



DECISION

Twin Lakes Telephone Cooperative Corporation v. DNS ADMIN / BEST WEB LIMITED

Claim Number: FA1704001725012

PARTIES

Complainant is **Twin Lakes Telephone Cooperative Corporation** (“Complainant”), represented by **Jonathan L West** of **Twin Lakes Telephone Cooperative Corporation**, Tennessee, USA. Respondent is **DNS ADMIN / BEST WEB LIMITED** (“Respondent”), represented by **Zak Muscovitch** of **Muscovitch Law P.C.**, Canada.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<twinlakes.com>**, registered with **Uniregistrar Corp.**

PANEL

The undersigned certifies that they have acted independently and impartially and to the best of their knowledge have no known conflict in serving as Panelists in this proceeding.

The Honorable Carolyn Marks Johnson, The Honorable Neil Brown, Q.C., and The Honorable John J. Upchurch comprise the Panel.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on April 3, 2017; the FORUM received payment on April 3, 2017.

On April 4, 2017, Uniregistrar Corp confirmed by e-mail to the FORUM that the <twinlakes.com> domain name is registered with Uniregistrar Corp and that Respondent is the current registrant of the name. Uniregistrar Corp has verified that Respondent is bound by the Uniregistrar Corp 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 April 7, 2017, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of May 1, 2017 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@twinlakes.com. Also on April 7, 2017, 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 Response was received on May 1, 2017. While the deadline for filing a response was April 27, 2017, FORUM does not consider the Response to be in compliance with ICANN Rule 5. However, the Panel, at its discretion, has chosen to accept and consider this Response. *See Victoria's Secret Stores Brand Mgmt., Inc. v. LaFond*, FA 1362225 (FORUM Jan. 7, 2011) (deciding that while the response was deficient, "the Panel has nonetheless decided to consider the deficient Response.").

On May 11, 2017, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the FORUM appointed The Honorable Carolyn Marks Johnson, The Honorable Neil Brown, Q.C., and The Honorable John J. Upchurch as Panelists.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the 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.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

1. Complainant, Twin Lakes Telephone Cooperative Corporation, is a telecommunication service provider based in Gainesboro, Tennessee. In connection with this business, Complainant uses the TWIN LAKES COMMUNICATIONS and TWIN LAKES marks to promote its goods and services. Complainant has rights in the marks based upon registration with the United States Patent and Trademark Office ("USPTO") (*e.g.*, TWIN LAKES COMMUNICATIONS—Reg. No. 3,855,097, registered Sept. 28, 2010; TWIN LAKES—Ser. No. 87,095,609, filed July 7, 2016). *See* Compl., at Attached Annex 1a–1c. Respondent's domain name, <twinlakes.com> (registered Nov. 16, 1996), is identical or confusingly similar to Complainant's mark as it contains the mark in its entirety less the space as it relates to the TWIN LAKES mark, or both the space and the term "communications" with regard to the TWIN LAKES COMMUNICATIONS mark, and the gTLD ".com."
2. Respondent lacks rights and legitimate interests in the domain name. Respondent is not commonly known by the disputed domain name, nor

has Complainant authorized Respondent to register a domain name containing its mark. Respondent has failed to use the website in connection with a *bona fide* offering of goods or services or for a legitimate noncommercial or otherwise fair use. Instead, the domain name resolves to a page containing pay-per-click advertising for Respondent's commercial gain.

3. Respondent registered and used **<twinlakes.com>** in bad faith. Respondent offered to sell the domain name for \$50,000, an amount in excess of the typical out-of-pocket costs for domain name registration and maintenance and a magnitude greater than the \$10,000 offered by Complainant.

B. Respondent

1. Complainant has registered the TWIN LAKES COMMUNICATIONS mark with the USPTO, while the TWIN LAKES mark application is currently pending. *See* Compl., at Attached Annex 1a–1c. Therefore, Complainant can only rely on the TWIN LAKES COMMUNICATIONS mark in this proceeding. Complainant has no common law rights in the TWIN LAKES mark as it has imparted no secondary meaning into it.
2. Respondent has rights and legitimate interests in the disputed domain name. Respondent's business of investing in descriptive terms to create and supply domain names imparts a legitimate interest in the disputed domain name.
3. Respondent's use of the domain name is not in bad faith, as Complainant's asserted mark did not exist at the time of Respondent's registration of the domain name. Respondent's registration of **<twinlakes.com>** pre-dates Complainant's filing and registration for the TWIN LAKES COMMUNICATIONS mark.

FINDINGS

For the reasons set forth below, the Panel finds for Respondent, and that Complainant's request for relief should be denied. Further, the Panel determines that Respondent has failed to assert sufficient evidence to support a finding of Reverse Domain Name Hijacking.

