



NATIONAL ARBITRATION FORUM

DECISION

Scene LLC, dba Ookla v. Domain Buyer / Innovation HQ, Inc.

Claim Number: FA1411001590403

PARTIES

Complainant is **Scene LLC, dba Ookla** (“Complainant”), represented by **Jeff Nelson** of **Miller Nash Graham & Dunn LLP**, Washington, USA. Respondent is **Domain Buyer / Innovation HQ, Inc.** (“Respondent”), represented by **Zak Muscovitch** of **The Muscovitch Law Firm**, Canada.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<speedtest.org>**, registered with **GoDaddy.com, LLC (R91-LROR)**.

PANEL

The undersigned each certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as a Panelist in this proceeding.

Scott R. Austin, Esq., as Chair

Fernando Triana, Esq., as Co-Panelist

Paul M. DeCicco, Esq., as Co-Panelist

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on November 17, 2014; the National Arbitration Forum received payment on November 17, 2014.

On November 19, 2014, GoDaddy.com, LLC (R91-LROR) confirmed by e-mail to the National Arbitration Forum that the <speedtest.org> domain name is registered with GoDaddy.com, LLC (R91-LROR) and that Respondent is the current registrant of the name. GoDaddy.com, LLC (R91-LROR) has verified that Respondent is bound by the GoDaddy.com, LLC (R91-LROR) registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On November 24, 2014, the Forum served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of December 15, 2014 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@speedtest.org. Also on November 24, 2014, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on December 8, 2014.

A timely Additional Submission was received from Complainant on December 12, 2014.

A timely Additional Submission was received from Respondent on December 16, 2014, and corrected on December 17, 2014, to render certain hyperlinks operative in the evidence previously submitted.

On December 18, 2014, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the National Arbitration Forum appointed Scott R. Austin, Esq., as Chair, and Fernando Triana, Esq. and Paul M. DeCicco, Esq., as Co-Panelists.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2. Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the National Arbitration Forum's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

RELIEF SOUGHT

Complainant requests that the disputed domain name be transferred from Respondent to Complainant.

Respondent requests that the Panel find that the Complainant has engaged in Reverse Domain Name Hijacking.

PARTIES' CONTENTIONS

A. Complainant makes the following contentions:

1. On August 18, 2004, Complainant organized its business as a Washington limited liability company, Scene, LLC, and does business under the name OOKLA, the name under which it operates today.

2. Complainant has registered the SPEEDTEST word mark with the United States Patent and Trademark Office (“USPTO”) for providing information in the field of Internet connections; providing information in the field of Internet connections via the Internet in International Class 38 (Reg. No. 4,047,266, registered October 25, 2011);
3. Although Complainant did not note this fact in its Complaint, upon careful review of the Certificate of Registration in the Annex, Exhibit D attached to the Complaint, it is apparent that Complainant’s registration is on the Supplemental and not the Principal Register.
4. Complainant also owns the SPEEDTEST mark in a manner that creates common law rights, namely, Complainant has extensively used and advertised the SPEEDTEST mark in connection with Internet upload/download speed measuring tools in more than 200 countries and territories around the world and has been using the <speedtest.net> domain name since as early as 2006.
5. The <speedtest.org> domain name is identical to Complainant’s SPEEDTEST mark.
6. Respondent lacks rights or legitimate interests in the disputed domain name.
7. Respondent is not commonly known by the <speedtest.org> domain name.
8. Respondent is neither licensed nor authorized to use the SPEEDTEST mark in a domain name.
9. Respondent does not provide any bona fide offering of goods or services, or make a legitimate noncommercial or fair use of the disputed domain name.
10. Respondent was previously a licensee of Complainant’s SPEEDTEST software tool. However, since the termination of the agreement between the parties, Respondent has been using the SPEEDTEST mark in the

disputed domain name in connection with an infringing software tool that directs Internet traffic away from Complainant.

11. Respondent uses the disputed domain name to offer competing services to that of Complainant for its own commercial gain.

