

ADMINISTRATIVE PANEL DECISION

elasticsearch B.V. v. david, hackernoon
Case No. D2024-3756

1. The Parties

The Complainant is elasticsearch B.V., Netherlands (Kingdom of the), represented by Quinn IP Law, United States of America.

The Respondent is david, hackernoon, United States of America, represented by HackerNoon, India.

2. The Domain Name and Registrar

The Disputed Domain Name <elasticsearch.tech> (the “Disputed Domain Name”) is registered with Dotservice Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 16, 2024. On September 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On September 17, 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 (United-Domains GmbH) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 17, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on September 25, 2024.

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

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 16, 2024. The Response was filed with the Center on October 9, 2024. On October 18, 2024 the Complainant submitted a supplemental filing (the “Complainant’s Supplemental Filing”).

The Center appointed Nick J. Gardner as the sole panelist in this matter on November 1, 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

The Complainant provides computer software for use in searching, analyzing, and reporting information and data and operates an “Elasticsearch” platform for search-powered solutions. The Complainant has multiple trademark registrations in many jurisdictions for the trademark ELASTICSEARCH including the following registrations: US Registration No. 4212205 registered on September 25, 2012, for goods and services in classes 9 and 42; United Kingdom Registration No. 00801114893 registered on March 26, 2013; and International Trademark Registration No. 1114893 registered on January 30, 2012. These trademarks are referred to as the “ELASTICSEARCH trademark” in this decision.

The Complainant also owns multiple domain names with the term “elasticsearch” forming part of the domain name, such as <elasticsearch.com>, <elasticsearch.biz>, <elasticsearch.net>, <elasticsearch.org>, <elasticsearch.co>, and <elasticsearch.us>.

The Disputed Domain Name was registered on March 12, 2024. See below for details as to how it resolves.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name. It also relies upon numerous previous UDRP decisions where it has prevailed in relation to the ELASTICSEARCH trademark. The Panel does not consider it necessary to set out the detail of these.

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

The Complainant also contends that the Respondent has no rights or legitimate interests in the Disputed Domain Name as required under paragraph 4(a)(ii) of the Policy. The Complainant points to the fact that there is nothing on the record to indicate that the Respondent has ever used the Disputed Domain Name in relation to a bona fide offering of goods or services, nor is the Respondent making legitimate noncommercial or fair use of the Complainant’s ELASTICSEARCH trademark in the Disputed Domain Name. The Complainant says that the Respondent has no trademark registrations for the relevant terms, is not affiliated with the Complainant, and is not commonly known as ELASTICSEARCH. The Respondent registered the Disputed Domain Name on March 12, 2024, whereas the Complainant points out that it has been using the ELASTICSEARCH trademarks since 2010.

The Complainant contends that the Respondent knew, or should have known, at the time of registration of the Disputed Domain Name, of the Complainant’s notoriety as a global innovator, and the Complainant’s rights in the ELASTICSEARCH trademarks. According to the Complainant, as of November 2023, Complainant’s Elasticsearch platform has been downloaded more than 4 billion times. Moreover, Complainant’s products and services are utilized and integrated in the data infrastructures of some of the world’s most recognizable and technically advanced businesses and solutions providers. As yet another indication of how well-known Complainant is in the technology space, Complainant has an active Elastic

Meetup community of over 101,000 members across 55 countries. The Complainant contends that the Respondent registered the Disputed Domain Name to confuse the public into believing that the Disputed Domain Name is associated or affiliated with the Complainant. These facts establish a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name for the reasons identified in paragraph 4(a)(ii) of the Policy, the Complainant asserts.

