

CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE

DOMAIN NAME DISPUTE

ADMINISTRATIVE PANEL

DECISION

CIIDRC case number: UDRP-12169

Decision date: June 16, 2020

Panelist The Honourable Neil Anthony Brown, QC

Domain Name in Dispute: <jonmac.com>

Complainant: Ecomm House Inc.

Respondent: K Hanly

Registrar: Network Solutions L.L.C.

PROCEDURAL HISTORY

Complainant submitted a Complaint concerning the domain name <jonmac.com> to the CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE (“ CIIDRC ”) electronically on April 30, 2020 and CIIDRC received payment of the required non-refundable filing fee of \$425 from the Complainant.

On May 6, 2020, Network Solutions L.L.C. transmitted a verification response informing CIIDRC that the <jonmac.com> domain name is registered with Network Solutions L.L.C., that the Respondent, the name given being K. Hanly, is the current registrant of the name and that the contact details for the Respondent and relating to the disputed domain name were as provided to CIIDRC and referred in more detail hereunder. The creation date of the domain name was given as September 9, 2011. Network Solutions L.L.C. has verified that Respondent is bound by the Network Solutions L.L.C. registration agreement and has thereby agreed to resolve domain name disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On May 7, 2020 CIIDRC confirmed administrative compliance of the Complaint and that the date of the commencement of the dispute resolution process was May 7, 2020 Pacific Time.

On May 7, 2020, CIIDRC served the Respondent with the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of May 27, 2020 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on

Respondent's registration as technical, administrative, and billing contacts, and to postmaster@jonmac.com.

Also, on May 7, 2020, the Written Notice of the Complaint, notifying Respondent of the service of the Complaint and its Annexes and the deadline of May 27, 2020 for a Response, was transmitted to Respondent via email to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts. The Written Notice also included login particulars of a username and a temporary password, together with the link to the Complaint and advice how to login to the CIIDRC online platform for the management of the administrative proceeding.

On May 20, 2020 the Respondent requested an additional extension of 4 calendar days to file its response and in accordance with UDRP Rule 5(b), CIIDRC automatically granted the requested extension. The new deadline for the Respondent's response was extended to June 1, 2020. The Respondent filed its Response on May 31, 2020.

On June 3, 2020, pursuant to Complainant and the Respondent's request to have the dispute decided by a single-member Panel, CIIDRC appointed The Honourable Neil Anthony Brown, QC as Panelist.

Having reviewed CIIDRC's records, the Administrative Panel (the "Panel") finds that CIIDRC has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2. Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, CIIDRC's Supplemental Rules and any rules and principles of law that the Panel deems applicable.

The Panelist has completed and returned to the Center the statement of acceptance and declaration of impartiality and independence.

THE PARTIES

The Complainant's address is Suite 526, Unit 22, 2475 Dobbin Road, West Kelowna, BC, V4T 2E9, Canada.

The Respondent's address is 1 Tregaron Avenue, London, BC, N8 9HA, GB.

It should be explained to the reader that the Respondent, when the Complaint was filed on April 30, 2020, was "Kirsty (Hanly) Macdonald & Jon Macdonald". However, the text of the Complaint stated that "The Respondents are Kristy (Hanly) Macdonald, Jon Macdonald and

Inspired Wellbeing (the “Respondents”).” It will be noted that the spelling of the given name of the first Respondent has changed from Kirsty to Kristy.

The Complaint then discusses a Kirsty (*sic*) Macdonald and asserts that “According to a LinkedIn profile for Kirsty Macdonald, who is listed on the Inspired Wellbeing Website as a founder of Inspired Wellbeing, Kirsty Macdonald previously used the name “Kirsty Hanly”.”

The Complainant then asserts that “...the Respondent Kristy (*sic*) (Hanly) Macdonald registered the Domain under the name K. Hanly and that the domain was transferred from Jon Macdonald to K. Hanly sometime after May 12, 2018. The WHOIS information for the Domain recorded on May 12, 2018 shows Jon Macdonald as the Registrant. All WHOIS reports after that date have the Registrant information redacted.”