B. Respondent makes the following contentions:

1. The Complaint is devoid of merit and it is impossible for it to succeed.
2. The disputed domain name was registered by the Respondent on September 12, 2000, which is six (6) years prior to the Complainant's first use of its alleged mark and four years before Complainant was even incorporated.
3. The Complainant provides Internet speed tests via its Internet web site.
4. The "About" section of Complainant's web site states: "Speedtest.net – The global Internet speed test for bandwidth throughput and VoIP performance".
5. Since 2006 the Complainant has consistently used the term, "speed test" descriptively and has consistently used the mark, OOKLA, to brand its particular speed test.
6. Complainant claims to own the SPEEDTEST mark through its registration with the USPTO, but has failed to advise the Panel that its registration is not on the Principal Register of the USPTO, but rather on the Supplemental Register.
7. The Complainant failed to disclose to the Panel that the USPTO expressly refused the Complainant's attempts to obtain trademark rights, and in fact the Complainant has no trademark rights on this generic and descriptive term.
8. Complainant's USPTO application history for the SPEEDTEST mark and submitted documents, shows that despite Complainant's attempt to convince the USPTO that SPEEDTEST was not generic for speed testing

services, the USPTO refused to allow the application to proceed to the Supplemental Register in connection with speed testing related services.

9. A simple Google search of the term, “speed test”, shows that millions of people use the term, “speed test” descriptively to refer to checking the speed of an Internet connection.
10. The Complainant *itself*, along with numerous other parties, currently uses the term, “speed test” in a descriptive manner.
11. Nowhere on its website does the Complainant ever use TM or ® to indicate that it is asserting trademark rights over “speed test”, but does so for Ookla.
12. Respondent has made a *bona fide* offering of goods or services, because it registered and used the disputed domain name years before Complainant existed; Respondent uses the disputed domain name for advertising related to Internet services and Internet speed testing, a legitimate use, even when pay-per-click advertising is employed; and Complainant’s mere assertions that traffic intended for Complainant has been redirected to Respondent, if any, are the result of Complainant electing to adopt a generic term for its service.
13. Complainant never had any trademark license agreement with Respondent concerning SPEEDTEST; the only license was over the OOKLA tool.
14. The Respondent was using the disputed domain name in accordance with its descriptive meaning well before the Complainant began using its alleged mark and continues to do so.
15. Since Complainant did not have trademark rights at the time of Respondent’s registration of the disputed domain, Respondent could not have registered in bad faith.
16. Respondent only made an offer to sell the disputed domain name to Complainant after being contacted by Complainant inquiring about a possible sale of the disputed domain name.

17. Respondent is not using Complainant's alleged mark to compete with Complainant, because Complainant has no mark and Respondent is lawfully using a generic term.
18. Respondent requests a finding of Reverse Domain Name Hijacking because Complainant's conduct meets all of the criteria of Reverse Domain Name Hijacking: Complainant knew or ought to have known that its case was fatally weak, Complainant misled the Panel by mischaracterizing its trademark rights or the lack thereof, made unsupported arguments, and filed a false declaration wherein it claimed that Respondent had licensed Complainant's trademark.

C. Complainant's Additional Submission

1. Complainant did register the mark, even if on the Supplemental Register, which is conclusive evidence that the USPTO has not deemed the mark generic, but rather determined that SPEEDTEST is eligible for trademark protection. Trademark rights in the United States are established by use, and registration is not actually necessary
2. Respondent admits that prior to licensing the SPEEDTEST mark from Complainant, it used the disputed domain name for nothing but a standard pay-per-click site, if it was used for anything at all. So, even if the Respondent registered the disputed domain name in 2000, the only evidence of use of the site was the standard pay-per-click site.
3. Respondent claims that it used the disputed domain name to advertise for content only related to the generic terms described in the disputed domain name, however, in its own Annex, it can be seen that Respondent advertised to links that had nothing to with the testing of Internet speed.
4. Respondent did not advertise to anything related to speed testing until Complainant publicly launched its SPEEDTEST software.