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

B. Respondent

The substantive part of the Response reads as follows "This is re: complaint filed by an entity for the domain elasticsearch.tech owned by HackerNoon. We contest the complainant's claims categorically and would like to highlight out the following aspersion cast in the complaint: Page 7 - Claim - "The Respondent has no rights or legitimate interests in respect of the domain name" As a free to publish technology website, HackerNoon receives submissions from developers, marketers, and their intersections in the literal tens of thousands. Quite a few of these stories pertain to elasticsearch. To make it easier for our 4M+ readers easily find content related to their preferred technology, we build out separate websites that host the content about that technology. In this case, we refer to elasticsearch as a technology, not as a company. There are over 100 stories about ElasticSearch on HackerNoon and a quick search on HackerNoon will make that clear".

C. Complainant's Supplemental Filing

The Complainant's Supplemental Filing says that the Response has introduced new evidence that could not have been anticipated, namely that the Disputed Domain Name now resolves to a "blog" page entitled "elasticsearch's Blog" and this page has only been configured by the Respondent subsequent to receiving the Complaint. The Complainant's Supplemental Filing goes on in further detail about why this is additional evidence of bad faith registration and use.

6. Discussion and Findings

Procedural Issue – Complainant's Supplemental Filing

No provision concerning supplemental filings is made in the Rules or Supplemental Rules, except at the request of the panel according to paragraph 12 of the Rules, which states the panel, in its sole discretion, may request any further statements or documents from the parties it may deem necessary to decide the case.

According to paragraph 10 of the Rules, the panel has the authority to determine the admissibility, relevance, materiality, and weight of the evidence, and also to conduct the proceedings with due expedition, ensuring that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

As stated in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.6, unsolicited supplemental filings are generally discouraged – unless specifically requested by the panel – and the party submitting an unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response.

Accordingly, UDRP panels generally accept supplemental filings only when they provide material new evidence or a fair opportunity to respond to arguments that could not reasonably have been anticipated. See, for example, *Welcomemat Services, Inc. v. Michael Plummer Jr., MLP Enterprises Inc.*, WIPO Case No. [D2017-0481](#).

It is not clear here that the record indicates that the way the Disputed Domain Name used changed after the Respondent received the Complaint. The Complainant's Annex VII which was an Annex to the Amended Complaint and to which it refers the Panel in its Supplemental Filing as showing non-use in fact requires further consideration. It shows on its first page a screenshot showing the text "elasticsearch.tech's server IP address could not be found" but the second and third pages in that Annex show the blog page referred to in the Supplemental Filing. Therefore, it is not clear to the Panel that the Complainant has established the content of the Respondent's website changed subsequent to the Complaint being filed. Accordingly the Panel declines to admit the Complainant's Supplemental Filing. In practical terms the consequences of this ruling are academic as the material the Complainant wished to introduce by way of that filing was already in evidence, as explained above.

Substantive Matters

To succeed, in accordance with paragraph 4(a) of the Policy, the Complainant must satisfy the Panel that:

- (i) the Disputed Domain Name is identical with or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has rights in the ELASTICSEARCH trademark. The Panel finds the Disputed Domain Name is identical to this trademark. It is well established that the generic Top-Level Domain ("gTLD"), in this case ".tech", does not affect the Disputed Domain Name for the purpose of determining whether it is identical or confusingly similar. See, for example, *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. [D2000-0429](#).

Accordingly the Panel finds that the Disputed Domain Name is identical to the Complainant's trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

The Panel finds the ELASTICSEARCH trademark is, on the evidence before the Panel, a term in which the Complainant has developed a significant reputation.

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a domain name:

- (i) before any notice to the respondent of the dispute, 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) the respondent has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

None of these apply in the present circumstances. The Complainant has not authorised, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use the ELASTICSEARCH trademark. The Complainant has prior rights in the ELASTICSEARCH trademark which precede the Respondent's acquisition of the Disputed Domain Name. The Complainant has therefore established a prima facie case under the second element and thereby the burden of production shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the Disputed Domain Name. See, for example, *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#); *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

The Panel finds that the Respondent has failed to produce any evidence to establish his rights or legitimate interests in the Disputed Domain Name. Even if the Respondent has published some sort of repository of articles and technical information, its use of a domain name, which is identical to and solely comprised of the Complainant's trademark, to allegedly point to articles about the Complainant's technology does not vest it with a right or legitimate interest.

