



Asian Domain Name Dispute Resolution Centre
beijing

(Beijing Office)

ADMINISTRATIVE PANEL DECISION

Case No. CN-1300729

Complainant 1: Galaxy Rainbow Limited

Complainant 2: Whole Person Development Institute Limited

Respondent: Digimedia.com L.P.

Domain Name: ican.com

Registrar: TUCOWS DOMAINS INC.

1、 Procedural History

On 5 November 2013, the Complainant submitted a Complaint in Chinese to the Beijing Office of the Asian Domain Name Dispute Resolution Center (the ADNDRC), requesting to set up a one-member panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy) approved by the Internet Corporation for Assigned Names and Numbers (ICANN), the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the ADNDRC Supplemental Rules). On the same date, the ADNDRC sent to the Complainant by email an acknowledgement of the receipt of the complaint and reviewed the format of the complaint for compliance with the Policy, the Rules and the ADNDRC Supplemental Rules.

On 6 November 2013, the ADNDRC transmitted by email to the Registrar a request for registration verification in connection with the disputed domain name.

On 7 November 2013, the Registrar transmitted by email to the ADNDRC its verification response, confirming that the Respondent is listed as the registrant and providing the contact details. According to the registration information, the language of the Registration Agreement is English; the ADNDRC requested the

Complainant to revise the Complaint. On 27 November 2013, the Complainant submitted the revised Complaint.

On 13 December 2013, the ADNDRC notified the Complainant that the Complaint has been confirmed and transmitted to the Respondent and the case officially commenced on 13 December 2013. On the same date, the ADNDRC transmitted the Written Notice of the Complaint to the Respondent, which informed that the Complainant had filed a Complaint against the Respondent over the disputed domain name and the ADNDRC had sent the Complaint and its attachments to the Respondent through email according to the Rules and the Supplemental Rules. On the same date, the ADNDRC notified ICANN and the Registrar of the commencement of the proceedings.

On 18 December 2013, the Respondent requested a three-member panel. The payment was made in due course. On 28 December 2013, the respondent submitted a response. On 30 December 2013, the ADNDRC transmitted the Response to the Complainant. On 2 January 2014, the ADNDRC notified both parties for the selection of the third panelist. The two parties submitted separate lists of candidates in order of preference on 2 January 2014 and 6 January 2014 respectively.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance from Mr. Zhao Yun, Dr. Shahla Ali and Sir Ian Barker, the ADNDRC notified the parties on 8 January 2014 that the Panel in this case had been selected. The Panel determines that the appointment was made in accordance with Rules 6 and Articles 8 and 9 of the Supplemental Rules.

On 8 January 2014, the Panel received the file from the ADNDRC and should render the Decision within 14 days, i.e., on or before 22 January 2014.

Pursuant to Paragraph 11(a) of the Rules, unless otherwise agreed by the parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding. The language of the current disputed domain name Registration Agreement is English and no request has been made to carry out the proceeding in a language other than English, thus the Panel determines English as the language of the proceeding.

2. Factual Background

For the Complainant

Complainant 1 in this case is Galaxy Rainbow Limited. Complainant 2 is Whole Person Development Institute Limited. Both Complainants share the same registered address: 28/F, Peninsula Tower, 538 Castle Peak Road, Cheung Sha Wan, Kowloon, Hong Kong. The authorized representative in this case is Wen Zhenbin from Guangdong Dien Law Firm.

For the Respondent

The Respondent in this case is Digimedia.com L.P. The address is 1414 S. Sangre Road, Stillwater, OK 74074, US. The Respondent is the current registrant of the disputed domain name “ican.com” according to the Whois information. The authorized representative in this case is John Berryhill.

3. Parties’ Contentions

The Complainant

(1) ICAN, main part of the disputed domain name “ICAN.com” is so similar to the Complainant’s trademark that it may cause confusion.

Complainant 2 is a wholly owned subsidiary under and 100% owned by ICAN Group Limited, which is a wholly owned subsidiary under and 100% owned by Complainant 1. Complainant 1 owns multiple “ICAN” registered trademarks, of which Complainant 2 is responsible for the publicity and use. Complainant 2 is dedicated to providing holistic psychological services for individuals, families, corporations and schools. Based on the ICAN applied psychological model, innovated by Dr. Wong Chung-kwong, J.P., the Chairman of the Board of Honorary Advisers, it offers cutting edge psychological services through three tactics, namely enhancement, prevention and therapy.