However, as the CIIDRC advised the Complainant on January 16, 2020, the registrant of the domain name is K Hanly, because the registrar so advised the CIIDRC as part of the verification process. Thus, in its verification response, the registrar disclosed that the registrant, administration and technical contacts for the domain name were:

K Hanly 1 Tregaron Avenue, -, London, N8 9HA, Great Britain	+1.4159496022 jonmac.com@wix-domains.com	Registration
K Hanly 1 Tregaron Avenue, -, London, N8 9HA, Great Britain	+44.7768418359 kirstymacdonald18@gmail.com	Administration
K Hanly 1 Tregaron Avenue, -, London, N8 9HA, Great Britain	+44.7768418359 kirstymacdonald18@gmail.com	Technical

Consequently, K Hanley is the Respondent. K Hanley is the Respondent because Rule 3 (b) (v) provides that the Respondent is “the domain-name holder.”

It is also clear that both Jon Macdonald and K Hanley have been active in this matter on behalf of the interests of the domain-name holder and hence on behalf of the Respondent. The Panel

has thus accepted the Response, although in the name of Mr. Macdonald, as being filed on behalf of the Respondent.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. COMPLAINANT

Complainant made the following contentions.

1. Ecomm House Inc. is a British Columbia company that specializes in delivering coaching and consulting services related to building and operating e-commerce businesses, under the brand name JON MAC.
2. The Complainant has spent a great deal of time, effort, and resources building the JON MAC brand and developing goodwill in the same in North America and Europe. The Complainant is the owner of several JON MAC trademarks, as detailed below.
3. According to the Complainant, the Respondents are Kristy (Hanly) Macdonald, Jon Macdonald and Inspired Wellbeing (the "Respondents"). The Respondents Kristy (Hanly) Macdonald and Jon Macdonald are listed as the co-founders of "Inspired Wellbeing", as shown in a screenshot from the website <https://www.inspiredwellbeing.com/who-we-are> ("Inspired Wellbeing Website"), copy of which is attached hereto as Annex B.
4. The Inspired Wellbeing Website indicates that the business offers "business consultancy & executive coaching services".
5. A Domain Tools search report ("Domain Search Report") reveals that prior to receiving correspondence from the Complainant regarding the Respondent's alleged trademark infringement, the Respondent Jon Macdonald was using the contested domain name, <jonmac.com> ("the disputed domain name") to host a single blog post. The Domain Search Report is attached Annex C.
6. After receiving notice from the Complainant of the Complainant's trademark rights associated with the trademark JON MAC, the Respondents began using the disputed domain name to host a website promoting its "business consultancy & executive coaching" business. A screenshot of the website promoting the consulting business, dated November 14, 2019, is shown on page 9 of the Domain Report attached as Annex C.

7. The website has since been removed from the Domain following further correspondence between the Complainant Jon Macdonald providing particulars of the Complainant's JON MAC Trademarks (as defined below). The email exchange between the Complainant and the Respondent Jon Macdonald, dated January 15, 2020, is attached as Annex D. Currently, when a visitor goes to the Domain, a standard Wix.com template webpage is presented, which indicates that the Domain is not connect to a website. A screenshot of this webpage taken on March 20, 2020 is attached as Annex E.
8. The Domain Report indicates that the Registrar for the domain is Network Solutions LLC and that the identity of the registrant is protected by privacy. However, the Complainant has been able to trace the owner of the Domain back to the Respondents. In particular, the May 12, 2018 WHOIS information (page 23 of the Domain Report) shows Jon Macdonald as the last owner before the registrant name become private. A copy of the Domain Report is attached as Annex C.
9. The Complainant was first made aware that the Domain was registered to "K Hanly" in the letter to the Complainant from Ina Ergasheva, Assistant Director of the Canadian International Internet Dispute Resolution Centre, dated January 16, 2020. After further research, the Complainant now believes that the registrant "K Hanly" is the business partner and/or spouse of the Respondent Jon Macdonald.
10. Trademark/Service Mark Information: The Complainant is the owner of the following trademark registration and pending applications for the trademark JON MAC (collectively, the "JON MAC Trademarks") and has been using the JON MAC Trademarks in association with its e-commerce coaching business since 2018:
 - JON MAC – Canadian trademark application number 1992971 for use in associated with "business consulting services in the field of e-commerce; business marketing consulting services", a copy of which application is included in **Annex G**. Ecomm House Inc. applied for this trademark October 30, 2019 and the trademark is pending.
 - JON MAC – U.S. trademark application number 88699816 for use in association with "Business consulting services in the field of e-commerce; Marketing services," a copy of which application is included in **Annex G**. Ecomm House Inc. applied for this trademark November 26, 2019 and the trademark is pending.
 - JON MAC – U.K. Registered trademark UK00003440622 for use in association with "Marketing, consulting and advertising services in relation to e-commerce," a copy of which registration is included in Annex G. Ecomm House Inc. applied for this trademark October 30, 2019 and the trademark was registered January 17, 2020.

