



DECISION

Charles E. Runels, Jr. v. Domain Manager / Affordable Webhosting, Inc., Advertising
Claim Number: FA1709001749824

PARTIES

Complainant is **Charles E. Runels, Jr.** (“Complainant”), represented by **Sheryl De Luca** of **Nixon & Vanderhye P.C.**, Virginia, USA. Respondent is **Domain Manager / Affordable Webhosting, Inc., Advertising** (“Respondent”), represented by **Zak Muscovitch** of **Muscovitch Law P.C.**, Canada.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<pshot.com>** (the “Domain Name”), registered with **Name.com, Inc.** (“Registrar”).

PANEL

The undersigned certify that they have acted independently and impartially and to the best of their knowledge have no known conflict in serving as Panelists in this proceeding.

David L. Kreider as the Chair of the three-member Panel along with David H. Bernstein and The Honorable Karl V. Fink, (Ret.).

PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on September 19, 2017; the FORUM received payment on September 19, 2017.

On September 20, 2017, Name.com, Inc. confirmed by e-mail to the FORUM that the <pshot.com> Domain Name is registered with Name.com, Inc. and that Respondent is the current registrant of the name. Name.com, Inc. has verified that Respondent is bound by the Name.com, Inc. 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").

On September 25, 2017, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of October 16, 2017 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@pshot.com. Also on September 25, 2017, 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 October 5, 2017.

On October 13, 2017, Complainant sought to introduce a Supplemental Submission in Support of Amended Complaint, which was received after the deadline provided for by the FORUM's Supplemental Rule #7. The Panel has not considered most of Complainant's Supplemental Submission because it merely reargued the points included in the Complaint and did not discuss any new facts or law that was previously unavailable. *See generally Yetti Coolers, LLC v. Ryley Lyon/Ditec Solutions LLC*, FORUM Claim No. 1675141 (July 11, 2016). The only exception is that the Panel has accepted and considered Section 3 of the Supplemental Submission, in which Complainant provides his defense against Respondent's request for Reverse Domain Name Hijacking ("RDNH"), since Complainant did not know at the time of the Complaint that Respondent would request a finding of RDNH.

Also on October 13, 2017, Respondent submitted its Objection to Complainant's Supplemental Submission and in the Alternative, Request to file Responding Submission of the Respondent, in accordance with the Supplemental Rules. For the same reason that the Panel has accepted and considered Section 3 of Complainant's Supplemental Submission, the Panel has accepted and considered Respondent's supplemental submission, which responded to the defense against Respondent's request for a finding of RDNH.

On October 13, 2017, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the FORUM appointed
David L. Kreider as Panelist;
David H. Bernstein as Panelist; and
The Honorable Karl V. Fink, (Ret.), as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the 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 be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

a. Respondent's Domain Name is nearly identical and/or confusingly similar to Complainant's trademarks

i. Since September 2010, Complainant has used the mark PRIAPUS SHOT in connection with his treatment for rejuvenation and enlargement of the penis.¹ He also owns Registration No. 3965320 for PRIAPUS SHOT, which was filed on September 12, 2010, registered on May 24, 2011, and covers “Non-invasive cosmetic medical procedure using blood-derived growth factors including platelet rich fibrin matrix to enhance the size or function of the penis,” in Class 44. Since February 25, 2012, Complainant has used the mark P-SHOT in connection with his treatment for rejuvenation and enlargement of the penis. He also owns Registration No. 4820964 for P-SHOT, which was filed on September 15, 2014, registered on September 29, 2015, and covers “non-invasive cosmetic medical procedure using blood-derived growth factors including platelet rich fibrin matrix to enhance the size or function of the penis.” Complainant’s ownership of a USPTO trademark registration for the PRIAPUS SHOT and P-SHOT trademarks demonstrates his rights in such marks for the purposes of Policy ¶ 4(a)(i). *See Microsoft Corp. v. Burkes*, FA 652743 (FORUM Apr. 17, 2006) (“Complainant has established rights in the MICROSOFT mark through registration of the mark with the USPTO”).

ii. Complainant also provides seminars, workshops, classes, social media videos, information, news and commentary, including on-line information, news and commentary in fields related to the above mentioned trademarked services.

iii. Complainant currently markets and extensively promotes his services under his trademarks, over the internet, through his websites, e.g., at www.priapusshot.com (among others). He also promotes his services through trade shows, trade publications, media advertisements, including newspaper and television, seminars, workshops, and classes, social media videos, e.g., on YouTube, and other marketing channels. In 2015, “PRIAPUS SHOT” promotions were given out in Oscars goody bags to actors, directors

¹ According to New World Encyclopedia on-line edition, in Greek mythology, “Priapus” was a minor rustic fertility god, protector of livestock, fruit plants, gardens and male genitalia.

and producers. Complainant has licensed the use of his trademarks to hundreds of physicians to perform his registered treatment services. As a result, Complainant has developed a significant amount of goodwill in his services, which are marketed, advertised and sold under his marks. Complainant's efforts, moreover, have generated strong rights under federal and state trademark law, unfair competition law and common law.

iv. The Domain Name is nearly identical and confusingly similar to Complainant's P-SHOT trademark for Complainant's medical treatments and related services. In that connection, the Domain Name fully incorporates Claimant's P-SHOT mark. The Domain Name is also confusingly similar to Complainant's PRIAPUS SHOT mark.

v. Here, similarity in appearance, sound, connotation and commercial impression are present with respect to the Domain Name and Complainant's marks. In any event, by law, similarity in any one of those elements may be sufficient to determine that marks are confusingly similar. *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014).