To live up to the vision of “Whole Person Development”, Complainant 2 is committed to supporting all round development of its clients. Since 2003, it adopts the scientific and value-based ICAN applied psychological model to develop a wide range of training programmes, seminars and workshops for schools, government departments, corporations and the general public. It has gained significant achievements in enhancing the mental wellness of individuals,

strengthening parent-children relationships, supporting corporations to achieve brilliant results and promoting whole person education in schools. Complainant 2 is proud of having maintained mutual and long-lasting relationships with its clients, including the office of the Ombudsman, Hong Kong, Independent Commission Against Corruption (ICAC), Civil Service Bureau, Mandatory Provident Funds Authority (MPFA), Shui On Group, Bank of China (BOC), The Hongkong and Shanghai Banking Corporation Limited ((HSBC), DBS Bank (Hong Kong) Limited (DBS), Hong Kong Disney Land, Smartone-Vodafone, Lam Soon Hong Kong Group, etc. Its dedication to the provision of quality services has gained wide recognition by the clients.

“ICAN” of Complainant 2 is an applied psychological model which is innovated by Dr. Wong Chung-kwong based on the philosophy of psychiatry and psychology, his clinical experience and training experience gained in the medical sector, the education sector and the business sector. The purpose is to help the general public to enhance their mind wellness and live a life of success, advancement and happiness. The three interacting objectives of Success, Advancement and Happiness of the ICAN model come from the core principles of three important domains of psychiatry and psychology: psychotherapy; motivational psychology and developmental psychology.

In the ICAN model, the psychological functioning of people is the interaction of four components: Self-value, perception (or Cognition); Emotion; Behaviour. The Complainants use the term Personality Functioning to refer to this four-component interaction.

Success is the result of positive Personality Functioning: good self-esteem and abiding by correct value of life; optimistic perception and thinking; positive emotion and effective behavior.

Advancement is brought about by the ICAN Self-empowerment Process. It starts from Insights in which people make conscious efforts to reflect upon themselves and their situations, including strengths and weaknesses. The next step is Confirmation: people set goals to better themselves. This is followed by Abilities: they activate their internal drive to learn and to act in order to achieve their goals. The process goes on to Nurture: they achieve “outward” attainment, and more importantly, “inward” self-appreciation and mastery. Such inward positive feelings motivate them to ask the salient question, “How can I do even

better?” This question is the starting point of the next round of Insights in that it motivates people to set further and high goals, thus generating very strong self-motivating force to make continuous progress and advancement in life.

Happiness is to “connect” and “empower”. To connect is to form and maintain high quality inter-personal relationship with family members, friends, colleagues, other people, and also society and country. To Empower means to have the power to influence others, through high quality inter-personal relationship. People who are able to Connect and to Empower are healthy, strong and happy.

The three objectives of Success, Advancement and Happiness do not work in isolation but rather in a continuous interactive manner. The three scientific disciplines of the ICAN model, namely psychotherapy, motivational psychology and developmental psychology, each has important contributions in helping us to understand the psychology of people and in promoting the mental well-being of people. The ICAN model captures the key factors of these three disciplines and organizes them in a pragmatic and synergistic way, thus allowing these factors to be readily understood and applied by people to enhance their mind wellness and power.

Complainant 1 is entitled to the trademark right over “ICAN”. It has registered multiple “ICAN” trademarks early in Hong Kong and Macao and licensed Complainant 2 for their publicity and use. Thanks to the publicity and use by Complainant 2, Complainant 2 and its “ICAN” have been widely known to Hong Kong and Macao, even all around China, and been awarded a lot of honors.

The right over the disputed domain name is identical to that over the Complainant’s trademark, so it is easy to cause confusion. The disputed domain name is mainly composed of ICAN, which is identical to the Complainant’s trademark. According to the foresaid statement, “ICAN” is not only owned by the Complainants, but has become a significant symbol of the Complainants after their publicity and use. Therefore, the disputed domain name may cause confusion and misidentification.

(2)The Respondent has no right or legitimate interests in respect of the disputed domain name or its main part.

The Respondent is known as “DigiMedia”, and has not registered “ICAN” trademark, so apparently it has no rights or legitimate interests in respect of the disputed domain name and its behavior of registering the said disputed domain name violates the provisions in Article 4-a-ii in the Policy, that is, “you have no rights or legitimate interests in respect of the domain name”.

