

## **ADMINISTRATIVE PANEL DECISION**

Elasticsearch B.V. v. Jason Harrington

Case No. D2023-4038

### **1. The Parties**

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

The Respondent is Jason Harrington, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <elasticsearch.tools> is registered with Porkbun LLC (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 27, 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 (Private by Design, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 4, 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 10, 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 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 6, 2023. The Respondent sent an email communication to the Center on October 17, 2023. The Complainant replied to the Respondent’s email on October 25, 2023, and November 6, 2023. On November 13, 2023, the Center informed the Parties that it would proceed to panel appointment.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on November 28, 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 provides computer software for use in searching, analyzing, and reporting information and data and operates an “Elasticsearch” platform for search-powered solutions. The Complainant has multiple trademark registrations in many jurisdictions for the trademark ELASTICSEARCH including the following registrations: US Registration No. 4212205 registered on September 25, 2012, for goods and services in classes 9 and 42; United Kingdom Registration No. 00801114893 registered on March 26, 2013; and International Trademark Registration No. 1114893 registered on January 30, 2012.

The Complainant also claims that it owns multiple domain names containing ELASTICSEARCH trademark, such as <elasticsearch.com>, <elasticsearch.biz>, <elasticsearch.net>, <elasticsearch.org>, <elasticsearch.co>, and <elasticsearch.us>.

The disputed domain name was registered on August 4, 2023. The disputed domain name does not resolve to any active website.

#### **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.

The Complainant contends that as the disputed domain name utilizes the Complainant’s ELASTICSEARCH trademark as its exclusive, primary, and prominent term, the public are likely to be confused into believing the disputed domain name belongs to the Complainant and not the Respondent. The fact that the Complainant’s trademark is recognizable within the disputed domain name results in a violation of paragraph 4(a)(i) of the Policy, the Complainant says.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name as required under paragraph 4(a)(ii) of the Policy. The Complainant points to the fact that there is nothing on the record to indicate that the Respondent has ever used the disputed domain name in relation to a *bona fide* offering of goods or services, nor is the Respondent making legitimate noncommercial or fair use of the Complainant’s ELASTICSEARCH trademark in the disputed domain name. The Complainant says that the Respondent has no trademark registrations for the relevant terms, is not affiliated with the Complainant, and is not commonly known as ELASTICSEARCH. The Respondent registered the disputed domain name on August 4, 2023, whereas the Complainant points out that it has been using the ELASTICSEARCH trademarks since 2010. According to the Complainant the word “tools” is widely used in the computing industry, including by the Complainant.

The Complainant contends that the Respondent knew, or should have known, at the time of registration of the disputed domain name, of the Complainant’s notoriety as a global innovator, and the Complainant’s rights in the ELASTICSEARCH trademarks. The Complainant contends that the Respondent registered the disputed domain name to confuse the public into believing that the disputed domain name is associated or affiliated with the Complainant. These facts establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name for the reasons identified in paragraph 4(a)(ii) of the Policy, the Complainant asserts.

As for the element of bad faith, the Complainant contends that the Respondent's contact information is not available through WhoIs or presented at the website at the disputed domain name. The Respondent's identity and contact details have been screened by a privacy service and the Respondent did not respond to a demand letter sent to the Registrar via electronic mail. The Complainant contends that given the distinctiveness of its ELASTICSEARCH trademarks, the Respondent has no legitimate reason to have registered a domain name which incorporates those marks of the Complainant. The Respondent instead registered the disputed domain name to prevent the Complainant from registering it and/or to profit from the Complainant's intellectual property rights in its ELASTICSEARCH trademarks, which the Complainant says are well known. The Respondent's registration of the disputed domain name cannot have been innocent, the Complainant says. The Complainant also says that the Respondent could have ascertained the existence of the Complainant and the Complainant's use of the Elasticsearch corporate name and the ELASTICSEARCH trademarks with a simple Internet search via Google.