11. The disputed domain name is identical to the JON MAC Trademarks. The use made of the trademark constitutes trademark infringement. In particular, in 2019 the Respondent was using the Domain to host a website promoting its “business consultancy & executive coaching” business (See page 9 of the Domain Report attached as Annex C). Thus, there is a very high likelihood of confusion being the Respondent’s use of the Domain and the Complainant’s JON MAC Trademarks.

12. RIGHTS AND LEGITIMATE INTERESTS

The Respondent has no legitimate rights or interests in the disputed domain name. In fact, the Respondent is currently not using the Domain for any Website.

The Complainant’s trademark rights pre-date the Respondent’s use of the Domain as a trademark. The Complainant began to acquire common law trademark rights in 2018. In October 2019 it began filing trademark applications to register the JON MAC Trademarks.

13. Up until 2019, it appeared that the Respondent had a self-published blog post on the website located at the domain, which first appeared sometime between February 2011 and July 2013. A copy of the capture from June 14, 2013 is shown on page 36 of the Domain Report attached hereto as **Annex C**. The blog post, entitled “Nothing ever happens” advises readers to live in the moment. Prior to the post, there appears to have been little-to-no content on the Website and the Domain appears to have been registered to a third party until early 2013 (see pages 31-59 of the Domain Report attached as **Annex C**).

In 2019, after the Complainant sent to the Respondent notice of the Complainant’s JON MAC Trademarks, the Respondent began using the Domain to intentionally attract users for commercial gain to its coaching business, as shown in the screenshot dated November 14, 2019 (page 9 of the Domain Report attached as Annex C).

14. In light of the foregoing, the Respondent’s use of the Domain in connection with its business coaching business amounted to trademark infringement and thus could not have been used in connection with a bona fide offering of goods or services. Rather, it was being used to trade on the goodwill of the Complainant’s JON MAC Trademarks and attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s JON MAC Trademarks.

15. The Respondent had not become commonly known by the <jonmac.com> domain name, given that it was barely used prior to 2019.

16. The Respondent is not making any legitimate, non-commercial use of the disputed domain name.

17. BAD FAITH

The Respondents are using the Domain in bad faith as evidenced by the fact that by using the domain name, the Respondents intentionally attempted to attract, for commercial gain, Internet users to their business coaching websites, by creating a likelihood of confusion with the Complainant's JON MAC Trademarks as to the source, sponsorship, affiliation, or endorsement of its websites and coaching services.

After acquiring the Domain sometime in 2013, the Respondents used to the Domain to publish a blog. The website was not updated until after the Respondent received notice from the Complainant of the JON MAC Trademarks in May 2019 (see the email correspondence attached hereto as **Annex H**).

Since the Respondent began using the Website to promote a business that offered very similar business consulting and coaching services to the Complainant's business after receiving notice from the Complainant, it is evident that the Respondent sought to direct traffic from the Complainant's business to that of the Respondent.

The Respondent's use for the purpose of intentionally attempting to attract, for commercial gain, Internet users to the Website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website and coaching business services, amounts to bad faith.

The fact that the Respondent has acknowledged its use amounts to trademark infringement by removing the content confirms that Respondent did not have a legitimate use for the domain name.

B. RESPONDENT

Respondent made the following contentions by way of submitting a statement from Jon Macdonald.

The statement provides as follows:

“Thank you for taking the time to consider this response. I am not a solicitor nor am I very familiar with the internet, domain names and URLs and so please accept my apologies for any mistakes or errors in this response.

I will share some personal background to help you in this dispute

I am a spiritual teacher and my vision in life is to help as many people as I can have a life filled with joy and happiness. I have dedicated my life to learning as much as I can about this and about how to help people. This has taken me many years. I am 48 now. And this is what I now do full time as my career.

I am called Jon Macdonald, and have over the years been known as both Jon Mac to many of my friends and people I talk to about spiritual matters. Hence this is why I bought the domain name www.jonmac.com in around 2012 or 2013. I bought it with the sole long-term intention of using it for my spiritual teachings under my name for the rest of my life. Hence it being paid for many years ahead.

My spiritual teaching is based on two websites. One of these is the domain under dispute www.jonmac.com. The other is www.alwayschoose.com. www.jonmac.com points to a selection of my spiritual poetry and also sets out that I am a spiritual writer, teacher and guide. I wrote a book of 200 spiritual poems in Jan-March this year and I am going to self-publish this. This is the website that I will use (see annex 1). www.alwayschoose.com is a more general website which has lots of free and helpful spiritual guidance for any visitors including a free ebook and events.

