

ADMINISTRATIVE PANEL DECISION

ELK Accesories Pty Ltd. v. Parnaz Farahani / Elk.com

Case No. D2012-0455

1. The Parties

The Complainant is ELK Accesories Pty Ltd. of Preston, Australia represented by Pointon Partners, Australia.

The Respondent is Elk.com of Northridge, California, United States of America (“U.S.”) represented by John Berryhill, Ph.d. Esq., U.S.

2. The Domain Name and Registrar

The disputed domain name <elk.com> (the “Disputed Domain Name”) 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 March 7, 2012. On March 7, 2012, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 8, 2012, 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 9, 2012 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 14, 2012.

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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced March 16, 2012. In accordance with the Rules, paragraph 5(a), the due date for Response April 5, 2012. The Response was filed with the Center March 28, 2012.

The Center appointed Nicholas Weston, Debrett G. Lyons and The Hon Neil Brown Q.C. as panelists in this

matter on May 4, 2012. 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 operates a fashion business through a single director company with a showroom in suburban Melbourne, Australia and distributes product through third party owned boutiques and wholesalers in Australia as well as a small number of other countries under the brand ELK. The Complainant is the owner of three trademarks that include the word ELK, in respect of jewelry leathersgoods, textiles, furnishings, homewears and accessories the first of which dates from July 2, 2008 including the following:

Serial No.	Trademark	Country	Reg. No.	Class	Registration Date
1	ELK (Stylized + Device)	Australia	1356304	14	April 15, 2010
2	ELK ELK ACCESSORIES	Australia	1249369	14, 18, 24, 25, 35	July 2, 2008
3	ELK ELK ACCESSORIES	UK	M1056795	14	September 14, 2010

The Complainant owns one domain name incorporating the word ELK, <elkaccessories.com.au> and operates a website relating to its products at that domain name.

The Disputed Domain Name <elk.com> was registered on June 28, 1995 and acquired by the Respondent in August 2009.

The Respondent uses the Disputed Domain Name for click-through or pay-per-click (“PPC”) landing pages. PPC advertisements display a link when a keyword query with a search engine matches an advertiser’s keyword list. PPC advertising is a search engine marketing technique for directing traffic to a landing page containing sponsored links or sponsored advertisements. In this case, when the Disputed Domain Name <elk.com> is typed in, it redirects traffic to a PPC landing page containing links for elks, elk hunting, hunting outfitters and hunting travel, with specific references to Rock Mountain Elk, Hunt elk, Mule Deer Hunting, Hunting in Texas, Guided Elk Hunting, Bear Hunting, Outfitters and Hunting Video, sponsored links for Australian Animals, Fishing Gear Online, Barramundi Fishing Lodge, Top Left Hand Bow Archery, Trophy Shop and others and, more randomly, for cars, tennis courts, computer related services, online dating and other links with no readily apparent common theme. The main thrust of the commercial content on the website is clearly material that relates to elks, wild animals, hunting and kindred subjects all of which are within a broad description of the subject of the domain name, namely the elk. There are no references to fashion accessories, the field of business of the Complainant.

5. Parties’ Contentions

A. Complainant

The Complainant cites its registration of the device trademark ELK in Australia, and registrations of the trademark ELK ELK ACCESSORIES in Australia and the United Kingdom of Great Britain and Northern Ireland (“U.K.”) as *prima facie* evidence of ownership. The Complainant also claims common law trademark rights in the word “Elk” through “extensive use”.

The Complainant submits that the Disputed Domain Name is “identical” or “substantially similar” to its trademark, because the Disputed Domain Name comprises a word that is identical to the trademark ELK and that the similarity is not removed by the addition of “the general country code such as .com.au” (citing *BT*

Financial Group Pty Limited v. Basketball Times Pty Ltd, WIPO Case No. DAU2004-0001).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because the Respondent has no trademark rights in or license to use the Complainant's trademarks and is not commonly known by that name. The Complainant also contends that "there has been no indication that the Respondent intends on using the (Disputed) Domain Name for either commercial or non-commercial purposes".

