



DECISION

SOG Specialty Knives and Tools, LLC v. Val Katayev / Poise Media Inc
Claim Number: FA1704001726464

PARTIES

Complainant is **SOG Specialty Knives and Tools, LLC** (“Complainant”), represented by **Patchen M. Haggerty** of **Perkins Coie LLP**, Washington, USA. Respondent is **Val Katayev / Poise Media Inc** (“Respondent”), represented by **Zak Muscovitch** of **Muscovitch Law P.C.**, Canada.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<sog.com>**, registered with **GoDaddy.com, LLC**.

PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

David L. Kreider as the Chair of the three-member Panel, along with The Honourable Neil Anthony Brown QC, and Sandra J. Franklin, as Panelists.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on April 11, 2017; the FORUM received payment on April 11, 2017.

On April 12, 2017, GoDaddy.com, LLC confirmed by e-mail to the FORUM that the <sog.com> domain name is registered with GoDaddy.com, LLC and that Respondent is the current registrant of the name. GoDaddy.com, LLC has verified that Respondent is bound by the GoDaddy.com, LLC 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 April 17, 2017, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of May 12, 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@sog.com. Also on April 17, 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 May 12, 2017.

An Additional Submission was submitted by Complainant on May 17, 2017 to which an objection was interposed by Respondent on May 19, 2017. Respondent asserts:

Rule 7 of the NAF Supplementary Rules does not afford a complainant the 'automatic right' to make an additional submission. As Panelist David Sorkin stated in, *Deep Foods, Inc. v. Jamruke, LLC. c/o Manish Patel*, FA0602000648190 (FORUM APRIL 12, 2006) ; " *The Forum's Supplemental Rule 7*

regulates the submission of additional statements and documents, but does not itself authorize such additional submissions; the controlling provision is Paragraph 12 of ICANN's Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), under which discretion to request such supplementation rests with the Panel'. See America Online, Inc. v. Miles, FA105890 (648190 May 31, 2002). Panels have routinely declined to consider documents submitted in usurpation of the sole discretion and authority provided to the Panel under the ICANN Rules to request and/or consider additional filings. See, Viacom v. Rattan Singh Mahon, WIPO Case No. D2000-1440.

The Panel agrees, and has not considered Complainant's Additional Submission.

On May 18, 2017, pursuant to Respondent's request to have the dispute decided by a three-member Panel, the FORUM appointed David L. Kreider as Panelist; The Honourable Neil Anthony Brown QC as Panelist; and Sandra J. Franklin 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.] The Domain Name is Confusingly Similar to Complainant's SOG Marks

[i.] In this case, Respondent's Domain Name is confusingly similar to Complainant's SOG Marks in that the Domain Name contains Complainant's SOG trademark in its entirety with the addition of the generic top-level domain ("gTLD") ".com." Previous panels have found that these variations are insufficient to differentiate a disputed domain name from a registered mark. *See Bank of Am. Corp. v. McCall*, FA 135012 (648190 Dec. 31, 2002) (holding that attaching a gTLD is "unable to create a distinction capable of overcoming a finding of confusing similarity"). Thus, the Domain Name is confusingly similar to Complainant's registered SOG Marks under Policy ¶ 4(a)(i).

[ii.] Complainant's rights in its SOG Marks predate the registration of the Domain Name. Complainant's SOG and SOG SPECIALTY KNIVES trademarks were first used in commerce in connection with knives and multipurpose utility tools as early as 1987, and have been used continuously since that time. Complainant's SOG POWERLOCK trademark was first used in commerce in connection with knives and multipurpose utility tools as early as 1998, and has been used continuously since that time. Complainant's United States Registration Nos. 1597203, 1973051 and 2323840 were issued on May 22, 1990, May 07, 1996 and Feb. 29, 2000, respectively, and are all now incontestable. *See* Exhibit D. On information and belief, Respondent did not acquire the Domain Name until February 23, 2007.

