



CPR Institute for Dispute Resolution

COMPLAINANT B'Box Corporation
Address 537 Newport Center Drive
 Newport Beach, CA 92660
Telephone 949 515 3838
fax 949 515 3929
E-mail michel@bboxcorp.com

File Number: CPR0223
Date of Commencement: August 14, 2002

Domain Name: bbox.com

Registrar: Network Solutions

vs.

Arbitrator: David W. Plant

RESPONDENT Black Box Images
Address 3800 Linden Ave. N., Suite 9
 Seattle, WA 98103-8727
Telephone 206 547 9748
fax
E-mail blackbox@bbox.com

Before David W. Plant, Arbitrator

PROCEDURAL HISTORY

Complainant transmitted to CPR a "Demand For Arbitration", dated July 2, 2002. A completed "Domain Name Dispute [sic] Complaint Form CPR Dispute Institute For Dispute Resolution" accompanied the July 2 submission. Complainant transmitted to CPR a letter dated July 8, 2002, together with a folder of materials and a binder of materials. Respondent filed a Response dated September 3, 2002, together with accompanying exhibits. Counsel for Complainant submitted counsel's declaration dated September 6, 2002, together with exhibits. Also, counsel for Complainant submitted a declaration, dated September 10, 2002, of Complainant's owner and chief executive officer, together with exhibits. Other counsel for Complainant submitted a "Reply To Response To Complaint", dated September 10, 2002, together with exhibits. (CPR received another copy of the foregoing Reply, unsigned and dated September 11, 2002, plus an undated copy of the owner's declaration and another copy of counsel's declaration.) CPR received via email two documents each entitled "Petition To Consider Surreply To Complainant's Reply To Complaint", dated September 18, 2002. The second document appears to be the Surreply. On September 20, 2002, counsel for Complainant faxed to CPR various documents relating to trademark registrations and applications. Finally, CPR received "Complainant's Response To Surreply", dated September 21, 2002.

On August 13, 2002, CPR requested the usual verifications concerning the domain name from Network Solutions. On September 10, 2002, Network Solutions verified (a) the registrant, administrative contact, billing contact, and technical contact for the domain name, and (b) the "Active" status of the domain name. CPR designated August 13, 2002, as the date it received the complaint, and August 14, 2002, as the date of commencement of these proceedings.

On September 11, 2002, I was appointed Arbitrator pursuant to the Uniform Domain Name Dispute Resolution Policy ("UDRP") and Rules promulgated by the Internet Corporation for Domain Names and Numbers (ICANN). Upon the written submitted record, I find as follows:

FINDINGS

Respondent's registered domain name, bbox.com, was registered with Network Solutions on April 15, 1995. In registering the name, Respondent agreed to submit to this forum to resolve any dispute concerning the domain name, pursuant to the UDRP.

The UDRP provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent's domain name is identical or confusingly similar to a trademark or service mark in which

Complainant has rights; and

- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

IDENTITY/CONFUSING SIMILARITY¹

Complainant's July 2002 Submissions

Complainant alleges that bbox.com is identical or confusingly similar to Complainant's service mark, BBOX, which applies to skin treatment essential oils and bath and body oils.

In its July 2, 2002 letter to CPR, Complainant's counsel asserts inter alia:

Complainant is the owner of U.S. service mark Registration No. 2,120,142.²

The mark has been registered in Europe, South America and Canada and has been in use worldwide for more than 10 years.

Complainant is a design, manufacturing and marketing company that manufactures and distributes "a variety of products worldwide".

Complainant also performs corporate brand image support, marketing research and strategic planning, etc.

As a result of extensive advertising and sales, "B'Box products are well-branded in the marketplace."

Complainant "jealously protects the integrity of its assets and guards against the unauthorized use of its service marks to the full extent of the law."

Complaint has obtained "numerous domain names, many of which have been secured from other companies who made unauthorized use of the [bbox](http://bbox.com) service mark," listing 17 domain names.

