



WORLD INTELLECTUAL PROPERTY ORGANIZATION

WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Netpreneur Connections Enterprises Inc. v. Anton Sheker, Seo.Com.Ph

Case No. DPH 2011-0003

1. The Parties

The Complainant is Netpreneur Connections Enterprises Inc. of Pasig City, Philippines, represented by the Law Offices of Ray Gilberto J. Espinosa, Philippines.

The Respondent is Anton Sheker, Seo.Com.Ph of Makati City, Philippines, represented by Vera & Associates Law Firm, Philippines.

2. The Domain Name and Registrar

The disputed domain name <sulit.ph> is registered with DotPH.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 19, 2011. On June 20, 2011, the Center transmitted by email to DotPH a request for registrar verification in connection with the disputed domain name. On July 21, 2011, DotPH transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amended Complaint on July 5, 2011.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the .PH Uniform Domain Name Dispute Resolution Policy ("phDRP" or the "Policy"), the Rules for .PH 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(1) and 4(1), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 12, 2011. In accordance with the Rules, paragraph 5(1), the due date for Response was August 1, 2011. The Response was filed with the Center on July 29, 2011.

The Center appointed Francine Tan as the sole panelist in this matter on August 12, 2011. 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 states that SULIT.COM.PH is its trade mark which was applied for in the Philippines on May 13, 2008 and registered on October 13, 2008, under Trademark Registration No. 2002008005602. The exclusive use of the element “.com.ph” in the trade mark was disclaimed. The mark is registered in respect of advertising services in Class 35.

The Complainant further states that it has operated its website at “www.sulit.com.ph” (“the Website”) since September 11, 2006. The Website provides an online classified advertisements portal “which incorporates interactivity among its users by allowing people to respond to ads via a personal message or posting messages. This facilitates initial contact and negotiation. The actual sale is consummated by the buyer and seller themselves when they eventually decide to meet up”. Members of the Website can, *inter alia*, maintain an online profile, create and manage their advertisements, and chat with other members. The Complainant asserts that due to the large number of postings of advertisements, the Website has become the most popular online advertisement listings facility and one of the top five websites in the Philippines. To date, the membership numbers have exceeded one million. Further, the extent of use of the Complainant's trade mark has been such that most people in the Philippines, even those with little access to the Internet, have associated the word “sulit” (a Filipino word which means “a good buy”) with the Website.

The Complainant submitted evidence of an email exchange in February 2010 between an individual and the Respondent as regards the availability of the disputed domain name for sale and the cost. An initial offer was made in the amount of USD 1,000, to which the Respondent asked for the “best price” that the individual was willing to offer. The offer was increased to USD 2,000 but no further response was received from the Respondent. The nature of the relationship of the individual (who had contacted the Respondent as indicated above) to the Complainant is not specified in the Complaint.

5. Parties' Contentions

A. Complainant

The Complainant submits as follows:

The disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights. In this regard, it is submitted that the Complainant's trade mark SULIT.COM.PH is "infringed" by the disputed domain name "as the second-level domain name both use the same word "sulit" and are both used by an online classified ad listing".

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent operates its own online classified advertising listing called "classifiedads.ph" at a website of the same name but which is "patterned after" the Website of the Complainant. The disputed domain name when entered on an Internet browser redirects the Internet user to "www.classifiedads.ph". The Respondent has no trademark registration rights in the term "sulit" nor does the word "sulit" appear on the Respondent's website except in reference to the Website of the Complainant.

The disputed domain name was registered and is being used in bad faith. The Respondent's objective is to ride on the popularity of the Website and confuse people wishing to look for an item through the Complainant's advertisement listings to end up using the Respondent's website. The fact that the disputed domain name is not used on a website reflecting <sulit.ph> but merely as a redirector to "www.classifiedads.ph" is, by itself, evidence that the Respondent has no legitimate interest in the disputed domain name and is using it in bad faith. Reference was made in this regard to the email communication between the parties regarding the proposed sale/transfer of the disputed domain name for monetary consideration. Visual and recall confusion can easily occur as:

the only difference between the Complainant's domain name and the disputed domain name is in the element ".com"; and the element ".ph" is the country code top level domain for the Philippines and both the Complainant's and the Respondent's websites are targeted at the Philippines market.

