

ADMINISTRATIVE PANEL DECISION

LAWCLOUD B.V. v. Wenjie Jiang

Case No. D2022-4908

1. The Parties

The Complainant is Lawcloud B.V., Belgium, represented by Advocatenkantoor Desdalex LLC, Belgium.

The Respondent is Wenjie Jiang, Cayman Islands, United Kingdom, represented by Muscovitch Law P.C., United States of America.

2. The Domain Name and Registrar

The disputed domain name <lawcloud.com> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 14, 2022. On December 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 22, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent (BRANDSLY) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 22, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on December 23, 2023.

The Center verified that the Complaint together with the amendment to 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 December 27, 2022. In accordance with the Rules, paragraph 5, the initial due date for Response was January 16, 2023. Upon the request of the Respondent, the due date for Response was extended to January 20, 2023, under paragraph 5(b) of the Rules. The Response was filed with the Center January 13, 2023.

The Center appointed Luca Barbero, Andrea Mondini, and Adam Taylor as panelists in this matter on February 7, 2023. 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 is a Belgian company that offers computer consulting activities primarily to law firms under the trade name "Lawcloud".

The Complainant has provided evidence of ownership of the Benelux trademark registration No. 1461322 for LAWCLOUD (figurative mark), filed on March 15, 2022, and registered on May 31, 2022, in classes 9 and 42; and of the International trademark registration No. 1671727 for LAWCLOUD (figurative mark), registered on April 14, 2022, in classes 9 and 42, designating the United Kingdom and Slovakia. Whilst the Complainant's application for registration in the United Kingdom has been opposed, a Statement of Grant of Protection has already been issued in connection with the Slovakia designation.

The Complainant is also the owner of many domain names consisting of LAWCLOUD, including <lawcloud.be>, registered on May 9, 2017, and <law.cloud>, registered on August 18, 2022, and used by the Complainant to promote its services under the trademark LAWCLOUD.

The disputed domain name <lawcloud.com> was registered on September 7, 2006, and is not pointed to an active website, but it is offered for sale on a domain name marketplace. The Respondent acquired the disputed domain name on October 19, 2016.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical to the trademark LAWCLOUD in which it has rights as it reproduces the trademark in its entirety with the mere addition of the generic Top-Level-Domain (TLD) ".com".

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name considering: i) the disputed domain name does not resolve to an active website and is not being used for legitimate noncommercial purposes, ii) the Respondent has not made demonstrable preparations to use the disputed domain name for an offering of goods and services, and iii) the Respondent is not known by the disputed domain name.

With reference to the circumstances evidencing bad faith, the Complainant submits that the disputed domain name was registered or acquired mainly with a view to selling, leasing, or otherwise transferring the disputed domain name to the holder of a name in respect of which a right is recognized or established by national and/or Community law, or to a public authority.

The Complainant underlines that the disputed domain name is offered for sale at the price of USD 98,000, and for hire purchase at a monthly fee of USD 8,167, and contends that the price for purchase or hire of the disputed domain name exceeds many times the registration fees.

The Complainant claims that the disputed domain name is the subject of cybersquatting, as a result of which the Complainant is prevented from registering and using the disputed domain name in good faith for its economic activities.

B. Respondent

The Respondent rebuts that the Complainant's allegations are unfounded considering the Complainant states it was incorporated in Belgium on September 5, 2017, which is long after the registration of the disputed domain name (in 2006) and submits that accordingly, from the very outset of the Complaint it is unclear why the Complainant had any basis to contend that the disputed domain name was registered in bad faith under the Policy when by its own admission, the Complainant was not incorporated until years later in 2017, and only obtained a trademark registration in 2022.

Moreover, the Respondent states that, though it is true that the Complainant was incorporated in 2017, the Complainant did not disclose that it was originally incorporated as "Integr8rs" B.V., and only changed its name to "Lawcloud" B.V. in December, 2021.

The Respondent also contends that the Complainant fails to provide any proof of its claims regarding its notoriety, such as media reports, customer volume, sales volumes, advertising and marketing expenditures, or survey evidence. In addition, the Respondent highlights that the Complainant states without evidence, that it is "known in the Benelux by its eponymous web application Lawcloud" but it failed to disclose when it launched its web application, how many users it has, what advertising and marketing was undertaken in relation to it, and what its sales volume are.