Complainant's enclosed materials "identify various product lines carried by B'Box Corporation."

Complainant is entitled to the exclusive use of the domain name bbox.com.

The Complaint Form accompanying the July 2 letter lists "cosmetics, beauty and bath products, spa products, and sportswear products" as goods with which Complainant intends to use the mark. It lists "private labeling, corporate branding, marketing research, creative design & support materials, display design, creative packaging" among the services with which Complainant intends to use the mark. Complainant asserts users who want to access "BBOX" would "instinctively type 'BBOX' – the full and complete name of the brand." Complainant states:

"As a result, it is extremely confusing for users to arrive at a dead site, or previously when the Black Box Images site was active, a computer company."

The Complaint Form asserts also Respondent has no rights or legitimate interests in the domain name because:

"Trademark. 'BBOX' has been a registered trademark in the U.S. since 1993, two-years prior to Black Box Images creating its site in 1995.

"BBOX also has trademark registrations in Canada, Europe, and Japan in process.

"Advertising. 'BBOX' has conducted extensive advertising and has invested significant amount [sic] of money to promote and grow the BBOX brand name around the world.

"Consumer Awareness. The BBOX brand has consumer awareness in large department stores (such as Sephora) and spas both domestically and internationally.

"Black Box Images has no presence. The respondents [sic] business is not established with this name or web site address."

¹ Because the issues under Policy Paragraph 4(a)(i), (ii), and (iii) are interrelated here, I discuss all of the contentions of the parties in this section of the decision.

² The USPTO registration for the service mark states that Michel Roochel is the registrant.

The Complaint Form asserts the domain name should be considered as having been registered in bad faith under Policy Paragraphs 4(b)(i) and 4(b)(ii) because Respondent has requested \$20,000 to transfer the domain name, and Respondent rejected Complainant's offer to trade b-box.com (which Complainant owns) for bbox.com.

The materials accompanying the July 8 submission include, inter alia:

Copy of U.S. service mark Registration No. 2,120,142, which shows registration on December 9, 1997, and alleged first use of the mark on July 17, 1997.

An April 20, 2001 thank you to Complainant for contributing makeup and bags to the "Celebration 2001 Delta Miracle Awards."

Photos of Complainant's product displays, promotional material and advertising, which to the extent they are dated are no earlier than 2000.

Respondent's September 3, 2002 Response

Respondent's September 3, 2002 Response asserts, inter alia:

Respondent registered bbox.com because it is "an abbreviation for its company name BlackBox Images, and thus Respondent has a legitimate interest in the domain name.

Respondent had no knowledge of Complainant or its "alleged trademark" when Respondent registered the domain name in April 1995 – more than two years before the registration of Complainant's trademark. Thus, there is no basis for finding the domain name was registered in bad faith.

Complainant has no enforceable rights under the Policy because its mark was registered after the domain name was registered.

Respondent mentioned \$20,000 only after Complainant contacted Respondent. There is no evidence Respondent registered with the intent to sell the domain name.

The panel should find that Complainant has engaged in reverse domain hijacking.

The Response details alleged facts and supports the allegations with a declaration by a partner in Respondent, Jim Galasyn. Respondent asserts it was founded in 1993 as a digital video editing and custom animation service. Respondent allegedly registered the domain name in 1994 [sic] because the "preferred domain name, BLAKBOX.COM, was unavailable." Respondent asserts it developed a web site focused on its digital video business. With declining revenues in 1997, Respondent avers it elected to focus on "software programming and commercial web services." Respondent asserts it "deactivated its web site, which was not relevant its the [sic] software programming endeavor, but continued to use the domain name for its business email." Respondent has not updated the bbox.com web site to correspond to its software programming business.

Respondent urges it did not register the domain name to sell it, to disrupt Complainant's business, to prevent Complainant from reflecting its mark in a domain name, or to confuse consumers. Respondent notes Complainant is wrong in claiming its mark was registered in 1993, that being the date of application for the registration. Respondent asserts it was only after Complainant threatened legal action that Respondent suggested the possibility of settlement.