(3)The Respondent has registered or used the said domain name in bad faith.

As specified in 4(b) (ii) in the Policy, “you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct”. The Complainants’ trademark “ICAN”, after their decades of operation and large advertising has been well known and acknowledged by customers, and enjoys high prestige in Hong Kong and Macao, even all around China. The Respondent should have known this, but it still preemptively registered the disputed domain name mainly composed of the Complainants’ registered trademark to prevent the owner of “ICAN” trademark from obtaining the domain name corresponding to its mark, which is obviously malicious.

As specified in (4) (b) (iii) in the Policy, “you have registered the domain name primarily for the purpose of disrupting the business of a competitor”. The Respondent itself has no connection with “ICAN” logo, so the Complainants cannot help questioning its intention for registering the disputed domain name. Apparently, it did so to seek unfair profits, intentionally prevent the Complainants from using the trademark, whose rights and legitimate interests belong to the Complainants, on the Internet in the form of domain name, and affect the normal business of the Complainant, which is obviously malicious.

As specified in (4) (b) (iv) in the Policy, “by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location”. As the Complainants’ “ICAN” trademark has been quite popular after their publicity and use, the Respondent intentionally took ICAN as main part of the said disputed domain name and registered it preemptively, clearly intending to make the public believes its website or the goods and services thereon have

certain relationship with the Complainants, thus to achieve the purpose of confusing the customers.

For the reasons above, the Complainant requests the Panel to issue a decision to transfer the disputed domain name from the Respondent to the Complainants.

The Respondent

(1) Identity or Confusing Similarity

The first criterion of the Policy requires the Complainant to show the domain name is identical or confusingly similar to a trade or service mark in which the Complainant has rights. The Complainant proposes that there be a joinder of two Complainants in this Proceeding. The Complainants proffer the trade mark registration certificates. All are owned by Galaxy Rainbow Limited. The Complainants provide no documentation of any interests of the second Complainant. None of the asserted trademark registrations are owned by the second Complainant in this Proceeding, and there is no assignment, license, or any evidence whatsoever which would entitle the second Complainant to claim any right at all in the asserted trademark registrations. The Complaint merely alleges that the second Complainant is somehow related to the owner of the trademark registrations, and provides no proof or evidence thereof. Accordingly, on the record of this Proceeding, there is no evidence the second Complainant has any rights in any “ICAN” mark.

While the first criterion of the Policy does not state, as an express condition, that the Complainant’s rights be senior to the Respondent, it of course must be observed that the earliest of the proffered trademark registrations is dated in 2008, while the Respondent has registered and used the domain name since 1998 – ten years prior to the earliest evidence of a trade or service mark owned by the first Complainant. Accordingly, the first Complainant has shown that it has rights in a trade or service mark which is ten years junior to the Respondent’s registration of the domain name.

(2) Legitimate Rights or Interests

The second criterion requires the Complainant to prove that the Respondent has no rights or legitimate interests in the domain name. The second criterion does

not require that the Respondent possess or claim a trade or service mark right, but includes such equitable rights as expectation interests, senior rights, and bona fide use of the domain name prior to any notification of a dispute.

There is no question that the Respondent is the senior party here in relation to the common English phrase “I can”, signifying a primary meaning of ability to do something. The right of seniority has been held to be sufficient and determinative for a finding in the Respondent’s favor on the second element. The Respondent registered the domain name in 1998, some ten years prior to the earliest evidence of a trade or service mark in this Proceeding. Indeed the earliest record of the DomainTools WHOIS history, dating from 2003, shows the domain name to be registered to the Respondent. That fact alone is sufficient to resolve this dispute in favor of the Respondent. The Complainant thus does not advance a prima facie case. Nowhere does the Complaint address this obvious and glaring fact.

The domain name in question consists of a common English phrase “I can”, which is susceptible to many different users. While the Complainant provides no evidence of how it uses the alleged marks, nor any evidence of reputation or goodwill apart from its bare junior trademark registration, there is no question that “I can” is a common phrase which is not per se unique, distinctive or exclusive to the Complainant. Prior to any notice of a dispute, and indeed prior to any evidence of the existence of the Complainant or the Complainant’s trademark registrations, the Respondent had registered domain name in the belief that “I can” is an English phrase which may be useful for a variety of purposes. A Google search on the phrase “I can” turns up hundreds of thousands of results, from which any prominent mention of the Complainant is notably absent.

