

WIPO

WORLD INTELLECTUAL PROPERTY ORGANIZATION

WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Deciso Group B.V. v. Registration Private, Domains By Proxy, LLC / Jamie Thompson, Rubicon Communications dba Netgate

Case No. D2017-1828

1. The Parties

The Complainant is Deciso Group B.V. of Middelharnis, the Netherlands, represented by Hollier-Larousse & Associates, France.

The Respondent is Registration Private, Domains By Proxy, LLC of Scottsdale, Arizona, United States of America ("United States") / Jamie Thompson, Rubicon Communications dba Netgate of Austin, Texas, United States, internally represented.

2. The Domain Name and Registrar

The disputed domain name <opnsense.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 21, 2017. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 22, 2017, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on September 26, 2017 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 amendment to the Complaint on September 28, 2017.

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 October 2, 2017. In accordance with the Rules, paragraph 5, the due date for Response was October 22, 2017. The Response was filed with the Center on October 11, 2017. On October 19, 2017, the Complainant submitted an unsolicited supplemental filing after which the Respondent submitted an unsolicited supplemental filing on October 23, 2017.

The Center appointed Luca Barbero as the sole panelist in this matter on October 27, 2017. 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 was founded in 2000 and develops network appliances and middleware software. Its field of expertise ranges from open source firewall & UTM technology to telecommunications and business intelligence.

The Complainant is the owner of the European Union trademark registration Nos. 012771457 for OPNSENSE (figurative mark), filed on April 8, 2014 and registered on August 20, 2014, for goods in class 9, and 016287716 for OPNSENSE (word mark), filed on January 26, 2017 and registered on May 9, 2017, for goods in class 9.

The Complainant also owns the domain name <opnsense.org>, registered on September 4, 2014, at which it promotes and enables users to download its open-source OPNSENSE firewall.

The disputed domain name <opnsense.com> was registered on April 8, 2014, and is not pointed to an active website.

According to the screenshots submitted by the parties, the disputed domain name was previously pointed to a website displaying images recalling Internet networks, the trademark OPNSENSE and comments about the Complainant's OPNSENSE firewall, such as: "The possibilities are limitless. Just think of all the places you can go on vacation when your boss finds out you've installed OPNsense on his network"; "Look at this f[] keyboard. Pretty cool, right? If you had one, you could probably manage a firewall with it. Just not ours"; and "Ease to manage. When your users start complaining, it's probably the firewall! Tell those whiny b[] to shut it. You're leading technology!". A video on the website also showed scenes taken from the film "Downfall", the historical war drama film depicting the final ten days of Adolf Hitler's rule over Nazi Germany, along with a comment reading "From deep within the OPNsense development bunker".

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical to the trademark OPNSENSE and the domain name <opnsense.org> owned by the Complainant and that, as a result, the likelihood of confusion between the signs is indisputable.

The Complainant states that the Respondent has started using the disputed domain name in early 2016 and has no rights or legitimate interests in it for the following reasons: i) there is no evidence of any use of the disputed domain name in connection with a *bona fide* offering of goods or services, since the website accessible through it does not offer any goods or services but only aims at bringing discredit on the products offered by the Complainant under the trademark OPNSENSE; ii) the Respondent has not been commonly known by the disputed domain name; and iii) the Respondent is not making a legitimate noncommercial use of the disputed domain name since the Respondent's use on the correspondent website tarnishes the Complainant's trademark.

The Complainant further points out that the Respondent registered and used the disputed domain name in bad faith because the Respondent has no business activity at the disputed domain name and the only purpose of the registration and use of the disputed domain name is to bring discredit on the OPNSENSE products of the Complainant, by using degrading words and publishing a video, showing an actor interpreting Hitler, with the following phrase above it: "From deep within the OPNSENSE development bunker".

The Complainant asserts that the comments and video published on the website to which the disputed domain name resolves cannot be considered as fair or editorial in nature, and concludes that this use of the disputed domain name is extremely damaging to the Complainant and provides a negative reputation, by misleadingly diverting consumers, tarnishing the Complainant's trademark and disrupting the Complainant's business.