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, pursuant to the Policy, paragraphs 4(a)(iii) and 4(b) and the Rules, paragraph 3(b)(ix)(3). On the issue of registration, the Complainant contends that the Disputed Domain Name was registered in a deliberate attempt to "take advantage of a popular and commonly used acronym or phrase Domain Name which could be used by other entities with a real connection to the acronym or phrase" and that by doing so "the Respondent has registered the (Disputed) Domain Name for the purpose of disrupting the business and activities of those persons/business proposing to use the word "Elk" and in particular the Complainant's business and activities" presumably in contravention of paragraph 4(b)(iv) of the Policy. On the issue of use, the Complainant contends that the Respondent "does not operate a website at the (Disputed) Domain Name" and "that the Respondent has not used the (Disputed) Domain Name as an operating website since the date of registration".

B. Respondent

In defense of its registration of the Disputed Domain Name, the Respondent's arguments are set out in the Response received by email to the Center on March 28, 2012. These are set out in summary below.

On the issue of confusing similarity to a trademark in which the Complainant has rights, the Respondent contends that:

- (i) the Complainant has not provided any evidence of a common law reputation in the name "Elk" as alleged by the Complainant and, as such, submits that the alleged reputation has not been made out.
- (ii) the Complainant misrepresents its Australian registered trademark No. 1249369 as a "word" mark whereas it is, in fact, a stylized or fancy mark with a constituent component comprising artwork of an Elk and therefore the Complainant has not demonstrated ownership of a trade or service mark in the word "Elk" *per se*, but has shown two trademark registrations of a stylized representation of the words "Elk Elk Accessories" and a lower case rendering of "elk" adjacent to a drawing of one, respectively.
- (iii) the Complainant's name is a business or trade name rather than a trade or service mark as alleged by the Complainant and, as such, the dispute resolution procedure under the Policy is inapplicable (citing *Ahmanson Land Company v. Vince Curtis*, WIPO Case No. D2000-0859).
- (iv) Consumers are not likely to be confused because the Disputed Domain Name comprises the word "Elk" and the trademarks of the Complainant do not grant exclusive rights to that word having regard to other registered trademarks on the Australian Trade Marks Register, including:

AU 851486 for "VISUAL ELK" to The Great Elk Company Inc
AU 1071242 for "ELK BRAND" to Austpaper Pty Ltd
AU 1337756 for "WHITE ELK" to Aristocrat Technologies Australia Pty Ltd
AU 1427879 for "TWO ELK" to Axlund & Goldstein Pty Ltd

- (v) even if the Panel were to find confusing similarity, any interest the Complainant acquired in the trademark ELK, which is denied by the Respondent, must have been after it incorporated in 2008 which is 13 years after the Respondent registered the Disputed Domain Name in 1995 and 15 years after the Complainant's trademark registrations issued in 2010.

On the issue of rights and legitimate interests, the Respondent contends that:

- (i) the Respondent started an e-commerce business in March 2009 as a sole proprietorship and was later in a partnership pursuant to an undated service contract (Exhibit D) to build an e-commerce website.
- (ii) the Respondent has a legitimate interest in the Disputed Domain Name because it has used, or made demonstrable preparations to use, the Disputed Domain Name since 2009 for *bona fide* offerings of goods or services. The Respondent submits that the use in this case was as a retail e-commerce website “having nothing to do with the Complainant’s trade”. However, as the Respondent’s business lost money, the use of the disputed domain name was changed so that it then resolved to a PPC parking page “generating revenue on the basis of the dictionary meaning of the word ‘elk’ while a buyer was sought to recoup the investment and losses.”
- (iii) use of the Disputed Domain Name for a PPC landing page is sufficient to grant a legitimate interest as the Respondent has a right to use “a dictionary word domain name in association with advertising content pertaining to the meaning of the dictionary word at issue”, citing advertising categories shown in Complainant’s Annex 4 depicting content from the Respondent’s PPC webpage that “overwhelmingly relate to hunting, fishing and topics clearly relating to the dictionary meaning of the word ‘elk’.”
- (v) the Respondent has made sufficient use of the Disputed Domain Name to grant a legitimate interest.

