

## **ADMINISTRATIVE PANEL DECISION**

Group One Holdings Pte Ltd v. Steven Hafto  
Case No. D2017-0183

### **1. The Parties**

The Complainant is Group One Holdings Pte Ltd of Singapore, represented by Rajah & Tann Singapore LLP, Singapore.

The Respondent is Steven Hafto of Berlin, New Jersey, United States of America, represented by Muscovitch Law P.C., Canada.

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

The disputed domain name <onechampionship.com> is registered with GoDaddy.com, LLC (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 31, 2017. On the same date, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same date, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

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

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 9, 2017. In accordance with the Rules, paragraph 5, the due date for Response was March 1, 2017. On February 22, 2017, the Respondent filed a request for an additional four calendar days to file the Response. In accordance with paragraph 5(b) of the Rules, the Center granted the extension of time. The Response was filed with the Center March 2, 2017.

The Center appointed Wilson Pinheiro Jabur, M. Scott Donahey and Adam Taylor as panelists in this matter on March 15, 2017. 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 Complainant is a Singapore company that owns and manages the “ONE Championship” mixed-martial arts (“MMA”) events. The Complainant was incorporated in July 2011 when it started using the ONE FIGHTING CHAMPIONSHIP trademark in connection with MMA events.

The Complainant owns Singapore trademark ONE CHAMPIONSHIP registered on July 28, 2015, with registration no. 40201512917R, in classes 25, 28 and 41, which it started using in 2015 in connection with its business activities and MMA events, having dropped the “fighting” element from the above trademark after a rebranding.

The disputed domain name was registered on October 14, 2006.

The disputed domain name at times resolved to parked pages displaying links to third parties’ websites and at other times did not resolve to an active website.

According to the Respondent, on or about October 3, 2016, a representative of the Complainant telephoned the Respondent and spoke with the Respondent’s wife, informing her that the Complainant was interested in purchasing the disputed domain name. On October 6, 2016, the Respondent sent an email to the Complainant’s representative informing him that he had registered several domain names relating to sports, Bollywood, etc. and that he was not in the habit of selling them but was nonetheless open to offers, to which the Complainant’s representative replied on October 7, 2016, offering USD 5,000 for the disputed domain name. On the following day, the Respondent replied, declining the offer. The Complainant sent a last email to the Respondent on October 13, 2016, asking for a counter-offer but the Respondent did not respond further.

#### 5. Parties’ Contentions

##### A. Complainant

The Complainant claims to have started using the ONE FIGHTING CHAMPIONSHIP trademark in connection with MMA events on July 14, 2011. The Complainant further states that, on or about January 13, 2015, it carried out a rebranding having dropped the word “fighting” from its mark and that, since then, it has used the trademark ONE CHAMPIONSHIP in connection with its business activities and MMA events.

The Complainant asserts that its ONE CHAMPIONSHIP trademark is well-known across the world and particularly in Asia where it enjoys significant popularity and reputation, amounting to a substantial goodwill accumulated since 2011.

Furthermore, in spite of the fact that the Complainant’s rights do not predate the registration of the disputed domain name, the Complainant argues, grounding such assertion on the consensus view of paragraph 1.4 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 2.0”), that the 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.

Therefore, in the Complainant’s view, the disputed domain name clearly incorporates the Complainant’s registered trademark in its entirety, certainly being confusingly similar therewith.

As to the Respondent’s lack of rights or legitimate interests in the disputed domain name, the Complainant claims that:

- i. the Respondent’s use of the disputed domain name is not connected to a *bona fide* offering of goods or services, since the disputed domain name resolved to webpages displaying pay-per-click links redirecting Internet users to other online locations, including websites related to the Complainant’s

direct competitors; and

- ii. there is no evidence that the Respondent, an individual has been commonly known by the disputed domain name or that he has used any mark containing such expression to offer any goods or services or that he has any rights in such a name.

In relation to bad faith use of the disputed domain name, the Complainant asserts that the Respondent, by using the disputed domain name, intentionally attempted to attract, for commercial gain, Internet users to his website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his website or location.

As to the registration of the disputed domain name in bad faith, the Complainant submits that the Respondent registered 234 other domain names, thereby indicating that the Respondent was seeking to capitalize on their potential for sale to rightful trademark owners for a sum exceeding their registration costs. The Complainant characterizes this as a pattern of registering a large number of domain names with complete disregard as to whether or not he was violating other party's rights.

The Complainant further submits that the reasoning of the past decisions in *PAA Laboratories GmbH v. Printing Arts America*, WIPO Case No. D2004-0338 and *Eastman Sporto Group LLC v. Jim and Kenny*, WIPO Case No. D2009-1688 should be followed in this case and that the renewal of the disputed domain name should amount to registration for the purposes of determining whether the disputed domain name was registered in bad faith.

