

ADMINISTRATIVE PANEL DECISION

Canonical Limited v. Phuc Hau Dang, Mat Biec Ltd.
Case No. D2024-0996

1. The Parties

The Complainant is Canonical Limited, Isle of Man, represented by Bristows, United Kingdom.

The Respondent is Phuc Hau Dang, Mat Biec Ltd., Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <lubuntu.net> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 6, 2024. On March 8, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 8, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 11, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On March 14, 2024, the Complainant filed an amendment to the Complaint.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 20, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 15, 2024. The Response was filed with the Center on April 15, 2024.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on April 23, 2024. 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

According to the Complaint, the Complainant launched the Ubuntu distribution of the Linux family of open source software on October 20, 2004. Since then, the Complainant has released a new version of the operating system approximately every six months. The software is used around the world. The Complainant estimates that approximately 30 per cent of websites using Linux use the Complainant's Ubuntu distribution. The Complainant also claims that there are some 40 million desktop computer users with the Ubuntu distribution installed.

According to the Complaint, "Lubuntu" is the Complainant's "lightweight operating system", based on Ubuntu. It does not seem to be in dispute between the parties that the first, preview version of the Lubuntu system was made publicly available in October 2008. The Complaint states "[f]urther preview versions of the system were released in December 2009 with further releases from 2010." There have been 29 releases of new versions of the Lubuntu operating system. Like the Ubuntu operating system, these releases have been made under Creative Commons licences.

The Complainant has provided a list of 46 registered trademarks around the world for UBUNTU it claims to own. According to the Complaint, it also owns two registered trademarks for LUBUNTU covering the European Union and the United Kingdom. For proportionality, the Complainant relies specifically on its two registered trademarks in the United Kingdom:

- (a) Registered Trademark No UK00904059119, UBUNTU, which was filed and is registered with effect from September 29, 2004 in respect of relevant goods and services in International Classes 9, 41 and 42; and
- (b) Registered Trademark No UK00917893362, LUBUNTU, which was filed and is registered with effect from October 27, 2018 in respect of relevant goods and services in International Classes 9, 38 and 42.

The disputed domain name was registered on January 2, 2009. For some time, it resolved to a website about the Lubuntu software. Currently, it resolves to a page stating that "This Account has been suspended."

The circumstances in which the disputed domain name became registered are not clear. The Complainant contends that the disputed domain name was registered by a Mr Mario Behling. Mr Behling apparently "spearheaded" the development of the Lubuntu operating system "supported by a vibrant community of developers" (according to the Respondent). As the Panel understands the Response, the Respondent was (or claims to have been) part of that founding team.

Mr Behling left the Lubuntu project in 2014. In 2018 and again in 2021 and yet further again in late 2023, the Complainant says it wrote to Mr Behling seeking transfer of the disputed domain name. No response to these communications was received. The Complainant states:

"The Disputed Domain Name previously hosted a website which was connected to the LUBUNTU community but the website subsequently ceased to exist and the Disputed Domain Name resolved to a white web page displaying a string of warning notices, but no substantive content. After the Complainant sent [Mr Behling] further correspondence at the end of 2023 requesting the return of the Disputed Domain Name, the website was reinstated."

To clarify this, the Panel reviewed a number of the captures for the disputed domain name made by the Wayback Machine at "www.archive.org" in 2023. A website about the Lubuntu operating system was captured on June 2, 2023. Thereafter, the captures were of the "Warning" page (including captures in early December 2023) until the capture of the Lubuntu operating system web page on December 18, 2023. As noted above, the disputed domain name currently resolves to a page stating "This Account has been suspended."

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of a disputed domain name, the Complainant must demonstrate each of the following:

- (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.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark rights.

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has proven ownership of at least the two registered trademarks in the United Kingdom for UBUNTU and LUBUNTU identified in section 4 above.

The Respondent contends that the Complainant does not hold trademark rights for LUBUNTU in Viet Nam, where the Respondent resides.