With reference to the Complainant's domain name <lawcloud.be>, registered on May 9, 2017, the Respondent states that the Complainant failed to provide any evidence of when it first began using this domain name or the extent and scope of such use.

With regards to the Complainant's claims on trademark rights, the Respondent contends that the Complainant has not claimed any common law or unregistered trademark rights nor did it provide any evidence of such rights and that the only jurisdiction where the Complainant holds a registered trademark is Benelux which was obtained only on May 31, 2022. The Respondent submits that the Complainant obtained no trademark in either the United Kingdom or Slovakia following its designations of these countries and underlines that a search of the Slovakian trademark registry shows no application or registration for a mark belonging to the Complainant whilst in the United Kingdom, the Complainant's application for registration has been opposed.

The Respondent also underlines that she registered the disputed domain name, because she is a technology and e-commerce entrepreneur and domain name investor, who, in 2016, took note of the emergence of cloud computing and foresaw the application of cloud computing to many fields of human endeavor, including law.

Moreover, the Respondent confirms that, since 2016, when she registered the disputed domain name, she began offering her domain names for sale via her website at "www.brandsly.com", including the disputed domain name, which was offered to the general public in 2016, before the Complainant even existed.

The Respondent also claims she registers domain names for investment and for potential sale to future purchasers who are looking to adopt a new brand or domain name, not to sell to existing brand owners or holders of well-known brands and that, as such, her domain names are innocuous and do not support any claim of a pattern or history of cybersquatting.

The Respondent states that the asking price for the disputed domain name was based upon her valuation of the disputed domain name for a new entrant to the marketplace looking for a particularly attractive and apt domain name related to cloud computing and is consistent with comparable domain name sale prices such as <automationcloud.com> (sold for USD 90,000 in 2020), <cloudlet.com> (sold for USD 50,000 in 2016), <livecloud.com> (sold for USD 92,000 in 2011), and <upcloud.com> (sold for USD 100,000 in 2011).

With regards to the individual substantive issues of the Complaint, the Respondent claims as follows:

- i) Though she considers questionable the fact that the Complainant's figurative mark with word elements should be considered identical or confusingly similar to the disputed domain name, she does not object to the acceptance of the first element;
- ii) With reference to rights or legitimate interests, the Respondent rebuts the Complainant's contentions claiming they are unfounded and inadequate considering the Respondent is using the disputed domain name in connection with her business, *i.e.*, investment in domain names, and cites a number of proceedings which state that speculating in and trading in domain names such as the disputed domain name, can indeed constitute a legitimate interest under the Policy;
- iii) With regard to the bad faith requirement, the Respondent claims that, in general, a finding of bad faith registration cannot be made with respect to a trademark that did not exist at the time of registration of the disputed domain name. Moreover, the Respondent submits that she has provided a credible and supported explanation of her good faith registration and use of the disputed domain name as she invested in a novel domain name consistent with her established business and not because of the Complainant, which had no corresponding trademark rights at the time.

The Respondent further contends that she has every right to offer the disputed domain name for sale to the general public as she did so both before and after the Complainant's recent acquisition of a trademark registration in Benelux. The Respondent highlights that if a registrant has a legitimate interest in a domain name, as she does here, being in the business of legitimately investing in domain names, she is entitled to offer her business asset for sale at market price and this is not bad faith.

Lastly, the Respondent asserts that the Complaint has been brought in bad faith and requests the Panel to make a finding of Reverse Domain Name Hijacking.

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademark LAW CLOUD based on the trademark registrations for LAW CLOUD (figurative mark) cited under section 4 above.

