

## **ADMINISTRATIVE PANEL DECISION**

**WGCZ S.R.O. v. Whois Privacy Services Pty Ltd. / Murat Yikilmaz**  
**Case No. D2014-0492**

### **1. The Parties**

The Complainant is WGCZ S.R.O. represented by Randazza Legal Group, United States of America (“US”).

The Respondent is Whois Privacy Services Pty Ltd. of Fortitude Valley, Queensland, Australia / Murat Yikilmaz of Istanbul, Turkey, represented by The Muscovitch Law Firm, Canada.

### **2. The Domain Name and Registrar**

The disputed domain name <xxnx.com> is registered with Fabulous.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 27, 2014. On March 28, 2014, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 1, 2014, 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 April 2, 2014 providing the registrant and contact information disclosed by the Registrar and invited the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 10, 2014.

The Center verified that 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 April 14, 2014. In accordance with the Rules, paragraph 5(a), the due date for Response May 5, 2014.

On April 22, 2014, the Complainant submitted a filing of Supplemental Evidence for consideration.

The Respondent filed its Response with the Center April 23, 2014.

The Center appointed Keith Gymer, M. Scott Donahey and Nicholas Smith as panelists in this matter on June 4, 2014. 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.

On June 16, 2014, the Complainant made a second supplemental filing, consisting of further submissions and evidence. The Respondent objected to this supplemental filing. The Panel declines to admit such extremely late submissions for consideration.

#### **4. Factual Background**

The Complainant is WGCZ S.R.O., a Czech registered company.

The Complainant operates a website for access to adult-oriented subject matter at "www xnxx.com".

The Respondent/registrant is Murat Yikilmaz, a Turkish individual, residing in Istanbul. The identity of the Respondent was originally concealed with the Whois record for the disputed domain name, < xnxx.com >, providing only a Customer ID number for Whois Privacy Services Pty Ltd. The Respondent's true identity was duly provided by the Registrar on request pursuant to the Policy.

The Whois record shows a Creation Date: 2002-11-30 (November 30, 2002) on the current record for the disputed domain name, and 2002-11-29 (November 29, 2002) on the Whois record shown for 2011-02-02 (the Panel assumes this apparent difference may be a consequence of records being taken from a different time zone base).

A website with links to adult-oriented content is operated at "www xnxx.com".

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant says that it owns and operates the domain < xnxx.com >, and has used this domain for several years in connection with the provision of adult entertainment services on the World Wide Web.

##### **Rights**

The Complainant asserts that such use has been sufficient, such that the Complainant has both acquired registered trademark rights and developed extensive common law trademark rights in the XNXX.COM mark.

In the Complaint, the Complainant cites USPTO Registration No. 4,363,782 for XNXX.COM (filed September 18, 2012; registered July 9, 2013), as *prima facie* evidence of rights under the Policy.

In its Supplemental Evidence filing, the Complainant further cites Community Trade Mark ("CTM") registrations 11946217 (for XNXX) and 11946134 (for an XNXX figurative mark), both filed July 1, 2013 and registered November 26, 2013, originally in the name of VLAB Limited, a Hong Kong company, with notices of assignment to the Complainant duly recorded by OHIM as of December 17, 2013.

The Complainant also claims to have extensive common law rights in the XNXX.COM mark acquired before the Respondent registered the disputed domain name, alleging that it has been using the XNXX.COM mark in international commerce in connection with adult entertainment services on the World Wide Web since at least 2004. It says that the Complainant's predecessor-in-interest first acquired the < xnxx.com > domain name as of February 22, 2003.

The Complainant submits a record of Archive.org's Wayback Machine caches for 2004; a number of news articles; some data from Google Trends; and information from Alexa Internet regarding website traffic, in support of its contentions. It says "Today, <xnxx.com> is one of the most popular adult entertainment websites in the world" and that it is currently the 102nd most visited website globally and 108th in the US.

### **Confusing Similarity of disputed domain name**

According to the Complainant, the disputed domain name is nearly identical to the Complainant's XNXX.COM mark, containing the same letters and the same number of letters. The only difference is that the second and third letters are transposed. The potential for confusion between the disputed domain name and the Complainant's mark is obvious, as is the potential for even a proficient typist to arrive at the Respondent's website inadvertently. See, e.g., *WNYC RADIO v. Mike Morgan*, WIPO Case No. D2006-1285 (finding that merely transposing two letters in the mark WNYC "is not sufficient to avoid the likelihood of confusion between the domain name and Complainant's mark").