B. Respondent

The Respondent made the following submissions in its Response:

"SULIT.COM.PH is a descriptive trade mark which deserves scant protection under Intellectual Property laws in the Philippines. "The only protection the Complainant has is the word 'sulit' disclaiming both '.com' and the '.ph'. Rather, Complainant's protection is only on the artistic presentation of the word 'Sulit' and not the word 'Sulit' itself [...] which cannot and never be in an actual URL". The trademark registration to which the Complainant relies on is therefore weak; "a weak trademark that is alleged to have been infringed should be totally similar or an actual copy. An actual viewing of the trademark and the URL shows only resemblance in the spelling".

The Complainant has yet to present concrete evidence to prove the claim that it is a "top 5 website", and that the trade mark SULIT.COM.PH is so successful and pervasive.

As admitted by the Complainant, the word “sulit” is a descriptive/generic word which cannot be registered as a trade mark. There is evidence of an abandoned Philippines trademark application by the Complainant for the word “sulit.com”. The Complainant has not presented evidence that this word has acquired a secondary meaning other than mere assertions of the Complainant’s fame and reputation.

The Complainant has not established a *prima facie* case as its statements have been unsubstantiated. Without having discharged its burden, the burden therefore remains with the Complainant to prove its case and the Respondent does not have to prove the contrary.

There are numerous domain names that incorporate the term “sulit”, e.g. <e-sulit.com>, <sulitbahay.com>, <sulitfranchisenegosyo.com>, <sulithomes.com>, <sulitmobile.com>, <sulitwebsolutions.com>. The sheer number of domain names using the term “sulit” as well as the popularity of trademark registrations in the Philippines incorporating the word “sulit” show that the Respondent did not and could not violate any legitimate right or interest of the Complainant with respect to the disputed domain name.

The disputed domain name was registered in the belief that “sulit” is a generic or descriptive word that is commonly used in abundance for advertising or in a business that involves the commerce of buying and selling goods and which cannot be the subject of a trademark registration.

The term “sulit” is commonly and widely used on the Internet and it is therefore not possible for the Complainant to substantiate its claim that the term is associated with the Complainant as to source.

As regards the communication between the parties in relation to the Complainant’s offer to buy the disputed domain name and the Respondent’s rejection of the offer, this *per se* does not prove bad faith on the Respondent’s part.

6. Discussion and Findings

A. General Principles

Paragraph 15(1) of the Rules requires panelists to “decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”. Further paragraph 10(4) of the Rules states that “the Panel shall determine the admissibility, relevance, materiality and weight of the evidence”.

Under paragraph 4(1) of the Policy, a complainant has to prove all three elements:

- (1) That the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (2) That the respondent has no rights or legitimate interests in respect of the domain name; and

(3) That the disputed domain name has been registered and is being used in bad faith.

Paragraph 4(2) of the Policy lists a number of circumstances which, without limitation, are deemed to be evidence of the registration and use of a domain name in bad faith. Those circumstances are:

(1) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(2) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(3) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(4) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

Paragraph 4(3) of the Policy sets out a number of circumstances, again without limitation, which may be effective for a respondent to demonstrate that it has rights to, or legitimate interests in, a domain name. Those circumstances are:

(1) Before any notice to the respondent of the dispute, use by the respondent 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

(2) Where the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or

(3) Where the respondent is 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.

B. Identical or Confusingly Similar

The Complainant has shown that it has registered trademark rights in the combination SULIT.COM.PH. The certificate submitted in evidence reflects that the trademark registration was in respect of a stylized mark with a colour claim. There is, however, no evidence from which the Panel is able to find that the Complainant has trademark rights in the word “Sulit” on its own.