[iii.] Upon information and belief, Respondent acquired the Domain Name on February 23, 2007. While the WHOIS record for the Domain Name lists a "Creation" date for the Domain Name of April 14, 1996, the DomainTools Domain Report attached hereto as Exhibit A shows that Respondent acquired

the Domain Name on February 23, 2007. See Exhibit A, page 17-18 (relevant entries are highlighted in yellow on DomainTools Report page nos. 63-64).

[b.] Respondent Has No Rights or Legitimate Interests in the Domain Name

[i.] A complainant must prove that a respondent has “no rights or legitimate interests in respect of the domain name.” UDRP Rule 3(b)(ix)(2). The SOG Marks are associated exclusively with Complainant and have no independent dictionary meaning. Therefore, Respondent had no reason to choose the Domain Name except to create the impression of an association with, or to trade off of the goodwill of, Complainant.

[ii.] Respondent is not commonly known by the Domain Name according to Policy ¶ 4(c)(ii). Instead, the WHOIS information for the Domain Name lists the registrant as “Val Katayev” and the registrant’s organization as “Poise Media Inc”. Further, Respondent is not an authorized licensee, distributor, retailer or subsidiary of Complainant. Respondent has never been authorized to use Complainant’s SOG Marks, nor has Complainant authorized or licensed Respondent to supply or distribute Complainant’s goods. Previous panels have found no rights or legitimate interests where (a) respondent is not a licensee of complainant; (b) complainant’s prior rights in the mark precede respondent’s registration of the domain name; and (c) respondent is not commonly known by the domain name in question.

[iii.] The term “SOG” is not a descriptive or geographically significant word in which Respondent might have a claim to rights of use. Further, Respondent is not making a legitimate noncommercial or fair use of the SOG Marks. Instead, Respondent registered and is using the Domain Name in connection with a site that is using Complainant’s registered SOG and SOG SPECIALTY

KNIVES trademarks and that provides links to websites offering competitive goods to those offered under Complainant's SOG Marks.

[iv.] Respondent has not used the Domain Name in connection with a bona fide offering of goods or services. Respondent is not commonly known under the Domain Name and has never performed any legitimate business activities under such a name. Instead, Respondent's business name is "Poise Media Inc". The Domain Name is and has been in use with a website that both provides links to competitive goods to those offered under Complainant's SOG Marks and advertises the Domain Name as for sale. Such use with links to competitive goods or with an offer to sell the domain name does not create a legitimate interest. *See Tropicana Entm't Holdings, LLC v. Transure Enter. Ltd.*, FA0902001246025 (648190 Mar. 19, 2009).

[v.] Respondent is clearly attempting to capitalize on using the SOG Marks in the Domain Name, as presumably it registered the Domain Name to gain revenue from each Internet user that clicks on one of the links on the website to which the Domain Name resolves. Past Panels have inferred that "links" websites such as the one operated by Respondent generate click-through fees for registrants when users click on the links. *See Tropicana Entm't Holdings, LLC v. Transure Enter. Ltd.*, FA0902001246025 (648190 Mar. 19, 2009). As such, Respondent's use of the Domain Names to gain revenue via pay-per-click links is neither a bona fide offering of goods or services pursuant to Policy ¶ 4(c)(i) nor a legitimate noncommercial or fair use of the Domain Names pursuant to Policy ¶4(c)(iii). *See id.*

[vi.] Further, Respondent lacks rights and legitimate interests in the Domain Name given that it is offering the Domain Name for sale through Sedo, an online domain name auction website, with a "minimum offer" price of \$40,000. Panels have held that a respondent lacks rights and legitimate interests in a

domain where it attempts to sell the domain for an amount in excess of its out-of-pocket costs associated with the acquisition of the domain. *See Hess Corporation*, FA FA1608001689684 (citing *Drown Corp. v. Premier Wine & Spirits*, FA 616805 (648190 Feb. 13, 2006) (“[T]he Panel interprets Respondent’s offer to sell the domain name registration for \$100,000 as evidence that Respondent lacks rights and legitimate interests in the disputed domain name pursuant to Policy ¶4(a)(ii).”).

