

ADMINISTRATIVE PANEL DECISION

Victron Energy B.V. v. Privacy Administrator, Anonymize Inc. / SARVIX, INC.
Case No. D2022-1186

1. The Parties

The Complainant is Victron Energy B.V., represented by Leopold Meijnen Oosterbaan advocaten, Netherlands.

The Respondent is Privacy Administrator, Anonymize Inc. / SARVIX, INC., represented by Howard M. Neu Law Offices, United States of America (“United States” or “US”).

2. The Domain Name and Registrar

The disputed domain name <victron.com> is registered with Epik, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 5, 2022. On April 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 5, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

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 (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 27, 2022. The Response was filed with the Center on April 27, 2022.

The Center appointed Assen Alexiev, Warwick A. Rothnie, and Jeffrey Neuman as panelists in this matter on May 11, 2022. The Panel finds that it was properly constituted. Each member of the Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant was founded in 1975. It designs and produces pure sine wave inverters and inverter/chargers, battery chargers, DC/DC converters, circuit breakers, charge current distributors, gel batteries, AGM batteries, lithium batteries, battery monitors, solar charge controllers, solar panels, complete network solutions, and other independent energy supply solutions. The Complainant's products are sold worldwide.

The Complainant is the owner of the following trademark registrations for the sign "VICTRON" (the "VICTRON trademark"):

- the European Union trademark VICTRON with registration No. 009730045, registered on November 9, 2012 for goods in International Class 9;
- the United Kingdom trademark VICTRON with registration No. UK00909730045, registered on November 9, 2012 for goods in International Class 9;
- the South African trademark VICTRON with registration No. 2011/10300, registered on February 14, 2013 for goods in International Class 9;
- the International trademark VICTRON with registration No. 1268076, registered on July 20, 2015 for goods in International Class 9; and
- the United States trademark VICTRON with registration No. 5,126,185, registered on January 24, 2017, for goods in International Class 9.

The Complainant uses the VICTRON trademark in its company logo, on its products and instruction manuals and on its main website, available in 20 languages, which is located at the domain name <victronenergy.com>, registered by the Complainant on July 20, 2000. The Complainant also promotes its goods and services under the VICTRON trademark on Facebook, Youtube, Twitter, and LinkedIn.

The disputed domain name was registered by a third party on January 29, 1993. The Respondent acquired it at a public tender in March 2020 for a price of USD 7,000. In 2020 and 2021, the disputed domain name resolved to a landing webpage that informed visitors that it was available for sale and invited them to request a price quote. The disputed domain name is currently inactive.

5. Parties' Contentions

A. Complainant

The Complainant states that the disputed domain name is confusingly similar to the VICTRON trademark, because it incorporates the entirety of this trademark without any other elements. The Complainant submits that the VICTRON trademark is registered in many jurisdictions and is widely known around the world and is inherently distinctive, without being descriptive or having a specific meaning. The Complainant also submits that a Google search carried out on April 5, 2022, for the countries Chile, France, Germany, Italy, Russia, Spain, Turkey, United States, United Kingdom, and South Africa with the key word "victron" shows that all search results on the first page relate to the Complainant.

According to the Complainant, the Respondent has no rights or legitimate interests in the disputed domain name, because it is not affiliated with the Complainant and has not been licensed by the Complainant to use the VICTRON trademark, is not commonly known by the disputed domain name, and has not acquired any trademark rights in it. The Complainant adds that the Respondent does not use the disputed domain name in connection with a *bona fide* offering of goods or services and is not making a legitimate noncommercial or fair use of it. The Complainant submits that the Respondent registered the disputed domain name in 2020 and immediately started offering it for sale.

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith. According to the Complainant, at the time of obtaining the disputed domain name the Respondent

knew of the existence of the Complainant's VICTRON trademark, registered earlier in many jurisdictions, including the United States, and should have known that its registration would be identical or confusingly similar to this trademark. The Respondent registered the disputed domain name in 2020 and started offering it for sale. It offered the disputed domain name for sale to the Complainant on September 7, 2021, for an amount in the "five figure range" (between USD 10,000 and USD 99,999), which is substantially more than the "out of pocket" costs for registering the disputed domain name. According to the Complainant, the above shows that the Respondent's intent in obtaining and registering the disputed domain name was to profit from its sale to the Complainant.

