

ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE
(Beijing Office)

ADMINISTRATIVE PANEL DECISION

Case No. CN 1300669

Complainant: Titi Tudorancea

Respondent: Patrick Larouche

Domain Name: audioenglish.net

Registrar: Register.com, Inc.

1. Procedural History

On 8 May 2013, the Complainant submitted a Complaint to the Beijing Office of the Asian Domain Name Dispute Resolution Center (the ADNDRC) in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy) approved by the Internet Corporation for Assigned Names and Numbers (ICANN), the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the ADNDRC Supplemental Rules).

On 14 May 2013, the ADNDRC sent to the Complainant by email an acknowledgement of the receipt of the Complaint. On the same date, the ADNDRC transmitted by email to the Registrar and ICANN a request for registrar verification in connection with the disputed domain name. On 21 May 2013, the Registrar transmitted by email to the ADNDRC its verification response, confirming that the Respondent is listed as the registrant and providing the contact details.

On 21 May 2013, the ADNDRC transmitted the Written Notice of the Complaint to the Respondent, which informed that the Complainant had filed a Complaint against the Respondent over the disputed domain name and the ADNDRC had sent the Complaint and its attachments to the Respondent through email according to the Rules and the Supplemental Rules. On the same day, the ADNDRC notified the Complainant that the Complaint has been confirmed and transmitted to the Respondent, and notified the ICANN and the Registrar of the commencement of the proceedings.

The Respondent failed to submit a Response within the specified time

period. On 14 June 2013, the ADNDRC notified both parties of the Respondent's default, and informed both parties that the ADNDRC would proceed to appoint the panel for this case. On 25 June 2013, the ADNDRC notified the parties of selection of the panelists.

On 2 July 2013, the ADNDRC notified both parties of candidates in connection with listing. Having received a Declaration of Impartiality and Independence and a Statement of Acceptance from Mr. Zhao Yun, Mr. Luo Dongchuan and Mr. Guo Shoukang (Mr. Zhao Yun as the presiding panelist, Mr. Luo Dongchuan and Mr. Mr. Guo Shoukang as co-panelists), the ADNDRC notified the parties on 5 July 2013 that the Panel in this case had been selected. The Panel determines that the appointment was made in accordance with Rules 6 and Articles 8 and 9 of the Supplemental Rules.

On 5 July 2013, the Panel received the file from the ADNDRC and should render the Decision within 14 days, i.e., on or before 19 July 2013.

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

2. Factual Background

For the Complainant

The Complainant in this case is Titi Tudorancea. The registered address is Bd. Timisoara, nr. 35B, Bloc 229bis, Ap. 43, Sector 6, 061311 Bucuresti, Romania.

For the Respondent

The Respondent in this case is Patrick Laroche. The address is 133 Besserer Street, 45788 Bergen, CT, United States. The Respondent is the current registrant of the disputed domain name "audioenglish.net" according to the Whois information. The registrar of the disputed domain name is Register.com, Inc.

3. Parties' Contentions

The Complainant

On 25 March 2013, the Complainant submitted an UDRP complaint for the same domain name to the On-line ADR Center for the Czech Arbitration Center (CAC). The decision, published on 2 May 2013, rejected the complaint. The Complainant submits a new complaint, with additional evidence, to a different ADR provider, because the Complainant suspects that the Panelist in the original complaint was biased and misrepresented the Complainant's statements. The Complainant never stated that the disputed domain name was owned by the Complainant's company, Global Info SRL, but that the domain name belonged to the Complainant. The original complaint included abundant evidence that the domain belonged to the Complainant, and also the company Global Info SRL also belonged to the Complainant. In this complaint, the Complainant is providing additional evidence, namely the Statement from Global Info SRL on the trademark rights regarding Audioenglish.net, which explains that the Complainant is the owner of these rights.

The complaint is based on the unregistered common law trademark(s) and/or service mark(s), and/or the unregistered well-known trademark(s) and/or service mark(s), and/or the unregistered trademark(s), service mark(s) and/or any other mark rights arising from the goodwill generated by the use of the unregistered mark(s): audioenglish.net in textual form and in the graphical form illustrated in the file AudioenglishNetTrademarkGraphical.gif arising from the usage of this mark by the Complainant via his company Global Info SRL since 2005: a) internationally, in all countries or jurisdictions, based on the world-wide extent of the global internet network and according to the protection referred to in various international treaties such as the Paris Convention for the Protection of Industrial Property and the Agreement on Trade-Related Aspects of Intellectual Property Rights (the "TRIPS Agreement"), according to lex mercatoria; and/or b) in any local jurisdiction(s) around the world that permit(s) and/or stipulate(s) that such unregistered trademark/service mark rights would arise.