vi. It is irrelevant that the registration of pshot.com predates Complainant's rights in his marks. *See, e.g., Clear!Blue Holdings, L.L.C. v. NaviSite, Inc.*, FA 888071 (FORUM Mar. 5, 2007) ("Although the domain name in dispute was first registered in 1996, four years before Complainant's alleged first use of the mark, the Panel finds that Complainant can still establish rights in the CLEAR BLUE marks under Policy ¶ 4(a)(i)."). *See also to the same effect, Coles Pen Company Limited v. Cole, Samantha / Coles of London*, FA1702001717458 (FORUM Mar. 30, 2017); *Javacool Software Dev., LLC v. Elbanhawy Invs.*, FA 836772 (FORUM Jan. 2, 2007) (holding that a complainant need not show that its rights in its mark predate the respondent's registration of the disputed domain name in order to satisfy Policy ¶ 4(a)(i)); and *AB Svenska Spel v. Zacharov*, D2003-0527 (WIPO Oct. 2, 2003).

b. Respondent has no rights or legitimate interests in the Domain Name

i. Respondent has no legitimate rights or legitimate interests in the Domain Name. Complainant neither licensed nor authorized Respondent to use the P-SHOT or PRIAPUS-SHOT marks.

ii. Subsequent to registering the pshot.com domain name, Respondent has parked and marketed the domain name using sedo.com (a domain name and website marketplace and domain parking provider). Respondent has never used, nor made demonstrable preparations to use, Domain Name or a name corresponding to the Domain Name in connection with a bona fide offering of goods or services.

iii. Respondent has failed to make any active use of the domain name since its registration in 2002.

vii. Further, on information and belief, Respondent, individually, as a business, or as any other organization, has never been commonly known by the Domain Name. The relevant WHOIS information identifies Respondent as Domain Manager/Affordable Webhosting, Inc., Advertising. Respondent's use of a WHOIS privacy service fosters a finding that Respondent is not commonly known by the disputed Domain Name. *See, e.g., Outdoorsy Inc. v. Laurel Michalek*, FA1705001729910 (FORUM May 12, 2017).

viii. Respondent has never made a legitimate noncommercial or fair use of the Domain Name, and has only parked the Domain Name since registration using sedo.com. Notably, only recently has Registrant's domain parking provider sedo.com put click-ads on the web pages in 2016. None of the click-ads make use of or refer to the mark P-SHOT. The failure to make active use of a domain name has led panels to make determinations that respondents have no rights or legitimate interests in domain names. *See, e.g., Coles Pen Company Limited v. Cole, Samantha / Coles of London*, FA1702001717458 (FORUM Mar. 30, 2017) (where the panel found that respondent's failing to make active use of the domain name for 8 years did not constitute a bona fide

offering of goods or services. It further noted “that parked pages may not confer rights or legitimate interests”). *See also Air Mauritius Ltd v. Anne c/o Anne*, FA1398938 (FORUM August 17, 2011) (“this Panel finds that failing to make an active use of the disputed domain names does not qualify as a bona fide offering of goods or services or a legitimate noncommercial or fair use of the disputed domain names under Policy”); *Am. Home Prods. Corp. v. Malgioglio*, D2000-1602 (WIPO Feb. 19, 2001) (finding no rights or legitimate interests in the domain name <solgarvitamins.com> where the respondent merely passively held the domain name); *Hewlett-Packard Co. v. Shemesh*, FA 434145 (FORUM Apr. 20, 2005) (finding that respondent’s non-use of a domain name that is identical to a complainant’s mark is not a legitimate noncommercial or fair use pursuant to Policy ¶ 4(c)(iii)); *Nucor Corporation v. LUIS ALONZO MURO*, FA 1580989 (FORUM Oct. 26, 2014) (where the use of a confusingly similar domain name for a website displaying links that were unrelated to complainant was “neither a bona fide offering of goods or services, nor a legitimate noncommercial or fair use of the domain.”); *Black & Decker Corp. v. Clinical Evaluations*, FA 112629 (FORUM June 24, 2002) (respondent’s use of the disputed domain name to redirect internet users to commercial websites, unrelated to the complainant and presumably with the purpose of earning a commission or pay-per-click referral fee did not give respondent rights or legitimate interests in the domain name); *The Coca-Cola Company v. Whois Privacy Service*, D2010-0088 (WIPO Mar. 16, 2010) (finding no rights or legitimate interests in domain name used for a parked website containing sponsored links); *The Royal Bank of Scot. Group Plc v. Demand Domains*, FA 714952 (FORUM Aug. 2, 2006) (operation of a commercial web directory displaying various links to third-party websites not a bona fide offering of goods or services because respondent presumably earned “click-through” fees for each consumer it redirected to other websites); *Hard Rock Cafe International (USA), Inc. v. Ryhan Estate Vineyards*, FA 35573 (FORUM Jan. 14, 2009) (use of a confusingly similar domain name to resolve to a website displaying third-party links to unrelated websites is not a “a bona fide offering of goods and services”); *Computer Doctor Franchise Sys., Inc. v. Computer Doctor*, FA 95396 (FORUM Sep. 8, 2000) (finding that the respondent’s website, which is blank but for links to other websites, is

not a legitimate use of the domain name); *Vance Int'l, Inc. v. Abend*, FA 970871 (FORUM June 8, 2007) (concluding that the operation of a pay-per-click website at a confusingly similar domain name does not represent a bona fide offering of goods or services or a legitimate noncommercial or fair use, regardless of whether or not the links resolve to competing or unrelated websites or if the respondent is itself commercially profiting from the click-through fees).

c. The Domain Name was registered and is being used in bad faith.

i. The classic definition of cybersquatting is the registering, selling or using a domain name with the intent of profiting from the goodwill of someone else's trademark, and generally refers to the practice of buying up domain names that use the names of existing businesses with the intent to sell the names for a profit to those businesses. Upon information and belief, Respondent is a speculator and serial cybersquatter that, due to the inexpensive cost of registration and maintenance of domain names, has registered numerous domain names in the hopes of being able to extort a ridiculous price from someone like Complainant who subsequently trademarks a like name/service mark and causes the name to become valuable.