### **The Respondent has No Rights or Legitimate Interests**

The Complainant alleges that the Respondent has no rights or legitimate interests and is not making a legitimate noncommercial or fair use of the disputed domain name.

The Respondent is using the disputed domain name for a commercial purpose, as its <xxnx.com> website contains links and advertisements to third party websites that compete with the Complainant. The Complainant's "www.xnxx.com" website offers adult entertainment services. The Respondent's website simply provides links to *other* adult entertainment websites as a pay-per-click site keyed to take advantage of the Complainant's rights. There is no descriptive element to the XNXX nor the XXNX domain names that would make such a use by the Respondent a good faith use.

The Complainant claims that the Respondent's website operates as a typosquat to redirect Internet users looking for the Complainant's site to other websites. The site exists only to guide Internet users seeking the Complainant's goods and services to other websites, including the Complainant's competitors. It does this by using an extremely common mistyping of the Complainant's XNXX.COM mark to redirect customers to its site, and then generate pay-per-click revenue.

Nor, it is said, can the Respondent claim any rights or legitimate interests to the disputed domain name based on familiarity with either the general public or the relevant market. No evidence indicates that the Respondent is commonly known by the text of the disputed domain name, and the Panel should presume that the Respondent is not known by the text of the disputed domain name.

The Complainant claims that "XNXX" is a coined term with no inherent meaning – the strongest kind of trademark – and considers it is inconceivable that that the Respondent has any legitimate argument as to why it registered a domain name differing from the Complainant's mark only in the arrangement of two letters except to profit from the mis-typings of Internet users. The Respondent purchased <xxnx.com> for the purpose of redirecting users from the Complainant's website and profiting from their confusion.

### **Registration and use in bad faith**

The Complainant alleges that the Respondent took possession of the disputed domain name on January 23, 2011, and that "It appears that the Respondent acquired the domain from another well-known cybersquatter, Greg Ricks, in 2011."

It says that by 2011, long after the registration of <xnxx.com> and the Complainant's use in commerce, and the accrual of common law rights in the XNXX.COM mark, it is inconceivable that the Respondent was not aware of the XNXX.COM mark, given its international prominence in the adult entertainment world. The Complainant submits a single Wayback Machine cache image from April 29, 2011 as evidence that lack of awareness is more unlikely as immediately after this alleged registration date, the Respondent began using the domain to run a website with links to competing adult services.

The Complainant argues that the Respondent registered and used the disputed domain name not because it refers to or is associated with the Respondent, but because the disputed domain name is confusingly similar to the <xnxx.com> domain name and XNXX.COM mark used by the Complainant in association with the Complainant's provision of adult entertainment services on the World Wide Web. The Respondent is profiting financially from the disputed domain name, and chose the <xxnx.com> domain name to profit from the goodwill of the Complainant's XNXX.COM mark.

The Complainant claims that it has common law rights, which were well established in 2004; that the Complainant's mark was well known in 2004, and it had both become federally registered with the USPTO and internationally recognized by 2012. Even if the Panel disagrees that the Complainant's common law rights had accrued at the date of registration, the Complainant asserts that even speculative registration is bad faith registration. See *Facebook Inc. v. Privacy Ltd. Disclosed Agent for YOLAPT*, WIPO Case No. D2007-1193.

It says that the Respondent desired to disrupt the Complainant's business and to divert Internet traffic away from the Complainant's "www.xnxx.com" website when Internet users mistakenly arrived at it after searching for the term "xnxx" on an Internet search engine, and then profit when Internet users followed the links on its website. In other words, the Respondent hoped to create confusion amongst the consuming public as to the source, sponsorship, affiliation, or endorsement of the website located at <xxnx.com>.

Since XXNX and XNXX are so confusingly similar, the likelihood of confusion between the two is obvious. The fact that the Respondent uses the infringing domain name to offer links to directly competing services, without so much as a disclaimer, makes it clear that confusion will occur – and has likely occurred, and was the Respondent's intention.

### **Remedy Requested**

The Complainant requests that the disputed domain name be transferred to the Complainant.

### **B. Respondent**

The Respondent submits as pertinent evidence an extract from a Czech Register of Economic Entities showing that the Complainant, WGCZ S.R.O. was only established on December 20, 2012.