[c.] The Domain Name Has Been Registered and is Being Used in Bad Faith

[i.] Finally, Complainant must show that the disputed Domain Name was registered in bad faith and has been used in bad faith. Policy ¶ 4(b). Respondent is offering the Domain Name for sale with a “minimum offer” price of \$40,000. Panels have found that a respondent’s attempt to sell a domain for an amount that exceeds its out-of-pockets costs to acquire the domain is evidence of bad faith registration and use under Policy ¶ 4(b)(i).

[ii.] Further, Respondent acquired the Domain Name without any bona fide basis for such registration in an attempt to capitalize unfairly on the goodwill of Complainant’s SOG Marks. Prior panels have held that bad faith is found if it is unlikely that the registrant would have selected the relevant domain name without knowing of the reputation of the trademark in question. Respondent is and has historically used the Domain Name to resolve to content that incorporates Complainant’s SOG Marks. Such conduct indicates that Respondent had actual knowledge of Complainant’s SOG Marks at the time it acquired the Domain Name.

[iii.] Complainant enjoys exclusive rights in the SOG Marks by virtue of its registrations for the marks and/or its long-term, widespread and prominent control over use of those marks. Complainant has never consented to

Respondent's registration of the SOG Marks as part of the Domain Name, nor has Complainant ever granted any of its rights to Respondent. Complainant's SOG and SOG SPECIALTY KNIVES trademarks had been in use for at least 20 years at the time Respondent acquired the Domain Name. In light of the fame and notoriety of Complainant's SOG Marks, it is inconceivable that Respondent could have acquired the Domain Name without actual knowledge of Complainant's rights in the SOG Marks, which constitutes evidence of bad faith under Policy ¶ 4(a)(iii).

[iv.] Simply by using the Domain Name with Complainant's SOG and SOG SPECIALTY KNIVES trademarks, Respondent makes prominent trademark use of the SOG Marks without authorization from Complainant. This use creates the false impression that the links and information provided on Respondent's website are sponsored or endorsed by Complainant.

[v.] As noted above, Respondent has used and is currently using the Domain Name to resolve to a pay-per-click website from which it derives revenue through Internet advertising. Complainant submits that the revenue derived from such advertising is one of the primary reasons Respondent registered and was using the Domain Name—to ride freely on the goodwill associated with Complainant's SOG Marks. Such use constitutes bad faith use and registration on the part of Respondent. *See Hess Corporation, supra.*

[vi.] Moreover, Respondent has never used the Domain Name to resolve to any active content. Respondent's failure to use the Domain Name is further "evidence of bad faith registration and use pursuant to Policy ¶ 4(a)(iii)." *State Farm Mut. Auto. Ins. Co. v. Anderson*, FA 1613011 (FORUM May 21, 2015); *see also Boch Imports, Inc. and Boch Imports West, Inc. and Boch New To You, Inc. v. Westboro Motors, Inc.*, FA1002001308051 (FORUM April 6, 2010)(finding that failure to make active use of the disputed domain name is

passive holding and supports a finding of bad faith registration and use under Policy ¶ 4(a)(iii); *DCI S.A. v. Link Commercial Corp.*, D2000-1232 (WIPO Dec. 7, 2000) (concluding that Respondent's [failure to make an active use] of the domain name satisfies the requirement of ¶ 4(a)(iii) of the Policy).

[vii.] Therefore, Respondent registered and is using the Domain Name in bad faith.

B. Respondent

RESPONSE TO FACTUAL AND LEGAL ALLEGATIONS MADE IN COMPLAINT

Introduction

1. The Disputed Domain Name, SOG.COM consists of three letters of the Latin alphabet, which is the most widely adopted writing system in the world.
2. As will be further explained herein, it was purchased by Respondent over ten (10) years ago from the prior registrant.
3. Respondent is an investor in three-letter acronym domain names which are a valuable commodity, traded on a daily basis, as will be explained further herein.
4. Respondent purchased the Domain Name along with nearly a hundred other comparable three-letter domain names during the months preceding and subsequent to Respondent's registration of the Domain Name.