This however mistakes the nature of the inquiry under the Policy at this stage. The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties, the date they were acquired and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g., [WIPO Overview 3.0](#), section 1.7.

Further, in undertaking the comparison between those trademarks and the disputed domain name, it is permissible in the present circumstances to disregard the generic Top-Level Domain ("gTLD") component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the ".net" gTLD, therefore, the disputed domain name is identical to the Complainant's registered trademark LUBUNTU.

The disputed domain name also consists of the Complainant's registered trademark UBUNTU with the letter "L" added as a prefix. As the first requirement under the Policy is essentially a standing requirement, the addition of this prefix does not preclude a finding of confusing similarity as, apart from anything else, the Complainant's trademark remains visually and aurally recognisable within the disputed domain name. See e.g., [WIPO Overview 3.0](#), sections 1.8 and 1.9.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is:

1. identical with the Complainant's LUBUNTU trademark; and
2. confusingly similar to the Complainant's UBUNTU trademark.

The requirement under the first limb of the Policy is therefore satisfied.

B. Registered and Used in Bad Faith

In the circumstances of this proceeding, it is appropriate to consider the third requirement under the Policy next.

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements, i.e. both must be satisfied for a successful complaint: see e.g., *Group One Holdings Pte Ltd v. Steven Hafto*, WIPO Case No. [D2017-0183](#).

Although the publicly available Whois information indicated that the registrant was a privacy protection service, the Complainant contended in the Complaint as filed that the registrant was in fact Mr Behling.

The Complainant contended that Mr Behling previously operated the disputed domain name as part of the Complainant's Ubuntu community. It says that, as part of that community, Mr Behling was bound by the Complainant's intellectual property rights policy which, amongst other things, required members to accept that the Complainant is the exclusive owner of its intellectual property. According to the Complainant, the policy further stated that community members may use the Complainant's trademarks in accordance with its brand guidelines. The Complainant contends that Mr Behling, having left the Ubuntu community, ceased to have any rights in the disputed domain name. The Complainant further contends that, having left the Ubuntu community and continuing to use the disputed domain name in the manner outlined above, "the Respondent" is intentionally creating a likelihood of confusion 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 and is in fact causing confusion. Yet further, the Complainant contends:

"It would be dangerous to allow the Respondent to retain ownership of the Disputed Domain Name as they could use it for further untoward purposes and could be successful in deceiving a company or individual as to a connection with the Complainant. This could lead to financial or other harm coming to that company or individual."

The Respondent denies registration and use in bad faith and advances a number of contentions in rebuttal. The Respondent's contention that the disputed domain name has been actively associated since inception with a legitimate open-source project that predates the Complainant's trademark claims and registrations can be readily dismissed. It is true that the disputed domain name was registered long before the Complainant's LUBUNTU trademark was registered. Apart from anything else, however, that is not the case with the UBUNTU Registered Trademark. It also does not address the Complainant's contention that LUBUNTU was being used as a trademark with the Complainant's permission even though it was not a registered trademark. See e.g., [WIPO Overview 3.0](#), section 3.8.2.

The Respondent further contends that the Complainant's (former) CEO, Mark Shuttleworth, explicitly acknowledged the independence and autonomy of the Ubuntu project on several occasions long before the Complainant registered its (LUBUNTU) trademark. The Respondent has not provided any evidence supporting this claim such as some form of contemporaneous corroborating communication. The Panel is not prepared therefore to act on this unsupported contention alone.

Even on the Complainant's case, however, it is accepted that the *original* registration of the disputed domain name was in good faith, or at least with permission. Thus, for example, the Complaint states (on the assumption that Mr Behling was the original (and continuing) registrant):

"The Respondent *no longer* has any rights or interests in owning a website under the name "ubuntu.net", nor with hosting a website which uses the Ubuntu Mark." (emphasis supplied)

If Mr Behling were the original registrant, that precludes a finding of registration in bad faith. It being well established now that a registration in good faith is not retrospectively converted into bad faith when the

original basis for registration ceases to apply. See e.g., *SPECS Surface Nano Analysis GmbH v. Rickmer Kose / Domain Name Administrator, PrivacyProtect.org*, WIPO Case No. [D2010-1173](#), where the respondent was a distributor of the complainant and registered the domain name with the complainant's permission but refused to transfer it to the complainant when the distributorship ceased.