The issue therefore to be considered by the Panel under paragraph 4(1)(1) of the Policy is whether the disputed domain name <sulit.ph> is confusingly similar to the trade mark SULIT.COM.PH in which the Complainant has registered trademark rights. As has been well established in previous decisions under the Uniform Dispute Resolution Policy (“UDRP”) which the Panel considers to be relevant to the decision herein, the gTLD elements e.g. “.com” should be disregarded when considering the issue of identity or confusing similarity. The Panel is of the view that the word “sulit” in the disputed domain name is confusingly similar to the trade mark SULIT.COM.PH as the word “sulit” in the trade mark is the more dominant component of the trade mark.

The Panel therefore finds that the first element of paragraph 4(1) of the Policy has been satisfied.

C. Rights or Legitimate Interests

Paragraph 2.1 of the [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition](#) (“WIPO Overview 2.0”) states that “while the overall burden of proof rests with the complainant, panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the respondent. Therefore a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP [...]. If the respondent does come forward with some allegations or evidence of relevant rights or legitimate interest, the panel then weighs all the evidence, with the burden of proof always remaining on the complainant.”

In relation to this second element of paragraph 4(1) of the Policy, the Complainant has submitted, *inter alia*, that:

the Respondent operates its own online classified advertising listing called “classifiedads.ph” which is patterned after the Website of the Complainant;

the disputed domain name when entered on an Internet browser redirects the Internet user to “www.classifiedads.ph”; and

the Respondent has no trademark registration rights in the word “Sulit”.

In relation to point (1), there is nothing on the face of the Respondent's website which appears to be a copy or a lookalike of the Website. In the absence of further clarification and substantiating evidence from the Complainant, the Panel is not persuaded by the Complainant's submission on this point. As regards point (3), the relevant issue is whether the Respondent has a legitimate interest (which does not necessarily require the Respondent to have trademark registration rights in the word "sulit").

The Panel observes that there is an overall lack of evidence to substantiate the Complainant's various assertions. Further, taking into account the meaning and/or generic nature of the word "sulit", and the fact that the Complainant has not shown it has trademark rights in the word "sulit" as a stand alone term, the Panel is of the view that the Complainant's case is marginal.

Paragraph [2.2](#) of the [WIPO Overview 2.0](#) states that:

"Panels have recognized that mere registration of a domain name, even one that is comprised of a confirmed dictionary word or phrase (which may be generic with respect to certain goods or services), may not of itself confer rights or legitimate interests in the domain name. Normally, in order to find rights or legitimate interests in a domain name based on the generic or dictionary meaning of a word or phrase contained therein, the domain name would need to be genuinely used or at least demonstrably intended for such use in connection with the relied-upon meaning (and not, for example, to trade off third-party rights in such word or phrase)."

The Respondent appears to be genuinely using the disputed domain name comprising a generic word in connection with the "relied-upon meaning" of the word "sulit", *i.e.* a good buy. It has provided a plausible explanation in its choice of the disputed domain name, namely that it was registered in the belief that since "sulit" is a generic or descriptive word that is commonly used in abundance for advertising or in a business that involves the buying and selling goods, it would not violate the Policy.

The Panel is of the view that the fact that the Respondent's website at "www.sulit.ph" is linked to the website at "www.classifiedads.ph" does not, in itself, constitute conclusive evidence of a lack of rights or legitimate interests (especially as the Panel finds that the use is consistent with the descriptive nature of the term "sulit").

The Respondent appears to have rights or legitimate interests in the disputed domain name in relation to a *bona fide* offering of goods and services on its online classified advertisement portal, which is not inconsistent with the meaning of the word "sulit". The Panel therefore finds that the Complainant has failed to establish the second element of paragraph 4(1) of the Policy.

In view of the Panel's finding on this point, there is no necessity for the Panel to consider paragraph 4(1)(3) of the Policy.

7. Decision

For all the foregoing reasons, the Complaint is denied.

Francine Tan

Sole Panelist

Dated: August 19, 2011