I feel that it is extremely unlikely that someone wanting to buy services relating to the Claimant’s “Marketing, consultancy and advertising services in relation to e-commerce” business will find my websites in any way, shape or form helpful for them in this matter. This is particularly so for the www.jonmac.com domain under dispute given that it is clearly for use by me in line with my long-standing intent for sharing my spiritual poetry and role as a spiritual writer, teacher and guide. I also have never had any referrals, business, nor interested parties through any mis-referrals from people wanting to access the Claimant’s website. I have never acted in bad faith. I have never intended to sell this domain, nor registered it for sale. I have never sought to mis-direct or siphon business away from the Claimant, nor confuse his customers, nor have a confusingly similar business.

History

I bought the domain name www.jonmac.com many years ago, around 2012 or 2013 as my spiritual teaching website. At that time, I added a quote to the front page about living a more spiritual life and also a blog. Back then, to my frustration, I was not able to add any more than this nor make this website very public because I was also an Actuary and a board director of a very conservative and large UK financial services company. This was because being seen as a 'spiritual teacher' would have damaged my credibility in this job and also the terms and conditions of my employment. So, I planned ahead for my retirement from this job to be in around 2018 so that I could dedicate my life to spiritual teaching, and once retired use this website properly and fully for this original intent. Over this time, I have invested much of my life into learning how to teach spirituality so that I could be ready for this time.

As planned, I resigned from my job in Q1 2018, and after working my one years notice I left at the end of April 2019 (see Annex 2). Straight after, in May 2019, I updated the domain website to reflect me offering spiritual teaching and related services. I then, later in the year, also set up a business called Inspired Wellbeing which was all about helping companies make their workplaces more inspiring and more connected to spirituality. However, I stopped this in December 2019, as it felt like a distraction from the focus I always wanted on one-to-one spiritual teaching.

So, my intent for www.jonmac.com is, was and always has been a way to provide my spiritual teaching to the world and to help people have lives filled with joy and happiness. This is what it is doing right now, with a selection of the 200 spiritual poems I have written, which people can read any explore, and when I self-publish it this website is where we will showcase this spiritual poetry book. This is all totally unrelated to the Claimants e-commerce business. I have over 2019 tried a few different descriptions of spiritual teaching, including the phrase "preeminent (*sic*) coaching", "executive coaching" and other such language in order to be more 'mainstream' in starting a conversation with people, as the phrase 'spiritual' put some people off. However, this never felt really very good and is now no longer the case. I use the language "spiritual writer, teacher and guide" instead now. This is clear and also as an aside clearly differentiates me from the Claimant's e-commerce trademarks.

Finally, to say, in my previous job on the board of the large financial services company, and also as an Actuary, I am bound by certain principles such as integrity, honesty and always acting in good faith. This is something I pride myself in doing, and is a pre-requisite for being a spiritual teacher in my opinion. I was also regulated by the UK's government and Bank of England for the same principles and was regularly formally tested for meeting these principles, which I did. So, it is upsetting to see this Claimant's solicitor make allegations about me acting in Bad Faith, which is my intention here to disprove. I have actually emailed the solicitor in question about

their conduct (I will in due course query it with the Canadian board of solicitors and her firm) as she appears to have taken certain facts and used them to create a false story to help the Claimant obtain my domain name.

Response to allegations

As I understand it is alleged that I updated my website in May 2019 at that time to promote my “business consulting & executive coaching business” due to receiving an email from the Claimant on 7th May 2019 about his apparent trademark rights (email chain in Claimant’s Annex H). As I understand it is also alleged that I acted in bad faith by intending to promote a business which offered very similar business consulting services and coaching services, by creating a likelihood of confusion with the Claimant.

Both of these are not true.

The first was not the reasons for me updating my website, as I hope I have explained above. It was timed to follow directly after me leaving my full-time job. I had waited many years to finally be able to update and publicise my website. It was nothing to do with receiving an email from the Claimant. He quickly vanished for some time after having sent it and I thought nothing more.

In fact, from my perspective, I received this email out of the blue from him asking “Am I interested in selling JonMac.com?” to which I said “Hi, sorry, not just now. Best Wishes” and then straight after I got what I felt was quite a scary and harassing email saying I was using his trademark and referring to him wanting me to give it to him and not wanting to start a legal battle. I responded asking for the specific details of the trademark and then never heard anything from him again until a long time later on the 5th January 2020 when he appeared to simply demand that I transfer the domain name to him (email chain in Annex D). It seems that he didn’t have any formal trademarks in May 2019, that he only applied for them later in the year.