5. When contacted by Complainant to hopefully reach a solution to this issue, Respondent eagerly offered to sell the disputed domain name for \$250,000.
6. Even if Respondent registered the disputed domain name prior to Complainant's first use, it is clear by Respondent's own evidence that as soon as Complainant began using its SPEEDTEST mark, the ads on Respondent's website began seeking to direct traffic away from Complainant.
7. A finding of reverse domain name hijacking is not warranted as Complainant is not acting in bad faith and denies each and every allegation regarding the Reverse Domain Name Hijacking against Complainant.

D. Respondent's Additional Submission

1. Complainant's mark still consists solely of generic terms and as such cannot be considered as Complainant's mark.
2. Complainant still to this day uses the terms "speed test" generically on its own website.
3. Complainant's allegation that none of Respondent's links from 2004-2006 relate to testing speed is plainly incorrect as shown in Respondent's Annex, V.
4. Complainant still has not proven that it owns the trademark.
5. There was no trademark license agreement in existence as Complainant alleges.

FINDINGS

The Panel finds that Complainant has failed to meet the threshold requirement of establishing trademark rights in the term "SPEEDTEST." In the absence of any such trademark rights, Complainant cannot possibly prevail in this proceeding. The Panel, however, has also considered whether Respondent lacks rights or a

legitimate interest in the disputed domain name, and whether Respondent registered and used the disputed domain name in bad faith and finds Complainant has failed to meet its burden on both requirements as well for the reasons set forth below.

The Panel also finds that Complainant brought this Complaint in bad faith. Given Complainant's lack of any trademark rights, as evidenced by the difficulty it has faced in registering its purported mark in the U.S. Patent and Trademark Office, and Complainant's own continued use of the term "speed test" as generic to describe its services, the filing of this Complaint appears to have been a bad faith attempt to hijack the disputed domain name from Respondent.

DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

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

Identical and/or Confusingly Similar: *Policy ¶ 4(a)(i)*

Respondent argues that Complainant has not sufficiently demonstrated its rights in the SPEEDTEST mark. Respondent argues that both the disputed domain name and mark are made up of two common generic terms, “speed” and “test” and thus, Complainant cannot claim that it owns the SPEEDTEST mark through common law rights. Respondent claims and provides evidence in Response Annex U, that Complainant’s initial registration attempt with the USPTO on the Principal Register was denied based on genericness, and instead, Complainant registered its mark on the Supplemental Register. Respondent also notes that Complainant merely referenced the number of its registration in the text of the Complaint and omitted the fact that Complainant was relying on a supplemental registration with the USPTO, rather than a registration on the Principal Register. The Certificate of Registration attached to the Complaint in Complaint Annex, Exhibit confirms Complainant’s registration is on the Supplemental Register.

It is well-settled that a Supplemental Registration in the U.S. is not sufficient in itself to establish that a Complainant has rights to a mark for the purposes of the Policy. *Tarheel Take-Out, LLC v. Versimedia, Inc.*, D2012-1668 (WIPO October 18, 2012); *see also Advance News Service Inc. v. Vertical Axis, Inc. / Religionnewsservice.com*, D2008-1475 (WIPO December 11, 2008) (holding that a Supplemental Registration for RELIGION NEWS SERVICE did not provide sufficient rights under the Policy to confer UDRP standing); *PC Mall, Inc. v. Pygmy Computer Systems, Inc.*, D2004-0437 (WIPO August 25, 2004) (holding that a Supplemental Registration for MOBILE MALL did not provide sufficient rights under the Policy to confer standing); *Rodale, Inc. v. Cambridge*, DBIZ2002-00153 (WIPO June 28, 2002) (holding that a Supplemental Registration for SCUBADIVING.COM did not provide sufficient rights under the Policy to confer standing). To the contrary, registration on the Supplemental register shows that at the time of registration the mark was descriptive and had not acquired secondary meaning. *CyberTrader, Inc. v. Bushell*, D2001-1019 (WIPO Oct. 30, 2001).