Although the Complainant was informed through the Registrar's verification response that Mr Behling is not the registrant, the Complainant has not sought to make any different or further arguments – merely filing an amendment to add the Respondent as the respondent whilst retaining the original respondent Mr Behling. Therefore, the Panel proceeds on the basis that the Complainant seems to accept the original registration of the disputed domain name was in good faith as the Complainant accepts the disputed domain name was originally registered in connection with the Complainant's permission in connection with the Complainant's Lubuntu community.

In the Complaint prior to the amendment, the Complainant contends that original registration was by Mr Behling. Other than that Mr Behling "spearheaded" the project, the Complainant has not offered any evidence to support that contention.

On the other hand, it is not entirely clear from the Response that the Respondent was the original registrant. For example, the Respondent states:

"As the long-term domain holder and continuous operator of Lubuntu.net, I, along with the project team, have been commonly known by the domain name long before any notice of dispute was received. The domain Lubuntu.net has become synonymous with the independent project we created"

and:

"The Lubuntu.net domain was registered and has been used continuously by myself, Phuc Hau Dang, and the founding team of the Lubuntu project well before any dispute or claim surfaced."

This could mean that the Respondent was the original registrant. It could also mean that the Respondent was not the original registrant and, consistently with the Complainant's case, became the registrant at some point on or after Mr Behling left the project.

Further, while the Panel acknowledges that the registration details involved a privacy protection service, the Complainant has not provided evidence of the disputed domain name ownership history including whether or not there have been any changes over time despite the ready availability of tools to search the history of a domain names ownership. Instead, the Complainant simply requested that the Respondent's name be added to Complaint as a respondent while retaining Mr Behling as a respondent also. The Complainant has not sought to establish that there was a transfer from Mr Behling (if he was the original registrant) to the Respondent.

Whether the Respondent was the original registrant has potential significance in this case as the question of registration in good faith falls to be determined at the date the Respondent became the registrant.

If the Respondent was the original registrant, the relevant date is the date the disputed domain name was originally registered in 2009. In that case, the Panel would find that the disputed domain name was not registered in bad faith because, as outlined above, the Complainant accepts the disputed domain name was registered with its permission.

If the Respondent was not the original registrant, however, a transfer (if that is what did occur) almost invariably counts as a new registration so that the issue of good faith registration falls to be assessed at the date of the transfer. See [WIPO Overview 3.0](#), section 3.9.

There are some very limited exceptions to that rule. The exceptions typically involve transfers between related entities at least where there is no material change in the nature of the use of the disputed domain name. For example, *Schweizerische Bundesbahnen SBB v. Gerrie Villon*, WIPO [D2009-1426](#);

and *The Proprietors of Strata Plan No. 36, A Turks and Caicos Corporation v. Gift2Gift Corp.* WIPO Case No. [D2010-2180](#).

The typical example of transfers between related entities involves a transfer between members of the same corporate group or an individual and a company to which the individual has subsequently transferred his or her business. That is not precisely the situation here. However, it appears on the unchallenged evidence of the Respondent that the Respondent was part of the “founding team” of the project which the Complainant contends Mr Behling spearheaded. On that basis, the Panel would be prepared to accept that the Respondent is a “related entity” to Mr Behling (or whichever member of the “founding team” registered the disputed domain name) and a transfer to the Respondent (or another member of the “team”) is readily explicable upon Mr Behling (or whomever) leaving the project.

It is also clear on the materials before the Panel that (apart from the comparatively short period when the Wayback Machine captured the “Warning” pages) the disputed domain name has been used continuously in the same manner and to the same ends.