The second is not true because I am clearly not selling similar services to the Claimant. I provide spiritual teaching, not e-commerce. It is really impossible to confuse these two services in order to intentionally attract, for commercial gain, anyone. I also knew nothing about the Claimant until he emailed me on the 7th May, and since he didn’t respond to my enquiry about his apparent trademarks, I forgot about him and never even looked him up on the internet until 2020 when I got his email communication in January 2020.

I have been a very successful business-person over my previous career and have no need to act in bad faith and piggy-back on the back of someone I don't know anything about to attempt to gain business, which as a spiritual teacher I don't actually need to get anyway. I also have had zero referrals for work from anyone from the website in question. I know this because I have only had one person who has worked with me on spiritual teaching since May 2019 and he was someone I knew personally. So, I have no accidental commercial gain here in any event, which makes sense given the difference between e-commerce and spirituality.

It is also **alleged that I acknowledged that my use of the domain might constitute trademark infringement** and also it is alleged that **I have acknowledged its use amounts to trademark infringement because I removed the contents and this also confirms I don't have a legitimate use for the domain.**

These are also both not true.

The Claimant has taken one line of many from an email I sent (in Annex D) and referenced it in isolation to make their claims sound true. It seems that my words have been deliberately taken out of context to help the Claimant. What I actually said in the email was:

"It is important for me that there is zero risk of trademark infringement" -> I said this because my previous career was a Chief Risk Officer and so I am very risk-aware individual. I was stating my intent of what is important for me, i.e. I would never want a trademark infringement nor would I actively create one for my bad faith benefit. I was definitely not stating that this was actually occurring. It is worrying that a solicitor can simply say this!

I later said "To make sure of this I have delinked the relevant URL... I don't believe there was any risk anyway but I have done so to make sure" and "I will repurpose it later on to make sure it is not selling any services which could create a trademark infringement risk" -> So I am saying I don't believe there is a risk here. But given I have had an email which I felt was threatening I immediately (and quite naturally) reacted and pulled my domain down. I then did some research on this situation and realised that there was no risk of infringement. And hence I point it again to my long-standing spiritual teaching / poetry legitimate use, knowing with certainty there is no trademark risk.

I hope this helps and I apologies for my ramble.

Warmest

Jon".

They being the submissions of the Complainant and the Respondent, the Panel will now consider the issues of law and fact that they raise. The objective of this consideration will be to determine if the domain name in question should be transferred to the Complainant or remain with the Respondent.

DISCUSSION AND FINDINGS

Pursuant to paragraph 4(a) of the Policy, in order to obtain the transfer of the Disputed domain name, the Complainant has to demonstrate that:

- (i) The Disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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 being used in bad faith.

Each of those elements must be established and they must be proved by evidence and on the balance of probabilities. The Panel will now proceed to examine each of those requirements in turn.

Identical or Confusingly Similar

The first question that arises is whether the Complainant has rights in a trademark or service mark on which it may rely in this proceeding and which will give it standing to bring this proceeding. The existence of such a trademark is pivotal in the UDRP machinery and if a complainant cannot show that it has a trademark, it will fail. The Complainant submits that it has two applications for trademarks that are on foot, one in Canada and one in the United States of America and one trademark, registered in the United Kingdom. The two applications and the trademark relied on are as follows:

- “JON MAC – Canadian trademark application number 1992971 for use in associated with “business consulting services in the field of e-commerce; business marketing consulting services”, a copy of which application is included

in Annex G. Ecomm House Inc. applied for this trademark October 30, 2019 and the trademark is pending.

- JON MAC – U.S. trademark application number 88699816 for use in association with “Business consulting services in the field of e-commerce; Marketing services,” a copy of which application is included in Annex G. Ecomm House Inc. applied for this trademark November 26, 2019 and the trademark is pending.
- JON MAC – U.K. Registered trademark [UK00003440622](#) for use in association with “Marketing, consulting and advertising services in relation to e-commerce,” a copy of which registration is included in Annex G. Ecomm House Inc. applied for this trademark October 30, 2019 and the trademark was registered January 17, 2020.”

As has been noted, copies of the two applications and the trademark have been adduced in evidence and the Panel accepts that evidence.