ii. On information and belief, Respondent, for an extremely minimal investment, speculated that the Domain Name would become commercially valuable, and registered the Domain Name for the sole purpose of selling, renting, or otherwise transferring the Domain Name for valuable consideration in excess of the out-of-pocket costs directly related to the Domain Name. Once Complainant's business activities using the trademarks PRIPAUS SHOT and P-SHOT caused the Domain Name to acquire value, for valuable consideration far in excess of Respondent's out-of-pocket costs directly related to the registration and parking of the Domain Name, Respondent offered to sell the parked pshot.com domain name to Complainant initially for \$150,000.00 and then for \$35,000 in a subsequent counteroffer.

iii. In this case Respondent registered the Domain Name on July 25, 2002. Complainant filed his PRIAPUS SHOT® trademark on September 12, 2010, which was registered by the USPTO on May 24, 2011 when the mark issued on the USPTO Principal Register; and Complainant filed his P-Shot® trademark with the USPTO on September 15, 2014, which was registered by the USPTO on September 29, 2015, when this mark was also placed on the USPTO Principal Register. In the fifteen (15) years since Respondent registered the Domain Name, the Domain has remained parked on the sedo.com website. Transfer of a domain has been awarded under such circumstances. *See, e.g., Clear!Blue Holdings, L.L.C. v. NaviSite, Inc., supra*, (ordering transfer of the domain name, when, inter alia, Respondent has failed to introduce any evidence as to use of the domain name prior to the time when Respondent acquired the domain name at issue after Complainant filed its applications for U.S. trademark registration.”).²

iv. The pshot.com website currently does not resolve to a functioning website with substantive content, but merely to a web page generated by the domain owner using sedo.com, its "domain parking" provider. Respondent has listed the Domain for sale on sedo.com, imputing bad faith under Policy ¶ 4(b)(i). Respondent explicitly states on the pshot.com web page "[b]uy this domain," and "[t]he domain pshot.com may be for sale by its owner!" The absence of a web site and the language of the web page clearly indicate that Respondent's only purpose in purchasing the Domain Name was to subsequently extort someone like Complainant who has given the name and Domain Name monetary value. On information and belief, there is not an "innocent explanation" for Respondent's lack of a functional website, nor does Respondent have any "legitimate plan" to have a functional website in the future. Complainant tried to negotiate the purchase of the Domain Name on July 1, 2017 by making a \$2,000 offer for the Domain. Respondent made a counter offer of \$150,000.00. When Complainant made subsequent offers of \$2500 and \$2510 on July 8, 2017, Respondent lowered the

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The Panel will address this case in its decision, below, but it is worth noting here that the Complainant has completely misrepresented the holding of this case. In *Clear!Blue*, the Panel in fact denied transfer of the domain name. The language Complainant quotes in the parenthetical, above, dealt only with the question of whether the Complainant has adequate trademark rights to prevail under the first factor of the Policy, not whether the Respondent registered the domain name in bad faith.

offer to the still exorbitant amount of \$35,000 for the Domain Name. Complainant made a final offer of \$1000 for the Domain Name, which was not accepted. This is a classic case of cybersquatting in bad faith where Respondent is holding the Domain Name hostage until Complainant pays an outrageous price for the Domain Name or this Panel orders a transfer of the Domain Name to Complainant. *See, e.g., Coles Pen Company Limited*, FA1702001717458 (FORUM Mar. 30, 2017) (finding that the circumstances of the domain registration and events that subsequently transpired, including the complainant's initial offer for sale and the respondent's several counter-offers, indicated that the respondent intended to profit in excess of out-of-pocket costs, in bad faith under Policy ¶ 4(b)(i)); *Bear River Mutual Insurance Company v. Dzone Inc.*, FA1311001528522 (FORUM, Dec. 11, 2013) ("the respondent's offer to sell the disputed domain name to the general public and to the complainant in the form of counter-offers demonstrates the respondent's bad faith registration and use of the disputed domain name pursuant to Policy ¶ 4(b)(i).").

v. Here, Respondent, by adding click-ads to the pshot.com web page in 2016, demonstrated an intent to use the Domain Name to attract internet traffic and to benefit commercially from the goodwill associated with Complainant's trademarks. This intent shows Respondent's bad faith under Policy ¶ 4(b)(iv). *See Allianz of Am. Corp. v. Bond*, FA 680624 (FORUM June 2, 2006) (finding bad faith registration and use under Policy ¶ 4(b)(iv) where the respondent was diverting internet users searching for the complainant to its own website and likely profiting by it). *See also Workday, Inc. v. Vaguine*, FA1702001716531 (FORUM, March 15, 2017) (finding bad faith where the confusingly similar domain contained pay-per-click advertisements for the complainant's competitors and other third parties).

vi. Finally, the fact that Respondent engaged a privacy service, and in doing so withheld identifying information along with the other facts noted above gives rise to a finding of bad faith registration and use under Policy ¶ 4(a)(iii).

B. Respondent

Introduction

1. Respondent registered the Domain Name at least ten (10) years before Complainant even adopted "P-Shot" for his brand of penis enlargement services. As such, bad faith registration is impossible. Moreover, Complainant readily admits that at no time did Respondent ever use the Domain Name in any infringing manner whatsoever.

2. Complainant also admits that he recently tried to purchase the Domain Name. When the negotiations did not result in a sale price that Complainant was happy with, he brought this Complaint as his "Plan B".

3. Complainant simply covets the Domain Name and has no entitlement to it. Accordingly, this Complaint is an attempted Reverse Domain Name Hijacking.

