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| **ARBITRATIONANDMEDIATION CENTER** |

**ADMINISTRATIVE PANEL DECISION**

Pacific House, LLC v. Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf / Connor Boyack

Case No. D2021-3086

**1. The Parties**

The Complainant is Pacific House, LLC, United States of America (“United States”), represented by The IP & Technology Legal Group, P.C., United States.

The Respondent is Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf, Iceland / Connor Boyack, United States, represented by John Berryhill, Ph.d., Esq., United States.

**2. The Domain Name and Registrar**

The disputed domain name <libertas.org> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

**3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 18, 2021. On September 20, 2021, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 20, 2021, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on October 1, 2021 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 amendment to the Complaint on October 4, 2021

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 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 11, 2021. In accordance with the Rules, paragraph 5, the due date for Response was October 31, 2021. The Response was filed with the Center on October 21, 2021.

The Center appointed W. Scott Blackmer, Torsten Bettinger, and Brian J. Winterfeldt as panelists in this matter on December 7, 2021. 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.

The Complainant and the Respondent submitted supplemental filings on December 14 and 15, 2021, respectively, chiefly to address the issue of Reverse Domain Name Hijkacking (“RDNH”). These are discussed in Section 8 below on the issue of RDNH.

**4. Factual Background**

The Complainant is a limited liability company organized under Delaware (United States) law. According to the Complaint, it is “working to establish, together with its affiliates, charitable and advocacy organizations that would support individual rights and other social causes, including, without limitation, democratic ideals, the rule of law, and social and human rights.” The Complaint does not refer to a live website or describe any past or present activities of the Complainant.

The Complainant has a pending application with the United States Patent and Trademark Office (USPTO) to register LIBERTAS as a standard character mark, Serial Number 88776032, on the basis of intent to use. The USPTO online database shows a Notice of Allowance issued on March 16, 2021, signifying that the Complainant was given three years from that time to file a statement of use or amend to another valid registration basis to complete the registration process, provided that it continues to duly request extensions of time to do so.

The Complainant already holds the following trademark registrations, based on its abandoned earlier United States trademark application (Serial Number 88436281), which was also based on intent to use:

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| **MARK** | **JURISDICTION** | **REGISTRATION NUMBER** | **REGISTRATION DATE** |
| LIBERTAS (word mark) | United Kingdom | UK00003402282 | August 16, 2019 |
| LIBERTAS (word mark) | European Union | 018072177 | February 26, 2020 |
| LIBERTAS (word mark) | Germany  | 302019012686 | March 26, 2020 |

The Complainant furnishes evidence that its law firm registered the Domain Name in June 2019 (during the period when the Complainant was first applying for United States trademark registration of LIBERTAS), but states that the Domain Name registration inadvertently lapsed because of undelivered emails. The Complainant evidently never published a website associated with the Domain Name or used it for email addresses. The Complainant recounts that it ultimately “tracked down” the new registrant after the Domain Name changed hands more than once and finally resolved to a live website. The Complainant reports that the new registrant declined repeated requests to transfer the Domain Name to its previous owner.

According to the Registrar, the Domain Name was registered on April 6, 2021, in the name of a domain privacy service. The Registrar identified the underlying registrant as the Respondent Connor Boyack, listing no organization and showing a postal address in the State of Utah, United States.

The Response identifies Mr. Boyack as the principal of Libertas Institute, a nonprofit corporation established under the laws of the State of Utah, United States on December 14, 2011 and recognized by federal and state authorities as a tax-exempt organization. The corporation is listed as active in the online database of the Utah Division of Corporations and Commercial Code, with Mr. Boyack shown as the registered agent. The Response attaches the Respondent’s 2020 United States tax return showing revenues of over USD 9 million and program fund expenditures exceeding USD 7.7 million. The record shows that the Domain Name has been used since the Respondent acquired it in 2021 for the Respondent’s political and economic advocacy website headed “Libertas Institute” (the “Respondent’s website”), which is focused on legislative and regulatory policy issues in the State of Utah.[[1]](#footnote-1)

The Respondent’s website was formerly hosted at the domain name <libertasutah.org>, which now redirects to the Domain Name. The Panel notes that the Internet Archive’s Wayback Machine has archived screenshots of the Respondent’s website at the former domain name, headed “LIBERTAS Institute”, dated as early as July 2012. The Response shows that the Respondent repeatedly attempted to acquire the Domain Name when it was held by third parties, beginning in 2014, and finally succeeded in purchasing the Domain Name on January 29, 2021 (the Response attaches a copy of the domain auction purchase receipt).