Correspondence accompanying the Response includes:

Galasyn August 11, 1999 letter to Complainant's attorney, Julia A. Duncan, noting the domain name registration predates first use of Complainant's mark and Complainant's mark applies to skin treatment products and is not related to Respondent's field of computer graphics. Galasyn stated "I might consider the sale of the BBOX.COM domain name. ... adequate compensation would need to be arranged."

Duncan's letter of August 24 to Galasyn, stating inter alia (1) because the trademark registration was applied for in December 1993, the domain name does not predate Complainant's trademark, (2) confusion is likely because "Internet users typically access a company's website by assuming that the company's domain name corresponds to its mark," and (3) it is "crucial for my client to have the ability to use the mark as his domain name." The letter threatens litigation to enjoin Respondent's use of the domain name.

Galasyn's counsel's (Erin P. Snodgrass) letter of August 31, 1999, to Duncan, requesting further information.

Snodgrass's letter of October 27, 1999 to Duncan, arguing inter alia (1) the parties' products are neither competitive nor complementary, (2) Complainant's use of its mark did not begin until July 17, 1997, two years after the domain name was registered, (3) the mark is not famous, and (4) it is "factually and legally impossible to either infringe trademark rights in marks adopted subsequent to your own mark, or to cybersquat on trademarks two years before those marks even exist commercially." Snodgrass concludes that, notwithstanding Respondent's strong legal position, it is willing to consider a reasonable offer regarding the sale of the domain name.

Snodgrass's letter of November 11, 1999 to Duncan, rejecting Duncan's telephonic offer to exchange b-box.com for bbox.com.

Respondent asserts "BBOX" is a common term, appearing in 50,200 web pages.

Respondent urges that Complainant has no enforceable rights against the domain name because (1) the intent to use application was filed in 1993, (2) the mark was not used until October 1997, and (3) Complainant "had abandoned the mark in 1995 and 1996."³ Respondent argues that, accordingly, Complainant did not even have common law rights that predate the registration of the domain name, and Complainant has not offered any evidence of any such rights. Respondent cites Business Architecture Group, No. 97051 (NAF June 5, 2001), John Ode d/ba ODE, No. D2001-0074 (WIPO May 1, 2001), and other authority to the effect that "Ordinarily, to satisfy the requirements of Rule 4(a)(1), the complaining party must have trademark rights before the domain name."

Respondent contends it has a legitimate interest based on Policy Paragraphs 4(c)(i) and 4(c)(ii). Respondent repeats its recital as to its reason for choosing the domain name, its business from 1993 to 1997, and its continued use of the domain name as its business email address. Respondent contends it registered the domain name in connection with a bona fide offering of goods and services. Respondent asserts abandonment of its initial business and web site does not undermine its legitimate interest, citing inter alia The Jolt Company, No. D 2001-0492 (WIPO Aug. 1 2001), and Ultrafem, No. 97682 (NAF Aug. 2, 2001). Respondent contends its only purpose in registering the domain name was for its BlackBox Images business, and it has never registered any other domain name.

Respondent asserts it has been commonly known by BlackBox Images, and "Bbox" is an abbreviation for the "common word BlackBox". Respondent cites G.A. Modefine S.A., No. D2001-0537 (WIPO July 20, 2001), for the proposition that Respondent's legitimate interest is established where the domain name constitutes an abbreviation of Respondent's name.

Respondent contends it has a legitimate use because BBOX is a common term "subject to substantial third party use." Respondent cites eight authorities in support of this proposition.

Respondent contends Complainant has not demonstrated the domain name was registered and is being used in bad faith. Citing authority for its various points, Respondent contends, inter alia:

Respondent registered an "extremely" common term with no intent to profit from Complainant's trademark rights. Complainant initiated discussions to settle the dispute by way of sale of the domain name to Complainant. Respondent could not have registered the domain name with bad faith intent in connection with a trademark that was not in existence at the time.

