

NATIONAL ARBITRATION FORUM

DECISION

BOSTEX, PLC v. Tal Dehtiar

Claim Number: FA1308001516781

PARTIES

Complainant is **BOSTEX, PLC** (“Complainant”), represented by **Alex P. Garens of Grossman, Tucker, Perreault & Pflieger PLLC**, New Hampshire, USA. Respondent is **Tal Dehtiar** (“Respondent”), represented by **Michelle L. Wassenaar of Method Law Professional Corporation**, Canada.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<solerebels.com>**, registered with **GoDaddy.com, LLC**.

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 H. Bernstein as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum (the "Forum") electronically on August 27, 2013; the National Arbitration Forum received payment on August 27, 2013.

On August 28, 2013, GoDaddy.com, LLC confirmed by e-mail to the National Arbitration Forum that the <solerebels.com> domain name is registered with GoDaddy.com, LLC and that Respondent is the current registrant of the name. GoDaddy.com, LLC has verified that Respondent is bound by the GoDaddy.com, LLC 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").

By letter on August 29, 2013, the Forum notified Complainant of a deficiency identified in the Complaint. On the same date, Complainant filed an Amended Complaint correcting the deficiency.

On August 29, 2013, the Forum served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of September 18, 2013 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@solerebels.com. Also on August 29, 2013, 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 September 18, 2013.

Complainant submitted an Additional Submission, which was deemed compliant with the Forum's Supplemental Rules on September 19, 2013 (the ultimate acceptance of which is within the Panel's discretion).

Respondent submitted an Additional Submission, which was deemed compliant with the Forum's Supplemental Rules on September 20, 2013 (the ultimate acceptance of which is within the Panel's discretion).

On September 25, 2013, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed David H. Bernstein as Panelist.

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

RELIEF SOUGHT

Complainant requests that the domain name <solerebels.com> (the "Domain Name") be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

Complainant states that it operates a business in the footwear market. Complainant claims that it owns a US federal trademark registration for SOLE

REBELS (Reg. No. 3,760,329; filed June 5, 2009; claimed first use as of at least December 2005; registered March 16, 2010) and has used its SOLE REBELS trademarks for over eight years in connection with its business. It alleges that it operates an online retail store at <solerebelsfootwear.co>.

Complainant asserts that the Domain Name is essentially identical to Complainant's SOLE REBELS trademark. Complainant states that, because of this similarity, the Domain Name is likely to be confused with its SOLE REBELS mark or to create confusion as to endorsement by or affiliation with Complainant. Complainant claims that, on August 21, 2013 or earlier, it discovered that Internet users who entered the Domain Name in their browsers were automatically redirected to the website <oliberte.com>. According to Complainant, that website promotes goods sold by Oliberté, a competitor of Complainant in the African-made footwear market. Complainant further asserts that Respondent is Oliberté's co-founder as well as the registrant and administrative contact of the <oliberte.com> domain name. Complainant alleges that, beginning on August 27, 2013, after Complainant raised its objections to Respondent's registration of the Domain Name, the website to which the Domain Name resolved displayed a GoDaddy parked page. Complainant asserts that, by using the Domain Name to resolve to Respondent's website and later to a parked page, users intending to reach Complainant's website or who otherwise attempt to access the website associated with the Domain Name will be confused into believing that they have reached a website affiliated with or endorsed by Complainant.

Complainant claims that Respondent has no rights or legitimate interests in the Domain Name because Respondent has no rights in the SOLE REBELS trademark and has never been known by the phrase "Sole Rebels." Complainant asserts that Respondent's alleged uses of the Domain Name—first to resolve to the website at the <oliberte.com> domain name, and later to resolve to a parked page—do not constitute a *bona fide* offering of goods and services pursuant to

Policy 4(c)(i). Complainant further suggests, without elaboration, that Respondent is not making a legitimate noncommercial or fair use of the Domain Name pursuant to Policy 4(c)(iii).

Complainant claims that Respondent has registered and used the Domain Name in bad faith by: (i) purchasing and using the Domain Name with actual knowledge that the Domain Name consists of Complainant's SOLE REBELS trademark in an effort to harm Complainant and divert internet users and would-be customers from Complainant to Respondent; (ii) obtaining a domain name confusingly similar to the trademark of a known competitor; (iii) making the Domain Name resolve to a parked page after becoming aware that Complainant would bring an action against Respondent; (iv) preventing Complainant from reflecting its own presence online by purchasing a domain whose name consists of the SOLE REBELS trademark; (v) offering to sell the Domain Name to Complainant at a price that, according to Complainant, would presumably be exorbitant; (vi) registering the Domain Name through a proxy service, DomainsByProxy, through which Respondent initially hid his ownership of the domain name; and (vii) harming Complainant's business and reputation, and diluting the distinctiveness of Complainant's trademark, by causing actual confusion among several of Complainant's customers who allegedly were redirected to the website at the <oliberte.com> domain name after attempting to access the website associated with the Domain Name.