The Respondent holds United States trademark registration number 4816541 (registered September 22, 2015) for LIBERTAS INSTITUTE as a standard character mark used for “Association services, namely, promoting awareness of individual liberty, private property, and free enterprise to the public; Association services, namely, promoting the interests of individuals, families, and communities, regarding individual liberty, private property, and free enterprise in the state of Utah.” The term “INSTITUTE” is disclaimed as descriptive in this mark.

In applying for trademark registration of LIBERTAS, the Complainant indisputably became aware of the Respondent’s senior registered trademark. The online docket for the Complainant’s first United States trademark application for the LIBERTAS mark in 2019 shows that the Complainant abandoned that application after the USPTO examining attorney rejected it for likelihood of confusion with the Respondent’s senior LIBERTAS INSTITUTE mark. The online docket for the Complainant’s pending United States trademark application for the LIBERTAS mark shows that the USPTO examining attorney similarly refused registration on the ground of likelihood of confusion with the Respondent’s LIBERTAS INSTITUTE mark. The docket shows that the Complainant ultimately overcame this objection only by amending the identification of its services expressly to exclude “fundraising for causes that promote free enterprise in the state of Utah, individual liberty, private property, and/or free enterprise to the public”, thus distinguishing its services from those of the Respondent, in words largely quoting from the identification of services in the Respondent’s trademark registration.

**5. Parties’ Contentions**

**A. Complainant**

The Complainant asserts that “it is readily apparent that the Disputed Domain Name is identical or confusingly similar to a mark in which Complainant has valid and enforceable rights. Complainant also has rights in and to the Disputed Domain Name itself, due to its prior ownership of same, with no demonstrable intent to abandon such rights.”

The Complainant argues that the Respondent has no permission to use the Complainant’s mark and had “constructive notice” of the Complainant’s United States trademark application and European registrations. The Complainant contends that the Respondent should have engaged a research or legal service to conduct due diligence before purchasing the Domain Name, much as a prudent buyer conducts a “title search” before purchasing a house or automobile. The Complainant asserts that the Panel has “broad leeway” to find that the UDRP elements are satisfied and take “prior ownership into account”, referring to the fact that the Complainant’s law firm held the Domain Name registration in 2019. “Courts in many jurisdictions, including the United States where the Respondent is based, routinely ‘undo’ transfers involving real property, automobiles and other assets with a publicly-verifiable history of ‘recorded’ ownership, similar to a Domain Name.”

The Complainant suggests that the Respondent’s acquisition of a Domain Name identical to the Complainant’s mark, for services similar to the Complainant’s, indicate a bad-faith effort to mislead Internet users, or at least that this would be the “inevitable” result that the Respondent should have exercised care to avoid. The Complainant hints at the possibility of the Respondent’s actual as well as constructive notice of the Complainant’s trademark rights:

“Also, the Complainant made repeated attempts to contact the Respondent in order to try and arrive at a mutually-agreeable resolution prior to filing this UDRP, but these efforts were ignored. One can therefore assume that the Respondent may have been fully aware of Complainant’s prior ownership of the Domain Name and Complainant’s trademark rights, but was unwilling to work in a fair and collaborative manner in order to come up with an amicable solution. Indeed, the Respondent may very well have been aware of Complainant’s ownership of the Disputed Domain Name for quite some time, and quickly seized upon the opportunity to take it away from the Complainant.”

In addition, the Complainant urges the Panel to consider the Respondent’s use of a domain privacy service as further evidence of bad faith.

**B. Respondent**

The Respondent observes that the Complainant relies on non-United States trademark registrations in jurisdictions where use is not required to obtain registration and on a pending United States intent-to-use application. The “Complainant claims no goodwill in actual use of a mark, because the Complainant provides no goods and offers no services, the Complainant has no customers, and the Complainant does not engage in any commercial activity under a LIBERTAS mark whatsoever.” The Respondent cites WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 1.1.4: “a pending trademark application would not by itself establish trademark rights within the meaning of UDRP paragraph 4(a)(i).”