Under United States law, marks that are merely descriptive, and that have not been shown to have acquired distinctiveness, may be registered on the Supplemental Register, but that registration does not confer any of the usual presumptions that accompany a mark registered on the Principal register (such as *prima facie* evidence of validity, ownership, and distinctiveness). Thus, the fact of a Supplemental Registration is no evidence whatsoever the Complainant owns trademark rights in the word SPEEDTEST. *See Advance News Service Inc. v. Vertical Axis, Inc. / Religionnewsservice.com*, D2008-1475 (WIPO December 11, 2008); *Rodale, Inc. v. Cambridge*, D2002-00153 (WIPO June 28, 2002).

A careful review of excerpts of Complainants application history provided to the Panel by Respondent in Response Annexes M and N show that even the supplemental registration was for a new class of broad Internet connection services in Class 38. This class was added after being suggested by the examiner in the USPTO's first office action, which also included an advisory to Complainant that that the SPEEDTEST mark applied to software in Class 9 and website services in Class 42 to test Internet connection speed was unlikely to register even on the supplemental register because the mark "appears to be generic in connection with the identified goods and services". The USPTO then warned, "Under these circumstances, an amendment to proceed under Trademark Act Section 2(f) or an amendment to the Supplemental Register can **NOT** be recommended. *See* TMEP §1209.01(c)." Resp., at Attached Annex M.

Review of Respondent's evidence submitted in Response Annex P of the USPTO's final Office Action shows the Examiner denied registration "because the applied-for mark [SPEEDTEST] is generic and thus, incapable of distinguishing applicant's goods and services. Trademark Act Section 23(c), 15

U.S.C. §1091(c)". The examiner relied on over 50 "excerpted webpages defining the phrase "speed test" and showing numerous examples of this phrase used in the industry by third parties, including webpages from Applicant that uses the wording to refer to this type of software program." *Id.*

Voluminous arguments by Complainant in its several responses shown in Response Annexes M and P failed to overcome the USPTO's refusal of the mark as generic under Trademark Act Section 23(c) and the application for services in Classes 9 and 42 was abandoned after a request to divide those classes from services in Class 38, which proceeded to the Supplemental Register. As the USPTO stated in its final office action denying registration shown in Response Annex P, "Applicant applied to register the mark SPEEDTEST for software that tests the speed of one's internet/broadband connection. Registration must be refused because the mark is generic for these goods and services." Resp., at Attached Annex P.

Based on the foregoing evidence, the Panel finds that Complainant's use of SPEEDTEST in connection with its speed test software and its website incorporating that software tool for testing the speed of an Internet connection appears to fall within the class of goods and services for which SPEEDTEST is generic. *See Tighrope Media Systems Corporation v. DomainCollection.com*, D2006-0446 (WIPO June 3, 2006) ("Cablecast" mark generic in connection with software and support for the management of cable television telecasts); *Tough Traveler, Ltd. v. Kelty Pack, Inc., Mike Scherer, and Inkling Pen Co.*, D2000-0783 (WIPO September 28, 2000) ("Kid Carrier" generic term for child carrying backpacks); *Shopping.com v. Internet Action Consulting*, D2000-0439 (WIPO July 28, 2000) ("Shopping" generic term for website services providing information necessary for personal buying decisions"). This conclusion is reinforced by the Trademark Office's rejection of Respondent's application for the mark SPEEDTEST for speed testing services. *Decision Analyst, Inc. v. Doug C.*

Dohring, D2000-1630 (WIPO February 6, 2001); see *Pet Warehouse v. Pets.com, Inc.*, D2000-0105 (WIPO April 13, 2000) (Trademark Office's refusal to register mark on ground of genericness is powerful evidence that Complainant lacks trademark rights in claimed PETWAREHOUSE mark).

In its Complaint, as well as its responses to the Trademark Office's office action, Complainant submitted exhibits showing that its software and website has received visits by millions of users, installations in 200 countries, high Internet popularity rankings, and apparently has invested in advertising and marketing for its SPEEDTEST software and website. Considering the USPTO's decision, which it would be inappropriate for this Panel to question or overrule, we agree with the findings of prior panels when confronted by such evidence under similar circumstances: "Although impressive, these efforts to establish secondary meaning fail as a matter of law because generic terms can never function as trademarks, and no amount of secondary meaning can convert a generic term into a trademark." *Shopping.com v. Internet Action Consulting*, D2000-0439 (WIPO July 28, 2000) (Noting also the importance of deference to USPTO decisions and distinctions in UDRP and USPTO determinations of genericness).

