

ADMINISTRATIVE PANEL DECISION

Elasticsearch B.V. v. JP Barkley

Case No. D2023-4036

1. The Parties

The Complainant is Elasticsearch B.V., Netherlands (Kingdom of the), represented by Quinn IP Law, United States of America (“US”).

The Respondent is JP Barkley, US.

2. The Domain Name and Registrar

The disputed domain name <elasticsearch-api.info> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 27, 2023. On September 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 28, 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 (Namecheap, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 28, 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 amended Complaint on October 4, 2023.

The Center verified that the Complaint together with the amended 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 4, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 25, 2023.

The Center appointed Mario Soerensen Garcia as the sole panelist in this matter on October 30, 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

Founded in 2012, the Complainant is a search company that builds self-managed and software as a service (SaaS). The Complainant's services are also implemented in cases such as application search, site search, enterprise search and business analytics.

The Complainant is the owner of several trademarks, including the US trademark ELASTICSEARCH, No. 79112495, registered on September 25, 2012; and the Brazilian trademark ELASTICSEARCH Nos. 907240771 and 907240690, registered on September 6, 2016.

The Complainant also owns several domain names comprising the mark ELASTICSEARCH, such as the domain name <elasticsearch.com>, registered on September 22, 2009.

The disputed domain name was registered on June 28, 2023 and resolves to a website with pay-per-click ("PPC") links which are related to the Complainant's services. On the cited website there is also a notice offering the disputed domain name for sale.

5. Parties' Contentions

A. Complainant

The Complainant argues that the trademark ELASTICSEARCH appears in its entirety in the disputed domain name. As a result, the disputed domain name is to be considered identical and confusingly similar to the Complainant's trademarks and domain names.

The Complainant alleges that the addition of the element "API" does not prevent the finding of confusion and similarity with its trademarks and domain names. On the contrary, the addition of "API" would worsen the likelihood of confusion, as it is an acronym for "Application Programming Interface," which is an expression frequently used by the Complainant in connection with its services.

According to the Complainant, there is no evidence that the Respondent has made demonstrable preparations to use the disputed domain name for legitimate purposes, nor is there any evidence that the Respondent is using the disputed domain name in connection with a *bona fide* offering of goods and or services.

The Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name. That being the case, the Complainant finds that the disputed domain name is used to take unfair advantage of the Complainant's rights for commercial gain, since Internet users and the Complainant's clients would inevitably associate the content of the website at the disputed domain name with the Complainant's prior trademarks and domain names.

Moreover, the Complainant stresses that the Respondent is not commonly known by the disputed domain name and that it has not authorized the registration and use of the disputed domain name, nor the use of its trade name and trademarks by the Respondent. The Respondent is not affiliated to or authorized by the Complainant to use or register the disputed domain name.

The Complainant emphasizes that its intellectual property rights for ELASTICSEARCH trademarks predate the registration of the disputed domain name.

The Complainant also argues that the Respondent was aware of the Complainant's rights and has clearly registered the disputed domain name to target the Complainant's trademark, so the registration of the disputed domain name was conducted in bad faith. Furthermore, the Complainant asserts that the disputed domain name is being used in bad faith given that it is offered for sale on a third party website and has resolved to a commercial website with PPC links.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

As per paragraph 4(a) of the Policy, the Complainant must prove that:

- (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 has been registered and is used in bad faith.

Based on the evidence and arguments submitted, the Panel's findings are as follows:

A. Identical or Confusingly Similar

The evidence demonstrates that the Complainant is the owner of several trademark registrations for ELASTICSEARCH.

The disputed domain name incorporates the Complainant's trademark ELASTICSEARCH in its entirety, with the addition of the acronym "API". The addition of this term does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark, since ELASTICSEARCH trademark remains recognizable in the disputed domain name; see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

As numerous prior UDRP panels have recognized, the incorporation of a trademark in its entirety or a dominant feature of a trademark in a domain name is sufficient to establish that a domain name is identical or confusingly similar to the complainant's mark. See section 1.7 of the [WIPO Overview 3.0](#).

The Panel finds that paragraph 4(a)(i) of the Policy has been proved by the Complainant, *i.e.*, the disputed domain name is confusingly similar to the Complainant's trademark ELASTICSEARCH.

B. Rights or Legitimate Interests

There is no evidence that the Respondent has any authorization to use the Complainant's trademarks or to register domain names containing the Complainant's trademark ELASTICSEARCH.

There is no evidence that the Respondent is commonly known by the disputed domain name.

Besides, the element "API" is frequently used by the Complainant in connection with its goods and services. Accordingly, the composition of the disputed domain name carries a risk of implied affiliation with the Complainant ([WIPO Overview 3.0](#), section 2.5.1). Furthermore, the disputed domain name resolves to a website with PPC links which are related to the Complainant's services. Such use cannot be considered as a *bona fide* offering ([WIPO Overview 3.0](#), section 2.9).

For the above reasons, the Panel finds that the Complainant has made out an un rebutted *prima facie* case and the condition of paragraph 4(a)(ii) of the Policy has been satisfied, *i.e.*, the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The Panel notes that the trademark ELASTICSEARCH is registered by the Complainant in many jurisdictions and has been used for years. The Complainant's trademarks predate the registration of the disputed domain name. The disputed domain name reproduces the Complainant's trademark in its entirety together with the acronym "API," often used by the Complainant in association with its services.

The Respondent has no rights or legitimate interests in the disputed domain name.

The Panel finds that the Respondent obviously was aware of the Complainant's marks when registering the disputed domain name, due to the use of the identical trademark, together with the descriptive element "API".

The Panel also finds that use of the disputed domain name in connection with a website displaying PPC links constitutes bad faith under paragraph 4(b)(iv) of the Policy.

The failure to respond to the Complainant's contentions and the fact that the disputed domain name is also offered for sale on the Internet contribute to the Panel's finding that the disputed domain name was registered and has been used in bad faith.

Therefore, this Panel finds that the disputed domain name was inherently likely to mislead Internet users, and the Respondent's use of the disputed domain name in this manner indicates neither a *bona fide* offering of goods or services under Policy, nor a noncommercial or fair use of the domain name under Policy.

For the above reasons, the Panel finds that the condition of paragraph 4(a)(iii) of the Policy has been satisfied, *i.e.*, the disputed domain name has been registered and is being used in bad faith.

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 <elasticsearch-api.info> be transferred to the Complainant.

/Mario Soerensen Garcia/

Mario Soerensen Garcia

Sole Panelist

Date: November 13, 2023