

ADMINISTRATIVE PANEL DECISION

John McGinnis Halliday Gibson v. Domain Admin
Case No. D2022-4274

1. The Parties

The Complainant is John McGinnis Halliday Gibson, United Kingdom, represented by Blackadders LLP, United Kingdom.

The Respondent is Domain Admin, United States of America (“United States”), represented by Grant Carpenter, United States.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 10, 2022. On November 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 11, 2022, 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 (Domains By Proxy LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on the same day, 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 November 14, 2022.

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 November 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 6, 2022. The Response was filed with the Center on November 21, 2022.

The Center appointed Assen Alexiev as the sole panelist in this matter on December 9, 2022. 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 private person. In the period 1994 – 2013, he was the director of the company Mojac Limited, registered in the United Kingdom, which was dissolved on September 6, 2013. While he was the director of this company, the Complainant registered the disputed domain name on November 18, 1998. In late 2021, the Complainant failed to renew the registration of the disputed domain name and it became available for registration. The Respondent then registered the disputed domain name in early 2022.

The disputed domain name resolves to a website that offered it for sale for USD 19,999.

5. Parties' Contentions

A. Complainant

The Complainant states that he first acquired the disputed domain name in November 1998. He explains that the narrative part of the disputed domain name "MoJac" was created by the joining of the Complainant's and his wife's names and holds significant sentimental value. The Complainant states that he does not have any registered rights of the narrative part of the disputed domain name, and does not trade in this capacity. The Complainant maintains that at the time he acquired the disputed domain name he was the director of MoJac Limited, which was subsequently dissolved in 2013. The Complainant states that he does have a number of other domain names incorporating the narrative part of the disputed domain name, including <mojac.co.uk>, and uses them for email and a website. According to the Complainant, as the disputed domain name has been held by him for a significant period, he has obtained rights in it.

The Complainant explains that since February 2003 he has engaged a company to renew the registration of the disputed domain name on an annual basis. In 2021, due to an error of this company, the auto-renewal was not carried out. The Complainant was not aware of the problem and did not renew the registration of the disputed domain name. The Complainant points out that the disputed domain name was then purchased by the Respondent, and is now up for auction.

The Complainant contends that the disputed domain name was registered and is being used in bad faith for the purpose of seeking an inflated sum for repurchase. The Complainant respectfully requests that the Complaint be considered on the basis that the loss of the disputed domain name was out of his control.

The Complainant believes that the disputed domain name was acquired by the Respondent solely for the purpose of selling its registration for purely commercial gain, as shown by the high auction price of USD 19,999.

B. Respondent

The Respondent notes that the Complainant admits that he "does not have any registered rights of the narrative part of the domain name, nor does he trade in this capacity". The Respondent points out that the Complainant did not enjoy any unregistered trademark or service mark rights in the disputed domain name at the time the Complaint was filed. The Respondent notes that the Complainant concedes that although "at the time the Complainant acquired the domain name he was the director of MoJac Limited", Mojac Limited "was subsequently dissolved on September 6, 2013". The Respondent points out that the Complainant does not claim to have continued any use of the "mojac" mark following this dissolution, and that the Complainant fails to claim that he (as opposed to MoJac Limited) maintained any trademark or service mark rights in the

disputed domain name at the time it was registered.

According to the Respondent, absent any use of the disputed domain name and <mojac.co.uk> in commerce, the Complainant's mere registration of these names does not grant the Complainant any trademark or service mark rights in the term "mojac." In the Respondent's view, the Complainant fails to claim that it has actually used these domain names in commerce and, accordingly, the Complainant did not maintain any trademark or service mark rights to the term "mojac" at the time of registration of the disputed domain name by the Respondent.

The Respondent contends that even assuming *arguendo* that the Complainant did maintain some degree of trademark or service rights in the disputed domain name, the Complainant fails to claim that his mark has become a distinctive identifier which consumers associate with the Complainant's goods and/or services – as required to establish unregistered or common law trademark rights for purposes of the UDRP. The Respondent adds that even assuming *arguendo* that the Complainant maintained sufficient acquired distinctiveness at the time of registration, this fails to meet the requirement that such rights must be in existence at the time the Complaint is filed.

According to the Respondent, the Complaint fails to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. The Respondent states that the Complainant never brings up the issue of whether the Respondent has any rights or legitimate interests in the disputed domain name.

The Respondent contends that the Complainant provides no evidence to support its stated belief that the disputed domain name was acquired by the Respondent in bad faith. The Respondent confirms that the disputed domain name is up for auction for USD 19,999.

The Respondent maintains that there is no reason that the Respondent should have known about the Complainant's supposed mark because (a) the Complainant was not actually using its supposed mark, (b) given that the Complainant was not even using his supposed mark, it could not have been widely known and could not have obtained the required acquired distinctiveness, (c) even an extremely in-depth search for possible conflicting trademarks or service marks prior to the Respondent's registration would not have made the Respondent aware of the Complainant or its supposed mark, and (d) the term "mojac" is generic and used by a variety of persons and organizations.