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

The Panel finds the subject domain name <twinlakes.com> is not identical or confusingly similar to Complainant's trademark, TWIN LAKES COMMUNICATIONS. Each party has made legitimate use of their respective marks, and each is different. Complainant's mark includes the generic addition "communications" which tells what it does. Respondent's mark is a pure geographic designation described in the mark. One who encounters the domain name <twinlakes.com> would not think it invokes TWIN LAKES COMMUNICATIONS absent use of the term "communications". Accordingly, the

Panel concludes that Complainant failed to establish that <twinlakes.com> is identical or confusingly similar to Complainant's mark.

Rights or Legitimate Interests

Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶ 4(a)(ii), and then the burden shifts to Respondent to show it does have rights or legitimate interests. *See Hanna-Barbera Prods., Inc. v. Entm't Commentaries*, FA 741828 (FORUM Aug. 18, 2006) (holding that the complainant must first make a *prima facie* case that the respondent lacks rights and legitimate interests in the disputed domain name under UDRP ¶ 4(a)(ii) before the burden shifts to the respondent to show that it does have rights or legitimate interests in a domain name); *see also AOL LLC v. Gerberg*, FA 780200 (FORUM Sept. 25, 2006) ("Complainant must first make a *prima facie* showing that Respondent does not have rights or legitimate interest in the subject domain names, which burden is light. If Complainant satisfies its burden, then the burden shifts to Respondent to show that it does have rights or legitimate interests in the subject domain names.").

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). Respondent has demonstrated it has used <twinlakes.com> in connection with a *bona fide* offering of goods or services or for a legitimate noncommercial or otherwise fair use. Respondent is in the business of investing in geographically descriptive domain names. Registration of a geographically descriptive domain name as a method of business does not evince a finding of a lack of rights and legitimate interests. *See Allocation Network GmbH v. Gregory*, D2000-0016 (WIPO Mar. 24, 2000) (holding that under appropriate circumstances the offering for sale of a domain name can itself constitute a *bona fide* offering of goods or services for purposes of paragraph

4(c)(i) of the ICANN policy); *see also Alphalogix Inc. v. DNS Servs.*, FA 491557 (FORUM. Jul. 26, 2005) (“Respondent is in the business of creating and supplying names for new entities, including acquiring expired domain names. This is a legitimate activity in which there are numerous suppliers in the United States.”).

Registration and Use in Bad Faith

The only trademark Complainant can legitimately rely on is Reg. No. 3,855,097 for TWIN LAKES COMMUNICATIONS. It was registered on September 28, 2010, which was after the subject domain name was registered, which was on December 28, 2005. It was also applied for, and has a first use date, after the domain name <twinlakes.com> was registered.

Registration of a disputed domain name that predates registration and use of a mark does not constitute bad faith per Policy ¶ 4(a)(iii). *See Ode v. Intership Ltd.*, D2001-0074 (WIPO May 1, 2001) (“[W]e are of the unanimous view that the trademark must predate the domain name.”); *see also Telecom Italia S.p.A. v. NetGears LLC*, FA 944807 (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). Respondent’s <twinlakes.com> domain name registration predates Complainant’s trademark registration, therefore preventing any finding of bad faith registration and use by Respondent per Policy ¶ 4(a)(iii).

Further, the Panel finds the subject domain name is a generic expression as well as a geographic one. Respondent has never identified Complainant or tried to do it any harm. There is no evidence of Respondent having targeted Complainant, or of even being aware of Complainant.

Also, Respondent did not directly attempt to sell the domain name <twinlakes.com> specifically to Complainant. Respondent's explanation, that the price increased as an ordinary business practice, seems plausible.

Moreover, the 12 year delay between Respondent's registration of the domain name and the bringing of this action presents equitable grounds for invoking estoppel as a potential defense to this untimely Complaint. The passage of time draws into serious question Complainant's assertion of Bad Faith.

REVERSE NAME HIJACKING

Even though the Panel finds that Complainant has failed to satisfy its burden under the Policy, this does not necessarily render a finding of reverse domain name hijacking on behalf of Complainant in bringing the instant claim. *See ECG European City Guide v. Woodell*, FA 183897 (FORUM Oct. 14, 2003) ("Although the Panel has found that Complainant failed to satisfy its burden under the Policy, the Panel cannot conclude on that basis alone, that Complainant acted in bad faith."); *see also Church in Houston v. Moran*, D2001-0683 (WIPO Aug. 2, 2001) (noting that a finding of reverse domain name hijacking requires bad faith on the complainant's part, which was not proven because the complainant did not know and should not have known that one of the three elements in Policy ¶ 4(a) was absent).

We decide this issue on the sole test of whether Complainant was motivated primarily by a desire to harass Respondent and to act in bad faith towards it. We consider it more likely that it was pursuing what it decided, perhaps misguidedly, was the best way to defend its trademark. Accordingly, the Panel declines Respondent's request to find Reverse Domain Name Hijacking.

DECISION

Having failed to establish any of the elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.

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



Honorable John J. Upchurch
Arbitrator

Panelists: John J. Upchurch, Chair,
Hon. Carolyn Marks Johnson and
Hon. Neil Brown, Q.C.

Dated: May 23, 2017