The Complainant also maintains that the Respondent's use of the service Anonymize Inc., to keep its identity hidden is a further indication of bad faith.

B. Respondent

The Respondent states that for many years, the Registrar has automatically provided its own privacy service Anonymize, Inc., for all domain names registered by the Respondent. The Respondent notes that it uses this privacy service to be able to conduct its business as a professional domain name investor without the necessity of constantly having to answer phone calls from prospective buyers.

The Respondent states that it is in the business of registering and using generic and brandable domain names for email addresses and has accumulated over 500 domain names that are used in this manner. The Respondent's business is investing in and selling or leasing domain names. The Respondent submits that it acquired the disputed domain name in March 2020 in a NameJet.com auction for USD 7,000.00. Upon acquisition of the disputed domain name, the Respondent placed it on the Uniregistry Market. According to the Respondent, monetizers always put up "for sale" signs on the website, and offers are made by potential buyers and either accepted or rejected by the domain name registrant.

The Respondent submits that the Complainant approached it to purchase the disputed domain name, but was unhappy with the asking price, so filed the Complaint. The Respondent at no time approached the Complainant to sell the disputed domain name to it and the Complainant falsely accused the Respondent of doing so. According to the Respondent, the Managing Director of the Complainant, initially reached out to the Respondent in September 2021, and asked the Respondent how much would be necessary to acquire the disputed domain name. The Respondent answered that it was looking for "five figures" without naming a price. The Complainant's response was, "Hi, thank you. Then we'll first check legal options to obtain it." The Complaint was subsequently filed by the Complainant, falsely accusing the Respondent of targeting the Complainant and seeking to sell the disputed domain name to the Complainant. In the Respondent's view, this is commonly known as a "Plan B" acquisition.

The Respondent states that prior to bidding on the disputed domain name at the NameJet auction, it researched Google, looked at the history of the disputed domain name and checked the Wayback Machine. The disputed domain name piqued the Respondent's interest as it had a very early initial registration date in 1993, and was used by Victron Electronics of California, which later went out of business and allowed the registration to expire. The Respondent then conducted a trademark search through the United States Patent and Trademark Office ("USPTO") and discovered many registered trademarks, both dead and live dating back to 1980 in different classes, so the Respondent knew that the word "Victron" had some value as it had been used by various registrants over the years.

The Respondent notes that Victron Energy, Inc., a Texas corporation registered VICTRON as a trademark on October 2, 2007, and renewed it on December 29, 2016. Victron Stores registered VICTRON as a trademark on October 7, 2007, and renewed it on December 28, 2016. Daifuku Co, Ltd, a Japanese corporation, registered VICTRON as a trademark on July 3, 2012, but cancelled the trademark on July 19, 2021, over a year after the Respondent registered the disputed domain name. The Respondent continued to research the word and found that it was not a "made-up" word, but rather was a Latin word for "conqueror". The Respondent claims that at no time since its acquisition has it used the disputed domain name to target the Complainant, its business, or even its competitors as there are no links on the associated website. The

Respondent points out that it has continuously parked the disputed domain name with Uniregistry Marketplace, a reputable aggregator, and has never used it to link to the Complainant's website, to its products or to any other business. There was simply a "For Sale" sign up on the website without links. The Respondent maintains that the website reflects no mention or reference to the Complainant's business and cannot cause any confusion with the Complainant's business. The Respondent categorically denies that it has registered the disputed domain name with an intent to sell it to the Complainant, to disrupt its business, to prevent it from registering its trademark or to confuse consumers, and notes that there is no evidence in support of the opposite.

The Respondent points out that there is no allegation in the Complaint that the disputed domain name has caused any confusion as there is no reference to the Complainant or any competitor of the Complainant, and there is no use of the Complainant's distinctive trademark on the website.

