registered and is being used in bad faith. The Complainant says that the Respondent registered the disputed domain name primarily for the purpose of preventing the Complainant from reflecting its trademark in a corresponding domain name (paragraph 2(b)(ii) of the Policy) and that this is evident from the Respondent's failure ever to host any website content other than an offer to sell the disputed domain name. The Complainant also submits that the Respondent is using the disputed domain name to confuse Internet users and to attract them to the Respondent's services or otherwise to derive a commercial gain from the disputed domain name. It alleges that the Respondent's asking price of USD 200,000 is *prima facie* evidence of bad faith, as is the use of the disputed domain name for the purpose of pay-per-click links and the Respondent's use of a "robots.txt" file.

The Complainant requests the transfer of the disputed domain name.

The Complainant submits that it has (as a minimum) not engaged in "reverse domain name hijacking". It states that it believes the Respondent has infringed its legitimate trademark rights by purchasing the disputed domain name "with the sole intent to sell it to a trademark owner at an exorbitant fee".

## **B. Respondent**

The Respondent denies that it registered the disputed domain name in the knowledge of the Complainant's trademark or with the intention of taking unfair advantage of any goodwill attaching to that trademark.

The Respondent states that it is an investor in generic, descriptive and personal domain names. It states that on or about April 5, 2012 it purchased a portfolio of 1,427 generic, descriptive, and personal domain names which included the disputed domain name. The Respondent exhibits the relevant purchase agreement together with a list of the purchased domain names. The Respondent says that the disputed domain name was included in the portfolio because it was a common female first name and states that the portfolio included another 15 ".com" domain names, similarly based on common first names, including e.g., <natalia.com>, <jodie.com>, and <gabriella.com>.

The Respondent denies that the name "Cassandra" is exclusively associated with the Complainant. It states that "Cassandra" is a popular first name derived from a Greek mythological figure and provides evidence that there are approximately 117,685 people with that first name in the United States alone. The Respondent exhibits the results of a Google search for the term "cassandra" and states that this generates 491 million results and that there is no reference to the Complainant in the first two pages of those results. It also exhibits evidence of 21 live United States trademark registrations which include the term "Cassandra", only one of which appears to be owned by the Complainant. The Respondent also provides evidence of other country code Top-Level Domain names ("ccTLDs") that it says are unconnected with the Complainant, including <cassandra.ca>, <cassandra.no>, and <cassandra.it>. Further, the Respondent exhibits evidence of 25 registered corporate entities in the state of New York (alone) all of which begin with the name

“Cassandra”, including “Cassandra Associates L.P.”, “Cassandra Complex LLC”, and “Cassandra Productions, Inc.”, all of which it contends are unconnected with the Complainant.

Concerning its knowledge or otherwise of the Complainant’s trademarks, the Respondent submits that, when it acquired the disputed domain name in 2012, the Complainant had no exclusive rights in the name “Cassandra” and that its trademark THE CASSANDRA REPORT was not widely known. The Respondent submits that the Complainant has failed to provide evidence of any continuous use of the brand “Cassandra”, its commercial promotion or any public recognition that would result in the name having become distinctive of the Complainant. The Respondent also observes that the term REPORT being disclaimed in the Complainant’s registered trademark THE CASSANDRA REPORT does not mean that the name CASSANDRA stands as a trademark on its own. With regard to the registered trademark THE CASSANDRA REPORT, the Respondent states that it was not “even remotely aware” of the Complainant or this trademark when it acquired the disputed domain name, and that there is no reason why it should have been so aware.

The Respondent contends that it has rights or legitimate interests in the disputed domain name by virtue of having registered a generic or descriptive domain name for the purposes of investment, and that the offer of such a domain name for sale represents a *bona fide* offering of goods or services. The Respondent disputes the Complainant’s contention that a registrant cannot have legitimate rights or interests without using the domain name for the purpose of a website, as well as any contention that the use of the disputed domain name for the purpose of pay-per-click links is in some manner illegitimate. The Respondent states that it has never employed “robots.txt” or any similar measure to prevent the review of archived pages and that the disputed domain name has at all material times included links to general, non-infringing advertising. The Respondent notes that there is no contention by the Complainant that any of the advertising in question has related to the Complainant or that it has caused confusion.

Concerning the Complainant’s allegations of bad faith, the Respondent submits that there is no basis upon which the Complainant can allege that the Respondent registered the disputed domain name in order to target the Complainant’s trademark. It contends that it would be “extraordinarily farfetched” to conclude that the Respondent purchased a portfolio of 1,427 generic domain names with the hidden intention of targeting the Complainant, which (the Respondent states) does not even have a trademark registration corresponding to the disputed domain name. The Respondent therefore disputes the Complainant’s claim that it registered the disputed domain name primarily for the purposes of preventing the Complainant from reflecting its trademark in a corresponding name. It states that, on the contrary, it has used the disputed domain name as part of its stock in trade of valuable, investment-grade domain names for sale and for the purpose of non-infringing, general advertising.

The Respondent also denies having solicited any sale of the disputed domain name from the Complainant and points out that it was the Complainant who initiated an enquiry about purchasing the disputed domain name. The Respondent submits that the price it requested for the disputed domain name in response to the Complainant’s enquiry was the market price and in line with the going rate for first name domain names. The Respondent provides evidence of the historical sale price of other first name domain names including <lola.com> reportedly sold for USD 550,000 and <alice.com> reportedly sold for USD 250,000.