As highlighted in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the first element functions primarily as a standing requirement, and the threshold test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

With respect to trademark registrations with design elements, as stated in section 1.10 of the [WIPO Overview 3.0](#), “To the extent that design (or figurative/stylized) elements would be incapable of representation in domain names, these elements are largely disregarded for purposes of assessing identity or confusing similarity under the first element. Such design elements may be taken into account in limited circumstances *e.g.*, when the domain name comprises a spelled-out form of the relevant design element. On this basis, trademark registrations with design elements would *prima facie* satisfy the requirement that the complainant show ‘rights in a mark’ for further assessment as to confusing similarity. However where design elements comprise the dominant portion of the relevant mark such that they effectively overtake the textual elements in prominence, or where the trademark registration entirely disclaims the textual elements (i.e., the scope of protection afforded to the mark is effectively limited to its stylized elements), panels may find that the complainant’s trademark registration is insufficient by itself to support standing under the UDRP. [See in particular section 1.2.3.]” This is not the case here.

In the case at hand, the Panel notes that the dominant portion of the Complainant’s trademark, consisting of the denominative element “lawcloud”, is entirely reproduced in the disputed domain name, with the mere addition of the TLD “.com”, which is commonly disregarded under the first element confusing similarity test (section 1.11.1 of the [WIPO Overview 3.0](#)).

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is identical to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant must show that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

“(i) before any notice to you [the Respondent] of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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.”

The Panel notes that, based on the record, there is no relationship between the parties and there is no evidence that the Respondent might be commonly known by the disputed domain name or may be the owner of trademark rights for the term encompassed in the disputed domain name.

Moreover, the disputed domain name is not pointed to an active website and there is no evidence of use of the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Indeed, the Respondent registered the disputed domain name rather for speculation and trading purposes, and the Respondent asserts that such activities can indeed constitute a legitimate interest under the Policy.

However, the Complainant has failed to demonstrate that the Respondent ever intended to target the Complainant and its trademark. Therefore, whatever the conclusion on the issue of rights and legitimate interest may be, the Complaint fails under the third element, and so it is unnecessary for the Panel to reach a conclusion under the second element.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain name was registered and is being used by the Respondent in bad faith.

The disputed domain name, created in 2006 according to the Whois records, was acquired by the Respondent in October 2016 (as shown by the transaction confirmation submitted as Annex I to the Response), before the Complainant's incorporation as "Integr8rs B.V." in 2017 and before the Complainant changed its name to Lawcloud B.V. in December 2021 (as highlighted in Annex A to the Response). Moreover, the disputed domain name was acquired by the Respondent more than five years before the filing of the Complainant's trademark LAW CLOUD in March 2022.

Therefore, the Panel finds that the Respondent did not register the disputed domain name in bad faith as she could not have been aware of the Complainant and its trademark, which did not even exist at that time. See section 3.8.1 of the [WIPO Overview 3.0](#): "where a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent."

The Panel also notes that there is no evidence that the Respondent may have intended to target the Complainant or its trademark, through the use of the disputed domain name, as it has not been pointed to an active website. Moreover, in the absence of any evidence that the Respondent intended to trade upon the Complainant's trademark, the Respondent's offer for sale of the disputed domain name to the general public for an amount exceeding the out-of-pocket costs is not sufficient to conclude that the Respondent acted in bad faith.

In view of the above, the Panel finds that the Complainant has failed to prove that the disputed domain name was registered and is used by the Respondent in bad faith.

D. Reverse Domain Name Hijacking

Paragraph 15(e) of the Rules provides that, if "after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding".

The Rules define Reverse Domain Name Hijacking as "using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name".

The Panel also bears in mind that the Complainant in this case is represented by counsel and, therefore, it is held to a higher standard (see section 4.16 of the [WIPO Overview 3.0](#)).

The Panel concludes that the Complainant's actions constitute Reverse Domain Name Hijacking since the Complainant, which is represented by counsel, should have appreciated the fact that it could not succeed in demonstrating that the Respondent registered the disputed domain name in bad faith, as the disputed domain name was acquired a year before the Complainant came into existence and even longer before the Complainant's trademark was registered. Moreover, the Complainant also failed to provide any evidence to demonstrate that the Respondent used the disputed domain name in bad faith.

The Panel makes a finding of Reverse Domain Name Hijacking.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Luca Barbero/

Luca Barbero
Presiding Panelist

/Andrea Mondini/

Andrea Mondini
Panelist

/Adam Taylor/

Adam Taylor
Panelist
Date: February 22, 2023