Lastly, the Complainant requests, if such is not the Panel's conclusion, that the Policy's requirement of "registration and use in bad faith" be read disjunctively as decided in *Octogen Pharmacal Company, Inc. v. Domains by Proxy, Inc. / Rich Sanders and Octogen e-Solutions*, WIPO Case No. D2009-0786 and *Jappy GmbH v. Satoshi Shimoshita*, WIPO Case No. D2010-1001, and that on that basis the Respondent's use of the disputed domain name in bad faith sufficed to fulfill the requirements of paragraph 4(a) (iii) of the Policy.

## **B. Respondent**

The Respondent asserts to have registered, on October 13, 2006, 161 domain names that had been percolating around his mind and which he had been meaning to register. To the best of Respondent's knowledge, not one of them was a trademarked word or phrase. He further claims that he envisioned to one day develop a general sports-related website in connection with the disputed domain name but ultimately did not do so.

In addition to such domain names, he registered others which he has placed, at least as of June 6, 2007, and since then from time to time, on parked pages that would allow him revenues from pay-per-click advertising.

As to the disputed domain name, the Respondent asserts to have parked it, long before any notice of the Complainant or any trademark-related claim from the Complainant, for sports-related advertising, as automatically selected by the parking provider given that such would be the natural, obvious and most relevant subject matter associated with the disputed domain name, never intentionally using the disputed domain name to target the Complainant or its trademark.

The Respondent further claims that he only first learned of the Complainant as a result of the Complainant's representative's contact in October 2016.

As to the arguments raised by the Complainant, the Respondent contends, firstly, that the Complainant only started using, and acquiring, trademark rights over the "ONE CHAMPIONSHIP" expression in 2015, almost a decade after his registration of the disputed domain name, thus not having demonstrated any pre-existing rights at the time of the registration of the disputed domain name. In that sense the Respondent's legitimate interest should be derived from his being the first person to register the disputed domain name at a time when it was not subject to any demonstrated trademark rights held by anyone (as in *Inbay Limited v. Ronald*

*Tse dba Neosparx International*, WIPO Case No. D2014-0096).

Secondly, in the Respondent's view, his use of the disputed domain name in connection with general sports advertising, long prior to the Complainant's existence, characterizes a lawful and appropriate use of the disputed domain name constituting a legitimate interest (in accordance with paragraph 2.6 of the WIPO Overview 2.0).

Thirdly, the Respondent claims that he is not a domain name speculator, having registered all of his domain names for his own use and not as an investment to resell to others – but even if he was a speculator, such a practice could be accepted as long as it was in connection with a *bona fide* offering of goods or services, as held in *Allocation Network GmbH v. Steve Gregory*, WIPO Case No. D2000-0016.

In relation to the claim of registration and use of the disputed domain name in bad faith, the Respondent contends that such is a factual impossibility given that the disputed domain name was registered in the absence of the existence of the Complainant and in the absence of any trademark rights held by the Complainant at the time of the registration of the disputed domain name (as stated by paragraph 3.1 of the WIPO Overview 2.0).

Furthermore, as to the Complainant's claim of a pattern of registering domain names in bad faith the Respondent asserts that none of his domain names relate to registered trademarks and that he has been using them in connection with advertising related to the subject matter of these domain names; and so it was incomprehensible that the Complainant claimed that such use was "unlawful".

The Respondent submits that, in addition, if a registrant has a legitimate interest in a domain name, as he does in this case, he is entitled to offer his asset for sale at a market price and this does not characterize bad faith, as recognized in *Etam, plc v. Alberta Hot Rods*, WIPO Case No. D2000-1654).

As to the Complainant's request that the Policy's requirement for "registration and use in bad faith" be read disjunctively and not conjunctively, the Respondent argues that such "retroactive bad faith theory", also referred to as "Mummygold/Octogen reasoning" has been considered an inappropriate approach by the emerging consensus, as observed in *Side by Side, Inc. /dba/ Sidetrack v. Alexander Lerman*, WIPO Case No. D2012-0771, *Mile, Inc. v. Michael Burg*, WIPO Case No. D2010-2011, and *TOBAM v. Thestrup / Best Identity*, WIPO Case No. D2016-1990.

Lastly, the Respondent submits that the Complainant brought this case for commercial purposes without any legal right to the disputed domain name, in a classic "Plan B" case after failing in the marketplace to acquire the disputed domain name, as described in *TOBAM v. Thestrup / Best Identity, supra*.

## **6. Discussion and Findings**

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

The Complainant has established rights in the ONE CHAMPIONSHIP trademark.

The disputed domain name is identical to the Complainant's trademark, disregarding the generic Top-Level Domain ("gTLD").

The Panel therefore finds that the Complainant has established the first element of paragraph 4(a) of the Policy.

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

It is unnecessary to consider this element in light of the Panel's conclusion below under the third element.

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

It is not in dispute that the Complainant's trademark post-dates the registration of the disputed domain name in 2006. Likewise, the Complainant's unregistered rights; the Complainant only started using the ONE CHAMPIONSHIP mark in 2015 and the ONE FIGHTING CHAMPIONSHIP trademark in 2011, which was when the Complainant was incorporated.