The Respondent submits that this is a case of attempted “reverse domain name hijacking” on the part of the Complainant. It states that the Complainant is represented by intellectual property counsel and that it must have realized it could not prove one of the essential requirements under the Policy, *i.e.*, that the Respondent was specifically targeting the Complainant’s trademark when it registered the disputed domain name. The Respondent claims that the Complainant is misusing the UDRP in bad faith following its offer to purchase the disputed domain name being met with an unacceptable counter-offer.

## **6. Discussion and Findings**

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set

out under paragraph 4(a) of the Policy are present. Those elements are:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

#### **A. Identical or Confusingly Similar**

The Complainant has established that it has registered trademark rights in the mark THE CASSANDRA REPORT. The Panel finds that the dominant element of this trademark is the term CASSANDRA and that disputed domain name is, therefore, confusingly similar to that trademark, despite the inclusion in the trademark of the definite article "THE" and descriptive term "REPORT". The Panel observes in this regard that the threshold for establishing confusing similarity under paragraph 4(a)(i) of the Policy is relatively low.

The Panel therefore finds that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

#### **B. Rights or Legitimate Interests**

While the Panel notes that the Complainant appears to be making some current use of the name "Cassandra" (alone) on its website, it has provided little or no evidence of its trading under that name or of any significant public recognition of that name, as opposed to "The Cassandra Report", in connection with its business. The Panel is not, therefore, satisfied on the evidence that the name "Cassandra" has gained any secondary meaning as an identifier of the Complainant or its business such as would give rise to unregistered trademark rights.

The Panel is not of the view, in any event, that the name "Cassandra" could be regarded as associated exclusively with the Complainant in the minds of consumers. This much is clear from the numerous examples provided by the Respondent of the use of the name "Cassandra" as, or as part of, business names, trademarks, and domain names by parties other than the Complainant.

The Respondent is in the business of trading in domain names and claims to have acquired the disputed domain name, being a commonly-known, female first name originating in Greek mythology, as part of a large portfolio of generic, descriptive, and personal domain names. It provides evidence of that purchase and of the other domain names that it comprised, including numerous other female first name domain names.

The Panel accepts that, where a party legitimately registers a domain name comprising commonplace or dictionary elements for sale, without intent to target the trademark of an existing trademark owner, then that offer for sale can give rise to rights or legitimate interests in the domain name as a *bona fide* offering of goods or services for the purposes of paragraph 4(c)(i) of the Policy (see *e.g. Allocation Network GmbH v. Steve Gregory*, WIPO Case No. D2000-0016; and *Voys B.V., Voys United B.V. v. Thomas Zou*, WIPO Case No. D2017-2136). The Panel finds that the same considerations are applicable to the registration of a personal first name. The question in this case, therefore, is whether the Respondent registered the disputed domain name in the knowledge of the Complainant's trademark and with the intention of taking unfair advantage of the goodwill attaching to that trademark, or legitimately in the circumstances described above. Based on the parties' submissions in this case, the Panel can find no evidence upon which to conclude that the Respondent was aware of the Complainant's United States trademark THE CASSANDRA REPORT at the date it registered the disputed domain name, or that it registered the disputed domain name with the intention of taking unfair advantage of that trademark. The Complainant has provided little or no evidence of its business activities and public profile in 2012 and has adduced no evidence that the Respondent was in fact aware of its trademark, or identified circumstances from which to infer that it must have been so aware. On the contrary, the Panel finds the Respondent's explanation for its acquisition of the disputed domain

name to be entirely credible, and concludes therefore that the Respondent has rights or legitimate interests in respect of the disputed domain name.

### **C. Registered and Used in Bad Faith**

In the light of the Panel's findings in respect of rights or legitimate interests, the question of registration and use in bad faith does not technically require to be considered. However, in view of the possibility of a finding of "reverse domain name hijacking", it is appropriate for the Panel to note that it finds no grounds to conclude either that the disputed domain name was registered, or that it has been used, in bad faith. The Panel rejects, in particular, the Complainant's allegations that the Respondent acquired the disputed domain name as a "blocking registration" against the Complainant, that it has used the disputed domain name misleadingly to attract Internet users to its website, or that its offer to sell the disputed domain name and/or its use of the disputed domain name for general pay-per-click advertising, and not for the purpose of any other website, evidences bad faith on its part.

### **7. Reverse Domain Name Hijacking**

According to paragraph 15(e) of the Rules:

"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."

In the view of the Panel, the Complainant has disclosed no reasonable grounds for believing that the Respondent registered the disputed domain name with the Complainant or its trademark THE CASSANDRA REPORT in mind or with the intention of taking unfair advantage of the Complainant's trademark. Nor, for the reasons set out above, has it disclosed reasonable grounds for believing that the Respondent has used the disputed domain name in bad faith. On the contrary, the Panel infers on balance that the Complainant commenced the current proceeding in the hope of acquiring the disputed domain name without paying the full price legitimately demanded by the Respondent for the sale of the disputed domain name. Noting also that the Complainant is legally represented in this proceeding, the Panel finds that that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

### **8. Decision**

For the foregoing reasons the Complaint is denied.

**Steven A. Maier**  
Presiding Panelist

**Adam Taylor**  
Panelist

**Kimberley Chen Nobles**  
Panelist  
Date: June 6, 2018