The Respondent submits that Panels acting under the Policy have held for many years that domain name investing is a legitimate business so long as the Complainant's trademark is not targeted by any links on the associated website, and that domain name investors can sell their domain names for whatever they believe the market will bear.

The Respondent notes that the Complainant alleges that "an amount between USD 10,000 and USD 99,999 is substantially more than the "out of pocket costs for registering the disputed domain name". However, the Respondent paid USD 7,000 for the disputed domain name in an after-market auction, in which the Complainant could have bid on it and won it at a price substantially more than it cost to file the Complaint. The Respondent adds that it has sold a number of domains for "five figures" or more, so it was in the ordinary course of business that the Respondent would respond to an offer to purchase the disputed domain name by the Complainant of "five figures".

The Respondent points out that the Complainant has made the certification in the Complaint that the information contained in this Complaint is to the best of the Complainant's knowledge complete and accurate. Yet, the Complainant alleges in of its Complaint that "the Respondent is actively offering the disputed domain name for sale and contacted the Complainant in order to sell the disputed domain name for an amount in the five figure range". According to the Respondent, this statement is false and is made purposely to prejudice the Respondent in this proceeding.

According to the Respondent, the Complainant is unable to exhibit evidence of bad faith registration and use under Paragraph 4(b)(i) of the Policy. The Respondent states that it has not set up any links to the disputed domain name and just has a "for sale" sign on the website, just like all of the Respondent's other domain names. According to it, there can therefore be no likelihood of confusion with the Complainant's trademark by having the disputed domain name parked at Uniregistry Marketplace.

6. Discussion and Findings

Pursuant to the Policy, paragraph 4(a), the Complainant must prove each of the following to justify the transfer of the disputed domain name:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has provided evidence of the registration of the VICTRON trademark and has thus

established its trademark rights for the purposes of the Policy.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the generic Top-Level Domain (“gTLD”) section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). See section 1.11.1 of the [WIPO Overview 3.0](#). The Panel sees no reason not to follow the same approach here, so it will disregard the “.com” gTLD section of the disputed domain name.

The relevant part of the disputed domain name is therefore the element “victron”, which reproduces the VICTRON trademark entirely without the addition of any other elements.

Therefore, the Panel finds that the disputed domain name is identical to the VICTRON trademark in which the Complainant has registered trademark rights.

B. Rights or Legitimate Interests

The Respondent is a domain name reseller, and one of its defenses is that the disputed domain name was acquired for its legitimate domain investment business and that it was not targeting the Complainant. As summarized in section 2.1 of the [WIPO Overview 3.0](#), generally speaking, panels have accepted that aggregating and holding domain names (usually for resale) consisting of acronyms, dictionary words, or common phrases can be *bona fide* and is not *per se* illegitimate under the UDRP. However, this would not apply if the registration and resale of a domain name is made with the trademark of another in mind. As discussed in detail in section 6.C below, the majority of the Panel believes that it is more likely than not that the Respondent has registered and used the disputed domain name in an attempt to extract profit from it based on the goodwill of the Complainant and the other entities that are holders of trademark registrations for VICTRON. The Panel does not regard such conduct as giving rise to rights or legitimate interests in the disputed domain name.

The Respondent also submits in its Response that the disputed domain name reflects a dictionary word. According to it, “victron” means “conqueror” in Latin, as indicated by the Google Translator. As summarized in section 4.8 of the [WIPO Overview 3.0](#), noting in particular the general powers of a panel articulated *inter alia* in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision. This may include, *inter alia*, a review of dictionaries or encyclopedias. On this basis, the Panel has made independent research by checking the word “Victron” in various online dictionaries, and the lack of any entries for it does not support a conclusion that “Victron” is indeed a dictionary word.

Further, even if “victron” were a term in Latin, in the experience of the majority of the Panel it is hardly a Latin word in anything like common usage such as “prima facie”, “bona fide”, “ad hoc”, or “victor”.