Citing authority, Respondent asserts Complainant has engaged in reverse domain name hijacking because, inter alia:

Complainant did not have any trademark rights at the time Respondent registered the domain name.
Complainant misrepresented the registration date of the trademark.

The Duncan September 6, 2002 Declaration

Ms. Duncan contends she has represented Michel Rochel, the owner of the registered mark "B'box", on "numerous occasions to protect his ownership rights against trade mark infringement." She avers Rochel has been selling products under "the name B'Box since 1989 which created common law rights to the trade name B'Box." Ms. Duncan attached copy

³ Respondent submitted a copy of a record of the prosecution of the application for registration of Complainant's mark, showing the application was abandoned in 1996 and again in 1997 apparently because "No use statement filed."

of her August 2, 1999 cease and desist letter to Galasyn⁴ and copy of his August 11, 1999 reply, both in support of the contention that neither she nor her “client” made an offer to purchase the domain name. She avers Galasyn’s offer to sell the domain name for \$20,000 was flatly refused.⁵ She avers that Galasyn declined the offer of use of the domain name b-box.com in exchange for “his abandonment of *bbox.com*.”

The Rochel September 10, 2002 Declaration

Rochel states he is the owner and CEO of Complainant. He avers Complainant has been selling products “under the ‘B’Box’ brand name” since 1989. He avers Complainant is the owner of Registration No. 2,120,142 for the service mark. Rochel avers Complainant has invested thousands of dollars to promote its “service mark and brand name.” Rochel states:

“B’Box Corporation was already using the B’Box brand name on product labeling, packaging and in advertising when it applied for registration of its service mark in 1993. Registration was issued December 9, 1997. Throughout that period of time, the B’Box service mark was in use as a product brand. ... The B’Box service mark has been used continuously by B’Box Corporation in its product labeling, packaging and advertising in the United States for over ten(10) year. B’Box temporarily discontinued use of the mark in 1995 and 1996 only for swimwear and clothing products. B’Box continued to use the mark for its line of cosmetics, essential oils, skin treatments and related products.”

Rochel identifies five other persons with “personal knowledge of B’Box Corporation’s sales, promotion and marketing activities over the years.” (None of those persons has tendered any form of statement in this proceeding.)

Rochel avers that, when Galasyn learned Complainant was interested in acquiring the domain name, Galasyn “demanded \$20,000 for transfer of the domain name.”

Rochel avers he and others at Complainant have attempted to locate Respondent and have been unable “to locate any evidence of any viable entity operating as Blackbox Images.” Inter alia, Rochel avers (1) Respondent has no phone listing in directories, no web site, and no phone number available from “information”, (2) Respondent is not licensed to do business, (3) Respondent’s “business” does not exist at the address listed in the domain name registration, (4) mail sent to that address is returned as undeliverable, (5) the listed address is not occupied by either Blackbox Images or Jim Galasyn, and (6) no record of Blackbox Images exists with any local utility company.⁶

Complainant’s Reply To Response To Complaint

A signed Reply, dated September 10, 2002, and an unsigned Reply, dated September 11, 2002, are both in the file of this proceeding. They are identical.

The Reply summarizes the averments in the Rochel Declaration. The Reply charges Respondent with distorting the record, contending in part:

“Despite the clear evidence of B’Box Corporation’s substantial prior use of the ‘Bbox’ service mark, Respondent nevertheless argues with an apparent straight face that it has priority in the *bbox.com* domain name because the U.S. Patent and Trademark Office did not act on B’Box Corporation’s 1993 application and issue a formal registration for the Bbox service mark until after the domain name was registered.”

⁴ Duncan’s August 2, 1999 letter states she represents the owner of the registered trademark. It does not mention Complainant.

⁵ Galayn’s August 11, 1999 letter does not mention \$20,000 or any other monetary amount.

⁶ In connection with his assertions (5) and (6), Rochel refers to an Escander Declaration. This declaration is not among the papers in the Arbitrator’s file.