The Respondent also denies that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, pursuant to paragraph 4(a)(iii) or 4(b) of the Policy. On the issue of bad faith registration, the Respondent contends that the Disputed Domain Name was purchased in 2009 prior to the registration of the Complainant’s trademarks and that “the Respondent’s registration and use of the domain name has in no way been shown to be exploitive of a storefront shop in suburban Melbourne, Australia”. The Respondent submits that the Complainant’s allegation that the Disputed Domain name is “a popular and commonly used acronym or phrase” is “in fact a defense to an allegation of bad faith” (citing *CNR Music B.V. v. High Performance Networks, Inc.*, WIPO Case No. D2005-1116).

The Respondent rejects the Complainant’s submission seeking transfer of the Disputed Domain Name based on claimed superior rights and states that “the Policy does not concern itself with ‘better rights’ but with the complete absence of rights in a maliciously registered domain name” (citing: *Credit Europe Bank N.V. v. Peter Yu*, WIPO Case No. D2010-0737).

Finally, the Respondent contends that the Complaint is brought in bad faith, in an attempt to “pirate the domain name” by reverse domain name hijacking, as contemplated by paragraph 15(e) of the Rules and as evidenced by the Complainant’s incorrect belief that the Disputed Domain Name was registered by the Respondent for thirteen years prior to the Complainant’s existence (citing: *Prime Pictures LLC v. DigiMedia.com L.P.*, WIPO Case No. D2010-1877).

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant has the burden of proving the following:

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

Paragraph 15(a) of the Rules requires the 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”.

A. Identical or Confusingly Similar

The Complainant argues three bases for a finding that it owns trademark rights in the ELK mark: some trademarks registrations, alleged common law usage since 2008, and some applications to register the mark in the USPTO. Against this, the Respondent argues that the Complainant's name is a business or trade name rather than a trade or service mark as alleged by the Complainant and, as such, the dispute resolution procedure under the Policy is inapplicable (citing *Ahmanson Land Company v. Vince Curtis*, WIPO Case No. D2000-0859). The Respondent further argues that the Complainant misrepresents trademark registered no. 1249369 as a “word” mark whereas it is, in fact, a stylized or fancy mark with a constituent component comprising artwork of an Elk and therefore the Complainant has not demonstrated ownership of a trade or service mark in the word “Elk” *per se*, but has shown two trademark registrations of a stylized representation of the words “Elk Elk Accessories” and a lower case rendering of “elk” adjacent to a drawing of one, respectively.

The Panel finds, first, that the Complainant has rights in “a trademark or service mark” within the meaning of paragraph 4(a)(i) of the Policy. The Complainant has produced evidence, which the Panel accepts, to demonstrate that it has registered trademark rights in the mark ELK in Australia based on trademark Registration Number 1356304 registered on the Australian register on April 15, 2010. It is true, as the Respondent submits, that this trademark contains some graphical features. However, it is well established that the similarity between a trademark and a disputed domain name is not eliminated by the mere fact that the trademark includes additional graphical elements (see *Sweeps Vacuum & Repair Center, Inc. v. Nett Corp.*, WIPO Case No. D2001-0031; *EFG Bank European Financial Group SA v. Jacob Foundation*, WIPO Case No. D2000-0036; *Delikommat Betriebsverpflegung Gesellschaft m.b.H. v. Alexander Lehner*, WIPO Case No. D2001-1447; *Sydney Markets Limited v. Nick Rakis trading as Shell Information Systems*, WIPO Case No. D2001-0932). Moreover, despite its graphical content, the dominant feature of the trademark in question is the word “elk”.

The Panel notes that the trademark was not registered until April 15, 2010 but that the Disputed Domain Name had been registered 15 years before that date, on June 28, 1995 and, indeed, that it was registered 13 years before the Complainant was incorporated in 2008. However, for the purpose of establishing trademark rights under paragraph 4(a)(i) of the Policy, it is not necessary that the trademark rights should pre-date the Disputed Domain Name (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (“WIPO Overview 2.0”), paragraph 1.4).

Further, it is also well established that, for the purposes of the Policy, the trademark may be registered in any country: (see *Thaigem Global Marketing Limited v. Sanchai Aree*, WIPO Case No. D2002-0358).

The Panel therefore finds that the Complainant has rights in the Registered Australian trademark No. 1356304 of April 15, 2010.

As the Complainant has thus established rights in the registered trademark referred to, it is not necessary for the Panel to decide if it also has rights in the other two registered trademarks relied on.