The Respondent first claims to have registered the disputed domain name, <xxnx.com>, on or about November 29, 2002, and submits what are said to be the earliest available historical Domaintools.com Whois records, showing the Respondent, Murat Yikilmaz, as the recorded registrant, administrative, billing, and technical contact, for the disputed domain name, as of August 17, 2004, with a creation date of November 29, 2002. It points out that this is far earlier than "January 23, 2011", which was expressly alleged by the Complainant as the Respondent's date of registration.

The Respondent also submits a sworn Declaration of Mr. Yikilmaz (in Turkish with a certified English translation), where the Respondent, Mr. Yikilmaz himself, states that he is 100% sure that he registered the disputed domain name on or about November 29, 2002, and that he has owned it continuously since then. When he originally registered the disputed domain name in 2002, he claims to have used the registrant name of "Dekarus net Inc"., which was subsequently changed to his current registrant profile, namely, "Murat Yikilmaz", in 2003 or 2004, consistent with the 2004 historical Whois records.

The Respondent submits a cache history and related email correspondence obtained from the Archive.org Wayback Machine alleged to show that the Respondent controlled the website associated with the disputed domain name, as of September 27, 2003, at the latest.

In any event, whether the Respondent's original registration was as early as 2002 or as late as 2003, the Respondent notes that both of these dates are:

- a) prior to the Complainant's existence in 2012 (see further below);

- b) prior to the Complainant's claimed earliest common law trademark rights dating from 2004;
- c) prior to the US application's 2012 filing date; and
- d) prior to the US registration's 2013 registration date.

Even if the earliest available historical Whois report from August 17, 2004 is accepted as establishing the Respondent's earliest registration date in 2004, the Respondent claims that date is still prior to any trademark rights being demonstrated by the Complainant.

According to the Respondent's Declaration, he registered the disputed domain name because it was a short, and relatively scarce and valuable, four-letter domain name and potential acronym. The Respondent is the owner of other three and four-letter domain names that are generic or descriptive in nature, including such as <xxx.com>, <xxxl.com>, and asserts that he did not register this particular four-letter domain name in order to target anyone. As set out in the Declaration, his motivation in registering the disputed domain name was because of its value as a four-letter domain name that was generic in nature, and not because of any trademark value, which in any event, did not even exist at that time in 2002, or even in 2004.

The Respondent claims to have provided a reasonable explanation for his registration of the disputed domain name, establishing a legitimate interest and good faith registration of the disputed domain name.

### **Complainant's Rights**

The Respondent observes that the US trademark registration cited by the Complainant does not show the Complainant as the registrant. The US trademark registration certificate on its face, shows that the registrant is "VLAB Limited", a Hong Kong company, and not the Complainant. No assignment agreement in respect of this trademark has been submitted that would explain this discrepancy. The Complainant cannot rely upon a trademark that is apparently registered to another entity, and as such, the Complainant has not proven that it is the owner of any registered trademark rights.

In the absence of any registered trademark rights as aforesaid, the Complainant must be able to demonstrate common law trademark rights under the Policy. However, the Respondent asserts that even the Complainant's claim of "extensive common law trademark rights" is wholly deficient in a number of material and crucial respects, as detailed below:

#### **a) Failure to Prove Ownership of Common Law Trademark Rights**

The Complainant states that the "Complainant has been using the XNXX.COM mark since at least 2004", but the Complainant was only incorporated on December 20, 2012, according to the records. Additionally, the Hong Kong company, VLAB Limited, that is the recorded owner of the USPTO registration (dated, July 9, 2013) as aforesaid, was even itself not incorporated until May 30, 2006, as evidenced by Hong Kong corporate search records, making it impossible for this company to have "been using" the mark since 2004 as alleged. Neither of these two corporate entities was even in existence in 2004. Consequently, the Complainant's claim that it has "been using" its purported mark since 2004, is unsubstantiated and contradicted by the available evidence.

#### **b) Failure to Show Chain in Title to Purported Common Law Rights**

Even if the Complainant itself could not have possibly have used the purported mark since 2004 as claimed, the Complainant has not provided any evidence to establish any chain of title to common law trademark rights which might, ostensibly, support a claim that it is the recipient of an assignment of the purported common law rights from earlier on. In the absence of any evidence proving that the Complainant was conveyed such common law trademark rights, there is no basis to conclude that it has any such rights, particularly when the Complainant was not in existence at the purported time that these common law rights supposedly arose, namely, in 2004.

