



## DECISION

Rockwell Automation v. zhejiang  
Claim Number: FA1811001818237

### PARTIES

Complainant is **Rockwell Automation** (“Complainant”), represented by **CSC Digital Brand Services AB**, Sweden. Respondent is **zhejiang** (“Respondent”), China.

### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<factorytalk.com>**, registered with **eName Technology Co., Ltd.**

### PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

David L. Kreider as Panelist.

### PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on November 28, 2018; the FORUM received payment on November 28, 2018.

On November 28, 2018, eName Technology Co., Ltd. confirmed by e-mail to the FORUM that the **<factorytalk.com>** domain name is registered with eName Technology Co., Ltd. and that Respondent is the current registrant of the name.

eName Technology Co., Ltd. has verified that Respondent is bound by the eName Technology Co., Ltd. registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On December 3, 2018, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of December 24, 2018 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@factorytalk.com. Also on December 3, 2018, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on December 10, 2018.

On December 11, 2018, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the FORUM appointed David L. Kreider as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the FORUM 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.

## LANGUAGE

Although the language of the registration agreement is Chinese, the Complainant requests that these proceedings be conducted in the English language for the following reasons:

1. Complainant is unable to communicate in Chinese and translation of the Complaint would unfairly disadvantage and burden the Complainant and delay the proceedings and adjudication of this matter;
2. Such additional delay poses continuing risk to Complainant and unsuspecting consumers seeking Complainant or its products;
3. The Disputed Domain Names are comprised of Latin characters;
4. The term FACTORYTALK, which is the dominant portion of the Disputed Domain Name, does not carry any specific meaning in the Chinese language;
5. Complainant previously sent cease and desist letters to Respondent as provided in the Complaint. Respondent issued its response in English, which demonstrates Respondent's understanding of the English language;
6. Pursuant to Paragraph 11(a) of the Rules, the Panel may determine the language of the proceedings having regard to all circumstances, and to help ensure fairness, and maintain an inexpensive and expeditious avenue for resolving domain disputes. Here, in light of Respondent's decision to register the domain name that misappropriates the famous Rockwell mark and brand, it would unduly burden Complainant to have to arrange and pay for translation where Respondent has demonstrated behavior that disrupts Complainant's business and has already required Complainant to devote significant time and resources to addressing these instances of abuse. Even in instances where a registration agreement was in a language other than English, past Panels have made the decision to allow a case to proceed in English based on the totality of circumstances in that case. See *Immobilière Dassault SA, Groupe Industriel Marcel Dassault v. DuanZuoChun*, D2011-2106 (WIPO Feb. 21, 2012). See also *Dama S.p.A. v. Duan Zuochun*, D2012-1015 (WIPO July 5, 2012).

After reviewing the English-language email correspondence between the parties, which reflects that Respondent is capable in the English language, and having considered the Complainant's arguments, the Panel, having discretion in the matter, considers that fairness and procedural efficiency mitigate in favor of conducting these administrative proceedings in English. The Complainant's application is granted.

## **RELIEF SOUGHT**

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

## **PARTIES' CONTENTIONS**

### **A. Complainant**

Rockwell Automation ("Complainant"), is the world's largest company dedicated to industrial automation. It is the owner of FACTORYTALK trademark registrations across various jurisdictions, including the European Union Intellectual Property Office (EUIPO), the Mexican Institute of Industrial Property (IMPI), the United States Patent and Trademark Office (USPTO), the Canadian Intellectual Property Office (CIPO), the World Intellectual Property Organization (WIPO), the Korea Intellectual Property Rights Information Service (KIPRIS) and China Trademark Office under State Administration for Industry and Commerce (CTMO). These registrations demonstrate that the Complainant has spent a considerable amount of time and money protecting its intellectual property rights.

FactoryTalk®, an integrated suite of software applications offered by the Complainant to the manufacturing industry, forms a crucial part of the success of the company. The Complainant achieved global sales of \$6.3B in 2017, and the Complainant employs about 22,000 individuals globally. In China specifically,

where the Complainant first marked its presence in 1988, work has been conducted with Chinese automobile manufacturers such as SAIC Motor, GAC, and Dongfeng Motor. More than 2,250 employees function in 34 offices across China, as well as one global R&D center in Shanghai, one software development center in Dalian and two plants. Furthermore, Complainant and its FactoryTalk® software played a major role in reducing the energy consumption of the Dalian metro system by 12%.