Finally, Respondent has submitted evidence in Respondent's Additional Submission Annex CC showing that Complainant itself, years after a certificate of registration has issued, uses the term SPEEDTEST on its own website predominantly in a generic manner as "speed test", without attaching any trademark symbol such as TM or circle R "®", which even a mark registered on the Supplemental Register is entitled to employ. As Professor McCarthy states, "If the proponent of trademark status itself uses the term as a generic name, this is strong evidence of genericness. A kind of estoppel arises when the proponent of trademark use is proven to have itself used the term before the public as a generic name, yet now claims that the public perceives it as a trademark" 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 12.1 (4th

ed. 2014)); *see also Decision Analyst, Inc. v. Doug C. Dohring, D2000-1630* (WIPO February 6, 2001) (Denying transfer for genericness and noting evidence that “Complainant does *not* use the Claimed Mark as a trademark on any of its websites” (emphasis in original)).

Since Complainant uses this combination of two dictionary words in their common meaning – to refer to testing the speed of Internet connections – the Panel finds the word SPEEDTEST is generic when used in connection with Complainant’s services and thus Complainant has not established any trademark rights in those words. *Rodale, Inc. v. Cambridge, DBIZ2002-00153* (WIPO June 28, 2002).

Because the Complainant has failed to prove the threshold question of holding trademark rights, and because Complainant cannot succeed unless it can prove all three UDRP elements, consideration of the other factors and the other allegations in the Complaint is unnecessary. *See Tightrope Media Sys. Corp. v. DomainCollection.com, D2006-0446* (WIPO June 2, 2006); *Creative Curb v. Edgetec Int’l Pty. Ltd., FA 116765* (Nat. Arb. Forum Sept. 20, 2002) (finding that because the complainant must prove all three elements under the Policy, the complainant’s failure to prove one of the elements makes further inquiry into the remaining elements unnecessary); *see also Hugo Daniel Barbaca Bejinha v. Whois Guard Protected, FA 836538* (Nat. Arb. Forum Dec. 28, 2006) (deciding not to inquire into the respondent’s rights or legitimate interests or its registration and use in bad faith where the complainant could not satisfy the requirements of Policy ¶ 4(a)(i)). Nevertheless, it is worth noting briefly below, that Complainant also has failed to establish the second and third factors. It has not shown that Respondent lacks a legitimate interest in the disputed domain name; to the contrary, Complainant admits that Respondent provides the same services for speed testing of Internet connections at its website using the disputed domain name as well as providing for pay per click (“PPC”) advertising under the generic

term “speed test.” Nor has Complainant established bad faith registration or use by Respondent.

Rights and Legitimate Interests: *Policy ¶ 4(a)(ii).*

Complainant has failed to sustain its burden of proving that Respondent has no legitimate interest in the disputed domain name.

The Panel finds that Complainant has not established a *prima facie* case in support of its arguments that Respondent lacks rights and legitimate interests under Policy ¶ 4(a)(ii). *See Terminal Supply, Inc. v. HI-LINE ELECTRIC*, FA 746752 (Nat. Arb. Forum Aug. 24, 2006) (holding that the complainant did not satisfactorily meet its burden and as a result found that the respondent had rights and legitimate interests in the domain name under UDRP ¶ 4(a)(ii)); *see also Workshop Way, Inc. v. Harnage*, FA 739879 (Nat. Arb. Forum Aug. 9, 2006) (finding that the respondent overcame the complainant’s burden by showing it was making a *bona fide* offering of goods or services at the disputed domain name).

The phrase “speed test” is generic for the services offered by both of the parties: testing the speed of Internet connections. The printout of Respondent’s <speedtest.org> web site submitted by Complainant in Complaint Annex Exhibits H and I shows that Respondent’s site contains links to various other web sites associated with speed tests of various internet connections. Complainant’s allegation that none of Respondent’s links from 2004-2006 relate to testing speed is plainly incorrect as shown in Respondent’s Internet Archive evidence in Response Annex V during that period.