The Respondent argues that it has senior rights and legitimate interests in the Domain Name, given that it has been established and commonly known as Libertas Institute since 2011 and owns the LIBERTAS INSTITUTE trademark registered in 2015. “Libertas” (Latin for “liberty”) is the dominant element of its name and mark; the word “institute” is disclaimed in the trademark registration as descriptive.

In reply to the Complainant’s claims of “opportunistic re-registration,” the Respondent argues as follows:

“The domain name expired in the hands of Complainant’s counsel in December 2019. The Respondent purchased the domain name in January 2021 - more than a year after the Complainant’s counsel let it go. … the Respondent had been attempting to buy the domain name since 2014 … Complainant, or Complainant’s counsel could have bought it the same way if they had wanted.”

The Respondent points out that the Complainant never used the Domain Name for a website of which the Respondent could have been aware. The Respondent, which already had a relevant trademark registration, denies any obligation to search United States and foreign trademark registries for junior applications or registrations before acquiring the Domain Name. This acquisition occurred more than a year after the Domain Name registration by the Complainant’s law firm lapsed. In this connection, the Respondent points out that the chronology given in the Response and in pre-UDRP correspondence from the Complainant’s counsel was factually inaccurate: the Complainant itself never registered the Domain Name, and its law firm held the registration for the Domain Name only for part of 2019 and was not prevented from renewing the registration in December 2019 because of COVID-19 shut-downs that did not occur until 2020.

**6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that in order to divest a respondent of a domain name, a complainant must demonstrate each of the following:

(i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) the respondent has no rights or legitimate interests in respect of the domain name; and

(iii) the domain name has been registered and is being used in bad faith.

Under paragraph 15(a) of the Rules, “[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

**A. Identical or Confusingly Similar**

The first element of a UDRP complaint “functions primarily as a standing requirement” and entails “a straightforward comparison between the complainant’s trademark and the domain name”. See WIPO Overview 3.0, section 1.7. The Complainant’s pending United States trademark registration is insufficient in itself to ground standing to bring a UDRP proceeding (*id.,* section 1.1.4), but the registrations of LIBERTAS as a word mark in the United Kingdom, European Union, and Germany suffice for purposes of this Policy element.[[2]](#footnote-2) The Domain Name is identical. As usual, the generic Top-Level Domain (“gTLD”) “.org” is disregarded as a standard registration requirement. See *id*., section 1.11.2.

Accordingly, the Panel finds that the Domain Name is confusingly similar to the Complainant’s mark for purposes of the Policy, paragraph 4(a)(i) and concludes that the Complainant has established the first element of the Complaint.

**B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy gives non-exclusive examples of instances in which a respondent may establish rights or legitimate interests in a domain name, by demonstrating any of the following:

(i) before any notice to it of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) that the respondent has been commonly known by the 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 domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Because a respondent in a UDRP proceeding is in the best position to assert rights or legitimate interests in a domain name, it is well established that after a complainant makes a *prima facie* case, the burden of production on this element shifts to the respondent to come forward with relevant evidence of its rights or legitimate interests in the domain name; the burden of proof always rests with the complainant. See WIPO Overview 3.0, section 2.1.

The Respondent demonstrates that it has been established since 2011 under the name Libertas Institute and holds a registered LIBERTAS INSTITUTE trademark, registered in 2015. Screenshots show that the Respondent has been using this mark online since at least July 2012. The Respondent’s website featuring the trademark has been associated with the Domain Name since shortly after its acquisition in January 2021. The record shows that the Respondent obtained tax exempt status in April 2013 and has substantial funding and programs through the current year. Thus, there is evidence that the Respondent uses both the Domain Name and a corresponding name in connection with a *bona fide* offering of services, and that the Respondent had relevant trademark rights and also had been commonly known by the Domain Name, all before notice of this dispute. In fact, the Respondent’s use of “Libertas Institute” as the name of the organization, and the trademark LIBERTAS INSTITUTE, precede by years the Complainant’s application for and constructive use of a LIBERTAS mark.