The Complainant also states that in two occasions, links on the website at the disputed domain name redirect users to the Complainant's website, a circumstance which increases the likelihood of confusion between the domain names.

B. Respondent

The Respondent contends that the Complainant has not shown that: i) it used the trademark OPNSENSE, in the United States and other countries, prior to filing the European Union application for the figurative trademark OPNSENSE, which was filed on the same day on which the disputed domain name was registered; ii) it registered the OPNSENSE mark, in the United States or other countries, prior to the registration of the disputed domain name; iii) the OPNSENSE figurative trademark shown above has been used by the Respondent; iv) the Complainant's figurative trademark OPNSENSE is identical or confusingly similar to the disputed domain name as used in context of the website associated with the disputed domain name; and v) it has any other prior rights in OPNSENSE that accrued before the registration of the disputed domain name.

The Respondent claims that, prior to notification of the Complaint, it used the disputed domain name in connection with a parody website, which was critical of the Complainant's goods and services. The Respondent asserts that such use constitutes legitimate noncommercial or fair use because no reasonable consumer would ever think or believe that the scenes taken from the much-parodied "Downfall" film was posted by Complainant in order to comment on its own company or products. In addition, the Respondent claims that it had no intent of commercial gain by setting up the parody site under the disputed domain name, as the site sold no competitive products, carried no advertising, and generated no revenue.

With reference to the bad faith requirement, the Respondent states that the Complainant has not provided any evidence that the Respondent registered the disputed domain name in order to i) sell or transfer it to the Complainant, ii) prevent the Complainant from using the disputed domain name or that the Respondent has engaged in a pattern of such behavior, iii) disrupt the Complainant's business, or iv) attract users for commercial gain.

As to the bad faith registration, the Respondent states that the disputed domain name was registered prior to any notification of a dispute, and prior to the acquisition of any alleged trademark rights by the Complainant. The Respondent also highlights that the Complainant has not established any prior use of the trademark OPNSENSE in the United States.

With regard to the Respondent's use of the disputed domain name, the Respondent points out that the disputed domain name was used for a parody site, in which the much-parodied "Downfall" film plays the most prominent role. It also states that Internet users will understand that the disputed domain name is being used to parody and criticize the Complainant and that it fully intends to improve and refine the parody used in connection with the disputed domain name, and to put that site back up as soon as possible. The Respondent further submits that, as a result, use of the disputed domain name in this manner is not likely to confuse consumers as to the source, sponsorship, affiliation or endorsement of the website.

The Respondent also claims that, in general, it is beyond the scope of domain disputes to consider the issue of the boundaries of free speech and the manner and extent to which a trademark may be used fairly and without infringement.

C. Supplemental filings

Before entering into the merits of the case, the Panel addresses the issue of the unsolicited supplemental filings submitted by the Parties to the Center.

No provision concerning supplemental filings are 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"), 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, along these lines, *Welcomemat Services, Inc. v. Michael Plummer Jr., MLP Enterprises Inc.*, [WIPO Case No. D2017-0481](#).

In the case at hand, the Panel notes that the Complainant's Supplemental Filing offers rebuttal to the Respondent's arguments that the Complainant did not register or use its trademark OPNSENSE in the United States, that the Respondent did not use the Complainant's figurative trademark on its website and that the Complainant did not use the trademark OPNSENSE before the filing of the Complaint.

The Panel notes that none of the Respondent's arguments in the Response was unforeseeable and finds that the Complainant's supplemental submissions is not grounded on evidence that was not available to the Complainant when the Complaint was filed. The Panel has also reviewed the Respondent's Supplemental Filing and notes that it mostly reiterates the Respondent's alleged use of the disputed domain name for a parody website and the asserted lack of prior use of the trademark OPNSENSE by the Complainant and therefore it would not be necessary to take into consideration these supplemental submissions made by the Parties.

However, in contesting the Complainant's supplemental submissions made by the Complainant to substantiate the asserted use of the trademark before the registration date of the disputed domain name, the Respondent introduces new elements which, in the Panel's view, are relevant for the assessment of the Respondent's position in this case and will thus be taken into consideration.