It will be instantly appreciated that the Complainant cannot rely on the two applications as they are applications and not trademarks. As the name implies, an application occurs when a party is desirous of having a trademark and applies to a trademark registration authority for one to be issued. So, at this stage of the application, the trademark has not been approved or granted. Indeed, it has not yet been examined to see if any other party objects to it being issued. That decision will be made in the future, after the application has been advertised and others have had an opportunity to object to it, which may or may not be upheld. Only when the trademark has been granted will it be a trademark in the full sense of the word. Only then will it be able to be the foundation of a claim in proceedings like the present, where the argument will be whether a claimant has standing to bring a claim for a domain name as the Complainant has done in the present case. So, the Complainant has only one trademark, but that is sufficient to give it standing.

It is interesting to note that the Canadian application was made as recently as October 30, 2019, the US application as recently as November 26, 2019, and the UK trademark on October 30, 2019 whereas the domain name the Complainant is seeking in this proceeding was registered on September 9, 2011. Nevertheless, for the purposes of this element of the claim, the complainant has only to show that it has “a trademark”, and it has done that by the evidence of the UK trademark. Any other consequences of the date when it was obtained may be left to consider at a later stage.

The Complainant therefore has a registered trademark for JON MAC. The next question that arises is whether the disputed domain name is identical or confusingly similar to the JON MAC trademark relied on. In answering that question, it is well established now that what is required

is a straight comparison between the domain name and the trademark without regard to extraneous facts such as how any website to which the domain name resolves has been used and what it contains; those issues are dealt with later in the process. It is also well established that in making that comparison, extensions such as “.com” is generally ignored, as all domain names must have such an extension. When those two principles are applied, it is apparent that the domain name and the trademark in the present case are identical, as they look, sound and feel the same.

The Complainant has therefore established the first of the three elements that it must prove.

Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

“(i) before any notice to you [respondent] of the dispute, your use 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
(ii) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
(iii) you [respondent] are making a legitimate non-commercial 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.”

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a complainant is required only to make out a *prima facie* case that the respondent lacks rights or legitimate interests and that when such a *prima facie* case is made out, the respondent carries the burden of rebutting it and demonstrating that the respondent has rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Panel, after considering all of the evidence, finds that the Complainant has not made out a *prima facie* case.

The Complainant's main, or at least first, argument is that the Respondent has no rights or legitimate interests in the domain name because "(t)he Complainant's trademark rights pre-date the Respondent's use of the Domain as a trademark." The Panel, with respect, has a number of difficulties with this submission. First, the Respondent has never used the domain name as a trademark, so far as the Panel is aware. Indeed, on the evidence, it has clearly not used the domain name as a trademark, but as a domain name, using it as an internet address for users to follow and to lead them to its website where the Respondent intends to share with them its knowledge of spiritual matters and related concepts.

Secondly, if the Complainant means by its submission that its trademark rights pre-date the Respondent's use of the domain name, that submission also must fail. That is so because, on the evidence, the Respondent registered the domain name on September 9, 2011. The Complainant says, in effect, that its trademark rights pre-date the domain name. The trademark was registered on January 17, 2020 and it could not, therefore, pre-date the registration of the domain name, which had already occurred on September 9, 2011. Sometimes it is said, depending on the jurisdiction, that "trademark rights" date from the time the trademark was applied for or filed, but even if that date is used in the present case, the trademark was applied for on October 30, 2019 and that date did not "pre-date" the registration of the domain name on September 9, 2011. So, on the day that the Respondent registered the domain name, the Complainant had no trademark rights, and nor did anyone else have any trademark rights inconsistent with the Respondent's right to register the domain name. Accordingly, the Respondent had a right to register the domain name because no-one had the right to stop it from doing so by virtue of a trademark over the name.

It is true that here, the Complainant submits that it had, or at least that it "began to acquire" common law trademark rights. Presumably this is argued for, as it is in other cases, to push the effective date back to an earlier date than the filing or registration date of a registered trademark so that the domain name may be said to have been registered after and not before the trademark rights of the person claiming the domain name. That will not work here, as the Complainant does not give any evidence of how those common law trademark rights are said to have been acquired or what they were. The evidence to support that submission must be readily available to the Complainant and, probably, only to it and it should have been produced as evidence in the proceeding if the Complainant wanted to rely on it. In its absence, the Panel must assume that there is no such evidence showing that the Complainant acquired common law trademark rights in JON MAC or that the evidence is not strong enough to be produced.