Complainant's P-SHOT Trademark

4. Pursuant to Complainant's own Declaration, Complainant began using the mark, P-SHOT "since as early as February 25, 2012." This date of claimed first use is confirmed by the USPTO Registration for P-SHOT, which was registered on September 29, 2015.

Third Party PSHOT Trademarks

5. It is noteworthy that there are several third parties who have trademark registrations for PSHOT which pre-date Complainant's registration. For example, Nestle has a trademark registered for PSHOT in the United Arab Emirates, which it registered long before the Complainant (January 14, 2009), which is registered in connection with food and dietary supplements for medical use, etc. And, since August 13, 2009, a New Zealand company has held a registered trademark for PSHOT for dietetic foodstuffs and

beverages. This shows that the mark, P-SHOT is not subject to any monopoly, as third parties have used the similar mark PSHOT, since long before Complainant.

The Date of Registration of the Domain Name

6. The Domain Name registration date is not contested. As expressly admitted in the Complaint, the Domain Name was registered on July 25, 2002 – nearly ten (10) years before Complainant’s claimed date of first use of its mark, i.e. February 25, 2012, and 13 years before Complainant obtained a US trademark registration in connection with his penis enlargement procedure.

7. Although unnecessary (since the Domain Name registration date is not contested and is admitted by Complainant), the date of registration is confirmable. The original domain name registration email confirmation from July 25, 2002 (fifteen years ago) is no longer available however. Also, the DomainTools’ historical Whois archives do not go back that far for this particular Domain Name. Nevertheless, confirmation of the registration date as belonging to Respondent is available from the current Whois Record, which shows that the “Creation Date” for the Domain Name is July 25, 2002. Corroborating this Creation Date as belonging to Respondent, is a screenshot from Archive.org from September 28, 2002 (the earliest available historical archived screenshot subsequent to the July 25, 2002 Creation Date), which shows that the website associated with the Domain Name was forwarded to www.AffordableWebhosting.com, which was registered to Respondent as per the DomainTools historical Whois Report dated December 12, 2002.

Respondent’s Adoption of the Domain Name for General Advertising in 2002

8. On July 25, 2002, Respondent selected the Domain Name for registration because a) it was a catchy invented term that Respondent thought would one day develop into a website, or alternatively, would be of interest to new businesses looking for a new

brand, and b) pshot.com was not subject to any trademark rights by anyone. In short, it was a made-up term that Respondent invented and was perfectly able to lawfully register without infringing upon any rights of any person, anywhere.

9. Respondent began using the Domain Name at the latest on September 28, 2002, to forward to Respondent's AffordableWebhosting.com website. Respondent figured that he might as well use the Domain Name to advertise its business, since it was not otherwise being developed for the time-being.

10. Commencing on or about September 12, 2003, Respondent commenced use of the Domain Name to forward to one of its other businesses, namely Names9.com. Respondent similarly thought that it might as well forward the Domain Name to this business for advertising purposes.

11. Commencing thereafter, Respondent began using the Domain Name for advertising on a stand-alone website associated with the Domain Name. The advertising was of a general nature. There were no trademarks registered worldwide for PSHOT or similar to PSHOT at that time, to the best of Respondent's knowledge. This general advertising continued through to-date. The hosting history report obtained from DomainTools demonstrates that the Domain Name has been used for advertising revenue since at least 2006.

12. Accordingly, commencing in 2002 and continuing to-date, the Domain Name has been used to advertise both Respondent's own businesses and to advertise third party businesses through general non-infringing advertising. Contrary to Complainant's allegation (*see* Complaint at paragraph c(v)), the use of the Domain Name has never substantially changed – it has in fact always been used for advertising from its initial registration date.

13. At no time has the Domain Name ever been used to infringe Complainant's marks, which were registered no earlier than 2015, and which were claimed to have been first used in 2010.

14. In fact, Complainant expressly admits that there has been no infringement of its marks. Complainant states that "none of the click-ads make use of or refer to the mark pshot".

15. Accordingly, not only has Respondent used the Domain Name for advertising long before Complainant started using P-SHOT as a mark, but Respondent's use has never materially changed.

15. In conjunction with this advertising, and commencing in or about 2013 when Respondent switched to the Sedo platform for advertising on the Domain Name, Respondent also began publically offering the Domain Name for sale to the general public. At no time did Respondent ever solicit Complainant. In fact, Respondent had never even heard of Complainant until receipt of this Complaint. Moreover, it was Complainant who eventually, in 2017, anonymously solicited the purchase of the Domain Name from Respondent. Complainant made several anonymous offers to purchase the Domain Name but was ultimately unhappy with the price, so it commenced this UDRP instead, as its "Plan B".

17. Complainant also complains that Respondent's use of a privacy service is proof of bad faith. First, there was nothing nefarious at all about Respondent's switch to a private domain name registration on March 3, 2015. After 12 years of using a public registration, Respondent switched to private registration because it recently had its email security penetrated and did not want to continue to display its email address publically. In fact, Respondent also, at or about the same time period, switched to private registrations for many of its other domains. Second, there is no correlation between the Domain Name registration being privatized and the nature of the ads that

appeared on the website. As aforesaid, long prior to the private registration and long prior to Complainant's existence, ads appeared on the associated website.

18. What has occurred here is that Complainant decided to select P-SHOT for his brand, perhaps in 2010 as claimed, when the Domain Name PSHOT.COM was already taken by Respondent. Apparently, it did not matter to Complainant then that there was already someone who had invented the term and was using the corresponding Domain Name. Years later, Complainant decided he wanted to purchase the Domain Name. He negotiated a sale, but did not want to pay more than USD \$3,500, so instead he concocted this Complaint to get the Domain Name for free, even though Respondent's rights and interest in the Domain Name far pre-date Complainant's trademark rights (and which are of course limited in scope, in any event).

