

## **ADMINISTRATIVE PANEL DECISION**

Ryan P. Boggs v. Name Administration Inc. (BVI)

Case No. D2013-0583

### **1. The Parties**

The Complainant is Ryan P. Boggs of Los Angeles, California, United States of America, represented by Molly Megee Hankins, ESQ., United States of America.

The Respondent is Name Administration Inc. (BVI) of Grand Cayman, Cayman Islands, Overseas Territory of the United Kingdom of Great Britain and Northern Ireland, represented by John Berryhill, Ph.D., Esq., United States of America.

### **2. The Domain Name and Registrar**

The disputed domain name <digilove.com> is registered with iRegistry Corp. (fka) Domain Name Sales Corp. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 29, 2013. On April 2, 2013, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 2, 2013, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced April 5, 2013. In accordance with the Rules, paragraph 5(a), the due date for Response was April 25, 2013. The Response was filed with the Center April 25, 2013.

The Center appointed Joan Clark, Dan Hunter and Andrew F. Christie as panelists in this matter on May 16, 2013. The Panel finds that it was properly constituted. Each member of 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 has a United States registration issued February 28, 2012 for the trademark/service mark DIGILOVE claiming first use in commerce on August 20, 2010.

The Respondent is the registrant of the disputed domain name <digilove.com> registered with the Registrar with a creation date of July 29, 2003, updated on January 31, 2013 and scheduled to expire on July 29, 2016.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant asserts that the disputed domain name is identical to his trademark/service mark which has been used in on-line retail store services featuring men's and women's clothing since August 20, 2010.

The Complainant states that the Respondent has been "squatting" on <digilove.com> since July of 2003 and that it provides no goods or services in connection with the disputed domain name.

Further the Complainant asserts that the disputed domain name was registered and has been used in bad faith, claiming that the Respondent's failure to use <digilove.com> commercially or non-commercially is evidence of cyber-squatting with intent to resell. The Complainant also states that the Respondent would not sell the disputed domain name for less than USD 16,000, an amount far in excess of the Respondent's out of pocket costs, indicating the Respondent's bad faith.

##### **B. Respondent**

The Respondent contrasts the Complainant's first use of his mark in 2010 with the registration of the disputed domain name in 2003 followed by its use for online dating purposes for ten years. The current proceeding, declares the Respondent, is not a good faith use of the Policy, but is simple harassment as the Policy does not provide retroactive trademark rights.

The Respondent concedes that the Complainant is in possession of a federal trademark registration to which the disputed domain name is identical or confusingly similar, which satisfies the first criterion of the Policy, but notes that the priority of the Respondent's domain name registration bears an admission of the Respondent's senior status.

The Respondent asserts it has rights in and was the original registrant of the disputed domain name which is composed of the common prefix "digi" and the word "love" and has been used since its registration in 2003 for a commercial service. The Respondent states "As the domain name is immediately suggestive of online services in relation to romance, the Respondent has used the domain name for nearly ten years to provide paid advertising links relating to online dating and personal advertising services."

As to "bad faith", the Respondent states that this criterion is an element of intent directed toward a complainant, arising from rights known by a respondent at the time a domain name is registered. The Respondent declares the suggestion that it registered the disputed domain name in 2003 for the "primary purpose" of selling it to the Complainant, on the basis of a then non-existing claim of rights, "is an insult to the intelligence of any marginally thinking person". The Respondent relates that in 2010 it was approached by one Molly Hankins stating she had started a business called Digi10ve ("spelled with the 1 and 0 numerals") and enquiring as to what the Respondent wanted for the disputed domain name. A further

enquiry was received by the Respondent, this time from the Complainant, stating he was willing to buy the disputed domain name "at a reasonable marked up price". The Respondent states that an offer of USD 16,000 was subsequently received from the Complainant and accepted by the Respondent, but later withdrawn by the Complainant explaining that the offer had been made to see what the Respondent would accept. The Complainant's last offer as submitted to the Panel was of USD 1,000. The Respondent asserts that none of the above offers, from the Complainant or one Molly Hankins who is also the Complainant's representative in this proceeding, makes reference to a claim of right to the disputed domain name, and cannot be considered probative evidence of bad faith intent of the Respondent when the disputed domain name was registered in 2003.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy states that, in order to be successful with respect to a disputed domain name, the Complainant has the burden of providing that all three elements are present in the Complaint, namely:

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

Paragraph 4(b) of the Policy sets out four illustrative circumstances which, for the purpose of paragraph 4(a)(iii) above, shall be evidence of registration and use of a domain name in bad faith but are not limitative.

Paragraph 4(c) of the Policy sets out three illustrative circumstances each of which, if proven, shall demonstrate the Respondent's rights or legitimate interests in the disputed domain name for purposes of paragraph 4(a)(ii) above.

