

ADMINISTRATIVE PANEL DECISION

Damstra Technology Pty Ltd (ACN 086 218 742) v. Domain Admin,
Tu cows.com Co
Case No. D2021-0675

1. The Parties

The Complainant is Damstra Technology Pty Ltd (ACN 086 218 742), Australia, represented by Rankin Business Lawyers, Australia.

The Respondent is Domain Admin, Tu cows.com Co, Canada, represented by John Berryhill, Ph.d., Esq., United States of America.

2. The Domain Name and Registrar

The disputed domain name <damstra.com> (the “Domain Name”) is registered with Tu cows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 8, 2021. On March 10, 2021, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed Domain Name. On March 11, 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 March 12, 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 amended Complaint on March 17, 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 March 25, 2021. In accordance with the Rules, paragraph 5, the due date for Response was April 14, 2021, which was extended until April 18, 2021. The Response was filed with the Center April 18, 2021.

The Center appointed Willem J. H. Leppink, Simon Minahan, and Nick J. Gardner as panelists in this matter on May 19, 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 submitted a Supplemental Filing on May 28, 2021 and the Respondent submitted a response to it on the same day.

4. Factual Background

The Complainant is an Australian company, founded in 1999.

The Complainant is the proprietor of the following trademark registrations in relation to DAMSTRA:

- Australian registration for the word mark DAMSTRA, with registration number 2085390, registered on May 1, 2020 for goods and services in classes 9, 35, 37, 41, 42, and 45;
- International registration for the word mark DAMSTRA, with registration number 1554875, registered on May 26, 2020 for goods and services in class 9, 35, 37, 41, 42, and 45, designating the United Kingdom, New Zealand, and the United States.

These trademarks will hereinafter in singular be referred to together as the “Trademark”.

The Complainant is the owner of the domain name <damstratechnology.com>, registered on August 8, 2016.

The Respondent is a well-known ICANN-accredited registrar, and is a publicly traded corporation on the NASDAQ exchange with annual revenue over USD 300 million. In June 2006 the Respondent paid USD 18 million to purchase Mailbank.com Inc., a company that owned over 17,000 domain names for common surnames. In December 2014, the Respondent launched its RealNames service (hereinafter: “RealNames”), offering a vanity email service enabling customers to use an email address corresponding to their surname. RealNames consists of 39,000 domain names, consisting of amongst others the domain names acquired from Mailbank.com Inc.

The Domain Name was registered on March 29, 2000 and was acquired by the Respondent in 2013. The Domain Name is part of RealNames and is used by the Respondent to provide to customers in return for an annual fee an email address *i.e.*, “[name]@damstra.com”.

5. Parties’ Contentions

A. Complainant

The following is a summary of the Complainant’s contentions.

The Complainant is the proprietor of the Trademark and several trademark applications for DAMSTRA. The Domain Name is confusingly similar to the Trademark.

The Respondent has no rights or legitimate interests in the Domain Name. The Respondent has not demonstrated preparations to use the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods and services.

The Domain Name was registered and is being used in bad faith. The Respondent operates as domain name service reseller and has registered the Domain Name primarily for the purpose of selling or otherwise transferring the Domain Name to the Complainant, for potentially valuable consideration that may exceed out of pocket costs. The website connected to the Domain Name is inactive and is passively held by the

Respondent for twenty years.

The Complainant submitted a Supplemental Filing on May 28, 2021.

B. Respondent

The following is a summary of the response filed by the Respondent.

The Domain Name has been acquired by the Respondent in 2013 and predates the registration of the Trademark. The Domain Name entirely consists of Damstra, the surname of hundreds of persons. That is also the reason that a trademark application from the Complainant in the United States for DAMSTRA has been refused; the Complainant has deliberately not disclosed this information. The Complainant has presented no evidence of a registration application or registration senior to the Respondent's registration of the Domain Name.

The Domain Name has been acquired and is being used as part of RealNames. The website is connected with the Respondent's Realnames surname based service. The Complainant tried to mislead the Panel by stating that the Domain Name is not being used and is passively held by the Respondent, whilst the Domain Name is being used as vanity email service. Several panels have decided that such use of a domain name constitutes a *bona fide* use of the domain name.

The Respondent has registered the Domain Name well before the Trademark was registered. The Respondent has never approached the Complainant to sell the Domain Name. To the contrary, it was the Complainant that approached the Respondent to purchase the Domain Name, after which the Complainant – for the sake of brevity – was told that the Domain Name is not for sale. The Complainant has failed to show registration and use in bad faith.