Whether the Domain Name Is Identical or Confusingly Similar to Complainant's Trademark

19. Respondent acknowledges that Complainant has a trademark for P-SHOT which was registered on September 29, 2015 – 13 years after the Domain Name was registered. As noted above, Complainant's claimed date of first use is February 25, 2012, and this post-dates Respondent's Domain Name registration by 10 years. Nevertheless, by merely having this current trademark registration which is sufficiently similar to the Domain Name for the purposes of the Policy, Complainant has met this preliminary first part of the three-part UDRP test.

20. Respondent submits that Complainant's other registered trademark (PRIAPUS SHOT) is not identical or even confusingly similar, but in any event, it is immaterial as Complainant's other aforementioned trademark is sufficient under this part of the test.

Whether Respondent has Rights or Legitimate Interests in Respect of the Domain Name

21. In order to meet the requirements of Policy Paragraph 4(a)(ii), Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the Disputed Domain Name, and then the burden shifts to Respondent to show that it does have rights or legitimate interests. *See Hanna-Barbera Prods., Inc. v. Entm't Commentaries*, FA 741828 (FORUM Aug. 18, 2006).³

22. Can Complainant make out a prima face case for no legitimate interest when at the time that the Domain Name was registered, Complainant itself had no trademark rights in "PSHOT", and did not even acquire a trademark registration until 13 years afterwards?

23. As held in *Riveron Consulting, L.P. v. Stanley Pace*, FA1002001309793 (FORUM APRIL 14, 2010) , without evidence of a complainant's trademark rights at the time of a respondent's registration, there is simply no foundation to conclude that a respondent has no rights in the domain name, since the respondent was not legally bound to license the mark from the complainant at the time of registration. Logically, a complainant cannot meet this initial threshold of showing that a respondent has no rights, if the complainant itself had no rights at the time of registration.

24. It is submitted that at the time that the Domain Name was registered on July 25, 2002, Complainant itself did not have rights or a legitimate interest in P-SHOT or PSHOT (since Dr. Runels did not adopt the brand until 2012 – ten years later), and as such, in accordance with *Riveron, supra*, he cannot make out a *prima facie* case against Respondent.

³ Respondent incorrectly asserts that after a complainant has established a *prima facie* case, the burden of proof shifts to the respondent. Only the burden of **production**, i.e. the burden to come forward with evidence of rights or legitimate interests in the disputed domain name, shifts to the respondent. The burden of proof remains with the complainant. *See National Cable Satellite Corporation, d/b/a C-SPAN v. Michael Mann/Omar Rivero*, FA 1707001741966 (FORUM Sept. 20, 2017), citing the WIPO Jurisprudential Overview 3.0, ¶ 2, and explaining that, "[a]lthough the burden of production shifts to the respondent, the complainant still has the burden of proof."

25. Upon registration, the only person who had any rights or legitimate interest in the Domain Name, was Respondent, and although those rights may have subsequently been curtailed in a very limited fashion by the coming into existence of a trademark in connection with penis enlargement, 13 years later, Respondent's original rights and legitimate interest in the Domain Name, were never extinguished.

26. The legal restrictions on the Domain Name's potential uses subsequent to Complainant's trademark registration in 2015, is another matter entirely, but is not the subject of the UDRP which is concerned only with bad faith registration and use, i.e. cybersquatting. Accordingly, if there are no pre-existing rights at the time of registration, the Domain Name registration could not be anything but legitimate.

27. Accordingly, Complainant's contention that "Respondent has no rights or legitimate interest" because Complainant "neither licensed nor authorized Respondent to use the P-SHOT or PRIAPUS-SHOT marks", is farcical. Respondent did not need any license or authorization from Complainant when it registered the Domain Name in 2002. Indeed, it would have come as quite a surprise to Dr. Runels, if in 2002, Respondent requested a "license or authorization" to register pshot.com, since Dr. Runels, by his own admission, would not even have conceived of P-SHOT as a brand for another 10 years into the future.

28. Put another way, Respondent's legitimate interest, first and foremost, stems from being *the first person* to register the Domain Name at a time when it was not subject to any trademark rights whatsoever. As held by the unanimous three-person Panel in *Inbay Limited v. Ronald Tse dba Neosparx International*, WIPO Case No. D2014-0096:

"The Panel notes that the system of domain name registration is, in general terms, a "**first come, first served system**" and, absent pre-existing rights which may be applicable to impugn a registration, the first person in time to register a domain name would normally be entitled to

use the domain name for any legitimate purpose it wishes.” (emphasis added).

29. And that is precisely what Respondent did; it was first to adopt the Domain Name in the absence of any other party’s rights or interests, and it proceeded to use the Domain Name for its own lawful purposes, namely advertising its own businesses and that of third parties. That conferred a right to the Domain Name, which is sufficient for the purposes of Paragraph 4(a)(ii), since the Panel must find that Respondent has “a total lack of any right or legitimate interest,” not merely that Complainant has a purported “better” right or legitimate interest (*see Borges, S.A., v. James English* (WIPO D2007-0477)). A finding that Complainant has a purported or arguable “better” legitimate interest, however measured, is insufficient.

30. As far as Respondent’s use of the Domain Name for general advertising is concerned, it was a lawful and non-infringing use of the Domain Name thereby constituting a legitimate interest – especially in the absence of any trademark rights, by anyone, for many years. Moreover, even after Complainant obtained a trademark registration, absent proof that the ads were generated to target Complainant’s trademark, use of a domain name for general advertising is considered a bona fide offering of goods and services and a legitimate interest under the Policy. *See, e.g., Eastbay Corporation v. VerandaGlobal.com, Inc.* FA105983 (FORUM May 20, 2003).