B. Respondent

Respondent alleges that he is the owner of Oliberté Limited, a shoe company. He states that he owns a number of domain names containing interesting words and phrases and that he uses such domain names to direct traffic to Oliberté Limited's website, at <oliberte.com>. Respondent provided a list of twenty of the more than fifty domain names that he alleges he has purchased and asserts that

he uses such domain names in connection with a *bona fide* offering of goods because he links them to the www.oliberte.com website. Respondent claims that he purchased the Domain Name on June 22, 2013.

Respondent states that he was not aware of Complainant's trademark registration until Respondent received the Complaint (although Respondent does not expressly admit or deny whether he was aware of Complainant's use of the SOLE REBELS mark). Respondent claims that, after receiving the Complaint, he offered to transfer the Domain Name to Complainant in exchange for his out-of-pocket costs in acquiring the Domain Name, which amount to \$500.00 plus various charges from GoDaddy.com. Respondent asserts that he did not acquire the Domain Name in order to sell or otherwise transfer it to Complainant. Respondent also denies registering the Domain Name for the purpose of preventing Complainant from reflecting its SOLE REBELS mark or disrupting Complainant's business, asserting that the Domain Name has existed since at least 2007 and yet, based on the allegations in the Complaint, Complainant did not seek ownership of the Domain Name until recently. Respondent does not expressly admit or deny Complainant's allegation that Respondent used the Domain Name to direct internet traffic to his website at <oliberte.com>.

C. Additional Submissions

Complainant submitted an additional submission responding to a number of the statements in the Response. In accepting Complainant's additional submission in part, the Panel notes that it will give consideration only to the allegations made in Paragraphs 5 through 7 (and the exhibits cited therein) of Complainant's additional submission, as those paragraphs respond to arguments that Complainant could not have reasonably anticipated, namely, that Respondent was not aware of Complainant's US trademark registration, Respondent's claim that he offered to sell the Domain Name to Complainant after receiving the

Complaint, and Respondent's allegations regarding the manner in which he acquired the Domain Name. Complainant asserts that Respondent's offer to sell the Domain Name at cost and willingness to cooperate came only after Respondent received the Complaint and therefore do not diminish Respondent's bad faith or cure the alleged violations of the Policy. Complainant claims that Respondent has misrepresented how Respondent acquired the Domain Name because Complainant disputes Respondent's claim that Respondent purchased the Domain Name at a public auction. Finally, Complainant claims that Respondent must have known of the SOLE REBELS trademark because both Complainant and Respondent offer shoes and footwear designed and manufactured in Africa, making Complainant and Respondent close competitors. Further, Complainant provides a series of e-mail correspondences from 2009 that appear to be between Respondent and persons whom Complainant identifies as the co-founders of the SoleRebels company to prove that Respondent was in fact aware of the SOLE REBELS trademark.

Respondent also submitted an additional submission to reply to Complainant's supplemental submission. With the exception of Paragraph 4 of Respondent's additional submission, in which Respondent denies the claim Complainant makes in Complainant's additional submission that Respondent used an alias when previously corresponding with Complainant, Respondent's additional submission merely elaborates on arguments that Respondent previously made in his Response. Accordingly, in accepting Respondent's additional submission in part, the Panel will give consideration only to the allegations made in Paragraph 4.

FINDINGS

After reviewing Complainant's and Respondent's submissions, the Panel finds the following:

- (1) The Domain Name is identical to a mark in which Complainant has rights;
- (2) Respondent has no rights or legitimate interests with respect to the Domain Name; and
- (3) Respondent registered and used the Domain Name in bad faith.

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

Complainant applied to register the SOLE REBELS trademark with the US Patent and Trademark Office (“USPTO”) on June 5, 2009, claiming first use as of at least December 2005, and the trademark was registered on March 16, 2010. Complainant’s ownership of this registration establishes its *prima facie* rights in the SOLE REBELS mark. Respondent does not dispute that Complainant has rights in the SOLE REBELS mark, nor does he dispute the date of Complainant’s purported first use of the mark, but asserts only that Respondent was unaware that Complainant had registered the mark with the USPTO. Accordingly, Complainant’s federal trademark registration is sufficient to satisfy Policy 4(a)(i). *See Metro. Life Ins. Co. v. Bonds*, FA 873143 (Nat. Arb. Forum Feb. 16, 2007) (finding that the registration of a mark with the USPTO satisfied Policy 4(a)(i)); *AOL LLC v. Interrante*, FA 681239 (Nat. Arb. Forum May 23, 2006) (same).