The Complaint refers at several points to the Respondent as “Libertas Institute of Utah” and suggests that “Libertas” is “merely part of a larger commercial designation”. However, the Respondent’s name is simply “Libertas Institute”, not “Libertas Institute of Utah”. “Libertas” is the dominant element of the Respondent’s name and mark as the first and most distinctive feature; “institute” is at least highly suggestive if not descriptive, as reflected by its disclaimer in the United States trademark registration. The Respondent also refers to itself as “Libertas” in several places on its website, which, among other things, is used to sell branded merchandise that features “Libertas” as the dominant element. The Panel considers that for purposes of the Policy, paragraph 4(c) (i) and (ii), the dominant element of the name or mark is relevant in considering whether the Respondent is using a corresponding Domain Name. If an organization has registered a mark including an entity designation (*e.g*., “Institute,” “Inc.”, or “S.A.”) but uses and is commonly known by a shortened version of the mark that excludes the entity designation in a way that does not materially alter the impression of the mark on consumers, then a domain name reflecting the shortened version on the second level would be viewed as a corresponding domain name despite lacking the entity designation.

In the present case, the Panel finds that the Respondent meets the conditions of the Policy, paragraph 4(c) (i) and (ii), as the Domain Name was used in connection with a *bona fide* offering of goods or services before the dispute arose and the Domain Name corresponds to the Respondent’s trademark LIBERTAS INSTITUTE, which is also a name by which the Respondent is commonly known. Prior UDRP panels have found that, where a respondent is using a disputed domain name to “market its own products” and where a respondent is commonly known by the disputed domain name, the respondent has legitimate rights and interests in the disputed domain name. See *Grundfos Holding A/S v. PrivacyProtect.org / Incredible SEO Mehul (Sailesh Patel / Ajay Soni)*, WIPO Case No. D2011-1355. Accordingly, the Panel concludes that the Complaint fails on the second element.

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

Given the Panel’s conclusion on the second element of the Complaint, it is unnecessary to enter findings and reach a conclusion on the third element, bad faith.

**7. Decision**

For the foregoing reasons, the Complaint is denied.

**8. Reverse Domain Name Hijacking and Supplemental Filings**

The Complainant and the Respondent each submitted supplemental filings on the issue of RDNH. Neither the Rules nor the Supplemental Rules make provision for supplemental filings, except at the request of the panel (see Rules, paragraph 12). Paragraph 10 of the Rules enjoins the panel to conduct the proceeding “with due expedition”. Therefore, UDRP panels are typically reluctant to countenance delay through additional rounds of pleading and normally accept supplemental filings only to consider material new evidence or provide a fair opportunity to respond to arguments that could not reasonably have been anticipated. See WIPO Overview 3.0, section 4.6. The Panel considers it fair and efficient to consider the parties’ brief submissions on RDNH, to which the Response alluded.

Paragraph 15(e) of the Rules provides that, if “after considering the submissions the panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking (‘RDNH’) 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”. The Response did not expressly request such a finding here but referred to the Complainant’s “bad faith”, mentioning certain factual inaccuracies in the Complaint and in correspondence between the parties prior to the filing of the Complaint.

It is generally accepted that mere lack of success of a complaint is not itself sufficient for a finding of RDNH. Further discussion as to the nature of RDNH and examples of certain past cases under the Policy in which it has been found are detailed in WIPO Overview 3.0, section 4.16. The three-member panel in *Yell Limited v. Ultimate Search*, WIPO Case No. D2005-0091, observed that whether a complainant should have appreciated at the outset that its complaint could not succeed will often be an important consideration for the assessment regarding RDNH. The Panel believes this is such a case.