31. Moreover, the record establishes that Respondent used the Domain Name for advertising from the get go, and did not (as alleged by Complainant) change its use of the Domain Name upon Complainant obtaining trademark rights. And in any event, Complainant admits that at no time were any of the ads infringing.

32. Respondent had a right to register the Domain Name for its own development or for speculation. Speculating in “brandable” and un-trademarked domain names is a “legitimate interest” under the Policy. As held in *Alphalogix, Inc. v. DNS Services d/b/a MarketPoints.com - New Media Branding Svcs.*, FA0506000491557 (FORUM JULY 11,

2005) , and as unanimously followed by the three-member Panel in *Arrigo Enterprises, Inc. v. PortMedia Domains*, FA1304001493536 (FORUM MAY 21, 2013), the business of creating and supplying names for new entities is a “legitimate activity in which there are numerous suppliers in the United States”.

33. This is essentially what Respondent was engaged in. It creatively came up with and registered the Domain Name, believing that it may in the future be of interest to itself for development, or for a new entity who would in good faith, acquire it from Respondent. As such, Respondent was engaged in legitimate speculation, supported by the Policy, and Complainant can only fault itself for not contacting Respondent prior to adopting its brand.

34. Lastly, speculating in non-infringing domain names in and of itself is a legitimate and well-established business, and also confers a “legitimate interest” in such a domain name. As held in *Allocation Network GmbH v. Steve Gregory*, WIPO Case No. D2000-0016, “such a practice [trading in valuable generic and descriptive domains] may constitute use of the domain name in connection with a bona fide offering of goods or services (i.e. the sale of the domain name itself).”

Whether the Domain Name has been registered and is being used in bad faith.

35. According to Dr. Runel’s own definition of cybersquatting (at Paragraph c(i) of the Complaint), cybersquatting “*generally refers to the practice of buying up domain names that use the names of existing business with the intent to sell the names for a profit to those businesses.*” (emphasis added).

36. Incredibly, Complainant (at Paragraph c(iii) of the Complaint), expressly notes: “In this case the Respondent registered the pshot.com domain name on July 25, 2002....and Complainant filed his P-SHOTG trademark with the USPTO on September 15, 2014.”

37. Dr. Runels therefore knew very well that Respondent was not a cybersquatter since Respondent registered the Domain Name before any existing business chose to adopt a corresponding domain name as a brand. Accordingly, even with the benefit of a sound definition of cyberquatting in hand which precluded Respondent from being a cybersquatter, Dr. Runels still brought this meritless Complaint.

38. It is an obvious factual impossibility for the Domain Name to have been registered in bad faith for the simple reason that the Domain Name was registered before Complainant's brand existed. *See Aspen Grove, Inc. v. Aspen Grove*, D2001-0798 (WIPO Oct. 5, 2001) (finding that it is "impossible" for Respondent to register disputed domain name in bad faith if Complainant company did not exist at the time of registration).

39. It is well-established that in general, a finding of bad faith registration cannot be made with respect to a trademark that did not exist at the time of registration of the disputed domain name. The WIPO Overview of WIPO Panel Views on Selected UDRP Questions states at 3.1:

"Normally speaking, when a domain name is registered before a trademark right is established, the registration of the domain name was not in bad faith because the registrant could not have contemplated Complainant's non-existent right."

40. UDRP Panels routinely determine that a domain name could not have been registered in bad faith when the registration pre-dates a trademark right. *See Telecom Italia S.p.A. v. NetGears LLC*, FA 944807 (FORUM May 16, 2007), (finding the respondent could not have registered or used the disputed domain name in bad faith where the respondent registered the disputed domain name before the complainant began using the mark); and *see ZZounds Music, LLC. v. Zounds c/o Mark LaForge*,

FA0610000817093 (FORUM NOV. 26, 2007); and also *see Interep Nat'l Radio Sales, Inc. v. Internet Domain Names, Inc.*, D2000-0174 (finding no bad faith where the respondent registered the domain prior to the complainant's use of the mark); and also *see Open Sys. Computing AS v. degli Alessandri*, D2000-1393 (finding no bad faith where the respondent registered the domain name in question before application and commencement of use of the trademark by the complainant).

41. Furthermore, it has been unequivocally determined that there is no such thing as "retroactive bad faith" in the UDRP. *See Hike Private Limited v. Perfect Privacy LLC / Zcapital*, WIPO Case No. D2017-0902 (August 25, 2017) (rejecting "the Complainant's submission concerning the *Octogen /Mummygold* line of cases and accept[ing] the Respondent's submission that the line of reasoning has now been fundamentally disavowed"; *see, e.g.*, section 3.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") (finding that under the circumstances, the complainant must establish both that the disputed domain name was registered and has been used in bad faith).

42. Without prior rights, there is just no UDRP case since there was no abusive registration. As the Panelist stated in *Riveron Consulting, L.P. v. Stanley Pace, supra*:

"The undisputed facts in this matter foreclose a finding of bad faith registration and use under Policy 4(a)iii. While Complainant currently has trademark rights in the at-issue mark by virtue of its RIVERON trademark registration, such rights do not magically relate back to the time that Respondent first registered the <riveron.com> domain name, a time well prior to Complainant's first use of its mark." (emphasis added).

43. Complainant also claims that "Respondent offered to sell the parked pshot.com domain name to Complainant." This is a misrepresentation. At no time did Respondent ever solicit Complainant – it was the other way round. Dr. Runels made an unsolicited

offer for the Domain Name which was offered for sale to the general public. Responding to an offer to purchase is not considered bad faith. *See Murad, Inc. v. Stacy Brock*, FA1202001431430865 (FORUM MARCH 31, 2012).