In any event, even if the Complainant could show that it had acquired common law trademark rights, on its own admission they did not start to accrue until “2018” and that year is after and not before the domain name was registered. So even if the Complainant could rely on a common law trademark, which it cannot, it would still not have been on foot when the domain name was registered.

The Complainant then submits that the domain name was used for various purposes from 2011 until 2019, but none of that shows the Respondent had no right to have registered the domain name or to use it. The Respondent could use it for any purpose it chose, provided it did not act illegitimately towards the Complainant’s trademark, and there is no evidence that it did.

The Complainant then says that in 2019 “the Respondent began using the Domain to intentionally attract users for commercial gain to its coaching business, as shown in the screenshot dated November 14, 2019 (page 9 of the Domain Report attached as Annex C).” It then proceeds to submit that this shows trademark infringement which could not amount to a bona fide offering of goods or services but rather that it shows an intention to trade on the goodwill of the JON MAC mark by creating confusion with that mark.

The Panel does not accept that this submission is justified by the facts as they are known from the evidence. The Panel has looked at the website to which the domain name resolves and has resolved in the past and the Respondent’s detailed exposition of its activities in Mr. Macdonald’s statement. The Panel concludes that there is no evidence to justify the conclusion that the domain name was being used at any time to attract internet users for commercial gain or that there was any intention by the Respondent or its associates to trade on the goodwill of the JON MAC mark. The whole thrust of the Respondent’s offering on its website was and is related to its teaching of spirituality and such activities as meditation and personal reflection. It is in fact the opposite of anything to do with commerce, which seems to be the main activity of the Complainant, and particularly e-commerce, as its name implies. It is true that the Respondent has offered “coaching” and similar services, but it is clear from the detail set out in the Response that this was coaching individuals in their own spiritual development and not coaching others to advance their commercial interests which is the work and the business of the Complainant. In any event, the Respondent presents a plausible scenario explaining how phrases like “coaching” were adopted and then abandoned, as they were not appropriate for the field of spiritual development. They cannot, therefore, be said to have coloured the website during all of, or even a substantial part of the life of the website. Any suggestion that the Respondent used the website regularly or persistently or as a matter of business by offering “coaching” or related services or that it was using the website to trade on the goodwill of the JON MAC mark is simply not borne out by the evidence and is certainly not established by the

content of the website. Moreover, the Complainant alleges that the Respondent was actually conducting a “coaching business” which is an exaggeration not supported by any evidence put before the Panel. Any suggestion that this was so has convincingly been rebutted by the evidence of the Respondent.

Finally, it appears to the Panel that the Respondent did not engage in trademark infringement, as is alleged, because there is no evidence that it engaged in any activities “in relation to e-commerce” which is the ambit of the Complainant’s UK trademark.

Moreover, there is an air of unreality about the suggestion that the Respondent had embarked on an intention to target the Complainant, trade on its goodwill, undermine it or seek to confuse internet users and that such conduct negates the Respondent’s right to and legitimate interest in the domain name. Such an intention would seem on all the evidence to be contrary to the Respondent’s *raison d’etre*, when, on all the evidence, it has apparently been content with its activities in the world of spiritual teaching without any reason for abandoning it to pursue the material endeavours of e-commerce. Moreover, the evidence is that the spiritual teaching at issue was taken up by Mr. Macdonald when he retired, thus making it less likely that he wanted to embark on a new commercial venture. There also seems no explanation as to why the Respondent would want to target the Complainant or even how it would do so, especially as the parties live and work in different countries and it is clear that not only are they not competitors but they are not in the same industry: the Complainant is in providing services in e-commerce; the Respondent is in spiritual teaching. It is therefore hard to see how any internet user would or could be confused by this clear distinction and the Panel does not accept that anyone has been confused.

Further, and pivotal to the Panel’s finding on this matter, is the fact that the Complainant’s argument must mean that the Respondent registered the domain name on September 9, 2011 and then did nothing untoward for eight years until 2019 when it suddenly started to target the Complainant, for no apparent reason. That seems highly unlikely. It is far more likely that the domain name has come to the notice of the Complainant and it has decided it would like to own it. That is a legitimate objective but not one that should be countenanced to the detriment of the Respondent in the absence of evidence that it has engaged in some impropriety or wrong doing, of which there is no evidence.

The Complainant has therefore not mounted a *prima facie* case showing that the Respondent does not have any rights or legitimate interest in the domain name. Indeed, the Respondent has shown it has more than a plausible case for being entitled to the domain name, there being no

obstacle to the registration and use of the domain name, so long as it does not transgress on the Complainant's or another party's trademark, which has not occurred.