It is necessary, however, for the Panel to give consideration to whether the Complainant has common law rights in ELK. That is so because, although the time when a Complainant acquires its trademark rights may not be significant for the purposes of paragraph 4(a)(i) of the Policy, it may well be important during a consideration of paragraphs 4(a)(ii) and (iii) of the Policy. It is therefore necessary to consider whether the Complainant has common law trademark rights and, if so, whether they date back to a time when the Disputed Domain Name was registered.

The Panel finds that the Complainant has not established that it has common law trademark rights to the word "Elk". The Complainant has submitted no evidence to show that it might have common law trademark rights. It offers only bald assertions concerning the recognition of the word "Elk" as a trademark and no evidence of the extent of any advertising, sales or other indicia of secondary meaning that might have occurred or any evidence that it has been known in the trade or publicly as the source of any specific goods or services. UDRP panels have said on many occasions that allegations made in these proceedings must be supported by evidence and, indeed, the Policy makes it plain enough itself in paragraph 4(a) that "...the complainant must prove that each of these three elements are present." Accordingly, this Panel finds the Complainant has for the purposes of the Policy, on the minimal record submitted in this proceeding, failed to submit sufficient evidence to this Panel to carry its burden of proving that it enjoys common law rights in the word "Elk". Moreover, it is telling that the Complainant was unable to persuade the United States Patent and Trademark Office to register its mark on the Principal Register and that it has failed to note in the Complaint that its U.S. Application No. 79/089,388 was refused and abandoned, despite the fact that the Complaint in the present proceeding is certified to be "complete". (see Respondent's Exhibit B).

The next question that arises is whether the Disputed Domain Name is identical or confusingly similar to the ELK trademark. In that regard, the Panel observes that the Disputed Domain Name comprises (a) an exact reproduction of the Complainant's trademark ELK; and (b) the top level domain suffix ".com", all in one continuous domain name.

It is well-established that for the purposes of making the comparison between the Disputed Domain Name and the trademark, the top-level designation used as part of a domain name should be disregarded: (see *Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525; *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. D2000-0429; *Phenomedia AG v. Meta Verzeichnis Com*, WIPO Case No. D2001-0374). The relevant comparison to be made in the present case is therefore between the second-level portion of the Disputed Domain Name, namely "elk" and the trademark which in substance is the word ELK together with a graphic outline of an elk and the question to be resolved is whether the former is identical or confusingly similar to the latter.

Opinions have differed on how such a comparison is to be made. That issue was discussed in *Deutsche Post AG v. NJDomains*, WIPO Case No. D2006-0001 where the panel said:

"It is true that some UDRP panelists have taken the view that in making the comparison presently under discussion, devices and similar figurative depictions should be ignored so that a straight comparison can be made between the words. Thus, the panelist in *Sweeps Vacuums & Repair Ctr. v. Nett Corp.*, WIPO Case No. D2001-0031 said that 'graphic elements . . . not being reproducible in a domain name, need not be considered when assessing identity or confusing similarity.' On the other hand, the panelist in *Curvon Corp. v. Lauren Kallareou*, WIPO Case No. D2001-0565, said that 'The Mark . . . is the whole of the composite of design matter and word matter [that] is shown in the registration document,' which is the same view taken by other panelists.

The better view, however, is to look at the overall impression or idea created respectively by the mark and the domain name, the approach that was taken recently in *Yell Ltd. v. Ultimate Search*, WIPO Case No. D2005-0091. Applying that test, the overall impression of the trademark in the present case is entirely different from that conveyed by the domain name. The pictorial representation of the horn is such a prominent and dominating part of the trademark that the result is a logo of the horn as well as the word 'Post'. It is highly artificial to contend that this is a trademark for the word 'Post' when it clearly is far more than that."

In the present case, however, the overall impression of the trademark is the word "elk" and of course the Disputed Domain Name consists entirely of that word. The Panel therefore concludes that the Disputed Domain Name is identical to the trademark.

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

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists some of the ways in which a respondent may demonstrate rights or a legitimate interest in the disputed domain name:

- (i) before any notice of the dispute, respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent (as an individual, business or other organization) has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

However, it should also be noted that, by virtue of paragraph 4(c) of the Policy itself, these criteria are non-exclusive and that a respondent may rely on any other consideration to show that it has a right or legitimate interest in the disputed domain name.