According to the Respondent, given that the Complainant lacks any trademark or service mark rights in the disputed domain name, a finding of bad faith use or registration would be impossible. A complainant that maintains no trademark or service mark rights cannot have its trademark or service mark rights taken advantage of or abused.

The Respondent requests a finding of Reverse Domain Name Hijacking ("RDNH"). According to it, the Complaint was filed in bad faith. The Respondent states that the Complainant, who is represented, clearly either knew or should have known that it lacked relevant trademark rights and that it did not maintain any trademark registration. The Complainant certainly should have known that it would be unable to establish unregistered or common law trademark rights for purposes of the UDRP given that its only claimed "use" of its supposed mark was its registration of the disputed domain name and a similar domain name.

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 Respondent has registered and is using the disputed domain name in bad faith.

A. Identical or Confusingly Similar

The Complainant claims that he has obtained unregistered rights in the disputed domain name, as it has been held by him for a significant period of time. The Complainant admits that he does not have any registered trademark rights in the disputed domain name, and does not trade in this capacity. The Complainant maintains that at the time he acquired the disputed domain name he was the director of MoJac Limited, which was subsequently dissolved in 2013. The Complainant states that he does have a number of other domain names incorporating the narrative part of the disputed domain name, including <mojac.co.uk>, and uses them for email and a website.

As discussed in section 1.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), to establish unregistered or common law trademark rights for purposes of the UDRP, a complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services. Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys. Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning.

The Complainant however does not submit any evidence that the disputed domain name or the name "MoJac" has become a distinctive identifier which consumers associate with the Complainant's goods and/or services. The Complainant admits that he has not traded through the disputed domain name, and provides no information or evidence about his activities through his other domain names such as <mojac.co.uk> that is mentioned in the Complaint, and no information or evidence about the activities of the company Mojac Limited of which the Complainant was the director and whether and how this company may have used the disputed domain name. In the absence of any information or evidence about any commercial activities of the Complainant or the company Mojac Limited, there is no basis for a finding that the Complainant has had any interactions with consumers and has acquired any unregistered trademark rights that may be relevant to the present proceeding. The mere registration of the disputed domain name and its maintenance, even for a long period, is not in itself sufficient for such a finding, as it does not show that even the Complainant, let alone third parties, has associated the disputed domain name with any product or service offered by him.

The Complainant also explains that the narrative part of the disputed domain name "MoJac" was created by the joining of the Complainant's and his wife's names and holds significant sentimental value.

As discussed in section 1.5.2 of the [WIPO Overview 3.0](#), the UDRP does not explicitly provide standing for personal names which are not registered or otherwise protected as trademarks. In situations however where a personal name is being used as a trademark-like identifier in trade or commerce, the complainant may be able to establish unregistered or common law rights in that name for purposes of standing to file a UDRP case where the name in question is used in commerce as a distinctive identifier of the complainant's goods or services.

As discussed above in this section, the Complainant himself admits not having used the disputed domain name in trade, and there is not evidence in the case to suggest that it has been used as a distinctive identifier of any goods or services offered by the Complainant or by the company Mojac Limited of which he was the director. For this reason, there is no basis for a finding that the personal names, as such, of the Complainant and his spouse may provide a standing of the Complainant to file a UDRP case.

For the above reasons, the Panel finds that the Complainant has failed to establish that he has rights in a trademark for the purposes of the Policy, and therefore the Complainant does not have the required standing to file the Complaint.

B. Rights or Legitimate Interests

In view of the finding of the Panel that the Complainant has failed to establish that he has rights in a trademark or service mark for the purposes of the Policy and does not have the required standing to file the Complaint, it is not necessary to address the issue of whether the Respondent has rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

In view of the finding of the Panel that the Complainant has failed to establish that he has rights in a trademark or service mark for the purposes of the Policy and does not have the required standing to file the Complaint, it is not necessary to address the issue of whether the disputed domain name has been registered and is being used in bad faith.

7. 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”. RDNH is furthermore defined under the Rules as “using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name”.

As summarized in Section 4.16 of the [WIPO Overview 3.0](#), reasons articulated by panels for finding RDNH include, *inter alia*: (i) facts which demonstrate that the complainant knew it could not succeed as to any of the required three elements – such as the complainant’s lack of relevant trademark rights, (ii) facts which demonstrate that the complainant clearly ought to have known it could not succeed under any fair interpretation of facts reasonably available prior to the filing of the complaint, (iii) unreasonably ignoring established Policy precedent notably as captured in the [WIPO Overview 3.0](#) – except in limited circumstances which *prima facie* justify advancing an alternative legal argument, (iv) and basing a complaint on only the barest of allegations without any supporting evidence. Given the undertakings in paragraphs 3(b)(xiii) and (xiv) of the UDRP Rules, some panels have held that a represented complainant should be held to a higher standard.

Taking into account the above and the findings in section 6.A, the Panel has reached the conclusion that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

8. Decision

For the foregoing reasons, the Complaint is denied.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: December 23, 2022