1) protected rights relied on by the Complainant: Common Law Trademark Rights

The domain name "audioenglish.net" is not only similar but is practically identical to the trademark "audioenglish.net" in textual form and in graphical form, the capitalization difference being minor. In considering whether the Complainant has sufficiently established rights in a mark,

panels have repeatedly held that trademark registration is not required under Policy 4(a)(i). Together, the domain name and the accompanying web site made the Audioenglish.net mark(s) well-known and famous over the about seven years of uninterrupted service, given the tremendously high traffic and revenues produced: more than 450 million pages viewed by users and internet visitors, more than 1.3 billion files served (hit), more than 140 million visits and more than 109 million unique visitors. The domain name was the property of the Complainant continuously from 2004 until March 2013, when took place the unauthorized, illegal transfer of the domain name to a new Registrar and a new Registrant (the Respondent). This fraudulent transfer was carried out by an unidentified cybercriminal who compromised the Yahoo Account of the Complainant.

Currently it is still under investigation how did the cybercriminal manage to compromise the Yahoo Account of the Complainant, but the hacker's subsequent actions are known. The hacker entered the Yahoo Account of the Complainant from IPs (Yahoo login proofs) belonging to at least two companies offering leased servers, server collation and web hosting services (Lease Web and Steadfast). It is possible that the cybercriminal used servers from these providers as internet access gateways, in order to conceal his real IP and location.

Subsequently, the hacker installed email blocking in the Yahoo account of the Complainant. The purpose of the blocking filters was to prevent confirmation emails from Yahoo and/or Melbourne IT to reach the inbox of the Complainant, who would have altered Yahoo/Melbourne IT to stop the domain name transfer. Then, impersonating the Complainant, using the Email Account of the Complainant, the hacker requested the transfer of the domain name from Melbourne IT to Register.com, to the name of a new Registrant. It is an obvious of identity theft. The hacker entered the Yahoo Account of the Complainant and stole the domain name, the domain name registration in the name of the Complainant was still valid. The domain name was renewed by the Complainant in August 2012 and the current registration was valid until August 2013.

Then the cybercriminal sent an email to the Complainant offering to sell him back the domain name, and sharing his Skype id. Via Skype chat, the cybercriminal admitted that he hacked the Yahoo Account of the Complainant. The original web site of the Complainant was as an online learning system giving access to probably the largest, most accurate database of English learning resources on the web. While the domain name was the property of the Complainant, the domain name and the accompanying web site were tremendously successful, reaching in 2012 an estimated figure of 36 million unique visitors per year. Commonly web

sites claim to be successful when they reach a daily traffic of about 2000 visitors, while the disputed domain name reached 50 to 100 times more than that, before being stolen.

The website was used by internet visitors from about 200 countries and its high traffic made it well known in the market sector of English learning all over the world. While it was owned by the Complainant, Audioenglish.net also reached an Alexa reputation of 837 sites linking in and the Global Alexa Rank 14343. The Complainant has established common law rights in the Audioenglish.net mark(s) pursuant to Policy 4(a)(1) through continuous and extensive use of the Audioenglish.net mark since August 2005, on the grounds of the following: evidence of Complainant's diverse global user and customer base, providing services under the Audioenglish.net mark in over 200 countries; evidence of more than 450 million pages viewed by users and internet visitors; evidence of more than 1.3 billion files served (hits); evidence of more than 140 million visits; evidence of more than 109 million unique visitors; evidence that Google users were effectively searching for Audioenglish.net or the variant "audio English" to reach the web site of the Complainant; evidence of advertisement of the Audioenglish.net mark since 2007 on the network of Internet Newspapers of the Complainant; and evidence of operation of the website of the Complainant from 2005 till 2013.

These facts are sufficient to permit the Panel to find the Complainant's Audioenglish.net mark has acquired secondary meaning, leading to common law rights in the mark. Also, the World Intellectual Property Organization's report entitled Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks recommends the factors to determine whether a mark is well-known: the degree of knowledge or recognition of the mark in the relevant sector of the public; the duration, extent and geographical area of any use of the mark; the value of the mark; and the record of successful enforcement of the mark. All these factors are met in this case.

As UDRP rules do not specify any local jurisdiction where the trademark rights should arise, any single jurisdiction around the world where Audioenglish.net could be granted or allowed to acquire unregistered well-known or common law trademark or service mark status, or through the accumulation of goodwill, would lead to the fulfillment of the requirement of UDRP 4(a). Also the requirement of UDRP 4(a) can also be seen as being fulfilled according to *lex mercatoria*, the internationally accepted rules of trade that grant Audioenglish.net an unregistered well-known trademark status.