Finally, the Complainant has alleged that the Respondent has acknowledged that it might have engaged in trademark infringement. That assertion is based on the fact that in an email Mr. Macdonald had said he had spoken to trademark lawyers, that it was "important to me that there is zero risk of trademark infringement (and that) (to) make sure of this I have delinked the relevant URL from pointing at the website it was." One only needs to reflect on those words to see that the conclusion reached by the Complainant about them is not correct. There is no acknowledgement or admission of trademark infringement to be found in those words. The clear meaning of what Mr. Macdonald said, from its context, was that there had been no trademark infringement and that he, Mr. Macdonald, was going to conduct himself so that things stayed that way.

For completeness, the Panel also expressly holds that the facts of the proceeding bring it within the provisions of Paragraph 4 (c)(i) of the Policy. That is so because the Respondent probably became aware of the dispute on May 7, 2019 when he received what was in effect a demand by the Complainant for the domain name which the Respondent rebuffed. But before that date, the Respondent had used the domain name in one form or another in its spiritual teaching, which was a legitimate use of the domain name. The facts therefore are that before notice of the dispute, the Respondent was using the domain name for a *bona fide* offering of services within the meaning of Paragraph 4 (c)(i) of the Policy. The Respondent therefore has a right or legitimate interest in the domain name on this ground alone and without more.

The sum total of all of these observations is that the Complainant has not made out a *prima facie* case that the Respondent has no rights or legitimate interest in the domain name. From an abundance of caution, that Panel adds that if a *prima facie* case has been made out, then it has been rebutted by the Respondent.

Accordingly, the Complainant has not made out the second of the three elements that it must establish.

In those circumstances, it is not strictly necessary for the Panel to address the third element, bad faith, but the Panel will make some brief remarks on it.

Registered and Used in Bad Faith

It is clear that to establish bad faith for the purposes of the Policy, the Complainant must show that the disputed domain name was registered in bad faith and that it has been used in bad

faith. It is also clear that the criteria set out in paragraph 4(b) of the Policy for establishing bad faith are not exclusive, but that Complainants in UDRP proceedings may also rely on conduct that is bad faith within the generally accepted meaning of that expression.

The criteria referred to, taken from the Policy, are:

“b. Evidence of Registration and Use in Bad Faith. For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that you (the Respondent) have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site 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 your web site or location or of a product or service on your web site or location.”

Having regard to those principles, the Panel finds as follows.

First, as the Panel has already found that the Respondent had a right to register the domain name and a legitimate interest in its use, clearly the Respondent could not have registered or used it in bad faith.

Secondly, the facts of the case, as shown by the evidence, do not bring it within any of the criteria set out above in Paragraph 4(b) of the Policy. The Complainant seems to base most of its bad faith argument on the case coming within Paragraph 4 (b)(iv). However, the idea that internet users might think that Mr. Macdonald's spiritual reflections were being offered as part of the Complainant's ecommerce service is far too tenuous to be accepted.

Thirdly, it is also unrealistic and not supported by the evidence, to suggest that the Respondent was trying to wean customers away from an ecommerce provider to a spiritual teacher's website.

Fourthly, the entire practice under the UDRP has been that bad faith registration cannot be proved if, as in the present case, the domain name was registered before the complainant acquired its trademark rights. Without more, it is impossible to say that the present domain name was registered in bad faith on September 9, 2011 when the Complainant did not acquire its trademark rights until January 17, 2020 and when, until then, there was nothing towards which the alleged bad faith could be directed.

This is more so in the present case as, according to the Complainant's Annex A, the Complainant was not incorporated until December 15, 2015 and did not exist when the domain name was registered. Clearly, no bad faith could be directed at the Complainant at the time the domain name was registered when it did not exist.

Apart from all of that, the evidence reveals a situation where there was no bad faith when the Respondent registered the domain name. On the contrary, the Respondent was entitled to register and use the domain name, provided it did not target or compromise the Complainant's trademark or engage in any other improper conduct. There is nothing in the evidence to suggest that it did.

Nor, in the opinion of the Panel was there any bad faith use after the domain name was registered.

The Complainant has thus not shown the third of the three elements that it must establish.

DECISION

As the Complainant has not established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.

Accordingly, it is Ordered that the <jonmac.com> domain name **REMAIN WITH** Respondent.

A handwritten signature in black ink, appearing to read 'N.A. Brown', with a long horizontal flourish extending to the right.

The Honourable Neil Anthony Brown QC

Panelist

Dated: June 15, 2020