Further, as discussed in section 2.10.1 of the [WIPO Overview 3.0](#), panels acting under the Policy have recognized that merely registering a domain name comprised of a dictionary word or phrase does not by itself automatically confer rights or legitimate interests on the respondent, and mere arguments that a domain name corresponds to a dictionary term/phrase will not necessarily suffice. In order to find rights or legitimate interests in a domain name based on its dictionary meaning, the domain name should be genuinely used, or at least demonstrably intended for such use, in connection with the relied-upon dictionary meaning and not to trade off third-party trademark rights. There is no evidence of any use of the disputed domain name in relation to the alleged dictionary meaning and the Respondent does not maintain to have carried out such use of it. Therefore, the Panel unanimously concludes that even if “Victron” was a dictionary word, the lack of any use of the disputed domain name in relation to its meaning in Latin does not support a conclusion that the Respondent has rights or legitimate interests in it. There is also no evidence, and the Respondent does not claim, that the Respondent has been using or engaged in demonstrable preparations to use, the disputed domain name in connection with goods or services of some other trademark owner.

Taking the above into account, the Panel concludes that the Complainant has met its burden under the second element.

C. Registered and Used in Bad Faith

The disputed domain name was first registered by a third party in 1993, which is nineteen years before the first registration of the Complainant's VICTRON trademark. The Respondent however submits that it acquired the disputed domain name at a public tender in March, 2020 for the price of USD 7,000. As discussed in section 3.9 of the [WIPO Overview 3.0](#), the transfer of a domain name registration from a third party to the respondent is not treated as a renewal of the registration by the same registrant and the date on which the current registrant acquired the respective domain name is the date a panel will consider in assessing bad faith. Therefore, the Panel will analyze the Respondent's conduct in March 2020 and afterwards to reach a conclusion on whether the disputed domain name has been registered and used in bad faith.

The Respondent states that "prior to bidding on the disputed domain name at the NameJet auction, it researched Google", but does not explain what its research revealed. The Complainant has submitted a printout of a Google search for the keyword "Victron", and the primary results refer to the Complainant. The Respondent has not disputed this printout. The Panel independently made a time-limited Google search for the keyword "Victron" for the first half of 2020, and the results of the search are similar to those of the search submitted by the Complainant. See section 4.8 of the [WIPO Overview 3.0](#).

Taking the above into account, in the absence of conflicting evidence and in the lack of any denial of knowledge of the Complainant by the Respondent, the Panel unanimously accepts that the Google search carried out by the Respondent made it aware of the Complainant prior to the acquisition of the disputed domain name in 2020.

The Respondent further states that after making the Google search it "then conducted a U.S.P.T.O. trademark search and discovered many registered trademarks, both Dead and Live dating back to 1980 in different classes".

While the Response does state that the USPTO search "discovered many registered trademarks, both Dead and Live dating back to 1980 in different classes", the Response includes evidence of only two currently registered trademarks for VICTRON, Trademark Nos 3304319 and 3309236, and one cancelled registration apart from the Complainant's registration. Trademark Nos 3304319 and 3309236 are formally registered in different entities' names although it appears from the details in the Response that they are likely closely related as they have the same address and the same attorney of record.

According to the majority of the Panel, the fact that a trademark has been removed from the Register, or cancelled, does not support an argument that the formerly registered term is in common use or even still in use at all.

Since the Respondent has conducted its USPTO trademark search in 2020, one of the results must have been the Complainant's United States trademark VICTRON with US registration No. 5,126,185 and International registration No. 1268076, registered on January 24, 2017. The Respondent does not deny that this trademark appeared in the results of its USPTO search. The Panel therefore unanimously accepts that when it acquired the disputed domain name at the public tender, the Respondent was aware that the Complainant of which it was aware as a result of its Google search also had a United States trademark for VICTRON.

The Respondent then states that based on its research, it "knew that the word 'VICTRON' had some value as it had been used by various registrants over the years." The majority of the Panel understands this to mean that the Respondent appreciated that the disputed domain name had value because it reproduced the name of the Complainant and its VICTRON trademark, as well as the names and trademarks of other parties, *i.e.*, to the secondary meaning of the word "Victron" that was generated through its use by the

Complainant and the other parties.

