



# CPR Institute for Dispute Resolution

## COMPLAINANT

Radioactive, Inc.  
350 West End Avenue, Suite 1A  
New York, NY 10024  
(212) 595-8066  
(212) 595-8795  
notalk888@aol.com

File Number: CPR 0105

Date of Commencement: 4/22/01

Domain Name(s): "radioactive.com"

Registrar: Network Solutions, Inc.

vs.

Arbitrator: Robert Weil

## RESPONDENT

Audio Mill, Inc.  
849 Almar Avenue, Suite C, #126  
Santa Cruz, CA 95060  
(831) 426-7595  
(831) 426-2595  
putnam@audiomill.com, press@audiomill.com, putnam@uaudio.com

Before Robert Weil, Arbitrator

## PROCEDURAL HISTORY

The Complaint was filed with CPR on April 19, 2001, and, after review for administrative compliance, served on the Respondent on or before May 10, 2001. The Respondent did file a Response on or before May 10, 2001. 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). Because of the fact that Complainant filed a Reply Brief while the Rules for Uniform Domain Name Dispute Resolution policy (the "Rules") make no provision therefore, I granted Respondent to and including Monday, June 11, to file a Reply to the Reply Brief in accordance with Rule 10(b) of the Rules. The Arbitrator also extended the time for the award to be rendered from June 1, 2001 to June 20, 2001, in accordance with Rule 15(b) of the Rules, finding that exceptional circumstances exist according to the fact that a Reply Brief was filed. Upon the written submitted record including the complaint, the response and the reply in further support of the complaint I find as follows:

## FINDINGS

Respondent's registered domain name, "Radioactive", was registered with Network Solutions, Inc. on March 13, 2001. 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 SIMILARITY:** Complainant alleges that “Radioactive” is identical or confusingly similar to Complainant’s trademark, “Radioactive”, which applies to phonograph records, audio and video cassettes and compact discs and containing music and vocals (sic). Complainant owns the federally registered trademark “Radioactive” (U.S. Trademark Registration No. 1,779,515) issued on June 25, 1993, as evidenced by the records of the United States Trademark and Patent Office. There is evidence submitted by Complainant which convinces Arbitrator that Complainant both owns the mark and is also the lawful operator of the URL [www.radioactive.net](http://www.radioactive.net). Both the trademark and domain name are used by Complainant in connection with Complainant’s business as the creator, producer, manufacturer and distributor of sound recordings throughout the world and throughout all media for internationally acclaimed musical groups such as “The Ramones”, “Live”, Shirley Manson, “The Heads” (formerly the “The Talking Heads”) and “Big Audio Dynamite”. Complainant’s business includes, among other things, internet downloading of music from Complainant’s website [www.radioactive.net](http://www.radioactive.net).

Respondent’s domain name “radioactive.com”, (except for the top-level “.com” extension), is identical to Complainant’s trademark and domain name. Respondent operates a web site under this domain name, where it allows the end user to search internet radio stations for music designated by the end user using Respondent’s “BitBop” sound recording transfer service. Respondent then allows the user to download the music chosen for free, including the music of those artists exclusively signed to Complainant’s record company and whose music is available at Complainant’s website. Accordingly, Respondent’s domain name is identical or confusingly similar to Complainant’s registered trademark and domain name. (*Flor-Jon Films, Inc. v. Ron Larson*, case # FA 0006000094974 in which “AmericanGladiator.com” and “AmericanGladiators.com” were held to be confusingly similar; *Lee v. Aeon Network Services*, National Arbitration Forum, case decided August 30, 2000, holding that the domain name “Aeon.net” is so close as to be identical or confusingly similar to Complainant’s “Aeon” mark.)

Respondent does not dispute that Complainant owns a federal trademark registration for the “Radioactive” mark for “phonograph records, audio and video cassettes and compact discs and containing music and vocals”. Respondent does, however, dispute both Complainant’s contention that it has the “exclusive right to use the ‘Radioactive’ mark in connection with the recording, manufacturer and distribution of sound recordings” and the contention of Complainant that its right to the ‘Radioactive’ mark are exclusive “throughout the world and throughout all media.” This Respondent submits as evidence an undated Trademark Search Report prepared by the Intellectual Resources Group for Chance Technologies with a transmittal letter dated March 7, 2001 which report indicates in item 8 that “the application for the mark ‘Radio Active Records & Entertainment’ was filed by I. Flooks and G. Kurfirst on October 19, 1990 in the class of ‘Electrical and Scientific Apparatus’. Used in association with phonograph records, audio and video cassettes and compact discs, the application has since been abandoned”.