The Domain Name <solerebels.com> wholly incorporates Complainant’s SOLE REBELS mark. The Domain Name and Complainant’s SOLE REBELS mark are identical for purposes of the Policy because the generic top-level domain (“gTLD”) (here, “.com”), and the elimination of spaces, may be disregarded for purposes of evaluating identity under the Policy. *See Bond & Co. Jewelers, Inc. v. Tex. Int’l Prop. Assocs.*, FA 937650 (Nat. Arb. Forum Apr. 30, 2007) (elimination of the letter “s,” removal of a space, and addition of a gTLD in domain name <bonddiamond.com> did not establish distinctiveness from the BOND DIAMONDS mark); *Hannover Ruckversicherungs-Aktiengesellschaft v. Ryu*, FA 102724 (Nat. Arb. Forum Jan. 7, 2001) (“The disputed domain name <hannoverre.com> is identical to Complainant’s HANNOVER RE mark, as spaces are impermissible in domain names and a generic top-level domain such as ‘.com’ or ‘.net’ is required in domain names.”); *Wembley Nat’l Stadium Ltd. V. Thomson*, D2000-1233 (WIPO Nov. 16, 2000) (holding that <webleystadium.net> was identical to the mark WEMBLEY STADIUM).

For these reasons, the Complainant has satisfied the first factor of the Policy.

Rights or Legitimate Interests

Because Policy 4(a)(ii) requires Complainant to prove a negative based on knowledge that may uniquely be within the Respondent's control, Complainant may try to satisfy the second factor of the Policy by making a *prima facie* showing that Respondent lacks rights or legitimate interests in the disputed domain name. *AOL LLC v. Gerberg*, FA 780200 (Nat. Arb. Forum Sept. 25, 2006); *Hanna-Barbera Prods., Inc. v. Entm't Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006). Once Complainant makes such a showing, the burden of production shifts to Respondent to come forward with evidence sufficient to show that it does have rights or legitimate interests (though the burden of proof always remains on Complainant). *Document Techs., Inc. v. Int'l Elec. Commc'ns Inc.*, D2000-0270 (WIPO June 6, 2000).

Here, Complainant has made the requisite *prima facie* showing and Respondent has failed to come forward with evidence sufficient to rebut Complainant's showing.

Policy 4(c) provides that a respondent may demonstrate its rights or legitimate interests to a domain name by proving one or more of the following:

“(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

“(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.”

The record contains a number of undisputed facts establishing that Respondent neither used the Domain Name in connection with a *bona fide* offering of goods and services nor made a legitimate noncommercial or fair use of the domain name without intent for commercial gain to misleadingly divert customers. Respondent does not dispute Complainant’s assertions that Respondent has no rights in the SOLE REBELS mark and has not secured permission from Complainant to use the mark. Despite having no right to the SOLE REBELS mark, Respondent acknowledges having purchased the Domain Name on June 22, 2013.

Complainant claims that, at least as early as August 21, 2013, the Domain Name was set to automatically redirect internet visitors to Respondent’s competing website at <oliberte.com>. In response, the Respondent states that “[i]n light of the Complaint . . . the Respondent is not using the domain name in connection with his shoe company” and that he never created a “likelihood of confusion with the Complainant’s mark as to the source of Respondent’s website” because the website <oliberte.com> is “very distinctive and also very different from” Complainant’s website, <solerebelsfootwear.co>. Tellingly, though, Respondent never challenges Complainant’s assertion that Respondent used the Domain Name to direct internet users to the <oliberte.com> website. Furthermore, Respondent concedes that he is the owner of Oliberté Limited and that he “owns a number of domain names that include interesting words or phrases and are used to direct traffic to his shoe company at oliberte.com.” Accordingly, the Panel finds that the Respondent did, for a time, use the Domain Name to direct Internet users to <oliberte.com>. The Panel further finds that use of the Domain Name to

redirect internet users to his competitive website is neither a *bona fide* offering of goods nor a legitimate noncommercial or fair use. See *Jerry Damson, Inc. v. Texas Int'l Prop. Assocs.*, FA 916991 (Nat. Arb. Forum Apr. 10, 2007) (finding that the respondent failed to establish rights under Policy 4(c)(i) and 4(c)(iii) where it used the disputed domain name as a portal displaying hyperlinks to other websites and advertisements, including websites for potential competitors of the complainant); *Ultimate Elecs., Inc. v. Nichols*, FA 195683 (Nat. Arb. Forum Oct. 27, 2003) (the respondent's "use of the domain name (and Complainant's mark) to sell products in competition with Complainant demonstrates neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the name").