The registration of common words as domain names, and the posting of advertising or hyperlinks relevant to that common word, can be a legitimate interest if the advertising and links are clearly and directly related to the common

word. *Advanced Drivers Education Products and Training, Inc. v. MDNH, Inc.* (Marchex), FA 567039 (Nat. Arb. Forum Nov. 10, 2005) (respondent had legitimate interest in <teensmart.com> domain name because site contained paid links of a teen-oriented nature); *Landmark Group v. Digimedia.com, L.P.*, FA 285459 (Nat Arb. Forum August 6, 2004) (respondent had legitimate interest in <landmarks.com> domain name because site contained paid links to “landmark”-related websites).

Respondent argues that it does have rights and legitimate interests in the <speedtesting.org> domain name. Respondent claims that it uses the disputed domain name to display a variety of advertisements that regard Internet speed testing, which is what the disputed domain name claims it is about. Respondent responds to Complainant’s allegations that Respondent solely uses the disputed domain name as a pay-per-click advertisement website, by pointing out that such a use does not automatically indicate that Respondent has no rights or legitimate interests in the disputed domain name. Previous panels have held that a respondent may hold rights and legitimate interests in a disputed domain name that operates as a website filled with pay-per-click (“PPC”) advertisements, and that a respondent may host PPC advertisements when they are in correlation with the title of the disputed domain name. *See McMullen Argus Publ’g Inc. v. Moniker Privacy Servs.*, D2007-0676 (WIPO July 24, 2007) (holding that “pay-per-click websites are not in and of themselves unlawful or illegitimate”); *see also Canned Foods, Inc. v. Ult. Search Inc.*, FA 96320 (Nat. Arb. Forum Feb. 13, 2001) (stating that “Respondent is using the domain <groceryoutlet.com> for a website that links to online resources for groceries and similar goods. The domain is therefore being used to describe the content of the site,” as evidence that the respondent was making a *bona fide* offering of goods or services with the disputed domain name). Accordingly, the Panel finds that the Respondent does have rights and legitimate interests in the disputed domain name under Policy ¶ 4(a)(ii).

Registration and Use in Bad Faith: Policy ¶ 4(a)(iii).

Although the Complaint fails for reasons discussed above, the Panel has also considered Complainant's evidence regarding the Respondent's bad faith.

Since the Panel concludes that Respondent has rights or legitimate interests in the <speedtest.org> domain name pursuant to Policy ¶ 4(a)(ii), the Panel may also find that Respondent did not register or use the disputed domain name in bad faith pursuant to Policy ¶ 4(a)(iii). *See Lockheed Martin Corp. v. Skunkworx Custom Cycle*, D2004-0824 (WIPO Jan. 18, 2005) (finding that the issue of bad faith registration and use was moot once the panel found the respondent had rights or legitimate interests in the disputed domain name); *see also Vanguard Group Inc. v. Investors Fast Track*, FA 863257 (Nat. Arb. Forum Jan. 18, 2007) ("Because Respondent has rights and legitimate interests in the disputed domain name, his registration is not in bad faith.").

Respondent argues that it could not have registered the disputed domain name in bad faith under Policy ¶ 4(a)(iii), because it registered the disputed domain name six years before Complainant registered its own domain name and in fact before it even existed as an entity. Prior Panels have determined that there can be no finding of bad faith where the respondent's registration of a disputed domain name predates the complainant's registration of its own domain name or use of the mark. *See Telecom Italia S.p.A. v. NetGears LLC*, FA 944807 (Nat. Arb. Forum May 16, 2007) (determining the respondent could not have registered or used the disputed domain name in bad faith where the respondent registered the disputed domain name before the complainant began using the mark). Accordingly, the Panel finds here that Respondent's registration of the disputed domain name cannot be in bad faith, considering the fact that Respondent registered the disputed domain name six years before Complainant first used the SPEEDTEST mark, and four years before Complainant even existed as a going

concern. *See Spacesaver Systems, Inc. v. Storage Systems USA*, FA 1577402 (Nat. Arb. Forum Oct. 13, 2014) (“[An] analysis and consideration of the history of the UDRP still clarify two important matters: (1) the drafters of the Policy were fully aware that requiring proof of both bad faith registration and use might result in denying relief under the streamlined dispute resolution process to parties who might in fairness be entitled to it, and (2) they still declined to expand the definition of “abusive registration” to include either bad faith registration or use.”).

