

## **ADMINISTRATIVE PANEL DECISION**

Reboxed Limited v. Adesoji Adeyemi  
Case No. D2021-0886

### **1. The Parties**

The Complainant is Reboxed Limited, United Kingdom (“UK”), represented by Sheridans, UK.

The Respondent is Adesoji Adeyemi, UK, represented by John Berryhill, Ph.d., Esq., United States of America.

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

The disputed domain name <reboxed.com> is registered with Go Australia Domains, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 24, 2021. On March 24, 2021, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 25, 2021, 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 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 30, 2021. In accordance with the Rules, paragraph 5, the due date for Response was April 19, 2021. On April 13, 2021, the Respondent requested an additional time to file a response. Accordingly, the Respondent was granted an automatic four calendar day extension for response under paragraph 5(b) of the Rules. The due date for Response was extended to April 23, 2021. The Response was filed with the Center April 23, 2021.

On May 3, 2021, the Center received a supplemental filing from the Complainant in response to which the Respondent submitted its own supplemental filing on May 4, 2021. The Complainant sent another supplemental filing on May 5, 2021.

The Center appointed Steven A. Maier, Brian J. Winterfeldt and Tony Willoughby as panelists in this matter on May 26, 2021. 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 is a private limited company which was registered in England and Wales on July 4, 2019. It offers services including the purchase and sale of used mobile phones.

The Complainant is the owner of UK and European Union trademark registrations for the word mark REBOXED. The earliest of these registrations is UK trademark number 00003417898 for the word mark REBOXED, registered on May 22, 2020 (with an application date of July 31, 2019) in International Classes 9, 35, 36, 37, 39, 40 and 42.

According to the publicly available Whois information, the disputed domain name was first registered on November 9, 2010. The disputed domain name was registered to a registrant different to the Respondent on September 4, 2012. However, it was acquired around December 2012 by a party stated to be the Respondent's wife, with the registration details having been amended to name the Respondent as registrant by November 7, 2014.

The Respondent has offered the disputed domain name for sale.

Between May and November 2019, individuals who eventually formed the Complainant were in negotiations with the Respondent for the purchase of the disputed domain name. The negotiations were unsuccessful.

In November 2019, the Respondent filed notice of intention to oppose the Complainant's application for the UK trademark referred to above. The opposition did not proceed and the Respondent was ordered to pay the Complainant GBP 300 for costs on August 23, 2020.

In or about August 2020, the Respondent's website included the wording: "Reboxed is a consumer marketplace to Sell, Swap and Shop Used, Refurbished and PreOwned Consumer Items".

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

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

The Complainant submits that the disputed domain name is identical to its REBOXED trademark.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It states in particular that it has never licensed or authorized the Respondent to use its REBOXED trademark and that the Respondent is seeking to create confusion between the disputed domain name and the Complainant's trademark for its own commercial purposes.

The Complainant submits that the disputed domain name was registered and is being used in bad faith. It provides evidence of the Respondent's efforts to sell the disputed domain name and contends that "the disputed domain name was registered primarily for the purpose of selling the domain name to the owner of a trademark or service mark associated with the disputed domain name for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name".

The Complainant submits that, in the negotiations between the parties mentioned above, the Respondent attempted to sell the disputed domain name to the Complainant for various excessively high prices, ultimately GBP 29,150, or to force the Complainant into an unwanted business arrangement whereby the Respondent would take a percentage share in the Complainant's business.

The Complainant submits evidence that in August 2020 its own website at "www.reboxed.co" included the wording "Sell, swap or shop premium reboxed refurbished tech," which it contends was substantially copied by the Respondent's wording "Reboxed is a consumer marketplace to Sell, Swap and Shop Used, Refurbished and PreOwned Consumer Items" referred to above. The Complainant submits that this conduct evidences the Respondent's intention to attract Internet users to its website by causing confusion with the Complainant's trademark.

The Complainant further contends that the Respondent's opposition to its trademark application was unsubstantiated and further evidences the Respondent's bad faith. It states that the Respondent has never paid the costs of GBP 300 which were awarded in those proceedings.

## **B. Respondent**

The Respondent states that, while the Respondent or his wife registered the disputed domain name in 2012, the Complainant was not even formed until 2019. In these circumstances, the Respondent contends that the disputed domain name could not have been registered in bad faith and that any assertion that it was acquired for the purpose of sale to the Complainant is ridiculous.

The Respondent further points out that the Complainant's founders were in negotiations with the Respondent prior even to forming their company, failed to buy the disputed domain name and eventually chose a different domain name for their business. The Respondent states that the founders were evidently willing to pay thousands of pounds for the disputed domain name, but now seek to set the level at which they consider the Respondent's price to have been excessive for the purposes of the Policy.

The Respondent accepts that the disputed domain name is identical to the Complainant's REBOXED trademark, for which the Complainant applied long after the disputed domain name had been registered.

The Respondent submits that it has rights or legitimate interests in the disputed domain name by virtue of having registered a common word with a literal meaning, namely, a reference to items being replaced in a box. The Respondent contends that, in the context of merchandise, the term typically refers to refurbished or sample goods that have been repackaged. The Respondent states that, having legitimately acquired the disputed domain name with seniority to any potential claim by the Complainant, the Respondent is entitled to deal with the disputed domain name in any manner it sees fit.