Indeed, in its Supplemental Filing, the Respondent states that a document submitted by the Complainant in its Supplemental Filing (as Annex 17) does not demonstrate the Complainant's use of the trademark OPNSENSE but provides, instead, evidence of use of a trademark PFSENSE in which the Respondent has rights. The Respondent also informs the Panel that it is the manager of Electric Sheep Fencing LLC, a United States company which owns the United States trademark registration No. 3571276 for the trademark PFSENSE, registered on February 10, 2009 claiming first use as of February 19, 2005, for services in International class 42 relating to technical support services, maintenance and development of computer software; and of the International trademark registration No. 1176766 for the trademark PFSENSE, registered on August 28, 2013, for goods in class 9, including computer security software. The Respondent also states that its company Electric Sheep Fencing LLC has rights in a book referenced on the document submitted by the Complainant entitled "pfsense.org The Definitive Guide to the Open Source Firewall and Router Distribution".

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "A Panel shall decide a 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". Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

A. Identical or Confusingly Similar

The Complainant has provided evidence of ownership of a European Union trademark registration for the figurative mark OPNSENSE, which was filed on the same day the disputed domain name was registered. In addition, the Complainant also relies on a European Union trademark registration for the word mark OPNSENSE filed after the registration date of the disputed domain name.

As recognized in prior UDRP decisions and in [section 1.1.2](#) of the [WIPO Overview 3.0](#), the jurisdiction where a trademark has been granted and the filing or registration date are not considered relevant to the first element test, although they may bear on the Panel's determination under the second and third elements.

The Panel notes that the disputed domain name reproduces the Complainant's word trademark OPNSENSE, with the mere addition of the generic Top-Level Domain ("gTLD") suffix ".com", which may be disregarded being a mere technical requirement for registration. Therefore, the Panel finds that the disputed domain name is identical to the Complainant's word trademark OPNSENSE.

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is identical to trademarks in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant is required to make a *prima facie* case that the Respondent lacks rights or legitimate interests and, once such *prima facie* case is made, the burden of production shifts to the Respondent to submit appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy or on any other basis, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See, *Banco Itau S.A. v. Laercio Teixeira*, [WIPO Case No. D2007-0912](#); *Wal-Mart Stores, Inc. v. WalMart Careers, Inc.*, [WIPO Case No. D2012-0285](#).

The Panel finds that the Complainant has made a *prima facie* case and that the Respondent has failed to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy for the following reasons.

According to the records, there is no evidence of an authorization granted by the Complainant to the Respondent to use the trademark OPNSENSE and/or to register and use of the disputed domain name.

Moreover, there is no element from which the Panel could infer a Respondent's right over the disputed domain name, or that the Respondent, whose name disclosed in the Registrar's Whols records for the disputed domain name is "Rubicon Communications dba Netgate", might be commonly known by the disputed domain name.

Furthermore, the disputed domain name has not been used in connection with a *bona fide* offering of goods or services.

The Complainant states that the Respondent pointed the disputed domain name to a website displaying content certainly apt to discredit the Complainant and its products. The Respondent invokes the fair use defence, indicating that the disputed domain name has been used for a parody website.

As described in [section 2.5.3](#) of the [WIPO Overview 3.0](#), in order to demonstrate a legitimate fair use, the consensus of UDRP panels is that the Respondent's use of the disputed domain name must not be misleading as to its source or sponsorship, and must not be a pretext for tarnishment or commercial gain. Moreover, as described in [section 2.6.2](#) of the [WIPO Overview 3.0](#), "Panels find that even a general right to legitimate criticism does not necessarily extend to

registering or using a domain name identical to a trademark” and that, “even where such a domain name is used in relation to genuine noncommercial free speech, panels tend to find that this creates an impermissible risk of user confusion through impersonation”.

The Panel finds that, in light of the identity of the disputed domain name to the Complainant’s trademark OPNSENSE, there is a high risk of user confusion, as Internet users looking for the Complainant’s OPNSENSE products may (wrongly) believe that the website published at the disputed domain name be operated by, or with the consent of, the Complainant.