The Complaint deliberately consists of misleading and incomplete statements of relevant facts, whilst it has been prepared by a professional legal representative. This includes, amongst others, that the Complainant 1) suggested that the Domain Name is not being used, 2) claimed a United States trademark application that had already been refused and 3) mischaracterized two express refusals to sell the Domain Name as an intent to sell the Domain Name to the Complainant.

The Respondent submitted a Supplemental Filing on May 28, 2021.

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove each of the following three elements:

(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.

A. Unsolicited Supplemental Filings

The Complainant submitted a Supplemental Filing on May 28, 2021, and the Respondent submitted a reply on the same day.

Paragraphs 10 and 12 of the Rules grant the Panel the sole discretion to determine the admissibility of supplemental filings (including further statements or documents) received from either Party. There is no provision in the Rules for a party to file additional unsolicited submissions.

A party submitting an unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response (see section 4.6 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”).

The Panel has reviewed the Complainant’s Supplemental Filing and the Respondent’s Supplemental Filing and decided that the arguments provided therein will not affect the outcome of the present case.

B. Identical or Confusingly Similar

The Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the Domain Name must be shown to be identical or confusingly similar to that mark.

The Complainant has sufficiently shown that it has rights in the Trademark.

As set out in WIPO Overview 3.0, section 1.7, the first element functions primarily as a standing requirement. The threshold test for confusing similarity between the Domain Name and the Trademark involves a relatively straightforward comparison.

In light of the foregoing, the Panel finds that the Domain Name is identical to the Trademark. The Domain Name consists entirely of the Trademark.

In addition, with regard to the suffix “.com” (which indicates that the Domain Name is registered in the “.com” generic Top-Level Domain (“gTLD”)), as it was established in many previous UDRP decisions (see *A.P. Møller v. Web Society*, WIPO Case No. D2000-0135; *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. D2000-0429; *Arab Bank for Investment And Foreign Trade (ARBIFT) v. Mr. Kenn Wagenheim / 07@usa.net*, WIPO Case No. D2000-1400; *Delikommat Betriebsverpflegung Gesellschaft m.b.H. v. Alexander Lehner*, WIPO Case No. D2001-1447; and *Crédit Industriel et Commercial S.A v. Name Privacy*, WIPO Case No. D2005-0457), it does not generally affect the analysis under the first element of the Policy for the purpose of determining whether a domain name is identical or confusingly similar; indeed, the suffix is a necessary component of a domain name and does not give any distinctiveness.

For all the foregoing reasons, the Panel is satisfied that the first element of the Policy is met.

C. Rights or Legitimate Interests

The Panel has carefully considered the factual allegations that have been made by the Complainant and are supported by the submitted evidence, and the Response including the submitted evidence that have been received from the Respondent.

Paragraph 4(a)(ii) of the Policy provides that “[a domain-name holder] is required to submit to a mandatory administrative proceeding in the event that [a complainant] asserts to the applicable [administrative-dispute-resolution service provider], in compliance with the Rules of Procedure, that [...] (ii) [the respondent has] no rights or legitimate interests in respect of the [disputed] domain name[.]”

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that the respondent has rights or legitimate interests in the Domain Name:

(i) use of, or preparations to use, the Domain Name in connection with a *bona fide* offering of goods or services;

(ii) the fact that the Respondent has commonly been known by the Domain Name, even if the respondent has acquired no trademark or service mark rights; or

(iii) 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.

The overall burden of proof on this element rests with the Complainant. However, it is well established by previous UDRP panel decisions that once a complainant establishes a *prima facie* case that a respondent lacks rights or legitimate interests in a domain name, the burden shifts to the respondent to rebut the complainant's contentions. If the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (*Danzas Holding AG, DHL Operations B.V. v. Ma Shikai*, WIPO Case No. D2008-0441; section 2.1 of WIPO Overview 3.0).

The Complainant stated that the Respondent has not made demonstrated preparations to use the Domain Name in connection with a *bona fide* offering of goods or services. The Panel finds that this statement is not substantiated, and that in any event the Respondent has provided credible rebuttal evidence that the Domain Name forms part of its portfolio of domain names which are used in a business providing email addresses to persons where the second-level domain name element of the relevant email address corresponds to a person's surname.

