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UDRP complaint for 'ecourier.com' fails to deliver

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- The complainant, the owner of registered trademarks comprising the term 'e-courier', sought the transfer of 'ecourier.com' under the UDRP
- As the domain name was registered at least six years prior to the complainant's incorporation, the registration could not have been made in an attempt to target its trademarks
- The intentional omission of relevant evidence by the complainant could justify a finding of RDNH

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has denied a UDRP complaint for the domain name 'ecourier.com', entering a finding of reverse domain name hijacking (RDNH).

Background

The complainant, Soft Trust Inc, was a Canadian company incorporated in 2004, and provided services related to the transfer of electronic communications (including electronic messages and files), as well as services related to remote access and sharing of electronic information. The complainant had registered trademarks comprising the term 'e-courier', including the Canadian trademark E COURIER (and design), registered on 25 January 2008, and the US trademark E-COURIER.CA, registered on 9 December 2014. The complainant had also been the registrant of the domain name 'e-courier.ca' since 17 May 2005.

The domain name 'ecourier.com' was first registered on 3 December 1997 by the respondent, Todd Hinton. The respondent incorporated the respondent company, Ikebana America LLC, on 11 May 2004. At the time of the decision, the disputed domain name resolved to a webpage stating "Sorry! This site is temporarily unavailable." In the period between 2007 to 2011, a representative of the complainant contacted the respondent three times, offering to purchase the domain name. The respondent declined to sell the domain name on all three occasions.

The complainant asserted that the domain name was confusingly similar to its E COURIER and E-COURIER.CA trademarks, and submitted that the respondent had no rights or legitimate interests in the domain name. The complainant claimed that:

- the message on the webpage to which the domain name resolved was misleading and contradicted the longstanding passive holding of the domain name by the respondent; and
- the respondent's passive holding of the domain name was seemingly to block the use of the domain name by an owner of associated trademark rights.

With regard to bad faith, the complainant stated that it was unsure as to the exact date that the respondent registered the domain name, but that it had taken place at some point between 14 September 2005 and 17 December 2015, after the date that the complainant had accrued rights in E-COURIER. The complainant further asserted that the respondent had a history of acquiring and stockpiling domain names that appeared to be unrelated to any commercial or other activities of the respondent. The complainant claimed that a number of these domain names were the same or similar to trademarks that had been registered in the United States, or whose registration was still pending. The complainant asserted that the respondent had been aware of the complainant and its rights in E-COURIER since at least 2012. The complainant argued that the respondent was using the reputation of the complainant's trademarks to attract internet users to the domain name and thereby increase its value in the eyes of potential purchasers.

The respondent claimed to have registered the domain name on 3 December 1997, and noted that despite having changed registrars several times, the respondent had personally been listed as the registrant of the domain name since its initial registration. The respondent asserted that he had registered hundreds of domain names, and that all of his domain names had been registered in good faith with the future expectation of developing them and that they were not held with malicious intent. The respondent conceded that the disputed domain name was confusingly similar to the complainant's trademarks. The respondent asserted that he had made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services, including by filing a trademark application in the United States for ECOURIER.COM in 2001, which was subsequently abandoned. The respondent explained that he had been employed by FedEx since 1997, which had inspired him to register the domain name, which in his mind was composed of a generic term connoting electronic courier, or an online delivery person. The respondent submitted that the non-use of the domain name did not demonstrate bad faith, and sought a finding of RDNH.

To be successful under the UDRP, a complainant must satisfy the requirements of Paragraph 4(a) of the UDRP:

- the disputed domain name is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;

- the respondent has no rights or legitimate interests in the disputed domain name; and
- the disputed domain name was registered and is being used in bad faith.

Decision

Paragraph 4(a)(i)

The panel found that the domain name was confusingly similar to the textual elements of the complainant's E-COURIER and E-COURIER.CA trademarks.

Paragraph 4(a)(ii)

The panel found that there was no evidence that the respondent had registered the domain name to trade off the complainant's rights. In fact, the panel noted that the respondent registered the disputed domain name in 1997, well before the complainant had come into existence. The panel found that it appeared that the respondent genuinely planned to use the domain name for a business related to the industry in which he was employed, as evidenced by his trademark application for ECOURIER.COM, and that the respondent had since used the domain name for email purposes. Further considering that the respondent had refused all offers to purchase the domain name, the panel found that the respondent had established rights or legitimate interests in the domain name.

Paragraph 4(a)(iii)

The panel found that the domain name was registered at least six years prior to the complainant's incorporation. Accordingly, it was not possible that the registration of the domain name could have been made in an attempt to target the complainant's trademarks. The complainant had therefore failed to prove registration in bad faith. The panel further found that the respondent's passive holding of the disputed domain name did not amount to bad faith. The complainant had not provided sufficient evidence to demonstrate that its trademarks were widely known; the respondent had provided evidence of actual or contemplated good-faith use of the domain name; and there was no evidence of the respondent's provision of false or misleading WHOIS information. The panel added that there was no other evidence to support the claim that the respondent had engaged in a pattern of registering domain names to target trademarks held by the complainant or any third parties.

RDNH

In entering a finding of RDNH, the panel stressed that the complainant should have been aware that the respondent, Todd Hinton, and his company, Ikebana America LLC, were connected at the time that the complainant submitted the complaint. Indeed, there were several factors that supported such a conclusion that were submitted by the complainant in evidence, and yet the complainant persisted with the complaint when it was evident that the domain name had been under the control of the respondent since 1997. The panel also cited the complainant's claim of having contacted the respondent in 2012, and noted that the complainant had omitted copies of its correspondence with the respondent in 2008 from the complaint. The panel considered the complainant's explanation of its history with the respondent to be incomplete, and that the intentional omission of relevant evidence could justify a finding of RDNH. Finally, the panel noted that the complainant's allegation that the respondent had registered the domain name to sell it at a profit had no evidentiary support. Rather, the respondent had never invited offers to purchase the disputed domain name, and had consistently rejected such repeat offers from the complainant.

Comment

This case highlights two important factors for prospective UDRP filers.

First, while mere delay between the registration of a domain name and the filing of a UDRP complaint does not create any bar to filing, when preparing a UDRP complaint for an 'older' domain name registration, complainants need to carefully consider whether there is an unbroken chain of registration between the creation of the disputed domain name and the current registration. If it comes to light from readily-available information, despite updates to the WHOIS information, that the original registrant is substantively the same as the current registrant, the question of bad-faith registration will be assessed at the time that the domain name was first registered. In cases where the creation of the domain name predates the accrual of trademark rights, it is typically simply not possible to prove bad-faith registration of a domain name.

Secondly, similar to the way in which it is incumbent on parties to litigation to disclose all documents that are relevant to issues that are in dispute to the other party, UDRP complainants are required to provide a complete and accurate record of material evidence, which may include pre-complaint correspondence. Failure to do so may be interpreted as an attempt to mislead the panel, potentially exposing the complainant to a finding of RDNH.

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TAGS

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