As discussed in the section on rights and legitimate interests, the majority of the Panel is not convinced by the Respondent's allegation that "Victron" is a dictionary word, and in any case, the Respondent has not used the disputed domain name in relation to its alleged dictionary meaning. Rather, the VICTRON trademark appears to be a made-up word, and its distinctiveness is also acknowledged by the Respondent. Therefore, the majority of the Panel finds no basis to conclude that the disputed domain name has been purchased by the Respondent due to an alleged dictionary meaning.

There is no dispute between the Parties that the Respondent started offering the disputed domain name for sale immediately after its acquisition. The printouts of the associated website as of August 1, 2020 and August 24, 2021, submitted by the Complainant have not been challenged by the Respondent, and they show that in 2020 and 2021 the disputed domain name resolved to a landing webpage that informed visitors that it was available for sale and invited them to request a price quote. According to the majority of the Panel, hanging a "for sale" sign out and then receiving a query can hardly be described as an unsolicited approach. In its words in the response to the Complainant's query about the price, the Respondent was "looking for offers in the 5 figure range for this domain name." In these circumstances, the Respondent cannot portray itself as innocently minding its own business until an unsolicited offer came in.

All the above leads the majority of the Panel to the conclusion that it is more likely than not that the Respondent has purchased the disputed domain name because of its potential to be resold at a profit mainly to the Complainant or to one of the other parties having rights over the name "Victron", and that the Respondent has targeted them with the acquisition of the disputed domain name and its subsequent putting up for sale. The fact that more than one entity has been targeted by the Respondent does not mean that such targeting would be legitimate, and the purchase of the disputed domain name with the expectation to set up a bidding war between two trademark owners is plainly a speculative attempt to exploit the trademark significance of the disputed domain name.

The majority of the Panel notes that this conclusion is consistent with the majority opinion in *Matias Eduardo Araya Varela v. Jason Newby*, WIPO Case No. [D2021-4256](#). As stated there;

"[t]he majority of the Panel considers that the fact that the Respondent targeted the Complainant's trademark in bad faith cannot be cured by the allegation that this target was not alone or exclusively to the Complainant and his trademark, but included as well other third parties' brands. In this respect, the majority of the Panel finds that the fact that the Respondent targeted more than one trademark does not cure or dilute his existing bad faith in relation to each of the targeted brands."

The majority of the Panel further notes that the circumstances of this case appear to be very different to the circumstances of the two cases quoted in the dissenting Panel's opinion in *Matias Eduardo Araya Varela v. Jason Newby*, WIPO Case No. [D2021-4256](#).

In *Asset Marketing Systems, LLC v. Silver Lining*, WIPO Case No. [D2005-0560](#), the unsuccessful complainant claimed rights in the term "guest speaker" and relied solely on constructive notice as a foundation for its bad faith allegation. The panelist rejected that claim on the basis that constructive notice has no basis under the Policy. In the present case, however, all members of the Panel accept that the Respondent clearly knew about the Complainant's trademark before registering the disputed domain name.

In *Terana, S.A. v. RareNames, WebReg*, WIPO Case No. [D2007-0489](#), the Panel found:

"The word Terana is not exclusively associated with the Complainant. It has many uses, including a geographical, botanical and personal name. The Complainant has not asserted that its mark has ever been used in the United States of America, where the Respondent is based, nor has it asserted that its mark is famous or well-known. The Respondent has produced sworn evidence that it did not have the Complainant in mind and was not aware of the Complainant's Mexican trademark when the Respondent registered the domain name. Under these circumstances the Panel is not satisfied to the contrary."

That is a very different case to the present case.

The Respondent has not specified the exact amount that it was looking for as price of the disputed domain name. A 5-figure amount would be anywhere between USD 10,000 and USD 99,999. Even if the lowest figure is taken, it would still make a 43% profit, and will be well in excess of the Respondent's documented out-of-pocket costs directly related to the acquisition of the disputed domain name, which it states were equal to USD 7,000.

