

ADMINISTRATIVE PANEL DECISION

Element Logic AS v. Lane Allen

Case No. D2023-4411

1. The Parties

The Complainant is Element Logic AS, Norway, represented by Berkley Sweetapple Law, United States of America (“United States”).

The Respondent is Lane Allen, United States.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 24, 2023. On October 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 27, 2023, 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 October 30, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 19, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 20, 2023.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on November 27, 2023. 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.

4. Factual Background

The Complainant is a Norwegian entity. According to the Complainant, it was founded in 1985 and was named “Arkiv & Lager AS” from 1985 to 2006. The Complainant adds that in 2006, it changed its name to “Element Storage Systems AS”, and in May 2009 changed its name to “Element Logic AS”. Besides these statements, the Complainant says that it first registered to do business in Norway under the name of “Element Logic” in 2006.

The Complainant is the owner of a variety of ELEMENT formative trademarks, the earliest of which appears to be Norwegian Registered Trademark No. 238965 for the word mark ELEMENT WMS, registered on April 30, 2007 in Class 9. The Complainant also owns Norwegian Registered Trademark No. 318242 for the combined word/figurative mark ELEMENT LOGIC in which the words appear in red in two stylized typefaces on a white background, registered on October 22, 2021 in Classes 6, 7, 9, 19, 20, 35, and 42.

The Complainant provides a list of some 26 domain names, which it states are designated to it, with either a Second Level Domain or Third Level Domain “elementlogic” in various generic Top-Level Domains (“gTLDs”) and country code Top-Level Domains (“ccTLDs”), the three earliest of which were registered on April 20, 2009. It also lists four “element-logic”, “ellogiq”, and “eltest” variants.

The disputed domain name was registered on February 27, 2003. Little is known of the Respondent, which has not participated in the administrative proceeding, although it appears to have been a web developer in the early 2000s. The Complainant has produced screenshots of the website associated with the disputed domain name dating from 2004. Initially, in 2004, the website appears to be mainly blank but with a cartoon-style line drawing superimposed on part of a human face. However, the left side of the screenshot shows the typical “torn document” icon indicating that the web page previously featured an image which has not been archived. A screenshot dated 2011 features a draft blog site under the title “ElementLogic / Design and Web Development Boutique in San Francisco” posted on December 13, 2010 by “lane” which states “Hello world! / Welcome to ElementLogic”. In 2013 and 2014 the site reduces to an otherwise blank page, also with the legend “Hello world!”.

The Complainant has produced historic Whois searches in respect of the disputed domain name. These show that on February 23, 2004, the disputed domain name was registered to an organization named “Stimuli Lab”, and the present Respondent was listed as the administrative and technical contact. By August 21, 2010, the disputed domain name was registered to the Respondent directly.

The Complainant has produced a reverse Whois search for the Respondent’s name which features some 32 domain names. The Complainant does not indicate that any of these are abusive, apart from its allegations regarding the disputed domain name, and the Panel likewise has not identified any *prima facie* obvious potential abuse, such as the presence of well-known trademarks, in the listed domain names. One of the identified domain names reflects the Respondent’s personal name and was registered in 2003, reasonably close to the time when the disputed domain name was registered. An archived screenshot of the website associated with this domain name dated February 6, 2004 lists “Stimuli Lab” as a project of the Respondent.¹ The list also features the domain name <stimulilab.com>, registered on February 26, 2000.

¹ The Panel visited the Internet Archive entries associated with this particular domain name in accordance with its general powers in paragraphs 10 and 12 of the Rules. The Panel’s intention in so doing was to understand the background to the historic Whois entry relating to the disputed domain name with the registrant “Stimuli Lab” dated February 23, 2004, which was produced by the Complainant. See also WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.8. The Panel considered putting the outcome of this limited factual research to the Complainant in a procedural order but determined that this was not necessary as the domain name concerned had already been identified and placed into evidence by the Complainant, and the Complainant had already demonstrated that it had the capability to perform its own searches within the Internet Archive by way of the searches it produced relating to the disputed domain name.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to its brand "in common use not under trademark". The Complainant also submits that the fact that the Respondent is not currently using the disputed domain name creates confusion with the Complainant's similar business name and "in itself creates a presumption of bad faith", adding that a finding of bad faith should be made under the doctrine of passive holding under the Policy. The Complainant observes that the Respondent changed its website from a personal blog to an unresolving website when the Complainant began using Element Logic as its brand.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The Panel notes that the Complainant's ELEMENT LOGIC mark is a combined mark, consisting of words in stylized typefaces. The stylized elements may be excised from the word elements for the purposes of comparison with the disputed domain name. [WIPO Overview 3.0](#), section 1.10.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

The requirements of paragraph 4(a) of the Policy are conjunctive. A consequence of this is that failure on the part of a complainant to demonstrate one element of the Policy will result in failure of the complaint in its entirety. Accordingly, in light of the Panel's finding in connection with registration and use in bad faith, discussed below, it is unnecessary for the Panel to address the issue of the Respondent's rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

In making its case under this element, the Complainant may point to any of the non-exclusive circumstances set out in paragraph 4(b) of the Policy, which may be evidence of registration and use in bad faith, or otherwise may identify factors that are indicative of respondent bad faith. To succeed, the Complainant must prove on the balance of probabilities both that the disputed domain name has been registered in bad faith, and that it is being used in bad faith. Both of these two limbs must be demonstrated by the Complainant to

the Panel's satisfaction. Failure to prove one or other limb will result in a failure to prove the third element under the Policy, and therefore failure of the Complaint itself. Generally speaking, in order to prove the first limb (registration in bad faith) the Complainant must show that the Respondent registered the disputed domain name with the Complainant's rights in mind and with intent to target these unfairly.