### **A. Identical or Confusingly Similar**

The Panel finds the disputed domain name, <digilove.com>, to be identical to the trademark DIGILOVE of the Complainant which the Complainant declares was first used in 2010. The Respondent has supplied the information, missing from the Complaint, that the registration of the Complainant's trademark issued on February 28, 2012. That the Complainant's trademark was first used and was registered after the registration of the disputed domain name is irrelevant for a determination of the issue under paragraph 4(a)(i) of the Policy, as priority of registration of the trademark is not a requirement for establishing the first element of this paragraph. The presence of the suffix ".com" in the disputed domain name is immaterial to the issue of identity or confusing similarity.

Accordingly, the Panel finds that the first requirement for the Complaint to succeed has been satisfied.

### **B. Rights or Legitimate Interests**

The disputed domain name is composed of two generic words, the abbreviation "digi" and the word "love", which are suggestive of online services in relation to romance. The disputed domain name has been used by the Respondent for nearly ten years to provide paid advertising links relating to online dating and personal advertising services. It is clear from the links appearing on pages produced by the Respondent from its website, links such as "Photo Personals", "Christian Online Dating", "Compatibility and Dating Advice", that the disputed domain name has been used in connection with a purpose related to its generic or dictionary meaning. In the absence of any attempt to trade off third party rights (including, particular, the Complainant's trademark), or any knowledge of potential confusion with third party rights (including, particular, the Complainant's trademark), the registration and use of the disputed domain name to direct users to other

websites of interest, that is the offering of a service of information, was *bona fide*, and the Respondent has rights and legitimate interests in the disputed domain name.

The Panel finds that the second requirement for the Complaint to succeed has not been satisfied.

### **C. Registered and Used in Bad Faith**

There is no indication in any of the material before the Panel that the registration of the disputed domain name was in bad faith or that at any time its use has been in bad faith. Certainly the Respondent could not have been aware of the Complainant's trademark at the time the disputed domain name was registered and the Respondent acquired rights and legitimate interests therein, as found under paragraph 6.B above. Nor is there any evidence the Respondent was aware of any potential rights of the Complainant with which the disputed domain name might have become confusing.

The Complainant contends that the Respondent's failure, as alleged in the Complaint, to use the disputed domain name commercially, together with the Respondent's failure to sell the disputed domain name for less than USD 16,000, is "evidence of cyber-squatting with intent to resell" for an amount in excess of out-of-pocket expenses. The Complainant's assertions are unsupported by evidence. The Respondent provides evidence that refutes the assertion of no commercial use of the disputed domain name, and that shows the Complainant had engaged in duplicitous dealings with the Respondent in relation to potential purchase of the disputed domain name. Nothing in the evidentiary record before the Panel supports a finding that the Complainant has discharged his burden of establishing bad faith under paragraph 4(a)(iii) of the Policy.

The Panel finds that the third requirement for the Complaint to succeed has not been satisfied.

### **D. Abuse of Administrative Proceeding**

Paragraph 15(e) of the Rules 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 was brought primarily 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 Panel considers that the Complaint filed in this case was brought in bad faith and constitutes an abuse of the administrative proceeding. The Complaint is egregiously deficient. First, the Complaint is largely bare of substantive content. The entire pleading and particulars of the Complaint comprise a mere seven sentences. Secondly, the Complaint is almost entirely devoid of probative evidence in support of the assertions contained therein. The only substantive item of evidence filed by the Complainant is an online printout of its trademark registration. Thirdly, and consequently, the Complaint is grossly misleading. The Complaint fails to set out facts that are fundamental to the Complainant's case and of which the Complainant must have had knowledge, such as the Respondent's use of the disputed domain name and the Complainant's unsolicited communications with the Respondent regarding possible purchase of the disputed domain. By asserting that the Respondent "has made no attempt to make use of the mark (*sic*) commercially or non-commercially", the Complainant implies that the Respondent has been holding the disputed domain name for an empty website solely for resale, without addressing the fact that the website under the disputed domain name has been actively used to provide advertising links to other sites. By failing to state these facts, the Complaint makes express and implied assertions that are false. These false assertions might have misled the Panel had not the Respondent provided the evidence, readily available to the Complainant, that refutes these assertions. Furthermore, it is simply not fair to require the Respondent to provide evidence establishing that the Complainant's case is without basis when the Complainant must have, or at least should have, known this fact. The egregiousness of these deficiencies of the Complaint is compounded by the fact that the Complainant was represented by counsel.

Having regard to all the circumstances of the filing of this Complaint, the Panel is of the firm view that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding that is provided by the Policy.

## **7. Decision**

For the foregoing reasons, the Complaint is denied.

**Joan Clark**  
Presiding Panelist

**Dan Hunter**  
Panelist

**Andrew F. Christie**  
Panelist  
Date: June 4, 2013