On this basis, taking into account all the circumstances of the present case, the Panel finds it more likely than not that the Respondent has acquired the disputed domain name primarily for the purpose of selling it to the Complainant who is the owner of the VICTRON trademark, or to another entity that has trademark rights in "Victron", for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name, and that therefore the Respondent has registered and used the disputed domain name in bad faith under Paragraph 4(b)(i) of the Policy.

7. 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 <victron.com> be transferred to the Complainant.

Assen Alexiev
Presiding Panelist

Warwick A. Rothnie
Panelist

Jeffrey Neuman
Panelist (Dissenting)

Date: June 2, 2022

Dissenting Opinion

Although I agree with a number of the points raised by the majority, I do not believe that the Complainant met its burden of proof in establishing that the disputed domain name was registered and used in bad faith. And for that reason, I would not have ordered the transfer of the disputed domain name.

Section 4(b) of the Policy states that for the purpose of satisfying that the domain name was registered and used in bad faith, the following shall be evidence of the registration and use of a domain name 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; (emphasis added)

The Complainant's evidence of bad faith targeting consists solely of (i) the Respondent knew the Complainant had rights in the VICTRON mark, (ii) it immediately put the domain name up for sale, and (iii) when the Complainant approached the Respondent, the Respondent asked for five figures. No further communication took place between the Complainant and the Respondent. Complainant filed this action. These facts alone are not enough to establish the requisite targeting required under paragraph 4(b)(i) of the

Policy. Yet, the majority did find that there was such targeting, stating “it is more likely than not that the Respondent has registered and used the disputed domain name in an attempt to extract profit from it based on the goodwill of the Complainant or any of the other entities that are holders of trademark registrations for VICTRON.” (emphasis added). In other words, even if the Respondent did not specifically have Complainant in mind but another rights holder when it registered the dropped domain name, nevertheless the registration must have been in bad faith. That is not consistent with the consensus view of the UDRP.

As stated in the dissent in *Matias Eduardo Araya Varela v. Jason Newby*, WIPO Case No. [D2021-4256](#) (March 21, 2022):

“It is a foundational principle of the UDRP that a complainant has the burden of proving that it is the targeted rights holder. The essence of the Complaint is an allegation of bad faith, bad faith targeted at the Complainant. Asset Mktg. Sys., LLC v. Silver Lining, WIPO Case No. [D2005-0560](#). There is a long history of decisions on this issue. There is no proof in the record of this case that supports targeting. Terana, S.A. v. RareNames, WebReg, WIPO Case No. [D2007-0489](#) (Holding that “Unless the trademark owner or its mark are targeted by the domain name registrant, the offering for sale to the general public of a domain name and the generation of pay-per-click advertising revenue from a domain name do not constitute evidence of bad faith registration or use”);”

[WIPO Overview 3.0](#) Section 3.2.1 provides a number of circumstances panels have taken into account in assessing whether the respondent’s registration of a domain name is in bad faith, including (i) the nature of the domain name (e.g., a typo of a widely-known mark, or a domain name incorporating the complainant’s mark plus an additional term such as a descriptive or geographic term, or one that corresponds to the complainant’s area of activity or natural zone of expansion), (ii) the chosen top-level domain (e.g., particularly where corresponding to the complainant’s area of business activity or natural zone of expansion), (iii) the content of any website to which the domain name directs, including any changes in such content and the timing thereof, (iv) the timing and circumstances of the registration (particularly following a product launch, or the complainant’s failure to renew its domain name registration), (v) any respondent pattern of targeting marks along a range of factors, such as a common area of commerce, intended consumers, or geographic location, (vi) a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent’s choice of the domain name, or (viii) other indicia generally suggesting that the respondent had somehow targeted the complainant.

In this case, we have such a thin record of facts to support a finding of bad faith. (i) The Complainant has not demonstrated that its mark is famous or well-known; (ii) there is no content on the website other than essentially a “for sale sign”. There are no links, advertising, or any other content on the website that generates revenue, points to the Complainant or a competitor of the Complainant; (iii) the registration was not linked in time to any product release of the Complainant, but rather was bought at an auction when the original registrant’s 26+ year registration expired; (iv) there is no evidence that the respondent has a pattern of targeting trademarks or (v) any other *indicia* generally suggesting that the Respondent had somehow targeted the Complainant.

