

AMERICAN ARBITRATION ASSOCIATION
INTERNATIONAL CENTRE FOR DISPUTE RESOLUTION

OPENTLD B.V.,) ICDR CASE NO. 01-15-0004-1379
)
)
Claimant,)
)
v.)
)
INTERNET CORPORATION FOR ASSIGNED)
NAMES AND NUMBERS,)
)
)
Respondent.)
_____)

**DECLARATION OF OWEN SMIGELSKI IN SUPPORT OF ICANN'S RESPONSE TO
CLAIMANT OPENTLD B.V.'S REQUEST FOR A STAY OF THE SUSPENSION**

Jeffrey A. LeVee
Kate Wallace
JONES DAY
Contact Information Redacted

Counsel to Respondent
The Internet Corporation
For Assigned Names and Numbers

DECLARATION

I, Owen Smigelski, declare:

1. I am a Director, Contractual Compliance for the Internet Corporation for Assigned Names and Numbers (“ICANN”) and have held this position since 2014. I have been employed by ICANN since 2012, and served as Contractual Compliance Manager between 2012 and 2013, and Senior Manager, Contractual Compliance between 2013 and 2014. As a Director, Contractual Compliance, I am responsible for, among other things, oversight and management of the processing of all registrar complaints, enforcement for registrars and registries (such as notices of breach and suspension), and management of ICANN’s Contractual Compliance complaint processing system. I have personal and first-hand knowledge of the matters set forth herein. I make this declaration in support of ICANN’s Response to the Request for a Stay of the Suspension (“Stay Request”) filed on 7 July 2015 by claimant and ICANN-accredited registrar OpenTLD B.V. (“OpenTLD”).

2. ICANN currently has over 1,700 accredited registrars, each with a Registrar Accreditation Agreement (“RAA”) in effect. ICANN has had three versions of the RAA, which respectively took effect in 2001, 2009, and 2013. Currently, there are no registrars operating pursuant to the 2001 RAA; approximately 200 operate pursuant to the 2009 RAA, and approximately 1,500 operate pursuant to the 2013 RAA. All of the 2009 RAAs in effect are identical to each other, and all of the 2013 RAAs in effect are identical to each other, regardless of the characteristics of the registrar, so that contractual compliance efforts can be carried out in a consistent manner across all registrars operating under the same RAA. Each version of the RAA has included additional responsibilities and obligations of the registrars to ensure the security and stability of the Internet, and to protect domain name registrants. All registrars must comply with all provisions of their RAA, which incorporate the ICANN Consensus Policies (which include the Uniform Domain Name Dispute Resolution Policy (“UDRP”), the Inter-Registrar Transfer Policy,

and the Expired Domain Deletion Policy (“EDDP”). The goal of ICANN’s Contractual Compliance function is to ensure that ICANN’s contracted parties fulfill the requirements set forth in their agreements with ICANN (including the ICANN Consensus Policies). As a Director, Contractual Compliance at ICANN, I oversee all enforcement activities concerning registrar compliance with the RAA.

3. Each registrar’s RAA with ICANN, including OpenTLD’s RAA, applies only to generic top-level domains (“gTLDs”). That is, pursuant to the RAA, OpenTLD, as an ICANN-accredited registrar, may offer consumers domain name registrations at the second level of a gTLD for which they are authorized¹. The RAA does not govern domain name registrations in any country-code top level domains (“ccTLDs”). Accordingly, ICANN’s Contractual Compliance function has no authority to mandate that registrations in ccTLDs are managed in accordance with any provision or policy that is embedded in any version of the RAA.

4. ICANN receives monthly reports from every gTLD registry, and this information is used by an internal Registrar Status tool that ICANN staff can use to determine how many gTLD domain names are registered monthly by each registrar in each gTLD. The monthly report data remains confidential for a period of time; ICANN publishes the reports three months after the report month. By using the Registrar Status tool, I am able to determine the number of gTLD domain name registrations a registrar had at the end of any month since October 2009 by searching the tool by registrar name. On 3 August 2015, I executed the above-described query for OpenTLD and found that OpenTLD had 4,386 gTLD domain name registrations in the month of May 2015.

5. As part of ICANN’s contractual compliance efforts, ICANN receives complaints relating to issues raised in UDRP proceedings, including, for example, failure of a registrar to

¹ Each registrar must enter into a Registrar Registry Agreement with the registry operator of each gTLD, which is outside of ICANN’s scope.

implement a UDRP decision, failure of a registrar to lock a domain subject to a UDRP, and/or failure to verify the registrant of a domain subject to a UDRP proceeding.

6. On 29 May 2015, ICANN received complaints from several ICANN-accredited registrars alleging trademark infringement by OpenTLD in breach of several sections of the 2013 RAA.

7. Attached hereto as **Exhibit 1** is a true and correct copy of the determination by the World Intellectual Property Organization (“WIPO”) in the UDRP proceeding *Key-Systems GmbH v. Joost Zuurbier, OpenTLD B.V.*, Case No. DME2015-0002 (19 May 2015), that I found at: <http://www.wipo.int/amc/en/domains/search/text.jsp?case=DME2015-0002>. I reviewed this determination in connection with processing the complaints against OpenTLD.

8. Attached hereto as **Exhibit 2** is a true and correct copy of the determination by the World Intellectual Property Organization (“WIPO”) in the UDRP proceeding *NetEarth Group, Inc. v. Stichting OpenTLD WHOIS Proxy*, Case No. D2015-0428 (19 May 2015), that I found at: <http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2015-0428>. I reviewed this determination in connection with processing the complaints against OpenTLD.

9. The WIPO panels in the matters of *Key-Systems GmbH v. Joost Zuurbier, OpenTLD B.V.*, Case No. DME2015-0002 (19 May 2015) and *NetEarth Group, Inc. v. Stichting OpenTLD WHOIS Proxy*, Case No. D2015-0428 (19 May 2015) (collectively, the “UDRP Decisions”) found that OpenTLD and an affiliate had registered seven disputed domain names for the purpose of disrupting the business of a competitor in violation of the UDRP. The WIPO panels ordered that the disputed domain names be transferred to the Complainants in those proceedings. I am not aware of any steps OpenTLD has undertaken to effectuate the WIPO-ordered transfers, however the WIPO decisions explain that OpenTLD failed to comply with other obligations of the UDRP as well as the EDDP.

10. Separate and apart from the WIPO decisions (involving seven domain names), ICANN has received other complaints that OpenTLD carries out abusive registration practices. For example, on 19 February 2015, Go Daddy Operating Company, LLC, which operates the ICANN-accredited registrar GoDaddy.com, LLC (collectively “GoDaddy”) (a competitor of OpenTLD), wrote OpenTLD a letter complaining that OpenTLD had registered several domain names that were identical to GoDaddy’s registered trademarks. GoDaddy asked that OpenTLD “immediately discontinue” its use of the disputed domain names and “take immediate steps to transfer” the domain names to GoDaddy. GoDaddy’s letter identified the <godaddy.cf> domain name, and included a screenshot of the <godaddy.cf> webpage displaying the banner wording:

Instead of Reselling BigDaddy’s domains

Make Freenom your Mommy and get domains at cost price

ICANN is not aware of any steps undertaken by OpenTLD to transfer these domain names to GoDaddy, and GoDaddy informed me that no response was received from OpenTLD. In fact, by running a Whois lookup on 3 August 2015, I was able to determine that at least three of the subject domain names were deleted by OpenTLD after GoDaddy’s letter was sent to OpenTLD, and that the domain names were not registered to GoDaddy as of that date. I received a copy of the 19 February 2015 letter from GoDaddy. A true and correct copy of GoDaddy’s 19 February 2015 letter to OpenTLD is attached hereto as **Exhibit 3**.