Concerning bad faith, the Respondent contends that bad faith can only be found in the context of predatory targeting of the relevant trademark, which cannot occur when registration of the disputed domain name predates the establishment of the trademark at issue.

The Respondent cites the negotiations for the purchase of the disputed domain name as evidence that the Complainant was well aware of the Respondent's senior rights and that the Complainant has turned to the UDRP only after failing in that negotiation: what is popularly known as a "Plan B case".

The Respondent submits that the Complainant has misquoted the Policy in support of its claim, since section 4(b)(i) of the Policy requires that bad faith registration involves an intention to sell "to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant. The Respondent contends that the Complainant wrongly suggests it is bad faith publicly to offer a domain name for sale having legitimately acquired that domain name.

Concerning the costs order of GBP 300 in connection with the failed trademark opposition, the Respondent states that it sought instructions for the payment of that sum but did not receive them.

The Respondent submits in all the circumstances that the Complaint was brought in bad faith as contemplated by paragraph 15(e) of the Rules.

The Panel notes that, in addition to submissions of relevance to these proceedings as summarized above, the Response contains a series of attacks upon the character of the Complainant's representative in significantly derogatory terms. Whatever the perceived provocation, the Panel makes the general observation that the adoption of such language in submissions does nothing to enhance the relevant party's case.

### **C. Unsolicited Supplemental Filings**

The unsolicited supplemental filings received from both parties relate principally to the payment or otherwise of the costs award of GBP 300 referred to above, a matter to which the Panel accords no material significance in this case. Accordingly the Panel declines to admit the supplemental filings.

## **6. Discussion and Findings**

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are that:

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

The Complainant has established that it has registered trademark rights in the mark REBOXED. The disputed domain name is identical to that trademark, ignoring the generic Top-Level Domain ("gTLD") ".com" which may be disregarded for the purpose of comparison. It is also irrelevant to the threshold test under paragraph 4(a)(i) of the Policy (although potentially significant elsewhere) that the trademark was registered after the date of registration of the disputed domain name. The relevant inquiry examines whether the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights *at the time of the Complaint*: WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.1.3 (emphasis added). The Panel therefore finds that the disputed domain name is identical to a trademark in which the Complainant has rights.

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

In the light of its findings in respect of bad faith, below, it is unnecessary for the Panel to address the question of rights or legitimate interests in this case.

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

The requirement that the disputed domain name “has been registered and is being used” in bad faith is a conjunctive requirement, meaning that both of these elements must be proven by the Complainant. While attempts have historically been made to imply retroactive bad faith in certain cases, current UDRP jurisprudence is clear that no such approach is permissible and that the respondent must be shown to have known of, and to have targeted, the complainant’s trademark at the date of registration of the disputed domain name (see *e.g.* WIPO Overview 3.0, section 3.2.1).

While the disputed domain name in this case was registered by the Respondent no later than November 2014, the Complainant did not exist prior to July 2019, nor is there any evidence that it, or anyone connected with its formation, used or otherwise had any interest in the mark REBOXED prior to that date. In these circumstances, the Panel accepts the Respondent’s submission that it is impossible for the Respondent to have known of and to have targeted the Complainant’s trademark at the date of registration of the disputed domain name and, therefore, the Complaint must inevitably fail.

The Panel expressly rejects the Complainant’s inaccurate reliance on paragraph 4(b)(i) of the Policy, which requires an intention to sell the disputed domain name to the current trademark owner (or a competitor) and not, as the Complainant implies, to some (unknown and potentially as yet non-existent) party who may acquire an interest in a relevant trademark at some point in the future.

The Complainant has therefore failed to establish that the disputed domain name has been registered and is being used in bad faith.

### **7. Reverse Domain Name Hijacking**

As provided by paragraph 15(e) of the Rules: “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 Complainant in this case is legally represented and, in view particularly of that factor, the Panel considers that the Complainant knew or ought to have known that the Complaint had no reasonable prospect of success. The Panel agrees with the Respondent’s contention that this is a “Plan B case”, in which the Complainant, having failed to purchase the disputed domain name by means of a commercial negotiation, has turned to the UDRP in an improper attempt to deprive the Respondent of it.

The Panel notes the adoption of wording on the Respondent’s website in August 2020 which was similar to that used by the Complainant. While the Panel believes that action to have been provocative, it cannot of itself justify the bringing of proceedings which were doomed to failure under the terms of the Policy and relevant jurisprudence. Similar considerations apply to matters surrounding the Respondent’s opposition to the Complainant’s trademark application.

The Panel concludes therefore that the Complaint was brought in bad faith, in an attempt at Reverse Domain Name Hijacking.

### **8. Decision**

For the foregoing reasons, the Complaint is denied.

The Panel finds that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

*/Steven A. Maier/*  
**Steven A. Maier**  
Presiding Panelist

*/Brian J. Winterfeldt/*  
**Brian J. Winterfeldt**  
Panelist

*/Tony Willoughby/*  
**Tony Willoughby**  
Panelist  
Date: June 2, 2021