2) the Respondent does not have any rights or legitimate interest in the domain name

categories of issues involved: Domain parking, Diversion of consumers/trade mark tarnishment, Competitors' sites, Domain acquired by identity theft. The Complainant never allowed the Respondent to use any of his trademark rights, and never had any contact with the unidentified cyber criminal before the domain was stolen. After the domain name was stolen by the cyber criminal who compromised the email address of the Complainant, the hacker offered it for sale to the Complainant for a sum far above the price of registering a domain name. When the hacker entered the Yahoo Account of the Complainant, the domain name registration was still valid. It was renewed by the Complainant in August 2012 and the registration was still valid until August 2013.

The offer was made immediately after the transfer of the domain was completed. Therefore, it is obvious that the purpose for registration of the domain name by the Respondent was blackmail, and blackmail has no connection with a bona fide offering of goods or services. Via Skype chat, the cybercriminal admitted that he hacked the Yahoo Account of the Complainant. The stolen domain is currently used by the Respondent to redirect users of the original website to the DNS of a second domain, parking.bodies.com through a DNS redirect (CNAME) and from here visitors are served a page from a third domain name, <http://52664.quikker.com/>. This page has virtually no content other than the text: SKIP THIS PAGE. From this empty page, through a sneaky JS-based redirect, visitors are redirected once more, to a fourth web site, worlddictionary.com.au, delivered from the IP 216.185.158.228 hosted by Hostway Services, Inc. This fourth web site does not mention any owner and seems to be used mainly in India. The relationship between this web site and the cybercriminal is unclear at this time.

From other countries, the web site audioenglish.net appears to be redirected to Casino Web Sites, and so on. The Respondent has not been commonly known by the domain name. As shown before, the Respondent is only using the stolen domain to redirect the users of the original web site to a chain of other web sites, misleading diverting consumers, tarnishing the trademark at issue and disrupting the business of the Complainant.

3) the domain name has been registered and is being used in bad faith

Categories of issues involved: cumulative requirement (registration in

good faith, use in bad faith); registration of a well-known/famous trademark; bad faith trademark/business name registration; deliberate provision of false/misleading Whois data; constructive knowledge/prior knowledge of potential rights; blocking registration; speculation in domain names; holding domain name for purpose of selling, licensing or renting (Offer to Complainant); selling, licensing or renting was the primary purpose; domain parking; disrupting the business of a competitor; attracting internet users for commercial gain by creating a likelihood of confusion with the Complainant; the domain name was transferred to the Respondent by way of identity theft.

The Respondent has made an offer to sell the domain name back to the legitimate, previous owner for a sum far above the price that is usually paid to register a domain name. Initially the hacker asked 450 USD, then via Skype chat he blackmailed the Complainant and raised the price to 1200 USD, 1800 USD, 2000 USD. Also, during the CAC Administrative Procedure, the Respondent offered by e-mail to sell the disputed domain name to the Complainant. The email address of the Respondent is the same as the address of the hacker. Therefore, there are circumstances indicating that the Respondent has registered (or acquired) the domain name primarily for the purpose of selling or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the domain name.

The Complainant agreed to pay 2000 USD, but only after the domain was returned to him. The hacker refused these terms and insisted to be paid upon. By not accepting to return the stolen domain name in exchange for a subsequent payment of 2000 USD from the Complainant, there are circumstances indicating the offer to sell back the domain was not made with the real intention to return the domain but in fact the Respondent may have acquired the domain name for the purpose of disrupting the business of the Complainant.

Also, keeping in mind the chain of redirects that the Respondent has set up from the stolen domain name to "parking.bodis.com", from there to "52664.quikker.com" and from there to "worddictionary.com.au", it is clear that the Respondent has intentionally attempted to mislead and attract, for commercial gain, Internet users to Respondent's web site or to another on-line location by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's web site or location or of service on

Respondent's web site or on another location.

Also, the WHOIS address on the Respondent appears to be fake, because according to the US Postal Service web site, there is no town/city called Bergen in Connecticut. Furthermore, according to the same web site, the postal code 45788 points to Whipple, OHIO. It is unclear if the name of the Respondent is the name of a real person or it is only a fake identity created by the hacker, but the email address is valid: it is the email address of the cybercriminal. From this same email address, the cybercriminal sent the offer to sell back Audioenglish.net to the original, legitimate Registrant.

Given the fact that there are circumstances indicating that the Respondent or the hacker impersonating the Respondent has registered the domain name by fraud for the purpose of disrupting the business of the Complainant, breaching not only one but all the terms of the UDRP article: "Evidence of Registration and Use in Bad Faith", the Complainant requests the Panel to require that any Response from the Respondent should be accompanied by a copy of a proper, government-issued ID document of the Respondent.