11. I received a similar complaint from Tucows (an ICANN-accredited registrar) indicating that OpenTLD, through its reseller Freenom, had registered a domain name that was identical to Tucows’ trademark. In addition, Tucows complained that a domain registered to OpenTLD (<freenom.com>) used a third level domain with Tucows’ trademark “opensrs” to redirect traffic to solicit domain name registration business. That subdomain was

<opensrs.freenom.com>. After ICANN sent the 2 June 2015 inquiry notice to OpenTLD (referenced below), the third level domain <opensrs.freenom.com> ceased operating.

12. On 2 June 2015, after review of the WIPO decisions and the website <freenom.com>, at my direction ICANN's Contractual Compliance Department sent an inquiry via email to OpenTLD seeking more information concerning certain issues raised in the UDRP proceedings and notifying OpenTLD of its investigation of OpenTLD's potential breach(es) of the RAA. A true and correct copy of the 2 June 2015 inquiry sent by ICANN's Contractual Compliance Department to OpenTLD is attached as **Exhibit 4**.

13. On 10 July 2015, I verified that the mail server log entries confirm that OpenTLD's mail server (mail.opentld.com) accepted ICANN's 2 June 2015 email three seconds after it was sent.

14. In the 2 June 2015 inquiry, ICANN asked that OpenTLD provide ICANN with certain records and information by 10 June 2015. ICANN did not receive a response to the inquiry.

15. On 23 June 2015, having still received no response from OpenTLD, at my direction ICANN sent OpenTLD a Notice of Suspension of Registrar's Ability to Create New Registered Names or Initiate Inbound Transfers of Registered Names ("Suspension Notice"). I understand that OpenTLD attached a copy of the Suspension Notice to its Request for Arbitration as Exhibit D.

16. OpenTLD's suspension applies only to the creation of new domains or the inbound transfer of domain name registrations for gTLDs; it does not affect renewals of existing domain name registrations with OpenTLD; and it has no affect whatsoever on domain name registrations for ccTLDs. Per Section 5.7.2 of the RAA, the suspension was to take effect on 8 July 2015 at 00:00 UTC, fifteen days following the issuance of the Suspension Notice.

17. On 8 July 2015 at 00:00 UTC (7 July 2015 at 17:00 Pacific Daylight Time), ICANN effectuated the suspension. However, shortly thereafter on 7 July 2015 PDT and following receipt of OpenTLD's Request for Arbitration, ICANN lifted the suspension pending a determination in

these emergency proceedings. The RAA provides that if an order granting a request for a stay is not issued within fourteen days of the filing of a claimant's stay request, ICANN may proceed with the suspension or termination of a registrar.

18. Following the filing of OpenTLD's Stay Request, ICANN Contractual Compliance staff conducted a review of OpenTLD's portfolio of domain names. Using a reverse Whois tool, I determined that there are approximately 7,862 domains registered to OpenTLD and Stichting OpenTLD WHOIS Proxy (which is OpenTLD's proxy service). There were at least 73 gTLD domains registered to Stichting OpenTLD WHOIS Proxy (which is OpenTLD's proxy service) that are identical to or contain the registered trademarks or trade names of third parties. Included, by way of small example, are the domain names <barnesandnoble.link>, <sephora.bargains>, <at-facebook.com>, <ebaybh.com>, <googlefreeporn.com>, <global-paypal.com>, <hotmailtechnicalsupport.com>, and <secure-apple.com>.²

19. It was further determined that of the gTLD domain names containing a trademark or trade name of a third-party, at least 14 were registered by OpenTLD's proxy service after the 23 June 2015 Suspension Notice was issued to OpenTLD.

20. OpenTLD has not, to date, complied with any of the requirements set forth in the Suspension Notice. Specifically,

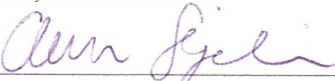
- OpenTLD has not provided ICANN with "a list of all domain names for which OpenTLD or its affiliates [such as Freenom and Stichting OpenTLD WHOIS Proxy] are the Registered Name Holder, which are identical or confusingly similar to a trademark or service mark of a third party, in which OpenTLD or its affiliate(s) have no rights, and which were registered and are being used in bad faith (collectively the 'Domain Portfolio')";

² In addition, there were at least 56 ccTLD domains registered to Stichting OpenTLD WHOIS Proxy (which is OpenTLD's proxy service) that are identical to or contain the registered trademarks or trade names of third parties.

- OpenTLD has not provided ICANN with a “remediation plan for OpenTLD to collaborate with the trademark or service mark owner(s) to transfer or cancel all domains in the Domain Portfolio”;
- OpenTLD has not in any way demonstrated that OpenTLD and its affiliates “do not use third level domains that are identical or confusingly similar to a trademark or service mark of a third party”;
- OpenTLD has not provided ICANN with the required lists of resellers and privacy and proxy providers, or demonstrated that OpenTLD complies with all RAA requirements regarding such entities;
- OpenTLD has not provided ICANN with any “corrective and preventative action(s) ... to ensure that OpenTLD complies with the [UDRP]”; and
- OpenTLD has not provided ICANN with any “assurances that OpenTLD and its affiliate(s) will not register any domain names in bad faith that are identical or confusingly similar to a trademark or service mark of a third party.”

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on this 4th day of August, 2015 in Los Angeles, California.



Owen Smigelski
Director, Contractual Compliance, ICANN

NAI-1500465439

EXHIBIT 1

ADMINISTRATIVE PANEL DECISION

Key-Systems GmbH v. Joost Zuurbier, OpenTLD B.V.
Case No. DME2015-0002

1. The Parties

The Complainant is Key-Systems GmbH of St. Ingbert, Germany, internally represented.

The Respondent is Joost Zuurbier, OpenTLD B.V. of Amsterdam, the Netherlands.

2. The Domain Names and Registrar

The disputed domain names <key-systems.cc> and <rrp-proxy.me> are registered with OpenTLD B.V. (the "Registrar").

3. Procedural History

The Complaint regarding the disputed domain name <rrp-proxy.me> was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 5, 2015. On February 5, 2015, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 26, 2015, the Complainant submitted an amended Complaint adding the domain name <key-systems.cc> to the dispute. On February 27, 2015, the Center transmitted by email to the Registrar a request for registrar verification in connection with this disputed domain name.

The Registrar did not respond to the Center's requests for registrar verification respecting the disputed domain names until March 16, 2015, despite reminders from the Center. On that date, the Registrar indicated in an email that the disputed domain name <rrp-proxy.me> had been "deleted" and would "soon be available for registration again with the Registry". A day later, on March 17, 2015, the Registrar by email advised the Center that both of the disputed domain names had been deleted and were in the redemption period. Subsequently, on March 24, 2015, when the Registrar transmitted a more detailed response to the Center's request for registrar verification, stating *inter alia* that "the domain name has been deleted at the Registry [sic]" and that the domain names had been or would be placed on "Registrar lock" status.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the

Complaint, and the proceedings commenced on March 24, 2015. In accordance with the Rules, paragraph 5(a), the due date for Response was April 13, 2015. The Respondent did not submit any response. Accordingly, the Center notified the parties of the panel appointment process on April 14, 2015.