The Complainant contends that the Respondent's registration of the disputed domain name is consistent with establishing a parked domain for potential "phishing" or "pharming" attacks, which is indicative of bad faith. In the hands of the Respondent, the disputed domain name may ultimately harm the Complainant's goodwill and reputation in addition to exposing users to potential malfeasant activity, the Complainant says.

According to the Complainant, web traffic directed to the disputed domain name is initially redirected to the website at "www.xypthe.com/jr.php?gz=8zjJ2N%2B93jC", which further redirects to the website at "www.toromclick.com", whereas it is well known that Toromclick and its corresponding website are malware that installs without authorization on to a user's computer. Unsuspecting Internet users may be tricked or forced into installing the Toromclick malware when visiting the disputed domain name, enabling cybercriminals access to their machine. The Complainant contends that this is evidence of a fraudulent scheme to trick users to download or install malicious content. The Complainant points out that as set forth in section 3.1.4 of [WIPO Overview 3.0](#), use of a domain name for per se illegitimate activity is considered evidence of bad faith.

## **B. Respondent**

The Respondent did not reply to the substantive arguments of the Complainant. However, the Respondent indicated in an email to the Center that the disputed domain name may be deleted, it was not being in use. The Respondent also said that there was no contact from the Complainant before the present filing. The Respondent indicated his wish that his decision to delete the disputed domain name would resolve the present matter. However, despite the Complainant's replies to this informal communication, requesting the Respondent's cooperation via the Rules' provisions for settlement under paragraph 17(a), the Respondent did not reply.

## **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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, 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 registered trademark ELASTICSEARCH of the Complainant 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).

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

## **B. Rights or Legitimate Interests**

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

While the Complainant claims use of the disputed domain name for redirection to potential malware, no evidence thereof was submitted and the Panel notes the Respondent’s, also unsupported, allegation that the disputed domain name has not been used. However, the use, or non-use, of the disputed domain name is not determinative in this matter.

The Respondent is not commonly known by the term ELASTICSEARCH or by the disputed domain name and has not laid claim to any prior rights in those terms. The composition of the identical disputed domain name carries a high risk of implied affiliation, which cannot constitute fair use. Moreover, the Respondent was not authorized by the Complainant to use its distinctive ELASTICSEARCH trademark, and given the goodwill that attaches to that mark, actual or contemplated good-faith use of the disputed domain name by the Respondent is inconceivable. In any case, the Respondent wrote to the Center to indicate that he was prepared to abandon the disputed domain name, thus suggesting the absence of rights or legitimate interests on his behalf.

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

## **C. Registered and Used in Bad Faith**

The Respondent registered the disputed domain name, which is identical to the Complainant’s ELASTICSEARCH registered trademark, at a time when that distinctive mark had acquired extensive goodwill in many jurisdictions. It is extremely unlikely that the Respondent registered the disputed domain name in ignorance of the Complainant or its rights in the ELASTICSEARCH trademark. Further, despite sending an informal communication in this proceeding, the Respondent did not rebut the Complainant’s contentions as to the Respondent’s awareness of, and targeting of, the Complainant.

As stated above, the evidence presented does not reflect any active use of the disputed domain name. However, such inactive status does not prevent a finding of bad faith. Given the totality of the circumstances, particularly the well-known status of the Complainant’s trademark, that it is identically incorporated into the disputed domain name, that the Respondent’s identity was initially masked through the use of a privacy service, and the Respondent did not rebut the Complainant’s contentions as regarding the Respondent’s awareness of, and intent to target, the Complainant, the Panel finds that the Respondent’s passive holding of the disputed domain name does not prevent a finding of bad faith. [WIPO Overview 3.0](#), section 3.3.

Based on the available record, the Panel finds that the Complainant has established the third element 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 <elasticsearch.tools> be transferred to the Complainant.

*/William A. Van Caenegem/*

**William A. Van Caenegem**

Sole Panelist

Date: December 12, 2023