Moreover, the Panel finds that the risk of confusion is not diminished by the various uses made on the Respondent’s website, documented by the screenshots submitted as annexes to the Complaint and the Response. Indeed, the Respondent published the trademark OPNSENSE and images representing Internet networks, thus generating a likelihood of confusion with the Complainant’s products. In addition, the Panel disagrees with the Respondent’s statement that the video showing scenes taken from the historical war drama film “Downfall” enjoyed a prominent position, since it appears that the video could be seen only after having scrolled down the website. It is also relevant to note that the Respondent failed to provide any disclaimer as to the lack of affiliation with the Complainant and published links to the Complainant’s website under the “support” section of the website at the disputed domain name.

Furthermore, based on the elements before the Panel, the Respondent appears to be a competitor of the Complainant, since the Respondent expressly stated to be a manager of a company which owns trademarks and copyrights on a firewall and other security software and the Respondent’s name is mentioned in the copyright line of the website “www.pfsense.org” – to which the Respondent made reference in its Supplemental Filing –, promoting open-source network security solutions.

The circumstances of the case suggest that the Respondent used the disputed domain name to discredit the Complainant’s competing products and, as such, disrupt the Complainant’s business and derive an indirect illegitimate commercial advantage. Therefore, the Panel finds that the Respondent did not make a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers looking for the Complainant’s products.

In view of the above, the Panel finds that the Complainant has proven the Respondent’s lack of rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

As mentioned above, the Complainant relied on its trademark registrations for OPNSENSE, the first of which was filed in European Union on the registration date of the disputed domain name.

Although, based on the documents attached to the Complaint, the Complainant did not provide a great deal of evidence of unregistered trademark rights before the registration date of the disputed domain name, the Panel finds that the Respondent's registration of the disputed domain name cannot be ascribed to a mere coincidence.

Indeed, also in light of the fact that the Respondent has not denied knowledge of the Complainant's trademark at the time of the registration of the disputed domain name, that the Complainant's mark is a coined term and that the Respondent made reference to the Complainant's OPNSENSE products on the website to which the disputed domain name resolves, the Panel finds that the Respondent obviously registered the disputed domain name with the Complainant's trademark in mind.

As to the use of the disputed domain name, the Panel notes that, based on the records, the Respondent, although a competitor of the Complainant and thus a commercial actor, does not advertise or offer for sale any products or services on the website at the disputed domain name and no sponsored links or banners are published therein.

Noting the above, the Panel does not find that the Respondent has been using the disputed domain name in good faith for genuine parody purposes, since the Respondent is involved in a business which directly competes with the Complainant and, by holding a domain name identical to the Complainant's trademark and using it to provide its critical views on the Complainant's products, is disrupting the Complainant's business according to paragraph 4(b)(iii) of the Policy.

The Panel shares the views expressed in *Mission KwaSizabantu v. Benjamin Rost*, [WIPO Case No. D2000-0279](#), in which the panel stated: "it is plain that the intent and indeed the effect of the website is to publish to a reader highly negative views which inevitably have a propensity to undermine any prior favourable views that the visitor to the website might have previously had. Plainly the Respondent in registering the domain names and establishing his website has used the best vehicle known to him of securing publicity for the website information on the Internet and has done so in a manner which inevitably brings visitors to the website who had an intention to find out authorised information about the Complainant's activities [...]. The Panel holds that bad faith in terms of paragraph 4(a) (iii) is established, it being no answer that the content of the website is offered in good faith. This determination is reinforced by the facts that visitors to the website are exposed to the Respondent's views and his continued ownership and use of the domain names is a barrier to the visitor finding out the information and views of the Complainant which is denied the opportunity to have a domain name in the most popular Registry where persons can be most expected to go at first instance to try and find a relevant website".

See also, *Gasparucci Factory Societa Reponsibilita Limitata / Gasparucci Contract Company Societa Reponsibilita Limitata v. Viktor N Ratiani*, [WIPO Case No. D2013-1651](#): "by using the disputed domain name to provide negative information about the Complainants on the website to which resolves the disputed domain name, the Respondent tried to affect commercial benefit of the Complainants."

In view of the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith according to paragraph 4(a)(iii) 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 <opnsense.com> be transferred to the Complainant.

Luca Barbero

Sole Panelist

Date: November 12, 2017