The Center appointed William R. Towns as the sole panelist in this matter on April 28, 2015. The Panel finds that it was properly constituted. 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. Due to exceptional circumstances, the date for the Panel to submit its decision to the Center was extended to May 19, 2015.

4. Factual Background

The Complainant is an ICANN accredited registrar headquartered in St. Ingbert, Germany, and operates a subsidiary in the United States of America. The Complainant provides registrar services under the KEY-SYSTEMS trademark and trade name, and owns a Community Trade Mark (“CTM”) registration for KEY-SYSTEMS. The Complainant also owns a CTM registration for the mark RRPPROXY, and provides registrations services for resellers and portfolio customers under the RRPPROXY mark and trade name. The CTM registrations for both marks were issued on October 21, 2009. The Complainant also holds a number of gTLD and ccTLD domain names reflecting these marks, which are used to communicate with customers and provide information about the Complainant’s products and services.

The Respondent is Joost Zuurbier / OpenTLD B.V. Joost Zuurbier is the CEO of OpenTLD B.V. (“OpenTLD”), an ICANN accredited registrar. OpenTLD also trades under the name “Freenom”. The Respondent registered the disputed domain names <key-systems.cc> and <rrpproxy.me> with OpenTLD B.V. on August 14, 2014. Thus, the Respondent is both the registrant and the sponsoring registrar of the disputed domain names. The Respondent has used the disputed domain names to divert Internet users to websites operated by the Respondent, on which visitors are solicited to switch from the Complainant’s RRPPROXY service to a competing service offered by the OpenTLD/Freenom.¹

After becoming aware of the Respondent’s registration and use of the disputed domain name <rrpproxy.me> the Complainant sent two cease and desist letters to the Respondent, dated September 1, 2014, and October 1, 2014, respectively. The Respondent did not reply to either of these communications, and the Complainant thereafter commenced this proceeding under the Policy.

It has come to the Panel’s attention that on August 14, 2014 – the same day the disputed domain names were registered – the Respondent registered five (5) other domain names corresponding to trade names or trademarks of domain name service providers with whom OpenTLD/Freenom competes. OpenTLD was the sponsoring registrar for all such registrations. A use similar to that made with the disputed domain names in this case has been made with these domain names. See *NetEarth Group, Inc. v. Stichting OpenTLD WHOIS Proxy*, WIPO Case No. D2015-0428.

5. Parties’ Contentions

A. Complainant

The Complainant identifies itself as an ICANN accredited registrar with a leading market position, selling

¹ The advertising on the Respondent’s websites includes the following: “For those who are still working with RRP Protocol - Join Freenom and make more money with cost price domains” (website: “www.rrpproxy.me”); “Forget your expensive Turn Key System Reselling Plan – Join Freenom and make more money with cost price domains” (website: “www.freenom.com/en/resellers”).

domain names, and providing hosting and DNS services to customers around the world. The Complainant relates that it manages more than 300 million domain names for some 70,000 end and corporate customers and 1,800 resellers in more than 200 countries, and is one of the larger ICANN registrars. In addition to using the KEY-SYSTEMS mark with its products and services, the Complainant explains that it uses the mark RRPPROXY with a reseller portal, featuring a domain registration and management system specifically developed for Internet service providers (“ISPs”), registrars and resellers.

The Complainant submits that the disputed domain names <key-systems.cc> and <rrpproxy.me>, respectively, are identical or confusingly similar to the Complainant’s KEY-SYSTEMS and RRPPROXY marks. The Complainant asserts that the incorporation of its marks in their entirety is sufficient to establish identity or confusing similarity, and that the extensions “.me” and “.cc” should not be taken into account when considering whether the disputed domain names are identical or confusingly similar to the Complainant’s marks. The Complainant argues that the risk of confusion is even greater because the services offered under the disputed domain names are substantially similar to those offered under the Complainant’s marks.

The Complainant maintains that the Respondent has no rights or legitimate interests in the disputed domain names. The Complainant avers that the Respondent has not been authorized to use the Complainant’s marks for any purpose, and that the Respondent has not been commonly known by the disputed domain names. According to the Complainant, the KEY-SYSTEMS and RRPPROXY marks are well-known, and as such the Respondent could not conceivably claim a legitimate activity was contemplated for the disputed domain names. Further, the Complainant argues that in the absence of any authorization or license to use the Complainant’s marks, no actual or *bona fide* use of the disputed domain names reasonably could be claimed, citing *Guerlain S.A. v. Peikang*, WIPO Case No. D2000-0055, and *Drexel University v. David Brouda*, WIPO Case No. D2001-0067.

The Complainant contends that the disputed domain names were registered and are being used in bad faith. According to the Complainant, the KEY-SYSTEMS and RRPPROXY marks are well-known among ICANN accredited and country code Top-Level Domain (“ccTLD”) accredited registrars, and the Respondent’s reproduction of those marks in the disputed domain names and their use in advertising clearly shows that the Respondent, itself a provider for domain name services, was aware of the Complainant’s marks when registering the disputed domain names. The Complainant also maintains that the Respondent was well aware of the Complainant and its marks because the Respondent’s CEO is also the CEO of Freedom Registry, Inc., which is a customer of the Complainant, and because the Complainant is a reseller of ccTLDs offered by subsidiaries of Freenom.

The Complainant also argues that the Respondent acted in derogation of Section 2 of the Policy, which imposes a duty on registrants to verify that the registration of a domain name will not infringe rights of third parties. The Complainant submits that even a cursory trademark search or Internet search would have disclosed the existence of the Complainant’s trademark rights. Thus, the Complainant concludes that the Respondent registered the disputed domain names in bad faith.

In light of the foregoing, the Complainant further submits that the Respondent has used the disputed domain names in bad faith. The Complainant asserts that the Respondent is seeking to exploit and benefit from the goodwill associated with the Complainant’s marks and has engaged in unfair competition by using the disputed domain names with advertising targeted directly at the Complainant’s customers. The Complainant observes that the disputed domain names resolve to websites on which the Respondent attempt to entice Key-Systems customers and RRPproxy users to switch to Freenom services.² The Complainant further presents evidence of the Respondent’s use of the disputed domain name <rrpproxy.me> in a Google advertising campaign using the search term “RRPproxy” (titled “Reselling with RRP proxy?”) to attract Internet users searching for the Complainant’s services to the Respondent.

² Refer to Note 1 and accompanying text *supra*.

B. Respondent

The Respondent did not submit a formal reply to the Complainant's contentions. However, in addition to the email communications from the Respondent to the Center referred to earlier, the Respondent by email on May 8, 2015, informed the Center that the disputed domain names are available for registration, questioning why the Complainant did not register the domain names instead of pursuing this case.

6. Preliminary Issues

A. Registrar as Registrant

Although cases of this nature are somewhat unusual, UDRP panels consistently have held that a registrar who registers a domain name, either for its own account or through a subsidiary, can be the "holder of a domain name registration against which a Complainant is initiated" under paragraph 1 of the Rules, and thus a proper respondent in a proceeding under the Policy. See, e.g., *Pernod Ricard v. Tucows.com Co*, WIPO Case No. D2008-0789 (three-member panel); *General Electric Company v. Marketing Total S.A*, WIPO Case No. D2007-1834; *DAVIS VISION, Inc. v. Demand Domains, Inc.*, NAF Claim No. 1142731; and *Paxar Americas, Inc. v. eNom, Inc.*, NAF Claim No. 980114. See also *Markel Corporation. v. Tucows.com Co*, WIPO Case No. D2007-1750.