**c) Acquisition of Domain Does Not Amount to Acquisition of Common Law Trademark Rights**

The Complainant alleges that the “Complainant’s predecessor-in-interest [unidentified] acquired the <xnxx.com> domain name on February 22, 2003”. The Complainant is alleging that the unspecified party that owned the disputed domain name prior to the Complainant, itself acquired it from yet another party, in 2003. Accordingly, in the same manner that the Complainant failed to prove any chain of title to purported common law trademark rights, the Complainant has failed to explain its purported chain of title to its domain name. Moreover, the acquisition of a mere domain name, does not amount to acquisition of common law rights. As WIPO acknowledged in its Final Report of the WIPO Internet Domain Name Process:

“It is further recognized that the goal of this WIPO Process is not to create new rights of intellectual property, nor to accord greater protection to intellectual property in cyberspace than that which exists elsewhere.”

Accordingly, without some evidence that there was a conveyance of common law trademark rights and goodwill (apart from a mere domain name assignment), from the original registrant to the Complainant’s predecessor, and finally to the Complainant itself, there is simply no basis for concluding that any such conveyance of common law trademark rights occurred.

**d) Failure to Prove Common Law Rights Themselves**

Even assuming that an actual assignment of common law trademark rights in favour of the Complainant existed, the Complainant has failed to prove the existence of any common law trademark rights themselves. Here, the Complainant has not submitted any evidence of the income or sales produced in association with the purported common law trademark, volume of customers or of Internet traffic associated with the purported common law trademark, or any volume or scope of advertising and marketing associated with the purported common law trademark. In the absence of “strong and serious evidence”, the Complainant has not proven the existence of common law trademark rights.

**e) No Common Law Trademark Rights Prior to the Disputed Domain Name Registration**

The very limited evidence that the Complainant does provide, does not establish common law trademark rights going back to sometime in 2004, being the date that the Complainant expressly claims as the original date of the purported acquisition of common law rights. The Respondent observes that the various third-party documents cited by the Complainant relate to dates significantly later than that, and offer only limited support for the Complainant’s claims to have any common law trademarks rights, let alone any such rights from 2004, as alleged. The Complainant’s reference to Google Trends may arguably show that “xnxx.com” has been searched to some degree on Google since 2004, but that it has only recently become a more common search term, suggesting that in fact the <xxnx.com> domain name was *not* widely known in 2004. There is no data whatever showing any searches prior to 2004, and back to 2002, when the disputed domain name was first registered by the Respondent. There is no evidentiary basis for the Complainant’s allegation that “by 2004, Complainant’s use of XNXX.COM as a trademark... was extensive”. The Complainant has failed to sufficiently demonstrate common law trademark rights, let alone common law trademark rights going back to 2002, or even 2004.

**f) No Common Law Trademark Rights Alleged from 2002 or 2003**

Finally, the Complainant has not alleged in its Complaint, that it had acquired common law trademark rights prior to 2004, *i.e.* in 2002 or 2003. That means that the Complainant has not alleged that it had any trademark rights prior to the Respondent’s registration of the disputed domain name.

**Whether the Respondent has Rights or Legitimate Interests**

The Complainant has alleged that the Respondent has no rights or legitimate interest in the disputed domain name. In the particular circumstances of this case, the Complainant itself does not appear to have demonstrated any registered trademark rights, or even sufficiently demonstrated common law trademark

rights, let alone for the material time period, of prior to the disputed domain name having been registered. Accordingly, the Respondent submits that since the Complainant has failed to satisfactorily demonstrate its own rights, that the Panel need not even consider the question of the Respondent's rights and legitimate interest.

However, the Respondent claims to be able to demonstrate its rights and legitimate interest. Pursuant to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), at paragraph 2.2,

"factors a panel tends to look for when assessing whether there may be rights or legitimate interests would include the status and fame of the trademark, whether the Respondent has registered other domain names containing dictionary words or phrases, and whether the domain name is used in connection with a purpose relating to its generic or descriptive meaning".

In the present case, there is no evidence of any fame of the mark at the time that the disputed domain name was registered, but there is evidence of the Respondent registering similar three and four-letter domain names. The disputed domain name comprises four letters of the English alphabet resembling an acronym, and is thereby generic. It has been held that where a domain name is generic, the first person to register it in good faith is entitled to the domain name. The Respondent asserts that this may be considered a "legitimate interest".