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

The Respondent

The Respondent failed to submit a Response within the specified time period.

4. Findings

Admissibility of the Refiled Complaint

The Complaint was earlier rejected in Case No. 100576 at the On-line ADR Center of the Czech Arbitration Court (CAC) on 28 April 2013 for the failure of the Complainant to satisfy the first element of paragraph 4(a) of the Policy concerning the rights of the Complainant. Thus, this Panel needs to consider whether this refiled complaint shall be admissible in the current form. Consensus has been reached that a refiled complaint shall be accepted only in limited circumstances. The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition provides the circumstances when the refiled complaint can be admitted, "when the

complainant establishes in the complaint that relevant new actions have occurred since the original decision, or that a breach of natural justice or of due process has occurred, or that there was other serious misconduct in the original case (such as perjured evidence). A refiled complaint would usually also be accepted if it includes newly presented evidence that was reasonably unavailable to the complainant during the original case.”

In the current complaint, the Complainant is concerned about the possibility of previous Panel’s misrepresentation of the Complainant’s statements and submitted further evidence to address the Complainant’s rights, which was the main justification for the previous Panel to reject the original complaint. Therefore, the current panel decides that the Complainant has clearly indicated the ground justifying the refiling of this complaint and as such, this refiled complaint is admissible.

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

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

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

Identity or Confusing Similarity

As correctly decided in the original decision, “the Complainant is the general manager of the company Global Info SRL that has been using the term “audioenglish.net” for about eight years. On the basis of the Complainant’s contentions the Panelist has no reason to doubt that Global Info SRL established common law trademark rights in the said term.” To elaborate a bit further this common law trademark, it is clear that the Complainant and its company have made extensive use of the mark “audioenglish.net” in relevant services in many jurisdictions for more than seven years and achieved great success in its business. This can be well evidenced by the company’s global customer base, the large number of viewers, visits and hits of the website, the wide advertisement of the mark for business. Furthermore, search results of this mark in major search

engines (such as google) lead to the company and its website. In view of the sufficient evidence submitted concerning the wide use and acceptance of the term “audioenglish.net” in the market all over the world, the current panel fully agrees with this earlier decision of this learned Panel and will not go further to elaborate on the issue of the existence of common law trademark rights.

The earlier decision failed to find the Complainant enjoys this common law trademark rights. In this refiled complaint, the Complainant submitted a statement made by the company Global Info SRL that the Complainant is the legitimate owner of the mark “audioenglish.net”. The Respondent did not submit any response to refute this evidence. With this further evidence submitted by the Complainant, this Panel has no problem in finding that the Complainant enjoys the indisputable common law trademark rights over the term “audioenglish.net”.

No doubt, the disputed domain name “audioenglish.net” is identical with the common law trademark “Audioenglish.net” of the Complainant.

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

Rights or Legitimate Interests of the Respondent

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

The Respondent has failed to show that the Respondent has any rights or legitimate interests in respect of the disputed domain name. No evidence has shown that the Respondent is using or plans to use the domain name for a *bona fide* offering of goods or services. The Respondent is not commonly known by the disputed domain name. The evidence submitted by the Complainant further shows that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. The act of registering the disputed domain name does not automatically endow any legal rights or interests with the Respondent.

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

Bad Faith

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

- (i) Circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) You have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) You have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) By using the domain name, you have intentionally attempted to attract, for commercial gain, internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

The Complainant has been carrying out business with the common law trademark "Audioenglish.net" and achieved great success. This can be well testified by the evidence submitted by the Complainant: the number of pages views by Internet users, the number of visits, the number of files visited and advertisement, etc. The Complainant has put in a lot of money and efforts in promoting its products and services trademarked with "Audioenglish.net".

The evidence shows that the Respondent, after obtaining the disputed domain name, tried to sell the domain name to the Complainant with the price of 2000 USD, which is much higher than the normal registration costs. This situation constitutes exactly the type of bad faith use of the disputed domain name as identified in the Policy, i.e. "circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name."

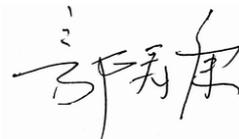
Accordingly, the Panel finds that the Complaint satisfies the condition provided in Paragraph 4(a)(iii) of the Policy.

5. Decision

Having established all three elements required under the Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the disputed domain name “audioenglish.net” should be TRANSFERRED from the Respondent to the Complainant Titi Tudorancea.

Panelist: 

Panelist: 

Panelist: 

Dated: 19 July 2013