Accordingly, where a registrar's conduct with respect to a domain name goes beyond merely performing administrative actions in accepting and implementing domain name registrations for another but instead concerns the registration and use of a domain name for itself, the registrar is subject to the full force and effect of the Policy, and faces the same scrutiny and liability under the Policy for its conduct as would any domain name registrant. *Pernod Ricard v. Tucows.com Co*, *supra* (citing *Paxar Americas, Inc. v. eNom, Inc.*, *supra*). As the panel in *Paxar Americas* explained:

"If this were not the case, then domain name registrars could, with impunity under the Policy, register and use domain names in a manner that inflicts harm on legitimate rights holders. Such a result would lie directly contrary to the very goals of the Policy -- recognition and preference to the legitimate rights of trademark holders as against abusive domain name registration."

Based on the undisputed facts in the record of this proceeding, including the Whois registrant information existing at the time of the filing of the Complaint, the Panel finds that the Registrar (OpenTLD B.V. d/b/a Freenom) is the registrant of the disputed domain names, and thus the proper Respondent in this case.

B. Registrar Conduct

The Panel considers the Respondent's conduct in its capacity as the Registrar highly suspect. As noted earlier, the Registrar delayed by more than a month in providing any response to the Center's initial request for registrar verification of February 5, 2015. The Registrar's initial reply on March 16, 2015, did not respond to the Center's request for registrar verification other than stating that the disputed domain name <rrrproxy.me> had been "deleted" and would "soon be available for registration again with the Registry".

A day later, on March 17, 2015, the Registrar by email represented to the Center that both the disputed domain names had been deleted and were in the redemption period. At that point, the Center reminded the Registrar of paragraph 3.7.5.7 ICANN Expired Domain Deletion Policy.

On March 24, 2015, when the Registrar finally made an ostensible effort to address the specifics of the Center's request for verification, the Registrar indicated that "the domain name has been deleted at the Registry [sic]", but answered "yes" to the question whether the disputed domain name was or would be placed on Registrar lock and would remain so during the course of proceedings under paragraph 8 of the Policy. Subsequently, however, the Respondent on May 8, 2015, informed the Center that the disputed domain names are available for registration.

The Panel entertains little doubt that the delays on the part of the Registrar were intentional. Further, the Registrar appears to have violated paragraph 8 of the Policy by deleting the disputed domain names during the pendency of this proceeding instead of placing the domain names on Registrar lock. See *Funix B.V. v. Domain Administrator*, WIPO Case No. D2009-1048. While the Registrar represented on March 24, 2015, that the disputed domain name had been or would be placed on Registrar lock, the Registrar's representation in this regard is dubious. The Panel notes that the Registrar failed to afford the Complainant the opportunity to restore the disputed domain name in contravention of paragraph 3.7.5.7 of the ICANN Expired Domain Deletion Policy, and as previously noted, on May 8, 2015 the Registrar informed the Center that the disputed domain names are available for registration.

The Panel considers the Registrar's conduct as described herein tantamount to the abusive and bad faith practice of cyberflight. At some point after learning of the Complaint, the Registrar deleted the disputed domain names (with the expiration dates still six months out), with the stated intention that disputed domain names would become available for registration. See *Fifth Third Bancorp v. Secure Whois Information Service*, WIPO Case No. D2006-0696 (defining cyberflight as "an attempt to avoid or delay judicial or UDRP proceedings by changing domain registration details or registrars after learning of a complaint"). See also *Funix B.V. v. Domain Administrator*, *supra*.

In *Fifth Third Bancorp*, *supra* the domain name at issue was registered using the registrar's privacy protection service. Shortly after receiving a letter from the complainant's attorney, to which there was no reply, the registrar informed the Center that the domain name had been "deleted" at the request of the registrant (whose identity was not disclosed). The following month the domain name was registered by a new owner and registrar. While in this case the Panel is not aware that the disputed domain names have been registered to a new owner, the Registrar's conduct is consistent with cyberflight, and seems to be calculated to avoid or delay proceedings under the Policy. As noted above, the Registrar is the Respondent herein, and faces the same scrutiny and liability under the Policy for its conduct as would any domain name registrant.

7. Discussion and Findings

A. Scope of the Policy

The Policy is addressed to resolving disputes concerning allegations of abusive domain name registration and use. See *Milwaukee Electric Tool Corporation v. Bay Verte Machinery, Inc. d/b/a The Power Tool Store*, WIPO Case No. D2002-0774. Accordingly, the jurisdiction of this Panel is limited to providing a remedy in cases of "the abusive registration of domain names", also known as "cybersquatting". See *Weber-Stephen Products Co. v. Armitage Hardware*, WIPO Case No. D2000-0187. See also Final Report of the WIPO Internet Domain Name Process, April 30, 1999, paragraphs 169 and 170.

Paragraph 15(a) of the Rules provides that the Panel shall decide a complaint on the basis of statements and documents submitted and in accordance with the Policy, the Rules and any other rules or principles of law that the Panel deems applicable.

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

- (i) 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
- (ii) The respondent has no rights or legitimate interests with respect to the domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

Cancellation or transfer of the disputed domain name are the sole remedies provided to the complainant under the Policy, as set forth in paragraph 4(i).

Paragraph 4(b) of the Policy sets forth four situations under which the registration and use of a disputed domain name is deemed to be in bad faith, but does not limit a finding of bad faith to only these situations.

Paragraph 4(c) of the Policy in turn identifies three means through which a respondent may establish rights or legitimate interests in the disputed domain name. Although the complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, panels have recognized that this could result in the often-impossible task of proving a negative, requiring information that is primarily if not exclusively within the knowledge of the respondent. Thus, the consensus view is that paragraph 4(c) shifts the burden of production to the respondent to come forward with evidence of a right or legitimate interest in the disputed domain name, once the complainant has made a *prima facie* showing. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. D2000-0270.

B. Identical or Confusingly Similar

The Panel finds for purposes of paragraph 4(a)(i) of the Policy that the disputed domain names <key-systems.cc> and <rrpproxy.me> are identical to the Complainant's corresponding KEY-SYSTEMS and RRPPROXY marks, in which the Complainant has established rights through registration and use. In considering the question of identity or confusing similarity, the first element of the Policy operates essentially as a standing requirement.³ The threshold inquiry under the first element of the Policy is framed in terms of whether the trademark and the disputed domain name, when directly compared, are identical or confusingly similar. Although TLDs may in appropriate circumstances be considered when evaluating identity or confusing similarity, TLDs may also be disregarded, and usually are not taken into consideration when evaluating the identity or confusing similarity between the complainant's mark and the disputed domain name. See *Magnum Piering, Inc. v. The Mudjackers and Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525; *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. D2000-0429; *Phenomedia AG v. Meta Verzeichnis Com*, WIPO Case No. D2001-0374.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

As noted above, once the complainant makes a *prima facie* showing under paragraph 4(a)(ii) of the Policy, paragraph 4(c) shifts the burden of production to the respondent to come forward with evidence of rights or legitimate interests in a disputed domain name. The Panel finds that the Complainant has made a *prima facie* showing. It is undisputed that the Respondent has not been commonly known by the disputed domain names. The Respondent, without the Complainant's authorization or consent, has registered domain names corresponding to the Complainant's RRPPROXY and KEY-SYSTEMS marks. The Respondent has used the disputed domain names to divert Internet users to websites where the Respondent is offering services that are competitive with those provided by the Complainant under its marks.