Having regard to all of the submissions and the evidence, the Panel finds, for the following reasons, that the Respondent has shown that it has a right or legitimate interest in the disputed domain name.

The Policy places the burden on the Complainant to establish the absence of the Respondent's rights or legitimate interest in the Disputed Domain Name. Because of the inherent difficulties in proving a negative, the consensus view is that the Complainant need only put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. The evidential burden then shifts to the Respondent to rebut that *prima facie* case (see *World Wrestling Federation Entertainment, Inc v. Ringside Collectibles*, WIPO Case No. D2000-1306; WIPO Overview 2.0, paragraph 2.1).

It is well established that a respondent may well have a right to register and use a domain name to attract Internet traffic based solely on the appeal of a commonly used descriptive phrase, even where the domain name is confusingly similar to the registered mark of a complainant (see *National Trust for Historic Preservation v. Barry Preston*, WIPO Case No. D2005-0424; *Private Media Group, Inc., Cinecraft Ltd. v. DHL Virtual Networks Inc.*, WIPO Case No. D2004-0843; *T. Rowe Price Associates, Inc. v. J A Rich*, WIPO Case No. D2001-1044; *Sweeps Vacuum & Repair Center, Inc. v. Nett Corp.*, WIPO Case No. D2001-0031; *EAUTO, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc.*, WIPO Case No. D2000-0047). However, this business model is generally recognized under the Policy as legitimate only if the domain name was registered because of its attraction as a descriptive phrase comprising dictionary words and not because of its value as a trademark and if the website to which the domain name resolves is then used to post links that are relevant only to the common meaning of the phrase comprising dictionary words. (see: *National Trust for Historic Preservation v. Barry Preston*, WIPO Case No. D2005-0424; *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. D2006-0340; WIPO Overview 2.0, paragraph 2.2).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because the Complainant has not licensed, permitted or authorized the Respondent to use the Complainant's trademark. The Complainant further contends that "there has been no indication that the Respondent intends on using the (Disputed) Domain Name for either commercial or non-commercial purposes". However, the Complainant provided evidence (Annexure 4) that typing in the Disputed Domain Name on February 21, 2012 diverted traffic to a webpage containing advertisements and a number of links for, amongst other things, elk hunting and hunting outfitters and hunting travel, with specific references to Rock Mountain Elk, Hunt elk, Mule Deer Hunting, Hunting in Texas, Guided Elk Hunting, Bear Hunting, Outfitters and Hunting Video, sponsored links for Australian Animals, Fishing Gear Online, Barramundi Fishing Lodge, Top Left Hand Bow Archery, Trophy Shop and others and, more randomly, for cars, tennis courts, computer related services, online dating and other links with no readily apparent common theme.

The main thrust of the commercial content on the website is clearly material that relates to elks, wild animals, hunting and kindred subjects all of which are within a broad description of the subject of the domain name, namely the elk. There are no references to fashion accessories, the field of business of the Complainant.

Prima facie, it appears that the Respondent is not misleadingly directing Internet users to a page composed of advertisements and links in connection with the Complainant or the same industry sector as the Complainant's trademarks and thereby seeking some illegitimate commercial gain (e.g.: *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. D2000-0847 which held that "use which intentionally trades on the fame of another cannot constitute a 'bona fide' offering of goods or services"). In the present case, the links generated appear to arise not because of any association with the Complainant's trademark, but simply because of the nature of the Internet user's search request (see *CNR Music B.V. v. High Performance Networks, Inc.* WIPO Case No. D2005-1116).