“The ‘Bbox’ service mark has been in continuous use in advertising and on products sold by B’Box Corporation over the past ten years. ... B’Box Corporation temporarily discontinued use of the mark in 1995 and 1996 only for swimwear and clothing products.”

The Reply repeats that Respondent has no legitimate interest in the domain name because (1) there is no evidence of any viable entity operating as Blackbox Images, and (2) “Bbox” is no more an abbreviation for Blackbox Images than are other terms, one of which (B-Box.com) Complainant offered to Respondent.

The Reply argues that “Bbox” is not a generic term subject to common usage, but rather, it is a unique and distinct service mark of Complainant registered with the USPTO.

The Reply asserts Respondent has acted in bad faith because inter alia (1) Respondent ceased using the bbox.com web site in 1997 and has not updated or activated the site since then, (2) Respondent has demanded \$20,000 for the domain name, and (3) although the web site is inactive, Respondent continues to renew the registration in hopes of a substantial payment.

Respondent’s September 18, 2002 Surreply

Respondent takes umbrage at Complainant’s attacks on its veracity and the practices of its counsel. Respondent iterates many of its earlier assertions and arguments. Inter alia, Respondent argues that, in light of the chronology here, Respondent cannot have registered the domain name in bad faith or with Complainant’s mark in mind. Also, Respondent is not a cybersquatter, has not registered any other domain name, and has never offered a domain name for sale –

“It is ridiculous to assume that Respondent registered the Disputed Domain seven years ago, waiting in the wings for Complainant to call it so it could sell it the Disputed Domain.”

Respondent points to the two entries in the USPTO status report for the application for the registered service mark, showing abandonments in 1996 and 1997 because “No use statement filed.” This application is for registration with regard to skin treatment essential oils, bath and body oils, etc., not for swimwear. In light of this, Respondent contends “that mark was abandoned in 1996 and 1997 because no use statement was filed.”

Respondent points again to its business card as evidence of the business in connection with which the domain name was registered.

Respondent presses its reverse domain name hijacking claim, because (1) Complainant brought this proceeding when Complainant knew of Respondent’s “unassailable right or legitimate interest or of the clear lack of Respondent’s bad faith registration and use,” (2) Complainant misrepresented its trademark registration, and (3) Complainant has leveled unwarranted personal attacks on Respondent’s counsel.

Complainant’s September 20, 2002 Facsimile

Among these documents is a record relating to Registration No. 2,120,142, which confirms that (1) the 1993 application was an intent to use application relating to skin treatment essential oils, etc., (2) the date of first use was July 17, 1997, (3) “Michel Roochel” continues to be listed as the registrant and at the end of the document as “Correspondent (Owner)”, and (4) the application was abandoned both in 1996 and 1997 with the notation “No use statement filed.”

Another document is a status report for November 13, 2000 intent to use application to register B’BOX for (1) footwear, headware and clothing, (2) swim fins, snowboards and body boards, (3) coffee and tea, (4) mineral water, (5) magazines and periodicals, and (6) bicycles. Rochel is the applicant. A notice of allowance was mailed May 28, 2002. Dates of first use are not stated.

Complainant’s September 21, 2002 Response To Surreply

Complainant asserts that the “evidence demonstrates the B’Box trademark has been in continuous active use since 1989.” With respect to the 1996 and 1997 abandonments of the application to register the mark, “all extensions were ultimately granted, the application was reinstated, and registration of the mark issued” The first use date is stated to be July 17, 1997, because that was the first time all of the products were in commerce.

Complainant asserts a second application for registration was for footwear, headware, clothing, etc. “This mark was abandoned effective December 6, 1998,” with a new application being filed November 13, 2000.