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a disputed domain name by demonstrating any of the following:

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

³ See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), paragraph 1.2.

(ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Based on the record in this proceeding, the Panel is persuaded that the Respondent was well aware of the Complainant's rights in the distinctive RRPPROXY and KEY-SYSTEMS marks when registering the disputed domain names. The Panel concludes that the Respondent did so in order to trade on the goodwill and reputation of the Complainant's marks through the creation of Internet user confusion. Internet users could easily expect that the disputed domain names, which are identical to the Complainant's marks, would be linked to the Complainant's website or another website that is affiliated with, or has the endorsement or sponsorship of, the Complainant. See *Levantur, S.A. v. Media Insight*, WIPO Case No. D2008-0774.

It is not a legitimate or fair use for the Respondent to register domain names appropriating the Complainant's trademarks (as well as trademarks of other competitors) without the trademark owner's consent, in order to create Internet user confusion and divert consumers seeking the Complainant's services to a website on which the Respondent's promotes its own competing services. In light of the foregoing, the Panel finds the Respondent's registration and use of the disputed domain name to be *male fide*; the Respondent's actions undermine any claim by the Respondent to have used, or made demonstrable preparations to use, the disputed domain names in connection with a *bona fide* offering of goods or services. The Panel further considers that the Respondent's highly questionable conduct when acting as the Registrar underscores the Respondent's lack of rights or legitimate interests in the disputed domain names.

Accordingly, the Panel finds the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant for valuable consideration in excess of respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) circumstances indicating that the respondent 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) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to its 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 its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003. The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant seeks to profit from and exploit the trademark of another. See *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. D2004-0230.

For the reasons discussed under this and the preceding heading, the Panel considers that the Respondent's conduct in this case constitutes bad faith registration and use of the disputed domain names within the meaning of paragraph 4(a)(iii) of the Policy. As noted above, the Panel has determined that the Respondent was well aware of the Complainant and the Complainant's marks when registering the disputed domain names. For the reasons noted earlier, the Panel concludes that the Respondent's primary motive in relation to the registration and use of the disputed domain names was to capitalize on, or otherwise take advantage of, the Complainant's trademark rights through the creation of Internet user confusion.

In that regard, the record amply supports a finding that the Respondent registered the disputed domain names for the purpose of disrupting the business of a competitor. The record further reflects the Respondent's use the domain names to intentionally attempt to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's marks as to source, sponsorship, or affiliation. In addition, the record reflects actions taken by the Respondent's that, as discussed above, the Panel considers tantamount to the abusive and bad faith practice of cyberflight.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

8. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain names <key-systems.cc> and <rrp-proxy.me> be transferred to the Complainant. For purposes of implementation of the Panel's order and any appropriate actions required, the Panel requests that a copy of this decision be provided to Verisign, the .cc Registry Operator, to DoMEn, the .me Registry Operator, and to ICANN, as the accrediting authority.

William R. Towns
Sole Panelist
Date: May 19, 2015

EXHIBIT 2

ADMINISTRATIVE PANEL DECISION

NetEarth Group, Inc. v. Stichting OpenTLD WHOIS Proxy

Case No. D2015-0428

1. The Parties

The Complainant is NetEarth Group, Inc of London, United Kingdom of Great Britain and Northern Ireland, internally represented.

The Respondent is Stichting¹ OpenTLD WHOIS Proxy of Amsterdam, the Netherlands.

2. The Domain Name and Registrar

The disputed domain name <netearthone.biz> is registered with OpenTLD B.V. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 11, 2015. On March 11, 2015, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. Following a reminder from the Center, the Registrar on March 16, 2015, forwarded an email to the Center stating that the “the domain has been deleted” and that it would soon be available for registration again. The Center on March 18, 2015, sent an email reminding the Registrar of the requirements of paragraph 3.7.5.7 ICANN Expired Domain Deletion Policy.

Subsequently, on March 20, 2015, the Center noted with concern the Registrar’s failure to provide a full response to the Center’s request for registrar verification, and requested a reply on or before March 23, 2015. On March 24, 2015, the Registrar forwarded a response to the Center, indicating that “the domain name has been deleted at the Registry [sic]”. The Registrar answered “yes” to the question whether the disputed domain name was or would be placed on Registrar lock and would remain so during the course of proceedings under paragraph 8 of the Policy.

The Center verified that the 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

¹ Stichting is “Foundation” in English.

(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 on March 24, 2015. In accordance with the Rules, paragraph 5(a), the due date for Response was April 13, 2015. The Respondent did not submit any response. Accordingly, the Center notified the parties of the panel appointment process on April 14, 2015.

The Center appointed William R. Towns as the sole panelist in this matter on April 28, 2015. The Panel finds that it was properly constituted. 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. Due to exceptional circumstances, the date for the Panel to submit its decision to the Center was extended to May 19, 2015.

4. Factual Background

The Complainant and its subsidiary companies (NetEarth One, Inc., NetEarth UK Limited, and NetEarth LLC) provide Internet related services in the Americas, Asia and Europe markets under the names NetEarth and NetEarth One. These services include domain name registration services. NetEarth One, Inc. is an accredited ICANN registrar, and NetEarth UK Limited is an accredited Nominet registrar. The Complainant owns a Community Trade Mark (“CTM”) registration for NETEARTH, filed on November 17, 2008 and registered on June 16, 2009. The Complainant and various subsidiaries offer their services under the NETEARTH mark. The Complainant and its subsidiaries also own a number of domain names which consist of or incorporate the NETEARTH mark.

The Respondent named in the Complaint appears to be a privacy protection service affiliated with the Registrar OpenTLD B.V. (“OpenTLD”). OpenTLD trades under the name “Freenom”. The disputed domain name was registered on August 14, 2014. Prior to the filing of the Complaint the disputed domain name was used to divert Internet users to a website soliciting Complainant’s customers to switch to the Freenom,² which in turn redirected to a page on Freenom’s website (“www.freenom.com/en/resellers”), offering domain name services similar to those provided by the Complainant and its subsidiaries.

Whols records provided by the Complainant reflect that on August 14, 2014 – the same day the disputed domain name was registered – either OpenTLD or its affiliated proxy service Stichting OpenTLD WHOIS Proxy registered no less than six (6) other domain names corresponding to trade names or trademarks of domain name service providers with whom OpenTLD/Freenom competes.³ OpenTLD was the sponsoring registrar for all such registrations. A use similar to that made with <netearthone.biz> in this case was made with these domain names.

5. Parties’ Contentions

A. Complainant

The Complainant submits that the true registrant of the disputed domain name is OpenTLD (d/b/a Freenom), and not the proxy service shown in the Whols records. The Complainant advances this argument given the use to which the disputed domain name has been put, OpenTLD’s registration of additional domain names corresponding to trademarks of its competitors, and the similar use of these domain names.

The Complainant submits that the disputed domain name is confusingly similar to the Complainant’s

² The website featured the following advertisement: “Ever wondered if it’s just One Earth Network? Enter Freenom’s new world and get domains at cost price”.