Furthermore and in the alternative, the Respondent respectfully submits that speculating and investing in generic and descriptive domain names is a legitimate and well-established business, and that in and of itself, it may confer a "legitimate interest" in such a domain name, pursuant to the UDRP. As held in *Allocation Network GmbH v. Steve Gregory*, WIPO Case No. D2000-0016, "such a practice [trading in valuable generic and descriptive domains] may constitute use of the domain name in connection with a *bona fide* offering of goods or services (*i.e.* the sale of the domain name itself)."

The Respondent is the owner of numerous similar three and four-letter domain names, many of which are acronyms, descriptive words, or generic in nature. Accordingly, it is respectfully submitted that the Respondent has a legitimate interest in the disputed domain name as a *bona fide* dealer in such descriptive and generic names.

In the further alternative, the Respondent argues that since the disputed domain name comprises a variation of the well-known "XXX" or "triple-x" descriptive moniker denoting adult content, as aforesaid, the Respondent's use of the disputed domain name for links to adult material of a triple-x nature, is an obvious and natural use, and is an appropriate use of the domain name constituting a legitimate interest, even when pay-per-click advertising is employed.

### **Whether the Disputed Domain Name was Registered and Used in Bad Faith**

The Complainant has claimed that the "Respondent's registration of the infringing domain name in 2011 was unquestionably in bad faith", based on the Complainant's claims to have established relevant rights itself well before that date.

The Respondent reiterates that the disputed domain name was not registered in 2011 as alleged, but rather in 2002, with corroborative evidence showing 2003 at the latest, and indisputable evidence from August 17, 2004. The Complainant is simply wrong when it alleges that the disputed domain name was registered in 2011.

Accordingly, the Respondent asserts that the basis for the Complainant's allegation of bad faith registration is erroneous.

The question necessarily becomes whether there is evidence that the Complainant had any relevant prior trademark rights as of November 29, 2002, (accepting the sworn Declaration's evidence), or on July 29, 2003 (alternatively, accepting the Archive.org code evidence), or even as late as August 17, 2004,

(alternatively, accepting the earliest-available DomainTools archive evidence).

The Respondent's position is that the US registered trademark relied upon by the Complainant apparently does not belong to it, but even if it does, it was not applied for until 2012, and was not registered until 2013, so it is irrelevant. The Complainant has not alleged, let alone proven, that it had any prior common law trademark rights dating from 2002 or 2003 nor shown any actual evidence of common law rights dating back to 2004, or prior to the earliest recorded Whois archive, from August 17, 2004.

The Complainant's allegation that the Respondent could be guilty of "speculative registration in bad faith" is also rebutted. The trademark registration that the Complainant references in connection with this allegation, is irrelevant, not only because it does not apparently belong to the Complainant, but also because its date of application is years later than the date of the disputed domain name registration. There can be no possible issue of "constructive notice of the Complainant's trademark application or registration", as alleged.

The Respondent asserts that it is well settled under the Policy that bad faith registration cannot be found if the disputed domain name was registered prior to the acquisition of trademark rights. See *Aspen Grove, Inc. v. Aspen Grove*, WIPO Case No. D2001-0798 (finding that it is "impossible" for the Respondent to register disputed domain name in bad faith if the Complainant company did not exist at the time of registration).

Without any evidence of "bad faith registration", the Respondent submits that an examination of "bad faith use" is irrelevant, and in any event, any claim of infringement of the Complainant's trademark rights is outside the scope of the Policy.

In the present case, there is no evidence that at the time of registration, there was any intention to capitalize on the Complainant's mark, if it existed at all at that time.

### **Reverse Domain Name Hijacking**

The Respondent considers this Complaint is unusual in that it made three crucial and foundational submissions, that turned out to be incorrect, namely:

- a) the trademark registration that it principally relied upon appears to be registered to someone else;
- b) the disputed domain name was clearly not registered 2011, as alleged; and
- c) despite various bald allegations, no actual evidence of common law trademark rights was submitted from the material time period of the actual date of registration of the disputed domain name.

It argues that the Complainant ought to have known that its case was fatally weak and that its arguments fell well short of advancing a colorable right so that a finding of Reverse Domain Name Hijacking ("RDNH") may be made.