**A. The Disputed Domain Name is Identical or Confusingly Similar to a Trademark or Service Mark in which the Complainant has Rights**

By virtue of its federal trademark and service mark registrations, Complainant is the owner of Complainant's trademarks. See *United Way of America v. Alex Zingaus*, FA 1036202 (NAF Aug. 30, 2007) ("Panels have long recognized Complainant's registration of a mark with a trademark authority is sufficient to confer rights in the mark pursuant to Policy ¶ 4(a)(i)"). Furthermore, a complainant is not required to register its marks within the country of the respondent in order to protect its rights in those marks. See *Renaissance Hotel Holdings, Inc. v. Renaissance Cochin*, FA 932344 (NAF April 23, 2007) (finding that it does not matter whether the complainant has registered its trademark in the country in which the respondent resides, only that it can establish rights in some jurisdiction); see also *Enter. Rent-A-Car Co. v. David Mizer Enters., Inc.*, FA 0622122 (NAF Apr. 14, 2006).

When comparing the Disputed Domain Name to Complainant's trademarks, the relevant comparison to be made is between only the second-level portion of the Disputed Domain Name and the Complainant's trademarks. See *Rollerblade, Inc. v. McCrady*, D2000-0429 (WIPO June 28, 2000) (finding that the top-level domain, such as ".net" or ".com", does not affect the domain name for the purpose of determining whether it is identical or confusingly similar). See also

*Gardline Surveys Ltd. v. Domain Fin. Ltd.*, FA 0153545 (NAF May 27, 2003) (“[t]he addition of a top-level domain is irrelevant when establishing whether or not a mark is identical or confusingly similar, because top-level domains are a required element of every domain name”).

The Disputed Domain Name contains Complainant’s FACTORYTALK trademark in its entirety, thus resulting in a domain name that is identical to the Complainant’s FACTORYTALK trademark. Where, as here, a disputed domain name encompasses and captures a complainant’s trademark in its entirety, past Panels have established that the disputed domain name should be found confusingly similar to that trademark. Thus, the Disputed Domain Name should be considered identical and confusingly similar to the Complainant’s FACTORYTALK trademark. See *The American Red Cross v. Leonard Habersham*, FA 0103926 (NAF Mar. 6, 2002). See also *Uniroyal Engineered Products, Inc. v. Nauga Network Services*, D2000-0503 (WIPO July 18, 2000) (Panel finding the disputed domain <nauga.net> confusingly similar to complainant’s NAUGA trademark).

**B. The Respondent has no Rights or Legitimate Interests in Respect of the Disputed Domain Name**

The granting of registrations by the European Union Intellectual Property Office (EUIPO), the Mexican Institute of Industrial Property (IMPI), the United States Patent and Trademark Office (USPTO), the Canadian Intellectual Property Office (CIPO), the World Intellectual Property Organization (WIPO), the Korea Intellectual Property Rights Information Service (KIPRIS) and China Trademark Office under State Administration for Industry and Commerce (CTMO) to Complainant for the FACTORYTALK trademark is *prima facie* evidence of the validity of the term “FACTORYTALK” as a trademark, of Complainant’s ownership of this trademark, and of Complainant’s exclusive right to use the

FACTORYTALK trademark in commerce on or in connection with the goods and/or services specified in the registration certificates.

Respondent is not sponsored by or affiliated with Complainant in any way.

Complainant has not given Respondent permission to use Complainant's trademarks in any manner, including in domain names.

Respondent is not commonly known by the Disputed Domain Name, which evinces a lack of rights or legitimate interests.

Where no evidence, including the Whois record for the Disputed Domain Name, suggests that Respondent is commonly known by the Disputed Domain Name, then Respondent cannot be regarded as having acquired rights to or legitimate interests in the Disputed Domain Name within the meaning of ¶ 4(c)(ii). See *Instron Corp. v. Kaner*, FA 0768859 (NAF Sept. 21, 2006) (finding that the respondent was not commonly known by the disputed domain names because the Whois information listed "Andrew Kaner c/o Electromatic a/k/a Electromatic Equip't" as the registrant and there was no other evidence in the record to suggest that the respondent was commonly known by the domain names in dispute).