³ The domain names were: <rrproxy.me>, <key-systems.cc>, <resellerclub.tk>, <resellbiz.biz>, <godaddy.cf> and <resello.ws>.

registered mark NETEARTH, and that the addition of the common or descriptive term “one” does not serve to distinguish the disputed domain name from the Complainant’s mark. According to the Complainant, its NETEARTH mark is inherently distinctive and in no way descriptive of the services provided under the mark. The Complainant further notes that the disputed domain name is virtually identical to the trade name of one of its subsidiaries, NetEarth One, Inc. (an accredited ICANN registrar).

The Complainant maintains that the Respondent has no rights or legitimate interests in respect of the disputed domain name. According to the Complainant, the Respondent, a direct competitor of the Complainant, is not and has never been connected to the Complainant and is not licensed or permitted to use the Complainant’s registered trade mark. The Complainant asserts that it is “utterly inconceivable” that the Respondent was unaware of the Complainant and its rights in the NETEARTH mark, given that the Respondent has operated in the same commercial field for a number of years.

The Complainant reiterates that its NETEARTH mark is inherently distinctive and in no way descriptive of the services being provided either by the Complainant or the Respondent. The Complainant submits that consequently there is simply no legitimate or justifiable reason for the Respondent to have registered the disputed domain name. The Complainant points to the Respondent’s registration on a single day of multiple domain names corresponding to the names and trademarks of competitors as further evidence that the Respondent is not making a *bona fide* use of the disputed domain name.

The Complainant contends that the Respondent registered and is using the disputed domain name in bad faith. The Complainant maintains that the Respondent and the Registrar (OpenTLD) are one and the same. According to the Complainant, this conclusion is supported by the use of the disputed domain name firstly to resolve to a website that seeks to entice the Complainant’s NetEarth One customers to switch to the service provider “Freenom” with the words “Ever wondered if it’s just One Earth Network? Enter Freenom’s new world and get domains at cost price”; which then automatically redirects to the webpage “www.freenom.com/en/resellers”. On that page, the Respondent offers services that compete with those provided by the Complainant under its NETEARTH mark.

The Complainant urges that bad faith also is clearly indicated by the Respondent’s registration of six other domain names corresponding to trademarks of other competitors of the Respondent, and by the use of these domain names in a manner similar to how the disputed domain name has been used. The Complainant maintains that the public would likely expect the disputed domain name to resolve to a website operated by the Complainant. However, the Complainant explains that entering the words “netearth” or “netarhone” into a search engine generates a list of websites that includes the Respondent’s website, which contains advertising actively targeting the Complainant’s customers.

In view of the foregoing, the Complainant submits that the Respondent registered and is using the disputed domain name to generate revenue and to divert consumers looking for the Complainant’s services to a website offering competing services. The Complainant submits bad faith registration and use within the meaning of the Policy is demonstrated in at least the following respects: (1) the disputed domain name was registered primarily for the purpose of disrupting the business of a competitor; an (2) in using the domain name, the Respondent is intentionally attempting to attract, for commercial gain, Internet users to its website 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 of a product of service on that website.

B. Respondent

The Respondent did not reply to the Complainant’s contentions.

6. Preliminary Issues

A. Registrar as Registrant

Although cases of this nature are somewhat unusual, UDRP panels consistently have held that a registrar who registers a domain name, either for its own account or through a subsidiary, can be the “holder of a domain name registration against which a Complainant is initiated” under paragraph 1 of the Rules, and thus

a proper respondent in a proceeding under the Policy. See, e.g., *Pernod Ricard v. Tucows.com Co*, WIPO Case No. D2008-0789 (three-member panel); *General Electric Company v. Marketing Total S.A*, WIPO Case No. D2007-1834; *DAVIS VISION, Inc. v. Demand Domains, Inc.*, NAF Claim No. 1142731; and *Paxar Americas, Inc. v. eNom, Inc.*, NAF Claim No. 980114. See also *Markel Corporation. v. Tucows.com Co*, WIPO Case No. D2007-1750.

Accordingly, where a registrar's conduct with respect to a domain name goes beyond merely performing administrative actions in accepting and implementing domain name registrations for another, but instead concerns the registration and use of a domain name for the registrant's use, the registrar is subject to the full force and effect of the Policy, and faces the same scrutiny and liability under the Policy for its conduct as would any domain name registrant. *Pernod Ricard v. Tucows.com Co*, *supra* (citing *Paxar Americas, Inc. v. eNom, Inc.*, *supra*). As the panel in *Paxar Americas* explained:

"If this were not the case, then domain name registrars could, with impunity under the Policy, register and use domain names in a manner that inflicts harm on legitimate rights holders. Such a result would lie directly contrary to the very goals of the Policy -- recognition and preference to the legitimate rights of trademark holders as against abusive domain name registration."

Based on the undisputed facts in the record, including the identification of the Whois registrant as a privacy service affiliated with the Registrar (OpenTLD B.V. d/b/a Freenom), and the use of the disputed domain name by the Registrar as reflected in the record, the Panel concludes that the Registrar is the actual or true registrant of the disputed domain name, and thus the proper Respondent in this case.

B. Registrar Conduct

The Panel considers the Respondent's conduct in its capacity as the Registrar highly suspect. As noted earlier, the Registrar delayed for five days before providing any response to the Center's initial request for registrar verification of March 11, 2015. The Registrar's initial reply on March 16, 2015, did not respond to the Center's request for registrar verification other than stating that the disputed domain name had been "deleted" and would "soon be available for registration". On March 18, 2015, the Center reminded the Registrar of paragraph 3.7.5.7 ICANN Expired Domain Deletion Policy. When on March 24, 2015, after further reminders from the Center, the Registrar finally made an ostensible effort to address the specifics of the Center's request for verification, the Registrar indicated that "the domain name has been deleted at the Registry [sic]", but answered "yes" to the question whether the disputed domain name was or would be placed on Registrar lock and would remain so during the course of proceedings under paragraph 8 of the Policy.

The Panel is persuaded from the record that the delays on the part of the Registrar were intentional. The Registrar appears to have violated paragraph 8 of the Policy by deleting the disputed domain name during the pendency of this proceeding instead of placing the domain name on Registrar lock. See *Funix B.V. v. Domain Administrator*, WIPO Case No. D2009-1048. While the Registrar represented on March 24, 2015, that the disputed domain name had been or would be placed on Registrar lock, the Registrar's representation is dubious. The Panel notes that the Registrar failed to afford the Complainant the opportunity to restore the disputed domain name in contravention of paragraph 3.7.5.7 of the ICANN Expired Domain Deletion Policy, even after receiving a reminder from the Center.

The Panel further considers the Registrar's conduct as described herein tantamount to the abusive and bad faith practice of cyberflight. At some point after becoming aware of the Complaint, the Registrar deleted the disputed domain name (with the expiration date still some six months away), with the stated intention of that the disputed domain would become available for registration. See *Fifth Third Bancorp v. Secure Whois Information Service*, WIPO Case No. D2006-0696 (defining cyberflight as "an attempt to avoid or delay judicial or UDRP proceedings by changing domain registration details or registrars after learning of a complaint"). See also *Funix B.V. v. Domain Administrator*, *supra*.

In *Fifth Third Bancorp*, *supra*, the domain name at issue was registered using the registrar's privacy protection service. Shortly after receiving a letter from the complainant's attorney, to which there was no reply, the registrar informed the Center that the domain name had been "deleted" at the request of the

registrant (whose identity was not disclosed). The following month the domain name was registered by a new owner and registrar. While the Panel is not aware that the disputed domain name at issue here has been registered to a new owner, the Registrar's conduct is consistent with cyberflight, and seems to be calculated to avoid or delay proceedings under the Policy. As noted above, the Registrar is the Respondent herein, and faces the same scrutiny and liability under the Policy for its conduct as would any domain name registrant.