Prior to notice of a dispute, the domain name has been used for the following legitimate purpose. Nowhere does the Complainant address how the domain name has been used since 1998 – i.e. for the last 15 years – by the Respondent or Respondent’s licensee.

In 2001, the Respondent was approached by a party who desired to license and eventually purchase the domain name from the Respondent according to a time-structured purchase plan during which the Respondent licensed use of the domain name subject to the payment and escrow terms, and from which

proprietary commercial terms and identities of third parties have been redacted. Should the Panel require an unredacted copy of the agreement, the Respondent will provide it to the Panel only, pursuant to an appropriate Procedural Order. As stated therein, the purchaser was to make certain payments according to schedule, in the breach of which all goodwill in the purchaser's use of the domain name reverted to the Respondent.

Screenshots showing use of the domain name from 2001 to 2011 by the Respondent's licensee can be independently confirmed by the Panel using Screenshots.com or Archive.org. The Screenshots.com archive for the disputed domain name includes captures dating back to 2004. Representative screenshots from 2004 and 2007 show that the Respondent's licensee utilized the domain name for a news and information site relating to the disabled, which was entitled "iCan! The Leading Disability Community". The site was used by the Respondent's licensee from 2001 to 2011, a period of ten years, prior to any notification of a dispute.

As a supporter of its licensee's use of the domain name, the Respondent allowed a considerable period of time to elapse after the licensee had defaulted on the payment terms established by the purchase agreement. Nonetheless, on 23 August 2011, the Respondent sent a termination notice dated August 2011 to the Respondent's licensee, as the Respondent's licensee had defaulted on the payment terms of the agreement. Under the terms of the Agreement, the licensee's goodwill reverted to the Respondent. The domain name has remained registered to the Respondent, and has been kept in its present condition since 2011 in order to allow any remaining links-in, email address, and association with the Respondent's prior licensee to drop off before re-purposing the domain name.

A domain name registrant is perfectly entitled to license descriptive domain names to others and the fact that the Respondent's licensee was willing to undertake a substantial licensing arrangement is itself evidence that the domain name is a valuable commercial asset of the Respondent. The Respondent is well known for registration and use of such descriptive domain names.

Accordingly, the Respondent has registered and used a common phrase as a domain name in connection with a legitimate purpose for a substantial span of time prior to any evidence of a trade or service mark of the Complainant. The

Complainant does not at all address the Respondent's substantial use of the domain name for many years, and the Complaint does not allege that the Respondent's current maintenance of the domain name infringes any trade or service mark right of the Complainant. The burden under this criterion is for the Complainant to prove the utter absence of legitimate rights or interests of the Respondent accruing from use of the domain name prior to notice of a dispute. The Complainant does not even attempt to address what the Respondent has been doing with the domain name in the nearly 16 years since it was registered by the Respondent.

(3)Bad Faith

The final criterion of the Policy requires the Complainant to prove the domain name was registered and used in bad faith by the Respondent. This is an element of intent, requiring the Complainant to show that registration and use of the domain name was somehow predicated on knowledge of the Complainant and its alleged mark. Here, the Complainant, showing no evidence of a right or reputation of any kind prior to 2008, ridiculously claims that Respondent "registered it preemptively, clearly intending to make the public believe its website [...has a] relationship with the Complainants."

How is that even possible? Quite obviously, the Respondent registered the domain name in 1998 – ten years prior to the earliest evidence of a trademark registration presented in the Complaint. Accordingly, it is not possible for the domain name to have been registered in bad faith. The use to which the domain name has been put during the last 15 years is discussed in the previous section. The Complaint uses the word "preemptively" to suggest that the Respondent had some sort of responsibility to know and predict future events, and that someone else would want the domain name in a dispute filed nearly fifteen years later.

Are we seriously to believe that an adult of ordinary mental capability can make this accusation and expect to be believed, let alone a legal professional with a duty to exercise competence? The Complainant apparently expects this Panel to believe that the Respondent has psychic abilities to "preemptively" know the future actions of others, and registered this domain name in 1998 from its office in Oklahoma, because the Respondent knew that some unheard-of entity would claim trademark rights in Hong Kong in 2008. This type of nonsense should not be tolerated from grownups, and yet the Respondent has to address exactly this

type of abject foolishness on a regular basis.