44. Furthermore, if a respondent has a legitimate interest in a domain name as Respondent does in this case, the respondent is entitled to offer its business asset for sale at market price and this is not bad faith. *See Etam, plc v. Alberta Hot Rods*, WIPO Case No. D2000-1654). A domain name registrant has the right to sell a domain name for whatever price he deems appropriate regardless of the value that a complainant or an appraiser may ascribe to the domain name. *See Personally Cool Inc. v. Name Administration Inc.*, FA1212001474325 (FORUM JAN. 17, 2013). It must be borne in mind that no one forced Complainant to adopt PSHOT as its brand in 2012. Complainant was perfectly able to investigate whether there were any corresponding domain names taken before deciding to adopt it as a brand. Complainant also could have purchased the Domain Name from Respondent if he had wanted it. The fact that Complainant decided that he was entitled to set the price himself, is what led to this meritless proceeding.

45. Lastly, Complainant complains that Respondent used a privacy service. As held by the unanimous Panel in *Mediaset S.p.A. v. Didier Madiba, Fenicius LLC*, WIPO Case No. D2011-1954, the use of privacy services in general is not objectionable. This approach is also supported by the “WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition”, at Section 3.9, wherein it is stated that the use of a privacy or proxy registration service is not in and of itself an indication of bad faith. It is only when a respondent uses a privacy service primarily in order to hinder legal proceedings, that the use of a privacy service may be an argument supporting an allegation of bad faith. In the present case, there was no effort to hide or hinder legal proceedings. In fact, Respondent’s registration was openly registered for years. It was only to cut down on spam which led to the use of a privacy service, not any intention of hindering legal proceedings.

Reverse Domain Name Hijacking

46. Initiating domain name dispute resolution proceedings necessarily involves putting the parties to a considerable expenditure of time and in many cases cost, and the Policy must not be used unless the complainant has a reasonable and credible belief it is entitled to succeed. In particular, proceedings must not be commenced in a brash and totally unjustifiable attempt to pressure a domain name owner into releasing a legitimately held domain name that considerably pre-dates any trademark rights held by the complainant. *See Software, Inc. v. Vertical Axis, supra.*

47. Allegations of reverse domain name hijacking have been upheld in circumstances where a respondent's use of a domain name could not, under any fair interpretation of the facts, have constituted bad faith, and where a reasonable investigation would have revealed the weaknesses in any potential complaint under the Policy. *See Rohl, LLC v. ROHL SA*, (WIPO Case No. D2006-0645).

48. Where a complainant should have known its case was fatally weak, was represented by counsel and filed no evidence beyond a mere assertion, it may be concluded that the arguments and evidence advanced by the complainant fall well short of those required to establish a colorable right, and RDNH may be found. *See Zenni Optical, LLC. v. DNS Administrator / Cykon Technology Limited*, WIPO Case No. D2009-1594).

49. Where a complaint was brought in knowing disregard of the likelihood that the respondent possessed legitimate interests because a domain name is generic, RDNH may be found. *See Dan Zuckerman v. Vincent Peeris*, WIPO Case No. DBIZ2002-00245 (SHOES.BIZ).

50. Where a complainant is represented by intellectual property counsel who even on a rudimentary examination of the Policy and its application in this area should have appreciated that the complaint could not succeed since the respondent's domain name had been registered prior to any trade-mark rights being acquired, RDNH may be found. *See, e.g., Proto Software, Inc. v. Vertical Axis, Inc/PROTO.COM* (WIPO Case No. D2006-0905).

51. This is a classic "Plan B" case, as described by *TOBAM v. M. Thestrup / Best Identity*, WIPO Case No. D2016-1990, i.e. "using the Policy after failing in the marketplace to acquire the disputed domain name." Complainant wanted to buy the Domain Name and it was only after that did not work, that it concocted this Complaint.

C. Additional Submissions

As noted above, on October 13, 2017, Complainant sought to introduce a Supplemental Submission in Support of Amended Complaint, which was received after the deadline mandated by the FORUM's Supplemental Rule #7. The Panel has not considered Complainant's untimely additional submission except with respect to Complainant's defense of Respondent's request for a finding of RDNH.

Also on October 13, 2017, Respondent submitted its Objection to the Complainant's Supplemental Submission and in the Alternative, Request to file Responding Submission of the Respondent, in accordance with the Supplemental Rules.

The Panel has considered the Respondent's Supplemental Submission both with respect to its objection, and with respect to Respondent's request for RDNH, which summarizes the Respondent's position in the following terms:

"Simply, Complainant has again ignored the fundamental flaw in its case; that absent any trademark rights in existence at the time of Domain Name registration, bad faith registration is simply impossible.

Complainant's additional submission does not even begin to address this issue, which was central to the Response and which is fatal to the Complaint. Such conduct existed in *Consuela, LLC v. Alberta Hot Rods*, FA1306001504547 (FORUM AUG. 8, 2013), and the Panel found that Reverse Domain Name Hijacking occurred."

FINDINGS

The Panel finds that the Domain Name was registered on July 25, 2002 – nearly ten (10) years before Complainant's claimed date of first use of its mark, *i.e.* February 25, 2012, and 13 years before the Complainant obtained a US trademark registration in connection with his penis enlargement procedure.

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

Respondent acknowledges, and the Panel finds, that Complainant has a trademark for P-SHOT. The Domain Name is identical to the trademark except for the hyphen, and is therefore confusingly similar to the trademark for the purposes of the Policy. Complainant has therefore met the standing requirement at UDRP Policy Paragraph 4(a)(i).