Complainant urges that Respondent’s passive holding of “the infringing mark” is evidence of bad faith. Complainant points to (1) Respondent’s knowledge of the mark as of the August 2, 1999 cease and desist letter, (2) Respondent’s response was to offer to sell the domain name for \$20,000, and (3) bad faith is evidenced by Respondent’s offer and Respondent’s passive holding of the domain name, citing authority, including Montgomery Mall Associates, Case No. FA0104000097042 (NAF May 14, 2001), quoting Netfolio Inc. FA 96684 (NAF Mar. 27, 2001):

“... even if I accept that the respondent originally had no intention to steal the goodwill of the complainant by registration of this name, it by now must be aware that its proposed use of this name would result in the loss of goodwill to the complainant. If the respondent now were to proceed with the implementation of a financial management service under the name Enefolio, it must be taken as intending to attract users to its site for gain by creating a likelihood of confusion with the complainant’s business. I think I am entitled to rely on evidence of bad faith after the complaint is offered..”

Complainant draws a parallel with this case and states:

“When advised of his infringing activity, he sought to extort a huge ;payoff. For three full years thereafter, he has continued to reregister the domain name without demonstrating any preparation or intent to use it in connection with a bona fide offering of goods or services. ... Accordingly, Respondent is cybersquatting and has no rights or legitimate interest in the domain name.”

Discussion

Complainant must prove Respondent’s domain name is identical or confusingly similar to a mark in which Complainant has enforceable rights. Whereas the domain name is indeed identical to the registered service mark on which Complainant relies, it is not at all clear that Complainant has enforceable rights in that mark.

Complainant asserts it is the owner of the mark. So does its owner and CEO (Rochel Decl. ¶2). The documentary record is to the contrary. The USPTO registration list Complainant’s owner and CEO, Rochel, as the registrant and owner. The March 13, 2000 application to register the same mark identifies Rochel as the applicant. Also, Complainant’s counsel, Ms. Duncan, avers that Rochel is the owner of the “registered trademark B’box”. Nothing in this record reflects any transfer of rights in the service mark BBOX from Rochel to Complainant.

Rochel declares that from 1993 to 1997 the “service mark was in use as a product brand.” Also, the service mark has been used continuously by Complainant “in its product labeling, packaging and advertising in the United States for over ten (10) years.” The documentary record fails Complainant here also. The 1993 application that resulted in the December 9, 1997 registration was an intent to use application. As issued, the registration states the date of first use of the service mark is July 17, 1997. The application was abandoned twice for failure to file the required statement as to use. None of the documents presented by Complainant in this proceeding exemplifying Complainant’s alleged use pre-dates 2000. No contemporaneous document in the record reflects any use of the service mark before 2000. This casts a cloud on any common law rights Complainant may have in the service mark.

No contemporaneous document evidences any promotion of the “service mark and brand name” since 1989 (cf. Rochel Decl. ¶2). Nor does any contemporaneous document evidence any use of the service mark as a “product brand” (cf. Rochel Decl. ¶3). Ms. Duncan’s declaration avers that Rochel’s (not Complainant’s) sales of products since 1989 “created common law rights to the trade name B’Box.” Alleged use of the mark as a “trade name” does not avail Complainant. The UDRP protects only rights in trademarks or service marks, not trade names.

How, when and where the service mark was used before 2000 – as a trade name, product brand name, trademark or service mark – cannot be gleaned from any of Complainant’s promotional and advertising material in this record. What rights in the service mark Complainant may have had before 1997 is simply not ascertainable.

Absent evidence of Complainant’s ownership of the service mark on which it relies, or a license from Rochel to Complainant to use the mark, Complainant cannot prevail here. Nor can Complainant prevail in the absence of any contemporaneous documentary evidence of any use of the mark before July 17, 1997, the date of first use alleged in the application for the registration of the mark – the earliest contemporaneous documents being dated in 2000.

Accordingly, I conclude that Complainant has not met its burden under UDRP Paragraph 4(a)(i).

RIGHTS AND LEGITIMATE INTERESTS

Having concluded that Complainant has not satisfied UDRP Paragraph 4(a)(i), I could terminate the discussion at this point. However, in the event Complainant pursues this matter in litigation, I am constrained to continue.