The Complainant has made the insulting accusation that the Respondent is a cybersquatter on the basis of no rational theory whatsoever. The Complainant, knowing that the UDRP decisions are made public, intends its insult to the Respondent to be a public one. The operative facts here on the point of bad faith registration do not differ at all from other cases involving this Respondent, which any competent Complainant is able to determine in mere seconds from the UDRP search capabilities provided by UDRP providers, or even from a Google search of “Digimedia domain dispute”. The Respondent respectfully requests to know from this Panel whether or not there is any duty of diligence whatsoever binding upon complainants in these proceedings to do even that much, or any duty of competence to know the basics of the Policy under which a licensed legal professional engages to practice.

The domain name was obviously not registered in bad faith ten years prior to any claim of trade or service mark rights by the Complainant, and the Complainant makes no factual allegation supporting a claim of use in bad faith. Yes, the domain name is registered to the Respondent instead of the Complainant. While that does prevent the Complainant from using the domain name, the notion that the Complainant has some sort of retroactive, global and exclusive association with the phrase “I can”, of which the Respondent had some duty to predict ten years in advance, is a theme under the policy which will persist so long as Panelists continues to condone it. The Respondent had no legal duty to refrain from registering the domain name in 1998, nor to refrain from using it in any manner the Respondent had desired to use it since then. The Complaint advances no rational theory otherwise.

The Respondent thus requests the Panel to deny the Complaint and determine the existence of abuse of procedure by the Complainant under UDRP Rule 15(e).

4.Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

Paragraph 4(a) of the Policy requires that the Complainant should prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- 1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- 2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- 3) the domain name has been registered and is being used in bad faith.

Identity or Confusing Similarity

The evidence submitted by the Complainants shows that Complainant 1 registered the trademark “ICAN” in Hong Kong and Macau. As such, the Panel has no problem in finding that the Complainant 1 enjoys trademark rights in “ICAN”.

The disputed domain name is “ican.com”. As the suffix “.com” only indicates that the domain name is registered under this gTLD and is not distinctive, the main part of the disputed domain name is “ican”. Obviously, the main part of the disputed domain name is identical to the Complainant’s trademark “ICAN”.

Accordingly, the Panel holds that the Complaint fulfills the condition provided in Paragraph 4(a)(i) of the Policy.

Rights or Legitimate Interests of the Respondent

The Complainant contends that the Respondent does not have rights to or legitimate interests in the disputed domain name. The Complainant has never authorized the Respondent to use the trademark or the disputed domain name. The Complainant’s assertion is sufficient to establish a prima facie case under Policy 4(a)(ii), thereby shifting the burden to the Respondent to present evidence of its rights or legitimate interests. The Respondent needs to show one of the three circumstances under Paragraph 4(c) of the Policy, or any other basis for

rights or legitimate interests.

The Respondent has failed to show that the Respondent has any rights or legitimate interests in respect of the disputed domain name. The use of the disputed domain name by the Respondent after the registration, as shown by the evidence, is only to license to a third party for profits. The Respondent is not commonly known by the domain name. The evidence submitted by the Complainant further shows, as evidenced by the Respondent's submissions, that the Respondent is not making a legitimate noncommercial use of the disputed domain name. The act of registering the disputed domain name does not automatically endow any legal rights or interests with the Respondent.

This case involves a generic/dictionary phrase ('ICAN'). The Consensus view, as listed in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, provides that "Normally, in order to find rights or legitimate interests in a domain name based on the generic or dictionary meaning of a word or phrase contained therein, the domain name would need to be genuinely used or at least demonstrably intended for such use in connection with the relied-upon meaning." "To trade off third-party rights in such word or phrase" is explicitly exemplified as the use of domain name not in connection with the relied-upon meaning.

The Panel therefore finds that the Complaint fulfills the condition provided in Paragraph 4(a)(ii) of the Policy.

Bad Faith

Under Paragraph 4(b) of the Policy, the following are relevant examples a Panel may take as evidence of registration and use in bad faith:

- (i) Circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) You have registered the domain name in order to prevent the owner of the

trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) You have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) By using the domain name, you have intentionally attempted to attract, for commercial gain, internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

The Respondent registered the disputed domain name in 1998. The evidence shows that the earliest trademark "ICAN" was registered by Complainant 1 in 2008. No evidence whatsoever has been submitted regarding possible common law trademark rights over "ICAN" by the Complainants before 2008. Thus, it is evident that the Respondent registered the disputed domain name well before any trademark rights which the Complainant might establish.