Reverse Domain Name Hijacking

Deciding that Complainant has failed to meet its burden in this case does not, however, end the Panel’s inquiry. Under the Rules, the Panel must also consider whether Complainant is guilty of Reverse Domain Name Hijacking (“RDNH”). Respondent here has requested such a finding, and even in the absence of such a request or of a response, the Rules specifically put the burden on the Panel to determine whether a complainant has tried to use “the Policy in bad faith to attempt to deprive a registered domain name holder of a domain name.” Rules, paragraph 1 and 15(e).

Complainant’s effort to obtain transfer of the disputed domain name on the basis of alleged cybersquatting of a generic word may in itself be indicative of RDNH. Even worse, Complainant did not disclose in the text of its Complaint the material fact that Complainant’s registration was on the supplemental register and it was forced to amend its application to new services when its original application for browser speed testing software services was refused as generic in the supplemental trademark registration upon which the Complainant relies. *Cf. Goway Travel Limited v. Tourism Australia*, D2006-0344 (WIPO June 6, 2006) (Complainant’s failure to disclose being forced to disclaim exclusive rights in portion of mark for relied-upon trademark registrations supports RDNH).

“[A] finding of [RDNH] is warranted if the Complainant knew or should have known at the time it filed the Complaint that it could not prove one of the essential elements required by the Policy. [. . .] [S]uch a finding is particularly appropriate where the Respondent’s registration of the domain name predates the very creation of the Complainant’s trademark.” *carsales.com.au Limited v. Alton L. Flanders*, D2004-0047 (WIPO April 8, 2004) (citing *Futureworld Consultancy (Pty) Limited v. Online advice*, D2003-0297 (WIPO July 18, 2003)). Ordinarily if the face of the complaint itself demonstrates a settled reason why the complaint must be denied, a panel may make a finding of RDNH. *See Liquid Nutrition Inc. v. liquidnutrition.com/Vertical Axis Inc.*, D2007-1598 (WIPO January 28, 2008) (finding RDNH where the Claimant alleged its first use of the mark was four years after the domain name had been registered). However, a finding of RDNH is always within the panel’s discretion. *See Rudy Rojas v. Gary Davis*, D2004-1081 (WIPO April 18, 2005) (finding that the facts justified RDNH but panel determined “to leave the parties as it found them” because both parties made misrepresentations to the panel).

Respondent contends that Complainant knew of Respondent’s rights in the disputed domain name, because Respondent registered the disputed domain name six years before Complainant first used its alleged mark and four years before Complainant’s LLC was formed. Additionally, Respondent argues that Complainant misled the Panel about Complainant’s trademark registrations, in that Complainant only had rights with the Supplemental Register and not the Principal Register. Lastly, Respondent claims that Complainant lied about the terms and existence of a licensure agreement that was allegedly made between the parties. Taken together, these facts are sufficient to show that the Complaint was filed in a bad faith attempt to deprive the Respondent of a domain name to which it is entitled. *Rodale, Inc. v. Cambridge*, DBIZ2002-00153 (WIPO June 28,

2002). The Panel finds Complainant to have been guilty of Reverse Domain Name Hijacking.

DECISION

Having determined that Complainant failed to establish all three elements required under the ICANN Policy, the Panel concludes that relief must be **DENIED**.

Accordingly, it is Ordered that the <speedtest.org> domain name **REMAIN WITH** Respondent.



Scott R. Austin, Esq.
Neutral

Scott R. Austin, Esq., Chair of the Panel

Paul M. DeCicco, Esq., Co-Panelist

Fernando Triana, Esq., as Co-Panelist

Dated: January 7, 2015