The Respondent further alleges that the Complainant failed to advise the Panel that it had previously tried to purchase the disputed domain name. Where a complainant fails to disclose material evidence such as the fact that it made or caused to be made, offers to purchase a disputed domain name, RDNH may be found.

In support of this allegation, the Respondent submits copies of email correspondence dated June 23, 2005, purportedly sent by a party named "nophest", with an email address using the Complainant's domain name and trademark, to the Respondent and claiming that the sender was "interested in buying [the Respondent's] domain xxnx.com", and asking the Respondent to "Let [him] know how much [the Respondent] want[s] for it".

The Respondent claims not to have replied to this solicitation, and asserts that this Complaint amounts to an attempt to use the Policy as an "alternative purchase strategy", so that a finding of RDNH may be made (see *X6D Limited v. Telepathy, Inc.*, WIPO Case No. D2010-1519).

## 6. Discussion and Findings

In order for a panel to decide to grant the remedy of transfer or cancellation of a domain name to a complainant under the Policy it is necessary that the Complainant must prove, as required by paragraph 4(a) of the Policy, that

- (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. Identical or Confusingly Similar

It is an essential requirement that the Complainant should demonstrate that it has rights in a trademark or service mark.

The Complainant provided evidence of a US trademark registration 4,363,782 for the mark XNXX.COM.

However, as the Respondent rightly observed, the evidence showed this registration to be in the name of another entity, VLAB Limited, not the Complainant, and the Complainant offered no evidence of any assignment or licence from this entity. The Panel therefore considers this registration not to be relevant under the Policy.

The Complainant otherwise asserted, in the original Complaint, that it had established unregistered, common law rights in XNXX.COM "at least since 2004". Some limited evidence was entered in support of this assertion.

However, the Respondent has challenged the validity of this assertion and the nature and extent of the evidence. In particular, it is to be noted that:

- a) the Complainant was not itself established until December 20, 2012;
- b) there is no evidence of any assignment of any common law rights (*i.e.* goodwill and unregistered trademark rights) from any alleged predecessor(s) in title (none of which are identified by the Complainant in the Complaint itself);
- c) the evidence of any use or reputation is scanty, relying on very limited statements from a few online reports.

The Panel shares the Respondent's scepticism regarding the Complainant's claim to have common law rights dating from 2004.

With respect to claims to common law rights, the WIPO Overview 2.0 (at paragraph 1.7) summarises the position:

"The Complainant must show that the name has become a distinctive identifier associated with Complainant or its goods or services. Relevant evidence of such "secondary meaning" includes length and amount of sales under the trademark, the nature and extent of advertising, consumer surveys and media recognition."

The Complainant's evidence of any common law rights at all is minimal and unconvincing (the presentation of the evidence as pdf screenshots (as received by the Panel), in some cases very small and of such poor resolution as to be almost wholly illegible (e.g. the Napoli Monitor article) when magnified, was also unhelpful).

Consequently, the Panel is not satisfied that the Complainant has established any claim to common law rights in XNXX.COM pre-dating its own earliest possible date of acquisition of the <xnxx.com> domain name, which, as the Complainant was itself incorporated on December 20, 2012, could not have been any earlier

than that date.

The Complainant's Supplemental Evidence, filed immediately prior to the Response, does show that the Complainant had subsequently acquired two CTM registrations for XNXX marks (plain text and figurative forms) from VLAB Limited, as recorded by OHIM as at December 17, 2013. The actual assignment documents are not exhibited, so again there is no evidence of any transfer of common law rights in these marks. In the circumstances, the Panel is prepared to accept that this late filed evidence would establish registered trademark rights only for the Complainant as from July 1, 2013, being the date the CTM applications were filed.

For the purposes of this element of the Policy, which only requires that the Complainant show it has rights in a mark, not that the rights arose before the registration of the disputed domain name, the Panel considers that the Complainant has trademark rights in XNXX and potentially XNXX.COM. The disputed domain name <xxnx.com> differs only by transposition of the same second and third letters. It is confusingly similar.

On balance, therefore, the Panel is prepared to find that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights, and that the requirements of paragraph 4(a)(i) of the Policy are met.

### **B. Rights or Legitimate Interests**

Under paragraph 4(c) of the Policy, any of the following circumstances, (by way of example) might serve to demonstrate a respondent's rights or legitimate interests to a domain name for the purposes of paragraph 4(a)(ii) of the Policy:

- (i) before any notice to the respondent of the dispute, 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) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate non-commercial 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.