The Respondent was using the Disputed Domain Name to redirect internet users to a website featuring links to third-party websites, some of which directly compete with Complainant's business. For instance, the website at which the Disputed Domain Name resolves featured third-party links for "intelligent automation software", "industries automation" and "industrial automation". Presumably, Respondent received pay-per-click fees from the linked websites that were listed at the Disputed Domain Name's website. Prior UDRP decisions have consistently held that respondents that monetize domain names using pay-

per-click links have not made a *bona fide* offering of goods or services that would give rise to rights or legitimate interests in a disputed domain name. As such, the Respondent is not using the Disputed Domain Name to provide a *bona fide* offering of goods or services as allowed under Policy ¶ 4(c)(i), nor a legitimate noncommercial or fair use as allowed under Policy ¶ 4(c)(iii). See *H-D Michigan Inc. v. Buell*, FA 1106640 (NAF Jan. 2, 2008) (As the “respondent’s disputed domain names resolve to a website featuring a series of advertising links to various third-parties, many of whom offer products and services in direct competition with those offered under [the complainant’s] mark,” the respondent is not using the disputed domain names for a bona fide offering of goods or services or a legitimate noncommercial or fair use).

The Respondent is using the Disputed Domain Name to redirect internet users to a website that resolves to a blank page and lacks content. Respondent has failed to make use of this Disputed Domain Name’s website and has not demonstrated any attempt to make legitimate use of the domain name and website, which evinces a lack of rights or legitimate interests in the Disputed Domain Name, as confirmed by numerous past Panels. See *Nenê f/k/a Maybyner Rodney Hilario v. Master, Host*, FA 0924563 (NAF Apr. 10, 2007) (Holding that absence of content at website evinced a lack of rights or legitimate interests in the disputed domain name). See also *Bloomberg L.P. v. SC Media Servs. & Info. SRL*, FA 0296583 (NAF Sept. 2, 2004) (Respondent is using the Disputed Domain Name to resolve to an empty page featuring no substantive content or links is further evidence that Respondent’s failure to actively use the Disputed Domain Name(s) suggests a lack of rights and legitimate interests in the Disputed Domain Name(s) as blank pages are neither a bona fide offering of goods or services under Policy ¶4(c)(i) nor a legitimate noncommercial or fair use under Policy ¶4(c)(iii)).



The Disputed Domain Name is being offered for sale in an amount that far exceeds the Respondent's out-of-pocket expenses in registering the domain, which serves as further evidence of Respondent's lack of rights and legitimate interests. Past Panels have consistently upheld this view. See *Reese v. Morgan*, FA 0917029 (NAF Apr. 5, 2007) (offer to sell a domain name in excess of the out-of-pocket expenses incurred in maintaining the domain name was evidence that the respondent had no true rights or legitimate interests). Email correspondence produced by the Complainant, shows that Complainant's representative acknowledged the sale listing at the price of 3,000 USD and Respondent offered to sell the Disputed Domain Name for an initial price of 25,000 USD.

The Disputed Domain Name was registered on March 23, 1999, but to the best of Complainant's knowledge at this juncture, the Disputed Domain Name only transitioned to the current registrant (Respondent), between March 26, 2016 and June 7, 2016, which is significantly after Complainant filed for registration of its FACTORYTALK trademark with the European Union Intellectual Property Office (EUIPO), the Mexican Institute of Industrial Property (IMPI), the United States Patent and Trademark Office (USPTO), the Canadian Intellectual Property Office (CIPO), the World Intellectual Property Organization (WIPO), the Korea Intellectual Property Rights Information Service (KIPRIS) and China Trademark Office under State Administration for Industry and Commerce (CTMO), and also significantly after Complainant's first use in commerce of its trademark in 2002.

**C. The Disputed Domain Name was Registered and is Being Used in Bad Faith**

The Complainant and its FACTORYTALK trademark are known internationally, with trademark registrations across numerous countries including Respondent's home country of China. The Complainant has marketed and sold its goods and

services using this trademark since 2002, which is well before the registration of the Disputed Domain Name on March 23, 1999 (*sic*).