Accordingly, the Panel would be prepared if necessary to treat the present case as falling within the limited exception to the general rule that good faith registration is assessed at the date of transfer to the Respondent (if the disputed domain name was transferred to the Respondent rather than registered by him). On that basis, the Respondent could continue to rely on the original registration of the disputed domain name in good faith as the purpose behind the transfer of the disputed domain name would have remained the same as with the original registration.

In the end, however, the Panel considers the better view in the present case is to treat the Respondent as the original registrant. That is consistent with one reading of the Response. Further, while the Complainant asserts Mr Behling was in fact the original registrant, as discussed above the Complainant has not provided evidence to support that claim. Further still, the Complainant has not sought to argue that the Respondent was not the original registrant or provide material such as changes in the domain name history supporting a contention that the Respondent was not the original registrant. Yet still further, so far as the record shows, the disputed domain name has essentially been used consistently and continuously in the same manner.

The Complainant does contend that the period of the “Warning” pages should be treated as a cessation of the former use and the “reinstatement” of the former website was a pretext merely to cloak bad faith. The period in question, a few months, is comparatively short compared to conduct which, even on the Complainant’s case, continued for at least nine years before the first objection was raised in 2018 and around a further five years before the “Warning” pages commenced. Further, it is not clear on the evidence before the Panel that the “Warning” pages indicate the website had been taken down (that is, ceased) as opposed to the result of some technical problem. If the Complainant relies on some technical understanding for its contention, it was incumbent on the Complainant to explain that.

The Respondent’s continued retention of the disputed domain name may be in breach of the contractual arrangements, if any, applicable. The Panel expresses no concluded view on this issue as it is unnecessary to do so. As cases such as *SPECS Surface Nano Analysis GmbH*, supra, show, the consequences of such a breach (if any) must be resolved in forums other than under the Policy.

Given the extensive debates in the formulation of the Policy ending in the adoption of the conjunctive form of the third requirement, panels have repeatedly recognized that a Policy amendment is required to extend its scope to cover cases of use in bad faith following registration in good faith.

Accordingly, the Panel finds that the Complainant has not established that the disputed domain name was registered in bad faith and therefore has not established the third requirement under the Policy.

C. Rights or Legitimate Interests

In light of the conclusion reached in relation to the third requirement under the Policy, no good purpose would be served by addressing this issue.

D. Reverse Domain Name Hijacking

Paragraph 15(e) of the Policy provides that, if after considering the submissions, the Panel finds that the Complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or to harass the domain-name holder, the Panel shall declare in its decision that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. The mere lack of success of the complaint is not, on its own, sufficient to constitute reverse domain name hijacking. [WIPO Overview 3.0](#), section 4.16.

The Complainant initiated this proceeding on the basis that it accepted the disputed domain name had been registered in good faith or, which for present purposes amounts to the same thing, with the Complainant's permission. The Complainant was mistaken about the identity of the registrant – understandably so, given the use of the privacy protection service. However, the Complainant did not seek to change the basis of its claim once the identity of the Respondent was revealed through the Registrar's verification response. It merely sought to add the Respondent to Mr Behling (formally addressed as a Respondent in the initial Complaint).

As discussed above, since the rejection of the so-called retrospective registration in bad faith theory advanced in cases such as *City Views Limited v. Moniker Privacy Services / Xander, Jeduyu, ALGEBRALIVE*, WIPO Case No. [D2009-0643](#), it has been long settled under the Policy that registration in bad faith must be demonstrated, not just use in bad faith. See [WIPO Overview 3.0](#), section 3.2.1.

Once the Complainant was on notice of the identity of the registrant, it was incumbent on the Complainant to provide a basis on which a conclusion could be reached that the disputed domain name was registered and being used in bad faith by the Respondent. Merely amending the Complaint to change the identity of the Respondent to add the newly disclosed registrant as a Respondent falls far short of attempting that.

7. Decision

For the foregoing reasons, the Complaint is denied. Moreover, the Panel finds that the Complaint has been brought in bad faith and constitutes an attempt at Reverse Domain Name Hijacking.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: May 7, 2024