Rights or Legitimate Interests

The undisputed evidence shows that Respondent registered the Domain Name prior to the creation of Complainant's trademark rights. Respondent asserts that it registered the domain name for speculative purposes, on the ground that it seemed like a good name and someone might want to purchase the name in the future. If Respondent registered the name based on its trademark value to an existing mark, such registration would be cybersquatting. But, in this case, Complainant has not submitted any evidence of any third-party trademark rights that predated the registration of the Domain Name in 2002. Therefore, Complainant has failed to prove that Respondent's registration of the Domain Name for speculative purposes in 2002 was not legitimate speculation. It is possible that other trademarks may have existed that the parties have not brought to the Panel's attention, or that there could be other arguments as to why Respondent lacks rights or legitimate interests in the Domain Name, but no such facts or arguments have been provided by Complainant in this proceeding. Accordingly, on this record, the Panel finds that Complainant has failed to prove that Respondent lacks any right or legitimate interest in the Domain Name for the purposes of Policy Paragraph 4(a)(ii).

Registration and Use in Bad Faith

On the facts of this case, Complainant cannot possibly prove bad faith registration, given that the Domain Name was registered nearly a decade before Complainant's claimed date of first use of its P-SHOT mark. As the WIPO Overview 3.0 makes clear,

the consensus view of WIPO UDRP panels is that, “where a Respondent registers a domain name before the Complainant’s trademark rights accrue, panels will not normally find bad faith on the part of the Respondent.” WIPO Overview 3.0, section 3.8.1; *see also id. section 1.1.3* (only in exceptional cases would a complainant be able to prove respondent’s bad faith where a domain name has been registered before a complainant has acquired trademark rights). The exception to which those provisions refers is where the respondent’s intent in registering the domain name was to unfairly capitalize on the complainant’s nascent (typically as yet unregistered) trademark rights, *see* WIPO Overview 3.0, section 3.8.2; that exception does not apply here since Complainant’s rights were not nascent at the time that Respondent registered the Domain Name.

Complainant nevertheless argues that bad faith can be found even though its trademark rights were created years after the Domain Name was registered. The only support Complainant provides for this assertion is *Clear!Blue Holdings, L.L.C. v. Navisite*. However, as noted in footnote 1 above, Complainant’s reliance upon *Clear!Blue Holdings* is completely misplaced, and Complainant misrepresents the outcome of that case. Complainant’s citation erroneously suggests that *Clear!Blue Holdings* demonstrates that panels have awarded transfer of a domain name in two, distinct circumstances: (1) when the respondent registered the domain name prior to the creation of the complainant’s trademark rights, but merely parked and failed to use the domain name, and (2) when the respondent registered the domain name after the complainant had submitted applications for trademark registration, and the respondent had never used the domain name prior to the registration thereof. *See* Complaint (c)(iii). This citation mischaracterizes the outcome of *Clear!Blue Holdings*. The panel in *Clear!Blue Holdings* did *not* order transfer of the disputed domain name; rather, the panel denied the complaint because the complainant failed to establish registration and use in bad faith. *See Clear!Blue Holdings, L.L.C. v. Navisite, Inc.*, FA 888071 (FORUM Mar. 5, 2007). Moreover, Complainant fails to acknowledge that, although *Clear!Blue Holdings* did involve a disputed domain name registered prior to the creation of the

complainant's trademark rights, the disputed domain name was initially registered by a different party and was not transferred to the registrant until one year after the complainant registered its trademarks and two years after the complainant started using the marks in commerce. *Id.* This variation could have supported a finding of bad faith, yet the panel still found that the complainant failed to carry its burden of proof under 4(a)(iii) of the Policy. As a result, Complainant's reliance on *Clear!Blue Holdings*, is both misleading and groundless.

Finally, Complainant argues that Respondent used the Domain Name in bad faith because it sought to sell the Domain Name to Complainant once Complainant's business activities using the trademarks PRIPAUS SHOT and P-SHOT caused the Domain Name to acquire value. There is no evidence, though, that Respondent sought out Complainant and offered to sell the Domain Name; to the contrary, Complainant reached out to Respondent and attempted to purchase the name (without disclosing that Complainant had trademark rights in P-SHOT). In the unique context of this case, Respondent's offer was not cybersquatting; rather, it merely reflected Respondent's seeking to sell a right that it believed it owned. Nor has Complainant shown use by Respondent in bad faith through offering click-through ads that targeted Complainant's penis enlargement services or any related goods or services. In any event, even if Complainant could show bad faith use, the Complaint still would fail in the absence of a showing of bad faith registration.

REVERSE DOMAIN NAME HIJACKING

Without prior rights, Complainant has no UDRP case, since there was no abusive registration. Here, the Panel found, based upon the undisputed evidence, that the Domain Name was registered on July 25, 2002 – nearly ten (10) years before Complainant's claimed date of first use of its mark, *i.e.* February 25, 2012, and 13 years before the Complainant obtained a US trademark registration. The undisputed facts **foreclose** a finding of bad faith registration and use under Policy 4(a)iii.

Respondent asserts in its submission:

“Where a complainant is represented by intellectual property counsel who even on a rudimentary examination of the Policy and its application in this area should have appreciated that the complaint could not succeed since the respondent’s domain name had been registered prior to any trade-mark rights being acquired, RDNH may be found[.] *See for example, Proto Software, Inc. v. Vertical Axis, Inc/PROTO.COM* (WIPO Case No. D2006-0905).”

The Panel agrees and finds Reverse Domain Name Hijacking by Complainant by unanimous decision. Complainant’s deceptive citation to the key case on which Complainant relied further supports the Panel’s finding of Reverse Domain Name Hijacking.

DECISION

Because Complainant has failed to establish all three elements required under the ICANN Policy, the Panel concludes that the relief requested in the Complaint must be DENIED. Because Complainant brought this Complaint in bad faith, the Panel finds Reverse Domain Name Hijacking by Complainant.

Accordingly, it is Ordered that the <pshot.com> domain name remain with Respondent.



David L. Kreider, Esq.
Panelist

David L. Kreider as the Chair, along with David H. Bernstein

and The Honorable Karl V. Fink, (Ret.), Panelists

Dated: October 23, 2017