By registering a domain name that is identical to the Complainant's FACTORYTALK trademark, Respondent has created a domain name that is confusingly similar to Complainant's trademark. As such, Respondent has demonstrated a knowledge of and familiarity with Complainant's brand and business. Furthermore, prior to initiating these proceedings, Complainant had attempted to reach an agreement to acquire the domain name for a reasonable amount. In those discussions, Respondent quoted Complainant a price of 18,000 USD stating the amount was, "...nothing to Rockwell" indicating Respondent was more than aware of Complainant, their business and their rights to the Disputed Domain Name.

In light of the facts set forth within this Complaint, it is "not possible to conceive of a plausible situation in which the Respondent would have been unaware of" the Complainant's brands at the time the Disputed Domain Name was registered. See *Telstra Corp. Ltd. v. Nuclear Marshmallows*, D2000-0003 (WIPO Feb. 18, 2000). Stated differently, FACTORYTALK is so closely linked and associated with Complainant that Respondent's use of this mark, or any minor variation of it, strongly implies bad faith – where a domain name is "so obviously connected with such a well-known name and products,... its very use by someone with no connection with the products suggests opportunistic bad faith." See *Parfums Christian Dior v. Javier Garcia Quintas*, D2000-0226 (WIPO May 17, 2000).

Further, where the Disputed Domain Name is identical to the Complainant's FACTORYTALK trademark "it defies common sense to believe that Respondent coincidentally selected the precise domain without any knowledge of Complainant and its trademarks." See *Asian World of Martial Arts Inc. v. Texas International Property Associates*, D2007-1415 (WIPO Dec. 10, 2007)

ICANN policy dictates that bad faith can be established by evidence demonstrating that the Respondent has “intentionally attempted to attract, for commercial gain, Internet users to [Respondent’s] website...by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the web site or location of a product or service on [Respondent’s] website or location,” see UDRP Policy 4(b)(iv). Here, Respondent creates a likelihood of confusion with Complainant and its trademarks by registering a domain that is identical to the Complainant’s FACTORYTALK trademark, which demonstrates that Respondent is using the Disputed Domain Name to confuse unsuspecting internet users looking for Complainant’s services, and to mislead internet users as to the source of the domain name and website. By creating this likelihood of confusion between the Complainant’s trademarks and the Disputed Domain Name, leading to misperceptions as to the source, sponsorship, affiliation, or endorsement of the Disputed Domain Name, the Respondent has demonstrated a nefarious intent to capitalize on the fame and goodwill of the Complainant’s trademarks in order to increase traffic to the Disputed Domain Name’s website for Respondent’s own pecuniary gain, as evidenced by the presence of multiple pay-per-click links posted to Respondent’s website.

Previous Panels have found bad faith under Policy ¶ 4(b)(iv) where a respondent uses a confusingly similar domain name to resolve to a website featuring links to third-party websites that create revenue for the respondent. See *PRL USA Holdings, Inc. v. LucasCobb*, D2006-0162 (WIPO Mar. 30, 2006) (“Respondent’s use of the Domain Name to earn referral fees by linking to other websites attracts Internet users to Respondent’s site by creating confusion as to source and results in commercial gain to Respondent. Accordingly, the Panel finds that the Domain Name was registered in bad faith”).

The Disputed Domain Name currently resolves to an inactive site and is not being used, though past Panels have noted that the word bad faith "use" in the context of ¶4(a)(iii) does not require a positive act on the part of the Respondent – instead, passively holding a domain name can constitute a factor in finding bad faith registration and use pursuant to Policy ¶ 4(a)(iii). See *Telstra Corp. v. Nuclear Marshmallows*, D2000-0003 (WIPO Feb. 18, 2000) ("it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith"). See also *Alitalia-Linee Aeree Italiane S.p.A v. Colour Digital*, D2000-1260 (WIPO Nov. 23, 2000) (finding bad faith where the Respondent made no use of the domain name in question and there are no other indications that the Respondent could have registered and used the domain name in question for any non-infringing purpose).