In the present case, the Respondent claims that the disputed domain name was registered as one of a number of generic three and four letter domain names with no obvious recognised meanings, for potential use in connection with the Respondent's admitted business in speculating and investing in such domain names. It also claims that domain names with "triple x" elements like <xxnx.com> are natural candidates for adult entertainment services, implying that it would be reasonable for the Respondent to have use the domain name for such services just as the Complainant does for <xnxx.com>.

The Respondent has shown one example of the domain name apparently being used for a conventional holding page with links to various search categories as of September 27, 2003. If the Respondent's claims to have owned the disputed domain name at that time are accepted, then that would also support a claim to legitimate use.

However, for the reasons explained below, the Panel does not consider it necessary to take a view on this factor, and leaves it moot.

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

Paragraph 4(a)(iii) of the Policy requires the Complainant to show both that the disputed domain name was registered and that it has been used in bad faith.

Under paragraph 4(b) of the Policy, the following are examples of the sort of conduct (without limitation) which, if found, shall be considered as evidence of registration and use in bad faith:

- “(i) circumstances indicating that [the Respondent has] registered or [has] 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 [the Respondent’s] documented out-of-pocket costs directly related to the domain name; or
- (ii) [the Respondent has] 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 [the Respondent has] engaged in a pattern of such conduct; or
- (iii) [the Respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, [the Respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent’s] website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the Respondent’s] website or location or of a product or service on [the Respondent’s] website or location.”

The Complainant has certainly presented a *prima facie* case that the Respondent’s use of the disputed domain name, apparently since at least April 29, 2011, for a website with links to adult content may constitute bad faith use pursuant to 4(b)(iv) above.

The Complainant says that the Respondent only acquired the disputed domain name as of January 23, 2011, and asserts that this was from “another well-known cybersquatter, Greg Ricks”. The Complainant thereby implies that the Respondent is also a “well-known cybersquatter”. No evidence has been presented at all to support either the purported acquisition of the disputed domain name from a “Greg Ricks”, or that the Respondent and said gentleman might each be classed as a “well-known cybersquatter”.

The Complainant’s assertion of the January 23, 2011 acquisition date appears to rely only on the reference on the submitted Domain Tools Whois record to the disputed domain name record being “Updated: 2011-01-23”. No evidence is provided to show that this update related to a change of registrant. The update made at that time could have been to any other element of the domain name record. Without more, the Complainant’s assertion of this date as the date of acquisition by the Respondent is merely unsupported speculation.

Taking account of the evidence presented by each party, the relevant chronology appears to be:

- |                      |   |
|----------------------|---|
| November 29/30, 2002 | Creation date for the disputed domain name <xxnx.com> - according to the Respondent, initial registration is to “Dekarus net Inc”, a business associated with the Respondent; |
| 2003-2004            | The Respondent changes name of initial registrant for <xxnx.com> to the Respondent personally;  |
| February 22, 2003    | The Complainant’s unnamed predecessor in interest acquires <xnx.com>  |
| September 27, 2003   | Evidence that the Respondent controls the disputed domain name at this date.  |
| June 2004            | The Complainant claims common law trademark rights arise from use of <xnx.com> - from Internet archive this appears to be earliest date for an active website at <xnx.com>;   |
| August 17, 2004      | Earliest Whois record that the Respondent is registrant of the domain name;   |
| December 2004        | Google Trends show some increase in interest in “xnx.com”;  |
| May 30, 2006         | VLAB Limited (Complainant’s immediate predecessor) incorporated in Hong Kong;   |

September 18, 2012	US trademark application for XNXX.COM filed in name of VLAB Limited;
December 20, 2012	The Complainant incorporated in Czech Republic;
July 9, 2013	US trademark application for XNXX.COM registered in name of VLAB Limited;
July 1, 2013	CTM applications filed for XNXX marks in name of VLAB Limited;
November 26, 2013	CTM registrations granted for XNXX marks in name of VLAB Limited;
December 17, 2013	Assignment of CTM registrations to the Complainant recorded by OHIM.

In the Panel's view, if the disputed domain name was registered before any trademark rights arose it is unlikely that bad faith registration can be imputed, unless the Respondent can be shown clearly to have been aware of the Complainant, and that the aim of the registration was to take advantage of the potential for confusion between the disputed domain name and any potential rights the Complainant may have acquired.