This Panel finds that the Respondent has shown independently of paragraph 4(c) of the Policy that it has rights or legitimate interests in respect of the Disputed Domain Name. It is well settled that a respondent may have a right to register and use a domain name to attract Internet traffic based on the appeal of a commonly used descriptive phrase, even where the domain name is identical or confusingly similar to the trademark of a complainant, provided it has not been registered with the complainant's trademark in mind (see: *Bradley D Mittman MD dba FRONTRUNNERS® v. Brendhan Hight, MDNH Inc*, WIPO Case No. D2008-1946; *National Trust for Historic Preservation v. Barry Preston*, WIPO Case No. D2005-0424; *Private Media Group, Inc., Cinecraft Ltd. v. DHL Virtual Networks Inc.*, WIPO Case No. D2004-0843; *T. Rowe Price Associates, Inc. v. J A Rich*, WIPO Case No. D2001-1044; *Sweeps Vacuum & Repair Center, Inc. v. Nett Corp.*, WIPO Case No. D2001-0031; *EAuto, L.L.C. v. Triple S. Auto Parts d/b/a Kung Fu Yea Enterprises, Inc.*, WIPO Case No. D2000-0047). The use of the domain name consistent with such good faith belief may establish a legitimate interest (see: *Mobile Communication Service Inc. v. WebReg, RN*, WIPO Case No. D2005-1304; *Media General Communications, Inc. v. Rarenames, WebReg*, WIPO Case No. D2006-0964; *Trade Me Limited v. Vertical Axis Inc*, WIPO Case No. D2009-0093; WIPO Overview 2.0, paragraph 2.6).

The Respondent says it has a legitimate interest in the Disputed Domain Name because it has used, or made demonstrable preparations to use, the Disputed Domain Name since 2009 for *bona fide* offerings of goods or services. While the Respondent is silent as to whether such date was prior to any notice of the dispute it seems to this Panel the fact that prior to the Respondent taking ownership of the Disputed Domain Name it had been registered for 15 years for reasons other than the Complainant's specific trademark value, this should, on balance, create a rebuttable presumption that it continued to be registered for reasons other than the Complainant's specific trademark value that is dispositive of this issue in favour of the Respondent. The Complainant has not made any submission or not tabled any evidence that would dispel such a finding.

In view of this, the Panel finds for the Respondent on the second element of the Policy.

Because the Complaint fails for the foregoing reasons, the Panel deems it is unnecessary to consider whether Complainant has prevailed under the third element of the Policy, namely, whether the Respondent registered and used the Domain Name in bad faith. However, for completeness and in view of a finding on the issue of Reverse Domain Name Hijacking that will be made at the end of this decision, the Panel will give a brief statement of its findings with respect to the issue of registration and use of the disputed domain name.

C. Registration and use in bad faith

The Panel finds that the Disputed Domain Name was not registered in bad faith and has not been used in bad faith. Essentially, this is for two reasons. First, the Panel has already noted that the registered trademark that the Complainant is able to rely on was not registered until April 15, 2010, but that the Disputed Domain Name had been registered 15 years before that date, on June 28, 1995 and, indeed, that it was registered 13 years before the Complainant was incorporated in 2008. Even the year when the Respondent acquired the Disputed Domain Name, 2009, was before the trademark was registered. That

being so, it was impossible for the Respondent to be motivated by bad faith toward the Complainant at the time the Disputed Domain Name was registered. There was therefore no registration of the Disputed Domain Name in bad faith.

Secondly, there has been no use of the Disputed Domain Name in bad faith as its use for the purpose, principally, of advertising goods and services applicable to the elk, is entirely legitimate. Moreover, there is no evidence that the Respondent pretended that it was the Complainant, advertised goods that the Complainant sells, tried to confuse Internet users, sought to damage the Complainant or its business or engaged in any other bad faith activities.

D. Reverse Domain Name Hijacking

The Respondent requests a finding of reverse domain name hijacking. This is defined in the Rules as “using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name.” Moreover, paragraph 15(e) of the Rules provides as follows: “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 present case, the Panel considers that the Complainant is represented by Counsel who even on a rudimentary examination of the Policy and its application in this area should have appreciated that the Complaint could not succeed where the Respondent’s domain name had been acquired by the Respondent two years prior to filing the ELK trademark application.