In this case, the Disputed Domain Name is confusingly similar to Complainant's trademarks, and Respondent has made no use of the Disputed Domain Name, factors that should be duly considered in assessing bad faith registration and use. See *DCI S.A. v. Link Commercial Corp.*, D2000-1232 (WIPO Dec. 7, 2000) (concluding that the respondent's passive holding of the domain name satisfies the requirement of ¶4(a)(iii) of the Policy). See also, D2000-1228 (WIPO Nov. 28, 2000) (finding that merely holding an infringing *Clerical Med. Inv. Group Ltd. v. Clericalmedical.com* domain name without active use can constitute use in bad faith).

The Disputed Domain Name can only be taken as intending to cause confusion among internet users as to the source of the Disputed Domain Name, and thus, the Disputed Domain Name must be considered as having been registered and used in bad faith pursuant to Policy ¶4(b)(iv), with no good faith use possible.

Complainant first attempted to purchase the Disputed Domain Name on October 1, 2018 through an anonymous acquisition initiated by Complainant's

representative. At the time the Disputed Domain Name was listed through SEDO for the “asking price” of 3,000 USD – the listing has since been removed. Upon learning of Respondent’s 25,000 USD asking price, it was revealed that the purchase attempt was being conducted on behalf of Complainant. Respondent was served with a Notice of Trademark Rights, alerting Respondent to the unauthorized use of the FACTORYTALK trademark within the domain name. Complainant also offered reasonable compensation for costs incurred related to the registration and maintenance of the Disputed Domain Name. Respondent replied, reducing the asking price to 18,000 USD and stating that the new price was, “...nothing to Rockwell”. Since the efforts of trying to solve the matter amicably were unsuccessful, the Complainant chose to file a complaint according to the UDRP Process. See *Encyclopedia Britannica v. Zuccarini*, D2000-0330 (WIPO June 7, 2000) (failure to positively respond to a demand letter provides “strong support for a determination of ‘bad faith’ registration and use”).

As indicated above, Respondent was offering to sell the Disputed Domain Name, even before Complainant’s representative reached out, which constitutes bad faith under Section 4(b)(i) because Respondent has demonstrated an intent to sell, rent, or otherwise transfer the Disputed Domain Name for valuable consideration in excess of his out-of-pocket expenses. It is well established that seeking to profit from the sale of a confusingly similar domain name that incorporates a third party’s trademark demonstrates bad faith. See *Broadcom v. Domain Management / Syed Hussain* FA 1419370 (NAF Jan. 17, 2012) (holding Respondent’s offer to sell <broadcomnetlogic.com> to the general public and to complainant constitutes bad faith under Section 4(b)(i)).

Finally, on balance of the facts set forth above, it is more likely than not that the Respondent knew of and targeted Complainant’s trademark, and Respondent should be found to have registered and used the Disputed Domain Name in bad faith. See *Tudor Games, Inc. v. Domain Hostmaster, Customer ID No.*

*09382953107339 dba Whois Privacy Services Pty Ltd / Domain Administrator, Vertical Axis Inc.*, D2014-1754 (WIPO Jan 12, 2014) (“the Panel makes its finding regarding bad faith registration by asking whether it is more likely than not from the record of the evidence in the proceeding that Respondent had the ELECTRIC FOOTBALL trademark in mind when registering the Domain Name.”)

#### B. Respondent

The Respondent alleges, *inter alia*, that Complainant’s FACTORYTALK trademark registration in China commenced on February 14, 2008 and expired on February 14, 2018, and that Complainant’s use of the mark has therefore not been demonstrated to be lawful.

The Complainant alleges that FACTORYTALK has no definitive meaning in the Chinese language, which is discriminatory against the peoples of non-English speaking countries. In fact, “FACTORY” and “TALK” are commonly understood English words in China, where English is taught in schools from year three onward, which when used in combination conveys the meaning of conversation on the factory floor. This meaning is useful to many industries in China seeking to internationalize and these generic words ought to not be restricted to use by persons living in English speaking countries but should reasonably be shared with non-English speakers including the Respondent.

The Complainant’s impressive business stature does not mean that FACTORYTALK and FACTORYTALK.COM will influence or confuse people’s judgements and recognition of Rockwell. The content on Respondent’s FACTORYTALK.COM website does not interfere with Rockwell’s goods or services, business or valuation.