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, although, if the facts of the case establish that the respondent's intent in registering the domain name was to capitalize unfairly on the complainant's nascent (typically as yet unregistered) trademark rights, panels have been prepared to find that the respondent has acted in bad faith. [WIPO Overview 3.0](#), sections 3.8.1 and 3.8.2. The renewal of a domain name while it is held by a respondent does not reset the time at which registration in bad faith should be assessed, although a transfer of a pre-existing domain name from a third party to a respondent (amounting to a new acquisition) would typically do so, even if the registration date reported on the Whois record does not change. [WIPO Overview 3.0](#), section 3.9. In the latter circumstance, the question of registration in bad faith would be tested as at the date of the respondent's acquisition of the domain name concerned.

In the present case, the Complainant does not suggest that the Respondent acquired the disputed domain name from a third party. It is reasonable for the Panel to infer that the Respondent is the original registrant, dating from 2003, given that "Stimuli Labs" appears to be the alter ego of the Respondent itself. This is the case whether one focuses on the fact that (1) the Respondent was the administrative contact of the disputed domain name in 2004, (2) the Respondent is the current registrant of <stimulilabs.com>, originally registered in 2000, or (3) "Stimuli Labs" may be identified from archived versions of the Respondent's personal website as one of the Respondent's web development projects at the material time. In the present case, therefore, the Panel considers that the Respondent registered the disputed domain name some four years before the first of the Complainant's ELEMENT formative trademarks was registered.

The Complainant asserts that it relies on its use of the "Element Logic" brand "in common use, not under trademark". However, even according to the Complainant's own submissions, it adopted the name "Element" or "Element Logic" no earlier than 2006. The Complainant identifies no point at which its trademark rights might have been regarded as nascent within the meaning of the [WIPO Overview 3.0](#), section 3.8.2. In these circumstances, there is nothing on the present record to indicate that the Respondent could have registered the disputed domain name in the knowledge of the Complainant's rights and/or with intent to target these because the rights in question did not exist, and could not reasonably have been anticipated, when the disputed domain name was registered in 2003. The Complainant's assertion that the Respondent changed the website associated with the disputed domain name from a blog site to an inactive page after the Complainant's rights had come into being is not relevant to the question of registration in bad faith.

On the basis of the above analysis, therefore, the Complainant has failed to prove that the disputed domain name was registered in bad faith. In these circumstances the Complaint must fail, bearing in mind the conjunctive requirement to prove both registration in bad faith and use in bad faith. The Panel does not therefore need to consider the Complainant's submissions regarding the operation of the doctrine of passive holding of the disputed domain name as the matter is moot.

Based on the available record, the Panel finds the third element of the Policy has not been established.

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 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 mere lack of success of the complaint is not, on its own, sufficient to constitute reverse domain name hijacking. [WIPO Overview 3.0](#), section 4.16.

The Complainant's case as pled here could never have succeeded on the topic of registration in bad faith. The Complainant is represented by counsel, who knew or should have known this. The Complainant acknowledges that the disputed domain name was originally registered in 2003. It does not seek to qualify this acknowledgement in any way. Therefore, as far as the Panel is concerned, the Complainant seems tacitly to accept that the 2003 registration was most likely undertaken by the same party in interest (see the above discussion regarding Stimuli Labs and the Internet Archive) if not by the Respondent itself. Based upon the Complainant's own submissions, the 2003 registration date predates any rights which the Complainant could have acquired in the term "Element" or "Element Logic", whether unregistered or registered. Although the Complainant referred to certain changes in the content of the relevant website in 2011, this can have no effect upon the question of registration in bad faith assuming a 2003 registration date. Furthermore, the Complaint is lacking in supporting evidence and ambiguous as to the material question of when the Complainant began to use the term "Element Logic". The Complainant hints that it wishes to rely on alleged unregistered trademark rights dating from, at the earliest, 2006, in reference to its brand "in common use not under trademark". Yet the Complainant provides no supporting evidence of such rights at the relevant date, for example, along the lines of the [WIPO Overview 3.0](#), section 1.3. It merely states "The company Element Logic AS was originally named Arkiv & Lager AS in 1985. In September 2006 it changed its name to Element Storage Systems AS. In May 2009 it changed its name to Element Logic AS. Element Logic AS first registered to do business in Norway under the name of Element Logic, in 2006." The last two sentences of this submission are at best ambiguous and, at worst, contradictory. It is not clear as to when the term "Element Logic" was first used by the Complainant, whether by way of a business registration in 2006, or by way of a company change of name in 2009, assuming that the two are independent occurrences. This level of ambiguity (and lack of evidence) as to a material issue relied upon by the Complainant should not be expected of a represented party, and panels have held that a represented complainant should be held to a higher standard, given the undertakings in paragraphs 3(b)(xiii) and (xiv) of the Rules. [WIPO Overview 3.0](#), section 4.16.

The Panel concludes that the Complainant's actions constitute Reverse Domain Name Hijacking.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Andrew D. S. Lothian/

Andrew D. S. Lothian

Sole Panelist

Date: December 11, 2023