The Consensus view, as listed in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, states explicitly that "Generally speaking, although a trademark can form a basis for a UDRP action under the first element irrespective of its date, when a domain name is registered by the respondent before the complainant's relied-upon trademark right is shown to have been first established (whether on a registered or unregistered basis), the registration of the domain name would not have been in bad faith because the registrant could not have contemplated the complainant's then non-existent right."

As such, the Panel finds that the Complainants failed to establish that the disputed domain name was registered in bad faith. Accordingly, the Panel finds that the Complaint fails to satisfy the condition provided in Paragraph 4(a)(iii) of the Policy. Since the Complainants need to establish all three elements required under the ICANN Policy, it follows that the Complainants' request cannot be supported in this case.

Reverse Domain Name Hijacking

The Respondent requests a finding of reverse domain name hijacking against the Complainants. “Reverse Domain Name Hijacking” is defined in Paragraph 1 of the Rules as “using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name.” It must be stressed that normally panelists have taken an extremely cautious attitude towards this issue.

Under Paragraph 15(e) of the Rules, 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 constitute an abuse of the administrative proceeding.

The onus of proving the Complainant’s bad faith is generally on the Respondent; the mere lack of success of the Complaint is not itself sufficient for a finding of Reverse Domain Name Hijacking. The Respondent would need to show knowledge on the part of the Complainant of the Complainant’s lack of relevant trademark rights, or of the Respondent’s rights or legitimate interests in, or lack of bad faith concerning, the disputed domain name.

In spite of the fact that the disputed domain name was registered before the registration of the trademark “ICAN”, the Panel in this case is not persuaded that the circumstances of this case justify a finding of reverse domain name hijacking.

The Complainants submitted a document issued by a law firm confirming the relationship between the two complainants and the role of Complainant 2 in the publicity and use of the “ICAN” mark. This serves as a prima facie case for Complainant 2’s rights and interests in this proceeding. The Respondent argues that Complainant 2 has no rights or interests in the “ICAN” mark; however, the Respondent did not submit any evidence supporting the argument. The Consensus view, as listed in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, provides that “In most circumstances, a licensee of a trademark or a related company such as a subsidiary or parent to the registered holder of a trademark is considered to have rights in a trademark under the UDRP. For the purpose of filing under the UDRP, evidence of such license and/or authorization of the principal trademark holder to the bringing of the UDRP complaint would tend to support such a finding.” Accordingly, this Panel

finds that Complainant 2 has rights and interests in the “ICAN” mark.

Although the earliest trademark “ICAN” was registered in 2008 in Hong Kong, the Complainants have already been using the trademark for the provision of services since their establishment before 2008. Through the years, the Complainants have achieved success in their businesses, which can be evidenced by the advertising materials, media coverage, and honor certificates submitted by the Complainants.

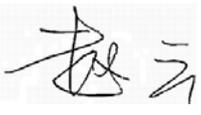
The evidence submitted by the Respondent shows that the Respondent also holds many other domain names. The mere act of registration does not automatically endow any legal rights or interests with the Respondent. The evidence before this Panel can only lead to the conclusion that the Respondent is making profits through licensing the domain name to a third party.

The Respondent argues that the Complainants’ case was hopeless and should never have been brought if further research work is done. Nowadays many cases, which appear so obvious to the panelists or one party, may not be the case to the other party. Circumstances when the WIPO panels have declined to find reverse domain name hijacking include: “the complainant’s argument under a required element of the UDRP fails, but not by such an obvious margin that the complainant must have appreciated that this would be the case at the time of filing the complaint;” “there is a question of clean hands or factual accuracy on the part of both parties.”

The Panel cannot find that the Complainants knew or should have known it would not succeed and thus declines to find that the Complainants have acted in bad faith, and so the Respondent’s application for a declaration to this effect is dismissed.

5. Decision

For the foregoing reasons, the Complaint is denied. The Respondent’s request for a finding of reverse domain name hijacking is also denied.

Panelist: 

Panelist: *See Ali*

Panelist: *Jan Barker*

Dated: 22 January 2014