Paragraph 3.1 of the WIPO Overview 2.0 states the following consensus view:

"Generally speaking, although a trademark can form a basis for a UDRP action under the first element irrespective of its date [...], when a domain name is registered by the respondent before the complainant's relied-upon trademark right is shown to have been first established (whether on a registered or unregistered basis), the registration of the domain name would not have been in bad faith because the registrant could not have contemplated the complainant's then non-existent right."

As the panel stated in *TOBAM v. Thestrup / Best Identity, supra*: "While there are a handful of UDRP cases around 2009-2010, including those cited by the Complainant, which considered alternative approaches based on the warranty in paragraph 2 of the UDRP and the wording of paragraph 4(b), amongst other things, the overwhelming approach of UDRP panels since then has been to affirm the literal meaning of paragraph 4(a)(iii) of the Policy and to require bad faith at the time of registration or acquisition of the disputed domain name. See, e.g., *Coolside Limited v. Get On The Web Limited*, WIPO Case No. D2016-0335, *Centroamerica Comercial, Sociedad Anonima de Capital Variable (CAMCO) v. Michael Mann*, WIPO Case No. D2016-1709, *New Forests Asset Management Pty Limited v. Kerry Schorsch, Global Advertizing, LLC*, WIPO Case No. D2015-1415, *Dreamlines GmbH v. Darshinee Naidu / World News Inc*, WIPO Case No. D2016-0111, *Lonza AG v. Onyx Networks, Inc.*, WIPO Case No. D2015-1460, *Movius Interactive Corporation v. Dynamo.com*, WIPO Case No. D2015-1717 and *Intellect Design Arena Limited v. Moniker Privacy Services / David Wieland, iEstates.com, LLC*, WIPO Case No. D2016-1349."

This Panel also agrees and considers that the lack of registration in bad faith is fatal to this case.

As to the Complainant's claim that Respondent has a pattern of registering domain names in bad faith, in addition to such claim being largely irrelevant in view of the timing issue, the Panel points out that the Complainant has not identified a single one of the 234 other domain names registered by the Respondent which illicitly reproduces or infringes obvious third-party trademarks.

In relation to the Complainant's claim that the renewal of the disputed domain name should be considered a new registration, this Panel agrees with the views stated in paragraph 3.7 of the WIPO Overview 2.0 in that "[...] Registration in bad faith must normally occur at the time the current registrant took possession of the domain name. (Movement of a domain name registration from one privacy or proxy service to another may in certain circumstances constitute evidence of a new registration for this purpose.) Panels have tended to the view that formal changes in registration data are not necessarily deemed to constitute a new registration where evidence clearly establishes an unbroken chain of underlying ownership by a single entity or within a genuine conglomerate, and it is clear that any change in Whols registrant data is not being made to conceal an underlying owner's identity for the purpose of frustrating assessment of liability in relation to registration or use of the domain name."

Furthermore, in the present case the Panel finds that the Respondent has not changed its use of the disputed domain name prior to its renewal.

The Panel therefore concludes the Complainant has failed to establish the third element of paragraph 4(a) of the Policy.

### **D. Reverse Domain Name Hijacking ("RDNH")**

The Respondent argues that the Complainant brought this case for commercial purposes without any legal right to the disputed domain name after failing in the marketplace to acquire the disputed domain name.

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”. RDNH is defined under the Rules as “using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name”.

The Panel considers that the Complainant has been guilty of RDNH for the following reasons:

- i. The Complainant has failed by a large margin. In the Panel’s opinion, the Complainant knew or at least should have known that it could not prove one of the essential UDRP elements. The Complainant’s representatives quoted extensively from UDRP case law and the Panel thinks it unlikely that they were unaware of the current overwhelming view of UDRP panelists as to the need to prove registration as well as use in bad faith.
- ii. In the Panel’s view, this is a classic “Plan B” case, where the Complainant initially attempted to acquire the disputed domain name making no mention of the UDRP or any other legal rights. Then, having been frustrated in its negotiations to buy the disputed domain name, it resorted to the ultimate option of a highly contrived and artificial claim not supported by any facts or the plain wording of the UDRP. This stratagem has been described in many UDRP cases as “a highly improper purpose” and it has contributed to findings of RDNH. See, *e.g.*, *Patricks Universal Export Pty Ltd. v. David Greenblatt*, WIPO Case No. D2016-0653 and *BERNINA International AG v. Domain Administrator, Name Administration Inc. (BVI)*, WIPO Case No. D2016-1811.

## 7. Decision

For the foregoing reasons, the Complaint is denied and the Panel finds that the Complainant has been guilty of Reverse Domain Name Hijacking.

**Wilson Pinheiro Jabur**

Presiding Panelist

**M. Scott Donahey**

Panelist

**Adam Taylor**

Panelist

Date: March 28, 2017