UDRP Paragraph 4(c) provides that Respondent's rights or legitimate interests in a domain name may be demonstrated, without limitation, by showing that (i) before notice to Respondent of the dispute, Respondent has used, or made 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) Respondent has been commonly known by the domain name; or (iii) Respondent is making legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Notwithstanding that, as of September 2002, Mr. Rochel had gathered information that Respondent was difficult (at minimum) to find, it is undisputed that before Ms. Duncan's letter of August 2, 1999 to Mr. Galasyn, Galasyn had registered the domain name and used it in connection with a bona fide offering of goods or services (Galasyn Decl. ¶¶3-5).

Respondent's deactivation of the web site in 1997 for financial reasons should not erode Respondent's rights or legitimate interests in the domain named under UDRP Paragraph 4(c)(i). Nothing in this record supports any inference that the registration for the service mark issued in December 1997 motivated Respondent's decision.

Respondent's failure to re-activate the web site in since 1997 goes more directly to the issue of bad faith use than to the issue of rights and legitimate interests.

Accordingly, I conclude that Respondent has rights or legitimate interests with respect to the domain name at issue.

BAD FAITH

For the reason stated above, I believe it appropriate and prudent to discuss this issue, notwithstanding the foregoing conclusions.

Paragraph 4(b) of the UDRP provides that indications of bad faith include, without limitation, (i) registration for the purposes of selling, renting or transferring the domain name to the Complainant for value in excess of Respondent's cost; (ii) a pattern of registration in order to prevent Complainant from reflecting the mark in a corresponding domain name; (iii) registration for the primary purpose of disrupting the business of a competitor; or (iv) an intentional attempt to attract, for commercial gain, Internet users to Respondent's web site by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of Respondent's web site or location, or of a product or service on Respondent's web site or location.

On this record, Respondent does not fit any of the four illustrative situations of Paragraph 4(b). Because Complainant must prove both bad faith registration and bad faith use of the domain name, Complainant fails with respect to Paragraph 4(a)(iii) as to bad faith registration. However, Complainant's assertions of bad faith use cannot be dismissed out of hand. Respondent's maintaining of the domain name registration for five years without any substantial business use or apparent preparation for any such use arguably amounts to a forbidden "passive use". Significantly, this is the only domain name Respondent has registered. The domain name was registered four years before Complainant obtained its service mark registration, and four years before Complainant's first use of its service mark according to the registration. Respondent's businesses and Complainant's businesses do not overlap. The only evidence that Respondent may be holding its registration for the purpose of selling the registration to Complainant is the correspondence following Complainant's August 2, 1999 cease and desist letter – in connection with suggestions that the matter might be resolved short of formal proceedings. Taken together, in light of all the circumstances in the record, this is not enough to paint Respondent as a bad faith user of the registered domain name.

Accordingly, I conclude that Respondent did not register and has not used the domain name in bad faith, as that term is defined in the UDRP.

REVERSE DOMAIN NAME HIJACKING

On this record, I cannot conclude that Complainant has abused the administrative proceeding. Complainant's failure to adduce evidence to prove its ownership or other rights in the service mark does not, in this case, rise to the level of abuse or bad faith. The service mark may well pre-date the registration of the domain name. That simply has not been proven. Complainant's misrepresentation of the registration date in its Complainant can be attributed to other factors than abuse and bad faith.

CONCLUSION

In light of my findings above that (a) Complainant has not proved it has enforceable rights in the service mark; (b) Respondent has rights and legitimate interests with respect to the domain name at issue; and (c) Respondent did not register and has not used the domain name in bad faith, as that term is defined in the UDRP, I find in favor of Respondent with respect to Complainant's request that the domain name registration be transferred to Complainant.

Also in light of my findings above, I find in favor of Complainant with respect to Respondent's claim of reverse domain name hijacking.

REMEDY

Complainant's request to transfer the domain name bbox.com is hereby DENIED.

Respondent's request that Complainant be found to have engaged in reverse domain name hijacking is DENIED.

Signature of Arbitrator

October 12, 2002
Date