The Respondent states in its Response, “the Respondent then conducted a USPTO trademark search and discovered many registered trademarks, both Dead and Live dating back to 1980 in different classes, so the Respondent knew that the word ‘Victron’ had some value as it has been used by various registrants over the years.” It then provides examples of other applicants that have, or have had, applications or registrations filed at the USPTO. The majority takes the Respondent’s statement as an admission that it was targeting trademark owners. However, the Respondent was merely providing examples of who else it discovered in its search used the mark and therefore it believed that the disputed domain name could be used by other parties in a manner that was non-fringing with any other trademark owner, including the Complainant. In fact, the Respondent’s search found another entity sharing the same company name as the Complainant which is unaffiliated with the Complainant (Victron Energy, Inc., a Texas Corporation).

The fact that the Respondent acknowledged that there are a few trademark owners that may have rights in a mark in certain classes of goods and services does not mean that it was targeting those trademark owners.

The Respondent was merely specifying the diligence it preformed prior to registering the disputed domain name. Many panels in the past several years have acknowledged that domainers or those that are in the business of buying and selling domain names should undertake good faith efforts to screen such registrations against readily available online databases to “avoid the registration trademark-abusive domain names.” See WIPO Overview at Section 3.2.3. The Overview then states:

“Noting the possibility of co-existence of trademarks across jurisdictions and classes of goods and services, and the fact that trademarks which may be inherently descriptive in one context may be generic in another, the mere fact of certain domain names proving identical or confusingly similar to third-party trademarks pursuant to a search does not however mean that such registrations cannot as such be undertaken or would automatically be considered to be in bad faith.”

This was reflected in the Overview because panels expect domain name investors to not be “willfully blind” to the trademark rights of others and to avoid trademark-abusive registrations. This registrant was showing that it did the good faith searches and found multiple parties using the mark, including the former registrant that owned the disputed domain name for over two decades. This Panelist believes that the “value” referenced by the Respondent was not an admission that it would be targeting trademark owners to engage in cybersquatting, but rather that given there are several current users of the mark, there potentially could be many other users of the mark in a non-infringing manner.

In addition, it cannot be discounted that the Complainant approached the Respondent about purchasing the disputed domain name, not the other way around. Finally, although the independent research performed by the majority shows that none of their online dictionaries show that the word “victron” translates to “conqueror”, the fact is that if you go into the Google Translate app and convert “Victron” from Latin into English, Google does in fact display that it means “conqueror” in English. When evaluating the intent of the Respondent in registering the disputed domain name, the panel should not be substituting its own research for that which the Respondent did prior to purchasing the domain and for which it provides as evidence attached to its Response. Even if Google Translate is wrong, that doesn’t change the fact that the Respondent, when it registered the disputed domain name, believed Google translate was correct. The state of mind of the Respondent, when it can be shown, is a critical piece of evidence that cannot be ignored.

I agree with the majority that the Respondent must have known that the Complainant had rights in the VICTRON mark because of its admitted Google search and a search of the USPTO database. However, the majority has discounted the fact that at least one other party legitimately registered and used the disputed domain from 1993 through early 2020. Thus, for over 26 years the disputed domain name was registered and being used in good faith by an entity that was not the Complainant. The fact that there was a prior user of the disputed domain name for so long means that even if you discount the Respondent’s argument that the term Victron translates to “conqueror” in Latin, the Complainant was not the only one entitled to use this non-dictionary term.

In sum, the majority has found registration and use in bad faith based upon a new generalized targeting standard to conclude that Respondent must have acquired the disputed domain name to “extract profit” from the Complainant or another entity that holds a trademark. But the standard is not a generalized standard, but a very specific one where the Complainant must prove that the Respondent registered the disputed domain name specifically to sell that name to the Complainant. However, there is simply no evidence in the record establishing that.

/Jeffrey Neuman/
Jeffrey Neuman
Dissenting Panelist