In the Panel's opinion, the evidence is insufficient to show that the Respondent registered the disputed domain name either in awareness of the Complainant or in order to take advantage of any potential for confusion between the disputed domain name and any rights held by the Complainant, whether potential or actual at that time.

On the balance of probability, the Panel accepts that the Respondent controlled the disputed domain name, whether it was in his own name, or as Dekarus net Inc, by September 27, 2003, and that it is also more likely than not that the Respondent was responsible for the creation of the disputed domain name in 2002. Both of these dates are well before the Complainant's unnamed predecessor in title is alleged to have commenced use of <xnxx.com>, and so the Respondent could not have registered the disputed domain name in bad faith.

Even if the Respondent is considered only to have formally registered the disputed domain name in his own name by August 17, 2004, that was barely two months after the Complainant's unnamed predecessor allegedly began commercial use of <xnxx.com>, there is no evidence that the Respondent was aware of the Complainant at the time or that it registered the disputed domain name <xxnx.com> intending to take advantage of the Complainant, rather than as part of a business plan of registering a series of generic or descriptive domain names. The Panel finds it improbable that the Complainant's <xnxx.com>, which had only operated for 2 months, would have established such a reputation that a Turkish domain name trader would have been prompted to register <xxnx.com> to take advantage of the similarity with <xnxx.com>, rather than as part of an independent business strategy to register generic or descriptive domain names, which by itself is not a bad faith activity.

Conversely, in order find registration in bad faith, Panel would have to ignore the Respondent's evidence about his 2002 registration, his control of the disputed domain name in 2003, assume that he only registered the domain name in August 2004, and find that he did so with intent to take advantage of "www.xnxx.com", a site that had only begun to trade little more than two months previously, and did not pick up in popularity until years later, and accept the Complainant's claim to be successor in title to common law rights established at that time (in the absence of any supporting evidence of any transfer of such rights between at least two previous owners and operators of the <xnxx.com> domain name).

Overall, the Panel considers that the Complainant has failed to discharge its burden to prove all elements required under the Policy, and its case relies on too many unsupported assumptions and presumptions to justify a finding of bad faith registration.

Whilst the Complainant may believe it has a case for referring to the disputed domain name as an "Infringing Domain Name" having regard to the Complainant's current trademark rights and the nature of the Respondent's current use of the disputed domain name, such allegations of trademark infringement are not

a matter for determination by the Panel under the Policy. And although such use might arguably be considered as bad faith use now, the Panel does not accept that the disputed domain name can be retrospectively deemed to have been registered in bad faith in the circumstances of this case.

Consequently, the Panel finds that the Complaint fails on this basis. It is therefore unnecessary for the Panel to come to a formal conclusion on legitimacy or otherwise of its alleged interests in the disputed domain name as noted above.

### **Reverse Domain Name Hijacking**

The Respondent's request for a finding of Reverse Domain Name Hijacking ("RDNH") alleges vexatious prosecution of this Complaint and lack of disclosure of a purported previous attempt to purchase the disputed domain name.

The evidence of the previous purchase attempt comprises a copy of an email enquiry dating from 2005 alleged to come from an email address within a subdomain of the Complainant's <xnxx.com> domain name. That was of course before the present the Complainant was even in existence. Given the ease in which email addresses can be spoofed, and without evidence of the actual email header details, the Panel does not find this sufficient to lay responsibility on the Complainant now. However, it would appear to show that the Respondent was made aware of the Complainant's (or one of its predecessors) website in 2005, so that any subsequent changes to the Respondent's own website using the disputed domain name, will have been made with prior knowledge of the Complainant's use.

Overall, whilst the evidence supporting the Complainant's case was undoubtedly weak and incomplete, the Complainant certainly has competitive grounds for objection to the Respondent's use, and the Complaint cannot be considered to be so entirely frivolous as to merit a finding of RDNH. The Panel therefore declines to make such a finding.

### **7. Decision**

For the foregoing reasons, the Complaint is denied. The Respondent's request for a finding of RDNH is also denied.



**Keith Gymer**  
Presiding Panelist



**M. Scott Donahey**  
Panelist

I concur in the result. Complainant has failed to prove bad faith under all the facts and circumstances of this case.



**Nicholas Smith**  
Panelist  
Date: June 17, 2014