The Respondent submitted that “whether the Complaint was filed in bad faith is a question which goes to the state of mind of the Complainant at the time the Proceeding was brought” citing *Prime Pictures LLC v. DigiMedia.com L.P.*, WIPO Case No. D2010-1877. Egregiously, the Complainant’s Counsel held the incorrect belief that the Disputed Domain Name was registered by the Respondent for thirteen years prior to the Complainant’s existence. Only in the Respondent’s Reply is the Complainant’s incorrect belief corrected by the admission, unhelpful to its own defense, that it purchased the Disputed Domain Name in 2009, still prior to registration of the Complainant’s ELK trademark in 2010. The Respondent states “the Complainant does not consider it the least bit odd to claim that such a registration was undertaken with a bad faith intent directed toward the Complainant. Not one word in the Complaint addresses this glaring oddity” and allegations of reverse domain name hijacking have been upheld in circumstances where the registration date of the domain name at issue preceded the dates of the complainant’s trademark registration, see *Deutsche Welle v. DiamondWare Limited*, WIPO Case No. D2000-1202; and *carsales.com.au Limited v. Alton L. Flanders*, WIPO Case No. D2004-0047.

In reaching its conclusions on Reverse Domain Name Hijacking, the Panel has also been influenced by the following considerations. The Complainant made two principal assertions regarding bad faith registration and two more on bad faith use: (i) that the Respondent registered the Disputed Domain Name in a deliberate attempt by the Respondent to “take advantage of a popular and commonly used acronym or phrase Domain Name which could be used by other entities with a real connection to the acronym or phrase” and (ii) that by doing so “the Respondent has registered the (Disputed) Domain Name for the purpose of disrupting the business and activities of those persons/business proposing to use the word “Elk” and in particular the Complainant’s business and activities” (iii) that the Respondent “does not operate a website at the (Disputed) Domain Name” and (iv) “that the Respondent has not used the (Disputed) Domain Name as an operating website since the date of registration”.

As the evidence provided by the Complainant itself showed, however, none of these assertions had any basis in fact. Accordingly, the Panel accepts the Respondent’s allegation that the Complaint was filed in willful disregard of the requirements of the Policy. It is clear to the Panel that the Complainant knew or ought to have known that the Respondent’s registration and use of the disputed domain name could not, under any fair interpretation of the reasonably available facts, have constituted registration and use in bad faith. The Panel therefore finds that the Complaint was brought in bad faith and constitutes an abuse of the

administrative proceeding. (See *Futureworld Consultancy (Pty) Limited v. Online advice*, WIPO Case No. D2003-0297; *Kur- und Verkehrsverein St. Moritz v. Domain Finance Ltd*, WIPO Case No. D2004-0158). The Complainant's statement in paragraph 1 of the Complaint that "the Complainant wishes to secure the domain name and has made previous attempts to secure this domain name" indicates that the Complainant is using the UDRP as an alternative purchase strategy after the acquisition of the Disputed Domain Name failed.

Initiating domain name dispute resolution proceedings necessarily involves putting the parties to a considerable expenditure of time and in many cases cost and the Policy must not be used unless the complainant has a reasonable and credible belief it is entitled to succeed. In particular, proceedings must not be commenced in an unjustifiable attempt to pressure a domain name owner into releasing a legitimately held domain name predating any trademark rights held by the complainant, see *Sustainable Forestry Management Limited v. SFM.com and James M. van Johns "Infa dot Net" Web Services*, WIPO Case No. D2002-0535.

In that regard it should also be said that the Complainant has entirely misconceived the nature of the proceedings it has brought. It says in the Complaint that it, the Complainant, "is a more appropriate owner and to which it has better rights than the Respondent." It has been said many times that this is not the test or even one of the tests of success in UDRP proceedings, which are concerned with abusive registration of domain names.

Finally, it should also be said that it was the Complainant who, on no evidence at all, accused the Respondent of acting in bad faith. That, itself, is an act of bad faith and is part of the reason why the Panel has made the finding of Reverse Domain Name Hijacking. Such allegations should not be made lightly or without cogent evidence to support them and certainly not where, after obtaining instructions, it must have been apparent to the Complainant that no such allegation could properly be made against the Respondent. Indeed, in a curious inversion of the roles of the Complainant and the Respondent, it was the Complainant who tendered evidence that the Respondent's advertising links on its website were mainly within the genus of the elk and activities associated with it and hence entirely legitimate and in good faith.

For all of the above reasons, the Panel therefore makes a finding of Reverse Domain Name Hijacking.

7. Decision

For all the foregoing reasons, the Complaint is denied.

Nicholas Weston
Presiding Panelist

Debrett G. Lyons
Panelist

The Hon Neil Brown Q.C.
Panelist
Dated: May 14, 2012