It is true that the Domain Name now resolves to a GoDaddy parked page (with no pay per click advertising), but that change was made on or about August 27, 2013, after Complainant had already objected to Respondent's registration of the Domain Name. Any efforts by Respondent to discontinue his illegitimate prior use after being notified of the dispute cannot serve to cure Respondent's earlier misconduct, nor can such post-notice actions be relied upon as establishing rights or legitimate interests because, under Policy 4(c)(i), a legitimate use can only be shown based on conduct undertaken before "notice to [a respondent] of the dispute." Further, regardless of when Respondent began using the Domain Name to direct internet users to a parked page, such use on its own does not constitute a *bona fide* offering of goods nor a legitimate noncommercial or fair use. See *Augur Sys., Inc. v. Direct Privacy ID 461B3, Domain Name Proxy Service, Inc.*, FA 1469641 (Nat. Arb. Forum Jan. 14, 2013) (finding that Policy ¶¶ 4(c)(i) and 4(c)(iii) were not met where respondent used a domain name to resolve to a nonfunctional webpage); *Hewlett-Packard Co. v. Shemesh*, FA 434145 (Nat. Arb. Forum Apr. 20, 2005) ("the passive holding of a domain name that is identical to Complainant's mark is not a *bona fide* offering of goods or services pursuant to Policy 4(c)(i) and it is not a legitimate noncommercial or fair

use of the domain name pursuant to Policy 4(c)(iii)"); *Ziegenfelder Co. v. VMH Enters., Inc.*, D2000-0039 (WIPO Mar. 14, 2000) (respondent had no rights or legitimate interest in the disputed domain name because it did not use the domain name to offer any product or service).

In an apparent alternative argument, Respondent attempts to argue that he has a legitimate interest in the Domain Name because it "includes the word 'sole' which is a part of a shoe and thus related to Respondent's business." There is no legitimate right to use the trademark of another in a competitive way merely because the mark includes a word that is related to the parties' goods and services unless the only aspects of the mark that are used by the Respondent are generic or merely descriptive, which is not the case here.

For all these reasons, the Panel finds that Complainant has shown by a preponderance of the evidence that Respondent does not have rights or legitimate interests in the Domain Name.

Registration and Use in Bad Faith

Paragraph 4(b) of the Policy lists four circumstances that, if proven by a complainant, shall be evidence of a respondent's registration and use of a domain name in bad faith:

"(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 documents 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.”

Respondent states that he was not aware of Complainant’s registration of the SOLE REBELS mark with the USPTO. He does not, however, allege that he was unaware that Complainant had used the mark in connection with Complainant’s business in the retail industry (nor could he credibly do so in light of the emails that Complainant submitted showing that Respondent was aware of the Sole Rebels name in 2009). Respondent also does not challenge Complainant’s claim that both Complainant and Respondent are competitors who sell footwear designed and manufactured in Africa. Accordingly, the Panel finds that, at the time that Respondent acquired the Domain Name, he was aware that the Domain Name consisted of a trademark used by his competitor in connection with the sale of competitive products.

The registration of this Domain Name, which Respondent knew was a competitor’s mark, along with his use of the Domain Name to automatically redirect internet users to his own competitive website, is paradigmatic abusive cybersquatting under Policy 4(b)(iii) and 4(b)(iv). *See Save on Energy, LLC v. Crono*, FA 1496896 (Nat. Arb. Forum June 17, 2013) (finding bad faith use and

registration under Policy 4(b)(iv) where Respondent registered a confusingly similar domain name in order to direct Internet users to the services of Complainant's competitor); *H-D Mich. Inc. v. Buell*, FA 1106640 (Nat. Arb. Forum Jan. 2, 2008) ("The disputed domain names resolve to websites that list links to competitors of Complainant, evidence that Respondent intends to disrupt Complainant's business, a further indication of bad faith pursuant to Policy 4(b)(iii)."); *Radio & Records, Inc. v. Nat'l Voiceover*, FA 665235 (Nat. Arb. Forum May 9, 2006) (inferring that Respondent knew of Complainant's rights in the mark and finding bad faith under Policy 4(b)(iv) where Respondent used a domain name confusingly similar to that mark to redirect traffic to Respondent's own website); *Luck's Music Library v. Stellar Artist Mgmt.*, FA 95650 (Nat. Arb. Forum Oct. 30, 2000) (finding bad faith where Respondent linked the disputed domain names, which were identical and confusingly similar to Complainant's mark, to a website affiliated with Respondent's own services).

For the reasons stated above, the Panel finds that Policy 4(a)(iii) is satisfied.

Complainant has raised various other grounds for why the Panel should find that Respondent registered and used the Domain Name in bad faith. Respondent disputes the facts underlying some of these claims: he disputes the Complainant's characterization of the manner in which he acquired the Domain Name and his alleged intention to sell Complainant the Domain Name for an exorbitant price. The Complainant's allegations in these areas are less compelling, but because the Panel finds that Respondent's conduct in its registration and operation of the Domain Name constitutes bad faith for the reasons described, it need not make detailed findings in these other areas.

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <solerebels.com> domain name be **TRANSFERRED** from Respondent to Complainant.

David H. Bernstein, Panelist

Dated: October 8, 2013