7. Discussion and Findings

A. Scope of the Policy

The Policy is addressed to resolving disputes concerning allegations of abusive domain name registration and use. See *Milwaukee Electric Tool Corporation v. Bay Verte Machinery, Inc. d/b/a The Power Tool Store*, WIPO Case No. D2002-0774. Accordingly, the jurisdiction of this Panel is limited to providing a remedy in cases of "the abusive registration of domain names", also known as "cybersquatting". See *Weber-Stephen Products Co. v. Armitage Hardware*, WIPO Case No. D2000-0187. See also Final Report of the WIPO Internet Domain Name Process, April 30, 1999, paragraphs 169 and 170.

Paragraph 15(a) of the Rules provides that the Panel shall decide a complaint on the basis of statements and documents submitted and in accordance with the Policy, the Rules and any other rules or principles of law that the Panel deems applicable.

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

- (i) 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
- (ii) The respondent has no rights or legitimate interests with respect to the domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

Cancellation or transfer of the disputed domain name are the sole remedies provided to the complainant under the Policy, as set forth in paragraph 4(i).

Paragraph 4(b) of the Policy sets forth four situations under which the registration and use of a disputed domain name is deemed to be in bad faith, but does not limit a finding of bad faith to only these situations.

Paragraph 4(c) of the Policy in turn identifies three means through which a respondent may establish rights or legitimate interests in the disputed domain name. Although the complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, panels have recognized that this could result in the often-impossible task of proving a negative, requiring information that is primarily if not exclusively within the knowledge of the respondent. Thus, the consensus view is that paragraph 4(c) shifts the burden of production to the respondent to come forward with evidence of a right or legitimate interest in the disputed domain name, once the complainant has made a *prima facie* showing. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. D2000-0270.

B. Identical or Confusingly Similar

The Panel finds for purposes of paragraph 4(a)(i) of the Policy that the disputed domain name is confusingly similar to the Complainant's NETEARTH mark, in which the Complainant has established rights through registration and use. In considering the question of identity or confusing similarity, the first element of the

Policy operates essentially as a standing requirement.⁴ The threshold inquiry under the first element of the Policy is framed in terms of whether the trademark and the disputed domain name, when directly compared, are identical or confusingly similar.

In this case, the disputed domain name incorporates the Complainant's mark in its entirety. The inclusion of the common or descriptive word "one" does not serve to distinguish the disputed domain name from the Complainant's mark. In that respect, the Panel also notes that NetEarth One is the name of one of the Complainant's subsidiary companies. Although a generic Top-Level Domain ("gTLD") may in appropriate circumstances be considered when evaluating identity or confusing similarity, gTLDs may also be disregarded, and usually are not taken into consideration when evaluating the identity or confusing similarity between the complainant's mark and the disputed domain name. See *Magnum Piering, Inc. v. The Mudjacks and Garwood S. Wilson, Sr.*, WIPO Case No. D2000-1525; *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. D2000-0429; *Phenomedia AG v. Meta Verzeichnis Com*, WIPO Case No. D2001-0374.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

As noted above, once the complainant makes a *prima facie* showing under paragraph 4(a)(ii) of the Policy, paragraph 4(c) shifts the burden of production to the respondent to come forward with evidence of rights or legitimate interests in a disputed domain name. The Panel finds that the Complainant has made a *prima facie* showing. It is undisputed that the Respondent has not been commonly known by the disputed domain names. The Respondent, without the Complainant's authorization or consent, has registered a domain name appropriating the Complainant's NETEARTH mark. The Respondent has used the disputed domain name to divert Internet users to a website where the Respondent offers services that are competitive with those provided by the Complainant under its marks.

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a disputed domain name by demonstrating any of the following:

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

Based on the record in this proceeding, the Panel is persuaded that the Respondent was well aware of the Complainant's rights in the distinctive NETEARTH mark when registering the disputed domain names. The Panel concludes that the Respondent did so in order to trade on the goodwill and reputation of the Complainant's marks through the creation of Internet user confusion. Internet users could easily expect that the disputed domain name, which appropriates to the Complainant's distinctive mark, would be linked to the Complainant's website or another website that is affiliated with, or has the endorsement or sponsorship of, the Complainant. See *Levantur, S.A. v. Media Insight*, WIPO Case No. D2008-0774.

It is not a legitimate or fair use for the Respondent to register a domain name appropriating the Complainant's trademark (as well as trademarks of other competitors), undertaken without the trademark owner's consent, in order to create Internet user confusion and divert consumers seeking the Complainant's

⁴ See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), paragraph 1.2.

services to a website on which the Respondent's promotes its own competing services. In light of the foregoing, the Panel finds the Respondent's registration and use of the disputed domain name to be *male fide*; the Respondent's actions undermine any claim by the Respondent to have used, or made demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services. The Panel further considers that the Respondent's highly questionable conduct when acting as the Registrar underscores the Respondent's lack of rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant for valuable consideration in excess of respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the respondent 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) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent is using the domain name to intentionally attempt to attract, for commercial gain, Internet users to its 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 its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003. The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant seeks to profit from and exploit the trademark of another. See *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. D2004-0230.

For the reasons discussed under this and the preceding heading, the Panel considers that the Respondent's conduct in this case constitutes bad faith registration and use of the disputed domain name within the meaning of paragraph 4(a)(iii) of the Policy. As noted above, the Panel has determined that Respondent was well aware of the Complainant and the Complainant's mark when registering the disputed domain name. For the reasons noted earlier, the Panel concludes that the Respondent's primary motive in relation to the registration and use of the disputed domain name was to capitalize on, or otherwise take advantage of, the Complainant's trademark rights through the creation of Internet user confusion.

In that regard, the record amply supports a finding that the Respondent registered the disputed domain name for the purpose of disrupting the business of a competitor. The record further reflects the Respondent's use the domain name to intentionally attempt to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement. In addition, the record reflects actions taken by the Respondent's that, as discussed above, the Panel considers tantamount to the abusive and bad faith practice of cyberflight.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

8. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <netearthone.biz> be transferred to the Complainant. For purposes of implementation of the Panel's order and any appropriate actions required, the Panel requests that a copy of the Panel's decision be provided to NeuStar, Inc., the .biz Registry Operator, and to ICANN, as the accrediting authority.

William R. Towns
Sole Panelist
Date: May 19, 2015

EXHIBIT 3



February 19, 2015

VIA EMAIL ONLY

Contact Information Redacted

Jeremie Godreche
Chief Operating Officer
OpenTLD B.V.
Contact Information Redacted

Re: Brand Name Domain Registrations

Dear Mr. Godreche:

I write on behalf of Go Daddy Operating Company, LLC, ("GoDaddy") the owner of the well-known trademarks for GODADDY and DOMAINS BY PROXY. GoDaddy owns numerous trademark registrations for GODADDY and DOMAINS BY PROXY in the United States as well as worldwide, including the CTM (Registration Nos. 005153184 and 004471488). As you are no doubt aware, these trademarks are used to identify the world's largest ICANN-accredited domain name registrar and leading web hosting provider as well as leading private domain registration service provider.

