

ADMINISTRATIVE PANEL DECISION

elasticsearch B.V. v. Rameez Shaikh
Case No. D2024-3996

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 Rameez Shaikh, India.

2. The Domain Name and Registrar

The disputed domain name <elasticsearchsecurity.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 29, 2024. On September 30, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 30, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 1, 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 October 7, 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 October 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 29, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 6, 2024.

The Center appointed Fabrizio Bedarida as the sole panelist in this matter on November 8, 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 in this proceeding is elasticsearch B.V., a Netherlands private limited company. The Complainant is a leading provider of technology related security products and services. The Complainant's Elasticsearch platform has been downloaded more than 4 billion times.

Previous UDRP panels have held that the ELASTIC and ELASTICSEARCH marks are well-known and distinctive.

The Complainant affirms and documents that it is the owner of multiple registrations consisting of the terms "ELASTIC" and "ELASTICSEARCH", including in India.

The Complainant also owns a number of domain names, including <elastic.co>

The Complainant is, inter alia, the owner of the following:

- United States trademark registration No. 4212205 for ELASTICSEARCH (word) registered on September 25, 2012;
- United States trademark registration No. 6263801 for ELASTIC (word) registered on February 9, 2021; and
- United States trademark registration No. 6211319 for ELASTIC (device) registered on December 1, 2020.

The disputed domain name resolves to a GoDaddy page displaying a pay-per-click site and the message that the disputed domain name is "parked free, courtesy of GoDaddy.com."

The disputed domain name was registered on October 9, 2022.

The Complainant's representatives, in an attempt to resolve the matter amicably, sent a cease and desist letter to the Respondent via email. The Respondent did not respond.

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.

Notably, the Complainant contends that the disputed domain name is confusingly similar to the ELASTICSEARCH trademark. In this sense, the Complainant claims: that the addition of the term "security" does not prevent a finding of confusing similarity with the Complainant's ELASTICSEARCH trademark, which remains clearly recognizable in the disputed domain name; that the Respondent has no rights or legitimate interests in respect of the disputed domain name; that the Respondent is passively holding the disputed domain name; and that such use does not constitute a bona fide offering of goods or services, nor does it give the Respondent rights or legitimate interests in the disputed domain name. Furthermore, the Complainant notes that the reputation of its ELASTICSEARCH trademark has already been

recognized in many previous UDRP decisions, and thus the registration of the disputed name (which contains a well-known trademark) amounts per se to a registration in bad faith. In addition, the Complainant states that the Respondent's bad faith is also evident in the Respondent's endeavours to conceal its identity. In addition, the Complainant contends that the combination of the term "security" with the ELASTICSEARCH trademark in the disputed domain name is likely to mislead consumers into believing that the website at the disputed domain name is associated with the Complainant or provides services related to the Complainant's business, and that this deliberate attempt to create confusion demonstrates bad faith use.

Finally, the Complainant claims that the Respondent's failure to respond to the Complainant's cease and desist letter is evidence of bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three following elements is satisfied:

- (i) the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights;
- (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.

A. Identical or Confusingly Similar

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 shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced and recognizable within the disputed domain name. Accordingly, the disputed domain name confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here "security", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or

legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Furthermore, the nature of the disputed domain name carries a risk of implied affiliation and cannot constitute a fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel notes that, as discussed below, it is highly likely that the Respondent was aware of the Complainant's trademark registrations and rights to the ELASTIC and ELASTICSEARCH trademarks when it registered the disputed domain name.

The disputed domain name contains in its entirety, without any authorization or approval, the Complainant's registered ELASTICSEARCH trademark.

Owing to the substantial presence established, worldwide and on the Internet, by the Complainant, it is at the least very unlikely that the Respondent was not aware of the existence of the Complainant, or of the Complainant's trademarks, when registering the disputed domain name.

In fact, the ELASTIC and ELASTICSEARCH trademarks were registered several years before the Respondent registered the disputed domain name. They have since been intensively used and are therefore well-known, as confirmed by previous UDRP panels (e.g. *Elasticsearch B.V. v. Nanci Nette*, WIPO Case No. [D2023-2938](#)).

Noting also the composition of the disputed domain name, incorporating the Complainant's distinctive trademark with a descriptive term related to the Complainant's activities, it is more likely than not that the Respondent, when registering the disputed domain name, had knowledge of the Complainant's earlier rights to the ELASTICSEARCH trademark.

Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4. The Panel is therefore satisfied that the Respondent registered the disputed domain name in bad faith.

The bad faith registration and use of the disputed domain name are also affirmed by the fact that the Respondent did not respond to the Complainant's cease and desist letter, nor has it denied the assertions of bad faith made by the Complainant in this proceeding.

Finally, Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness and reputation of the Complainant's trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds that the Complainant has established the third element of the Policy.

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 <elasticsearchsecurity.com> be transferred to the Complainant.

/Fabrizio Bedarida/

Fabrizio Bedarida

Sole Panelist

Date: November 22, 2024