5. The sole reason that Respondent registered the Domain Name was because of its value as a three-letter acronym and not because of Complainant or its trademarks.

6. The Domain Name is comprised of a widely used three-letter acronym and is capable of adoption by innumerable existing and newly formed parties all over the world, who have no connection at all with Complainant or its goods and services.

7. Numerous persons over the years have made offers to purchase the Domain Name, as will be shown herein.

8. In fact, one of these prospective purchasers was Complainant itself, as will be shown herein, although this fact was not disclosed in the Complaint.

Respondent

9. Respondent in this proceeding is Poise Media, Inc., a corporation incorporated on January 18, 2001 pursuant to the laws of New York.

10. Valeriy (Val) Katayev is the founder, sole officer, director, and shareholder of Poise Media, Inc. Val is a successful tech entrepreneur, investor and fund manager.

11. Respondent has been an investor in the technology field since 2001. It has focused on investment in early stage tech companies, investment in generic and descriptive domain names, and on development of various Internet websites.

12. Neither Respondent nor its principal has ever previously had a UDRP or cybersquatting lawsuit commenced against them.

The Domain Name Registration

13. Respondent purchased the Domain Name on or about February 28, 2007 – over ten (10) years ago - for the sum of USD \$33,146.85.

14. On or about March 1, 2007, Respondent became the duly recorded registrant of the Domain Name.

15. The Domain Name was purchased solely because it corresponded to a valuable generic three-letter acronym. At no time prior to its registration of the Domain Name had Respondent nor its principal ever heard of Complainant or its trademarks. At the time of registration, Respondent held the reasonable view that it was entitled to register the Domain Name because no one party had a monopoly on such a commonly used acronym.

16. NameBio, a publically accessible database of reported domain name sales, shows that 'three-letter .com acronym domain names' are particularly valuable and are bought and sold on a regular basis for amounts ranging from USD \$62,501.00 for cml.com on December 3, 2015, to USD \$2,890,000.00 for fly.com on April 4, 2017.

17. Respondent acquired numerous three-letter .com domain names over the course of the months preceding and following the acquisition of this particular Domain Name, thereby indicating that the Disputed Domain Name was not selected because of Complainant, but rather was selected merely because of its value as a common three-letter acronym .com domain name.

18. Respondent provided as many historical Whois reports as possible.

A Note About the 'SOG' Knife

19. Although it is not a material issue in this proceeding, it is nevertheless noteworthy that Complainant did not come up with "SOG" for knives. In fact, it appropriated 'SOG' as a knife-brand long after 'SOG knives' were created by another party entirely.

20. The "SOG knife" was "designed for and issued to covert Studies and Observations Group [SOG] personnel during the Vietnam War". The SOG Knife was designed by Benjamin Baker, the Deputy Chief of the U.S. Counterinsurgency Support Office (CISCO). The first contract was awarded to Japanese Trading Company Yohi Shokai prior to 1966. In 1986, Complainant marketed a replica knife very similar to the original SOG knife and named it as the "S1 Bowie".

21. This history was not mentioned by Complainant, but does add some interesting background to its SOG trademark, since from the Complaint alone one would be left with the incorrect impression that 'SOG' was a made-up and novel term for knives, rather than a descriptive reference to the "Special Operations Group" which invented the knife in the first place.

The Ubiquitous 'SOG' and 'sog' as an Acronym or Word

22. In any event, SOG doesn't only refer to a type of knife or even to Complainant's brand of knife. Not even close. In fact, the acronym, "SOG" is absolutely ubiquitous all over the world where Latin characters are used. A Google search for "sog" without reference to "knives" or "knife", reveals over 62 million references.