As a trademark owner, Go Daddy has the affirmative legal obligation to enforce its trademarks to ensure that our customers are not confused as to the source of GoDaddy products and services and to protect our valuable intellectual property from diminishment.

It has come to our attention that you have been using the GODADDY and DOMAINS BY PROXY marks in connection with several domain names registered by you or affiliated entities located here <http://www.godaddy.cf>, <http://www.godaddy.ml>, <http://www.domainsbyproxy.tk> and <http://www.domainsbyproxy.ga> (the "Domain Names"). See attached printouts for GoDaddy.cf and DomainsByProxy.tk.

Your use of our trademarks in this manner violates GoDaddy's trademark rights and falsely suggests a connection to GoDaddy and Domains By Proxy.

As you are not doubt aware, Section 5.5.2.4 of the 2013 Registrar Accreditation Agreement that you have executed with ICANN states that an agreement may be terminated if Registrar "is found by ICANN, based on its review of the findings of arbitral tribunals, to have been engaged, either directly or through its Affiliate, in a pattern and practice of trafficking in or use of domain names identical or confusingly similar to a trademark or service mark of a third party in which the Registered Name Holder has no rights or legitimate interest, which trademarks have been registered and are being used in bad faith."

Accordingly, we demand that you agree to the following:

1. Immediately discontinue any and all use of the Domain Names;
2. Take immediate steps to transfer the Domain Names to us;
3. Identify and agree to transfer to us any other domain names registered by you that contain the terms GODADDY or DOMAINS BY PROXY or any terms that are confusingly similar to GODADDY and/or DOMAINS BY PROXY.
4. Immediately and permanently refrain from any use of the GODADDY and DOMAINS BY PROXY trademarks or any variation thereof that are likely to cause confusion or dilution.
5. Provide written assurances within 5 calendar days that you will cease your unauthorized use of these domains and transfer ownership of the Domain Names to us. When you transfer the domain names to GoDaddy, the registrant fields should read as follows:

First Name	:	Domain
Last Name	:	Administrator
Email	:	Contact Information Redacted
Company Name	:	Go Daddy Operating Company, LLC
Address1	:	Contact Information Redacted
Address 2	:	
City	:	
State or Providence	:	
Zip Code	:	
Country	:	
Phone	:	

6. Inform GoDaddy, in an email sent to Contact Information Redacted of the measures that you have taken in this regard and agreeing not to use any trademarks or copyrights owned by GoDaddy without advance written consent of Go Daddy.

Given the seriousness of this matter, we would appreciate receiving a response from you by **February 25, 2015**.

Failure to comply with our demands will force GoDaddy to evaluate all available remedies, including but not limited to instituting a complaint with ICANN under Section 5.5.2.4 of the 2013 Registrar Accreditation Agreement, which could result in suspension or termination of your accreditation.

Jeremie Godreche
February 19, 2015
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Please be advised that this letter is without prejudice to any of Go Daddy's rights or remedies.

Very truly yours,

A handwritten signature in blue ink, appearing to read "Sara Bockey", with a long, sweeping flourish extending to the right.

Sara Bockey
Policy Manager
Go Daddy Operating Company, LLC

Freedom Pro Partners can register unlimited .free domains for chris and buy domain names for the same price as we buy them for. We don't want to make any money on said domains. That's why we sell them at Cost Price. Register your COM, NET and many other top level domains for the lowest price in the market.

Instead of Reselling BigDaddy's domains
Make Freenom your Mommy and get domains at cost price.

Free and Cost Price Domains with one unique account

Freenom Pro Partners can register unlimited .free domains for chris and buy domain names for the same price as we buy them for. We don't want to make any money on said domains. That's why we sell them at Cost Price. Register your COM, NET and many other top level domains for the lowest price in the market.



Unlimited Free Domains



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Free Proxy Server

Home

SATURDAY, APRIL 26, 2014



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EXHIBIT 4

To: Contact Information Redacted

Subject: ICANN 1st_Inquiry Re: UDRP [OpenTLD B.V.] (1666) [netearthone.biz]

Dear OpenTLD B.V. (1666),

This inquiry concerns Uniform Domain Name Dispute Resolution Policy (“UDRP”) Case Numbers D2015-0428 and DME2015-0002 (“Decisions”) filed with World Intellectual Property Organization (WIPO). The texts of the Decisions are at <http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2015-0428> and <http://www.wipo.int/amc/en/domains/search/text.jsp?case=DME2015-0002> respectively.

OpenTLD B.V. (“OpenTLD”) and Stichting OpenTLD WHOIS Proxy were respondents in the Decisions, which found that (1) OpenTLD engaged in the abusive and bad faith practice of cyberflight, and (2) registered a domain name identical to the trademark of a competitor for the purpose of disrupting the competitor’s business. ICANN is requesting information to assist in the determination of whether OpenTLD complies with the Registrar Accreditation Agreement (“RAA”) and ICANN Consensus Policies, including whether the requirements of Sections 5.5.2.3 and 5.5.2.4 of the RAA have been triggered.

To assist ICANN’s determination, please provide ICANN the following records and information by 10 June 2015:

1. Copy of the correspondence in which your registrar communicated to ICANN, the Provider and the Parties, the dates for the implementation of Case No. D2015-0428;
2. Copies of all written communications, including time-stamped communications, between OpenTLD and the Registered Name Holder (“RNH”) of the domain <netearthone.biz>, including a copy of registration agreement entered into between your registrar and the RNH of the domain, copies of the Whois outputs, including all changes to the Whois for the above domain from initial registration until it was no longer registered with OpenTLD;
3. Explanation and details regarding OpenTLD’s alleged failure to respond to the UDRP Provider WIPO, and failure to maintain the status quo of the disputed domain subject to the UDRP complaint. Please note a condition of your ICANN accreditation under Section 3.8 of the 2013 RAA is your compliance with the UDRP. Specifically, under Section 7 of the UDRP your registrar must “not cancel, transfer, activate, deactivate, or otherwise change the status of any domain name registration under this Policy except as provided in Paragraph 3;”
4. Explanation and details why the UDRP complainant NetEarth Group, Inc, was not given the option to renew or restore the domain name <netearthone.biz> under the same commercial terms as the registrant, as required by Section 3.7.5.7 of the Expired Domain Deletion Policy (“EDDP”);
5. Explanation and details regarding how, as detailed in the Decisions, your registrar’s actions do not, either directly or through its affiliates or resellers, trigger Sections 5.5.2.3 and 5.5.2.4 of the RAA.
6. Confirmation that the Freenom is a reseller of OpenTLD, and if so, please also provide a copy of the executed reseller agreement between Freenom and OpenTLD, as required by Section 3.12 of the RAA;
7. Documentation demonstrating that Freenom is a separate legal entity from OpenTLD, as required by Section 3.12 of the RAA;

8. Confirmation that Stichting OpenTLD WHOIS Proxy is the Privacy/Proxy Service Provider of OpenTLD, and if so, please provide links to the required disclosures and requirements of Sections 2.1 to 2.5 of the Privacy/Proxy Specification of the RAA; and

9. Copies of the time stamped renewal notices sent to the RNH of domain name <netearthone.biz> by your registrar (or reseller if applicable).

Please send the information and records requested above via reply email (no more than 4 MB total) and do not change the email subject heading. Please provide records as attachments in .TXT, .PDF, or .DOC(X) format.

Thank you in advance for your cooperation.

Sincerely,

Yungsheng Wang
ICANN Contractual Compliance