In particular, the usage concerned, as shown in evidence provided by the Complainant, clearly acknowledges the Complainant's mark, and risks giving the impression that the website and blog page in question are produced by the Complainant. That is manifestly not the case.

The term "elasticsearch" combines two ordinary English words but the result is a conjoined term which is in the Panel's opinion relatively unusual and distinctive. There is no evidence to suggest that the conjoined term has any independent meaning or that the Respondent is commonly known by the Disputed Domain Name. The Complainant has provided evidence of its substantial reputation in that term as the Complainant's trademark.

In summary, there is nothing in the Response which establishes grounds for a right or legitimate interest in the Disputed Domain Name (which is identical to the Complainant's trademark) and the Panel considers the Respondent has failed to rebut the inference raised by the Complainant.

Accordingly, the Panel finds the Respondent has no rights or any legitimate interests in the Disputed Domain Name and the second condition of paragraph 4(a) of the Policy has been fulfilled.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy a non-exhaustive list of factors evidencing registration and use in bad faith comprises:

(i) circumstances indicating that you 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.

Assuming, in its favour, that what the Respondent says is true in that it is a "free to publish technology website, [which] receives submissions from developers, marketers, and their intersections in the literal tens of thousands" and "Quite a few of these stories pertain to elasticsearch" the Panel does not understand why that means the Respondent says it is entitled to use a domain name which is identical to the Complainant's distinctive trademark. In essence, this seems to be either a claim of fair use or that the term is generic; neither is accurate nor supports the Respondents case. To the former, this would not entitle the Respondent to register and use the Complainant's mark as a domain name. To the latter, this is undermined by the use to which the Complainant's mark is put on the Respondent's main site. The Response says as follows: "There are over 100 stories about ElasticSearch on HackerNoon and a quick search on HackerNoon will make that clear". The Panel has accordingly carried out a search on the Respondent's main website for "elasticsearch". The results show it is used to identify the Complainant or the software and services it provides –e.g., "Apache Doris for Log and Time Series Data Analysis in NetEase: Why Not Elasticsearch and InfluxDB?" or "Using Elasticsearch to Offload Search and Analytics from DynamoDB: Pros and Cons" or "Understanding Elasticsearch Reindexing: When to Reindex, Best Practices and Alternatives".

In the present circumstances the Panel finds the Respondent's exact motivation difficult to discern and the Panel cannot clearly determine which, if any, of the factors under paragraph 4(b) of the Policy (above) may apply; arguably it is a case of 4(b)(iv). However, the Panel notes that in any event this list is non-exhaustive and concludes that the registration of the Disputed Domain Name with knowledge of the Complainant's trademark is itself evidence of bad faith. See *Magneti Marelli Motopropulsion France S.A.S. v. Mopex S.A.* WIPO Case No. [D2003-0187](#), stating that "Previous Panels have held that the awareness of a Complainant's mark at the time of registration of a disputed domain name that is confusingly similar to that mark is evidence of bad faith".

In summary, the Respondent is simply using the Complainant's distinctive trademark when it has not shown any clear reasons why that was appropriate and it has done so in a manner which, even by the Respondent's own account, either trades off of or gives the impression that the Disputed Domain Name is one of the Complainant's or was authorised by the Complainant, when neither is the case. The evidence in the case file as presented indicates overall that the Respondent's aim in registering the Disputed Domain Name was to unfairly exploit the Complainant's trademark.

Accordingly, the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith and the third condition of paragraph 4(a) of the Policy has been fulfilled.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Name <elasticsearch.tech> be transferred to the Complainant.

/Nick J. Gardner/

Nick J. Gardner

Sole Panelist

Date: November 15, 2024