23. The following are just a sample of the innumerable uses of the SOG acronym, or the term, sog, by persons all over the world, which have absolutely nothing to do with Complainant or its knives. [Examples omitted]

24. There are also numerous SOG acronyms in addition to the ones shown above, as listed in AcronymFinder.com.

25. In addition, the word, “sog” is an actual word on its own, as shown in the Definition by Merriam-Webster Dictionary, and means ‘to soak’. It also refers to a “soft or marshy place” as set out in the Online Etymology Dictionary and is a recognized word in the game of Scrabble.

26. The WIPO Global Brand Database shows that there are numerous parties other than Complainant who have registered trademark rights for SOG, all over the world, ranging from Indonesia, to New Zealand, Czech, the Philippines, Europe, and WIPO International trademarks, for all manner of goods and services ranging from fans, motorhomes, toilet paper, retailing and wholesaling, medical invalid chairs, air purification, leather products, umbrellas and parasols, walking sticks, oil seals, hoses, polytetrafluorethylene products.

27. Accordingly, there are numerous parties, none of which have anything to do with Complainant, who would each likely be very happy to own SOG.COM, including but not limited to persons who wish to start a brand new business or new organization and want a short, easy-to-remember .com domain name, as will be shown below through purchase inquiries received from such parties.

28. Over the years numerous people have contacted Respondent and have tried to purchase the Domain Name.

29. For example, on April 16, 2015, Cody Keys contacted Respondent by email and advised that he wanted to purchase the Domain Name for a new start-up. Negotiations ensued and Cody ended offering USD \$30,000.00 but his offer was not accepted by Respondent.

30. October 5, 2011, a former soldier and operator of SYOPS.COM wanted to purchase the Domain Name for his company to use for a new gaming website. Respondent quoted him a price of \$79,000.

31. On January 8, 2017, a broker named Paul Haughney contacted Respondent and advised that he represented domain name investors, and offered to broker the sale of SOG.COM and QYN.COM to Western and/or Chinese investors for between \$15,000 and \$45,000 per domain name. Respondent was not interested so did not respond.

32. On January 23, 2008, another Broker from a leading domain name marketplace, Sedo.com, contacted Respondent on behalf of a client with an offer to purchase the Domain Name and negotiations ensued but Respondent did not accept the broker's highest offer of USD \$25,000, and indicated that he "paid more for it myself".

33. On March 12, 2017, Kianah Fisher emailed Respondent and advised that she was looking for a "short domain name to use for our new company" and expressed interest in purchasing the Domain Name.

34. And remarkably, on March 2, 2007 – over 10 years ago – Mr. Chris Cashbaugh, Marketing Director of Complainant itself, contacted Respondent and asked if Respondent would sell the Domain Name. Respondent did not respond, as Respondent had just purchased the Domain Name itself.

Nowhere in the Complaint was it disclosed that Complainant had previously tried to purchase the Domain Name from Respondent, and then waited 10 years to try a 'Plan B', namely this UDRP proceeding.

Respondent's Use of the Domain Name

35. Respondent's primary use of the Domain Name has been as part of its inventory of investment grade three-letter .com domain names, as set out above.

36. Although Respondent has over the years sold several of its Domain Names, thRespondent has not been quick to sell its Domain Names as it treats them as a long term investments and the prices have continued to rise.

37. To-date, the Domain Name has remained parked using a commercial domain name parking service which populates the Domain Name with advertising and which publically lists it as being for sale. At no time did Respondent ever target these advertisements to Complainant or its products. All of the ads were automatically selected by the parking service provider based upon its own algorithm. In fact, at all material times Respondent set the Domain Name's subjectmatter to "sports", with no intention at all of any ads coming up that related to knives.

38. The evidence from Screenshots.com, which contains archived screenshots of the website associated with the Domain Name, shows that over the years from 2008 to 2016, the advertisements did not relate to knives at all or only related to knives in small part. In fact advertisements were shown for adult content, gyms, sports, fundraising, and music, and videos.