While Respondent wholeheartedly agrees to a resolution by means of rules and legal process to protect legal interests, he cannot accept resorting to rules and

legal process to intimidate him to relinquish his legal rights and interest for a low price. If he were cybersquatting, Rockwell would have sought to arbitrate from the start and would not have retained cscglobal to seek to purchase the domain from him, nor would they resort to arbitration while negotiations as to price were still underway. Who can prove whether FACTORYTALK.COM is worth \$3,000 and not \$18,000?

### C. Additional Submissions

The Complainant's Additional Submission was received on December 12, 2018. The Additional Submission complies with Supplemental Rule 7 and has been reviewed and considered by the Panel. The Complainant's Additional Submissions includes proof that Complainant renewed timely its trademark registration for FACTORYTALK in China and that the current registration expires on February 13, 2028, thus, rebutting the Respondent's assertion that Complainant's registration of the trademark in China had lapsed.

## FINDINGS

The Complainant admits that the Disputed Domain Name was registered on March 23, 1999, before the Complainant first registered its trademark in 2002. This is significant because where a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent.

The Complainant further alleges: "[T]o the best of Complainant's knowledge at this juncture, the Disputed Domain Name only transitioned to the current registrant (Respondent), between March 26, 2016 and June 7, 2016," but provides no substantiating evidence. This would be significant if the Complainant could show that it was true because, irrespective of the original creation date, if a respondent acquires a domain name by transfer from a third party *after* the complainant's trademark rights have accrued, the panel will then look to the

circumstances at the date the UDRP respondent itself acquired the domain name in determining whether the domain was registered in bad faith. Here, it is not apparent to the Panel how the Complainant reached its conclusion, nor has the Complainant shown any relevant circumstances surrounding the purported “transition” of the Disputed Domain Name to the Respondent “between March 26, 2016 and June 7, 2016.” This lacuna is fatal to the Complainant’s case.

## **DISCUSSION**

Paragraph 15(a) of the Rules instructs this Panel 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."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

### **Identical and/or Confusingly Similar**

The Disputed Domain Name is identical to the Complainant’s registered trademark at the second level.

The standing requirement at Policy Paragraph 4(a)(i) is satisfied.



### **Rights or Legitimate Interests**

Complainant has not given Respondent permission to use Complainant's trademarks in any manner, including in domain names. Respondent is not commonly known by the Disputed Domain Name, which evinces a lack of rights or legitimate interests.

The Respondent has parked the Disputed Domain Name on a pay-per-click website which is largely blank and without content but features third-party links for "intelligent automation software", "industries automation" and "industrial automation" which directly compete with Complainant's business. The Panel finds that Respondent is not engaged in the *bona fide* offering of goods or services as allowed under Policy ¶ 4(c)(i), nor a legitimate noncommercial or fair use as allowed under Policy ¶ 4(c)(iii).

Further, the Disputed Domain Name is being offered for sale in an amount that far exceeds the Respondent's out-of-pocket expenses in registering the domain, which serves as further evidence of Respondent's lack of rights and legitimate interests.

The Panel finds that the Complaint satisfies Policy Paragraph 4(a)(ii).

### **Registration and Use in Bad Faith**

The Policy requires Complainant to prove bad faith registration and use.

Especially given that the Disputed Domain Name is composed solely of two common words in combination, absent direct proof that the generic Disputed Domain Name was registered solely for the purpose of profiting from Complainant's trademark rights, there can be no finding of bad faith registration and use. See, *e.g.*, *Ultrafem, Inc. v. Warren Royal*, NAF Claim No. FA0106000097682. Complainant has failed to make the required showing.

As has been noted above, where a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent. See, *e.g.*, *WIPO Jurisprudential Overview 3.0* at 3.8.1 and cases cited therein.

The Complainant has failed satisfactorily to establish bad faith registration of the Disputed Domain Name by the Respondent.

The Panel finds that the Complaint does not satisfy Policy Paragraph 4(a)(iii).

#### **DECISION**

Having failed to establish all three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.

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

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David L. Kreider, Panelist  
Dated: December 16, 2018