Responding to the trademark search, and contrary to Respondent’s contention, Complainant filed the trademark for registration with the United States Trademark and Patent Office and the trademark was registered on June 29, 1993, as evidenced by material submitted with the complaint. On June 22, 1999, Complainant filed an affidavit with the United States Patent and Trademark Office in which it declared that the trademark was still in use in interstate commerce and had been in continuous use since its registration by Complainant in 1993. In answer to Respondent’s contention that Complainant’s rights in the trademark “extend only to phonograph records, audio and video cassettes and compact discs and containing music and vocals”, Complainant claims, and the Arbitrator finds, that Complainant’s trademark registration covers computer software as well as all transmission and reproduction of sound. The Arbitrator finds that Complainant trademark registration was registered by the United States Patent and Trademark Office for goods and services in the international class 9, “[a]pparatus for recording, transmission or reproduction of sound or images: magnetic data carriers, recording disc... data processing equipment and computers...” Complainant submits evidence to that effect and the Arbitrator so finds.

I therefore conclude that the registered domain is identical or confusingly similar to Complainant’s protected mark.

**RIGHTS AND LEGITIMATE INTERESTS:** Complainant alleges that Respondent has no rights or legitimate interests with respect to the domain name at issue. Complainant notes that because Complainant’s registration of the trademark “Radioactive” entitled Complainant to exclusive use of the trademark in connection with the recording, manufacture and distribution of sound recordings throughout the world and throughout all media. In

addition, Complainant contends, Respondent's website is operated by Respondent's company, Audio Mill, Inc., and Respondent is not known or referred to by the name "Radioactive" nor does it have any trademark or service rights in said name. Furthermore, Complainant contends Respondent operates another identical website called [www.BitBop.com](http://www.BitBop.com) which provides the same exact service to end users as "[www.radioactive.com](http://www.radioactive.com)" and that the sites are linked. It would appear that there is no reasonable justification for Respondent to use Complainant's trademark in connection with any of Respondent's internet services for business activities. Respondent contends that it paid good money to an organization called WebPresence which, Respondent contends, had been using that domain name since March of 1999. In addition, WebPresence had been trying to sell the domain name for some time and during its "extensive marketing efforts" WebPresence claims that it sent a personalized email to Complainant offering to sell Complainant the domain name.

UDRP Paragraph 4(c) provides that Respondent's rights or legitimate interests in a domain name may be demonstrated, without limitation, by showing that (a) 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 (b) Respondent has been commonly known by the domain name; or (c) 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.

It seems that the principal issue outstanding is the fact that Respondent paid WebPresence some \$29,000 at or about the time that it was placed on notice by Complainant of Complainant's rights in the trademark. There is no question in the Arbitrator's mind that WebPresence tried to sell the domain name of Complainant.

The Arbitrator therefore concludes that Respondent does not have rights or legitimate interests with respect to the domain name at issue.

**BAD FAITH:** In support of the contention of Respondent's bad faith registration and use, Complainant notes that Respondent bought the disputed domain name from WebPresence, Inc., that Respondent is claiming that it acted in good faith because it did a "comprehensive" trademark search and that Respondent conceded that once Complainant's counsel complained that Respondent was infringing the trademark, Respondent immediately changed its product name from "Radioactive" to "BitBop Radio" and then subsequently to "BitBop Tuner".

In its reply, Complainant points out that even the simplest, most basic search of the web and the trademark office has always disclosed Complainant's activities as "Radioactive Records".

The fact that Respondent purchased the domain name from WebPresence is illustrative of its bad faith. (See *Flor-Jon Films, Inc. v. Ron Larson*, supra holding that purchase from a third party who appears to be in the business of registering and selling domain names is evidence of bad faith.) Thus a purchase from a third party in the business of registering and selling domain names is evidence of this Respondent's bad faith. Furthermore, a diligent trademark search would have uncovered the Complainant's interest in the mark.

The Arbitrator therefore concludes that Respondent did register and use the domain name in bad faith, as that term is defined in the ICANN Policy.

## CONCLUSION

In light of the Arbitrator's findings above that (a) the registered domain name is identical or confusingly similar to Complainant's protected mark; (b) Respondent does not have rights or legitimate interests with respect to the domain names at issue, and (c) Respondent did register and use the domain name in bad faith, as that term is defined in the ICANN Policy, the Arbitrator finds in favor of the Complainant, Radioactive, Inc.

## REMEDY

Complainant's request to transfer the domain name, "radioactive.com" is hereby GRANTED. The domain name

shall be transferred to Complainant, Radioactive, Inc.

Robert Weil

Signature of Arbitrator

Dated: June 17, 2001