Here, the Complainant misstated or obscured relevant facts in its possession. The Complainant said that it owned the Domain Name from June 2019 until it “inadvertently lapsed when the registration expired” due to “technical issues” “coupled with staffing limitations stemming from the COVID-19 global pandemic.” The Complainant’s counsel, in demand correspondence prior to filing the Complaint in this proceeding, stretched the facts even further, claiming that the Complainant held the Domain Name for “over a year” and that the registration “lapsed in mid-late 2020”, partly because of the pandemic. In fact, the Complainant itself did not register the Domain Name and never used it. The Complainant’s law firm registered the Domain Name in June 2019, and the registration expired six months later in December 2019, before the COVID epidemic imposed “staffing limitations”. The Respondent did not acquire the Domain Name until more than a year later, after the Domain Name had been held by other parties. In filing the UDRP Complaint, the Complainant was well aware of these facts and that this was quite a different case from “opportunistic re-registration” of a lapsed domain name that had been used by a trademark holder for its website, as in the decisions cited in the Complaint.

The Complainant was also well aware of the Respondent and its own senior trademark rights in a corresponding name. The USPTO examining attorney cited the Respondent’s LIBERTAS INSTITUTE trademark in refusing the Complainant’s applications for trademark registration, until the Complainant precisely excluded the Respondent’s activities from the services in its own trademark application to avoid confusion. It is remarkable that the Complainant would simply sidestep this obvious ground for the Respondent’s claim of rights or legitimate interests. The Complainant sought to discredit the Respondent’s defense of being “commonly known” by a name corresponding to the Domain Name by giving the Respondent’s name, incorrectly, as “Libertas Institute of Utah”. Otherwise, the Complaint largely overlooks the second UDRP element and the Respondent’s own claims to rights or legitimate interests in the Domain Name. The Complainant urges the Panel to give precedence instead to restoring a lost domain name to its “former owner” at all costs, which is not the purpose of the Policy.

Both parties have legitimate interests in the Domain Name. One of the risks of a failure to renew a domain name registration, through whatever series of errors, is that another party with a legitimate interest will subsequently register the domain name and use it in good faith. The record here does not indicate that the Respondent sought to exploit the Complainant’s junior mark, and the Respondent is certainly not responsible for correcting the Complainant’s errors in maintaining the registration of the Domain Name.

The Complainant, in brief, was in possession of sufficient facts to recognize that it was unlikely to prevail on the second and third elements of the Complaint, given the plain language of the Policy and existing precedent. The Complainant strained or misstated facts, cited inapposite decisions, and failed to confront the obvious claims of a senior trademark rights holder.

In its supplemental filing, the Complainant argues that the Panel nevertheless cannot find RDNH so long as the Complainant prevails on a single element of the Complaint, such as the first element, its standing to bring the complaint because it holds European trademark registrations. Rule 15(e) does not compel such a conclusion. A complainant must establish all three elements of the complaint, and if the complainant does not furnish credible support for one or two of those elements, the complaint is doomed and should not have been filed, imposing costs and other burdens on the respondent. This suffices for an RDNH finding, as reflected in other WIPO decisions that emphasize the defects of a complaint with respect to one or two but not all three elements of the complaint. See WIPO Overview 3.0, section 4.16; see also, *e.g*., *Proto Software, Inc. v. Vertical Axis, Inc / PROTO.COM*, WIPO Case No. D2006-0905.

Taken together, the Complainant’s factual inaccuracies and strained reading of the Policy and Policy decisions reflect the Complainant’s bad faith in resorting to the UDRP to recover a Domain Name lost through its own errors. The Panel finds that the Complaint represents an instance of attempted Reverse Domain Name Hijacking.

/W. Scott Blackmer/

**W. Scott Blackmer**

Presiding Panelist

*/Torsten Bettinger/*

**Torsten Bettinger**

Panelist

*/Brian J. Winterfeldt/*

**Brian J. Winterfeldt**

Panelist

Date: December 26, 2021

1. The parties refer to Libertas Institute and Mr. Boyack collectively as “the Respondent”, and the Panel does so as well. The Response indicates that Mr. Boyack is the principal of Libertas Institute and acted in its behalf in acquiring the Domain Name, and the Domain Name has been used since the acquisition for the website of Libertas Institute. [↑](#footnote-ref-1)
2. These registrations remain valid even though they were based on a subsequently abandoned United States intent-to-use application. United Kingdom, European Union, and German trademark registrations are effective prior to use but may be subject to cancellation for non-use after five years. [↑](#footnote-ref-2)