The Panel has no doubt that this represents a legitimate and *bona fide* business. A number of previous UDRP panels have reached the same conclusion in relation to the Respondent's business in this regard (or its predecessors in that business) – see for example *Grasso's Koninklijke Machinefabrieken N.V., currently acting as Royal GEA Grasso Holding N.V. v. Tucows.com Co*, WIPO Case No. D2009-0115; *International Raelian Religion and Raelian Religion of France v. Mailbank.com Inc.*, WIPO Case No. D2000-1210; and *Buhl Optical Co v. Mailbank.com, Inc.*, WIPO Case No. D2000-1277.

Accordingly, the Panel finds that the Respondent has established a legitimate interest and the Complainant has failed to establish that the second condition of paragraph 4(a) of the Policy has been fulfilled.

D. Registered and Used in Bad Faith

Since the Complainant has failed to establish the second element under the Policy, this would normally make it unnecessary for the Panel to deal with the issue of bad faith. Nevertheless, the Panel has found it appropriate to express its views on some of the relevant circumstances of this case and the related contentions of the Parties.

There is no evidence presented that the Respondent had the Complainant in mind when registering the Domain Name. Damstra is originally a Dutch (Frisian) family name. As a result of emigration there are also a number of Canadians and Australians who have that family name.

The Complainant has contended that the Respondent has registered the Domain Name primarily for the purpose for selling it to the Complainant for out-of-pocket expenses. However, this allegation is manifestly incorrect. The Respondent has provided detailed evidence that the Complainant contacted the Respondent and that the Respondent indicated that it was not prepared to sell the Domain Name.

In addition, the contention from the Complainant that the Respondent has not made use of the Domain Name and that the Respondent is solely passively holding the Domain Name, is as well manifestly incorrect. The Panel refers to its findings under Section B.

Overall it is clear that the Respondent's webpage has no connection whatsoever to the Complainant or its business, and no sensible visitor to the webpage could conclude otherwise.

The question of how and why the Complainant has come to make such a completely inaccurate characterization of the Respondent's webpage is discussed below in relation to the issue of Reverse Domain Name Hijacking.

Accordingly, the Complainant has failed to establish that the third condition of paragraph 4(a) of the Policy has been fulfilled.

D. Reverse Domain Name Hijacking

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. In assessing this issue the Panel adopts the approach in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”) at section 4.16:

“Reasons articulated by panels for finding RDNH include: (i) facts which demonstrate that the complainant knew it could not succeed as to any of the required three elements – such as the complainant’s lack of relevant trademark rights, clear knowledge of respondent rights or legitimate interests, or clear knowledge of a lack of respondent bad faith (see generally section 3.8) such as registration of the disputed domain name well before the complainant acquired trademark rights, (ii) facts which demonstrate that the complainant clearly ought to have known it could not succeed under any fair interpretation of facts reasonably available prior to the filing of the complaint, including relevant facts on the website at the disputed domain name or readily available public sources such as the Whois database, (iii) unreasonably ignoring established Policy precedent notably as captured in this WIPO Overview – except in limited circumstances which *prima facie* justify advancing an alternative legal argument, (iv) the provision of false evidence, or otherwise attempting to mislead the panel, (v) the provision of intentionally incomplete material evidence – often clarified by the respondent, (vi) the complainant’s failure to disclose that a case is a UDRP refiling, (vii) filing the complaint after an unsuccessful attempt to acquire the disputed domain name from the respondent without a plausible legal basis, (viii) basing a complaint on only the barest of allegations without any supporting evidence.”

In the present matter, the Panel finds that the Complainant should have known at the time that it filed the Complaint that it could not prove one of the essential elements required, as it is clear that the Respondent registered the Domain Name before the Complainant filed and registered the Trademark.

Furthermore, the Panel also finds that the Complainant (or rather, its professional representative) has either been extremely careless, or has tried to mislead the Panel by 1) suggesting that the Domain Name was not being used at all, 2) not disclosing accurately the status of the United States trademark application and 3) not disclosing that the Complainant sought to purchase the Domain Name rather than the Respondent offering the Domain Name for out-of-pocket expenses.

Based on the above the Panel finds that the Complaint was filed in a bad faith attempt to deprive the Respondent of the Domain Name. These facts justify a finding of Reverse Domain Name Hijacking.

7. Decision

For the foregoing reasons, the Complaint is denied. The Panel finds that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

/Willem J. H. Leppink/
Willem J. H. Leppink
Presiding Panelist

/Simon Minahan/
Simon Minahan
Panelist

/Nick J. Gardner/
Nick J. Gardner
Panelist
Date: June 2, 2021