39. In fact, a popular search term for people who visited the website, was for songs and videos, particularly Hindi ones, and as such the algorithm employed by the parking service showed ads for Hindi songs and music videos. It may be that “sog” was a misspelling of “song”.

40. Accordingly, although there were apparently inadvertent and unintentional instances of knife-related advertisements showing up, this was not the only type of ad, nor even the predominate type of ad that consistently showed up.

41. Moreover, there was absolutely no intention to show knife ads whatsoever, and Respondent adamantly denies that it would ever intentionally infringe upon a trademark or bring any such exposure against its valuable investment quality domain name. Accordingly, any objectionable use of the Domain Name in connection with the limited instances of knife related ads was purely unintentional and was corrected immediately upon the first notice of same, which was this UDRP proceeding. At no time prior did Complainant once complain about the advertisements and had it done so, Respondent would have immediately rectified same.

The Three-Part Test Under the UDRP

42. It has been confirmed over and over again, that the onus is on Complainant to prove each of the three elements set out in Paragraph 4(a) of the ICANN UDRP (*See, for example, Damon Hill Grand Prix Limited v. The New Group*, WIPO Case No. D2001-1362).

Part 1: “Confusing Similarity”

43. Respondent acknowledges that Complainant has two registered SOG trademarks and therefore meets the first part of the three-part UDRP test, but

that is of course, only the beginning of the inquiry required. As aforesaid, the domain name is clearly composed of a common acronym capable of numerous uses and Complainant has no entitlement to a monopoly.

Part 2: Legitimate Interest

44. In order for Complainant to meet this part of the three-part test, the Panel must find Respondent has “a total lack of any right or legitimate interest”, not merely that Complainant has a “better” right or legitimate interest. A finding that Complainant has a “better” legitimate interest is clearly insufficient.

45. Accordingly, if Respondent is able to show that it has a legitimate interest in the Domain Name, the Complaint must fail.

46. Time and time again, UDRP Panels have ruled in favor of respondents when it comes to domain names corresponding to three-letter acronyms which are widely used, particularly by domain name investors. As explained in *SK Lubricants Americas v. Andrea Sabatini, Webservice Limited*, WIPO Case No. D2015-1566), as early as the year 2000, it was decided in *Philippe Tenenhaus v. Telepathy, Inc.*, NAF Claim No. 94355, that the complainant trademark owner did not have exclusive rights to the acronym DAF, as many other parties also used it.

47. In 2002, in *Trans Continental Records, Inc v. Compana LLC*, WIPO Case No. D2002-0105 a further panel again held that the complainant had not established the lack of a right or legitimate interest in the acronym in the domain name <lfo.com>, although the complainant had a trademark for LFO.

48. In 2007, in *Franklin Mint Fed. Credit Union v. GNO, Inc.*, FA 860527 (FORUM Mar. 9, 2007) the Panel concluded that Respondent had rights or

legitimate interests in the <fmcu.com> domain name because it was a generic domain name reseller who owned numerous four-letter domain names.

49. In 2012, in *Electronic Arts Inc. v. Abstract Holdings International LTD / Sherene Blackett*, FA111100141590 (FORUM JAN. 5, 2012), it was held that the three-letter acronym 'ssx' is composed of common or generic letters and the complainant did not hold a monopoly over the term. The Panel found that the buying and selling of generic domain names is a bona fide offering of goods under Policy ¶ 4(c)(i).

50. Over the years, numerous panels have held that the registration of two, three, and four-letter domain names, even by domain name speculators, can constitute a "legitimate interest" as understood by the Policy.

51. In *CTV Inc. Murat Yikilmaz*, FA080401177671 (FORUM JUNE 10, 2008), it was held that, "*the three letters which constitute the essence of the <ctv.com> domain name are generic initials and in common use by many parties to identify many goods and services. Accordingly, Complainant does not have a monopoly on these terms on the Internet...*" Similarly in this situation involving SOG, Complainant has no monopoly since SOG is comprised of common letters not unique to Complainant.

52. As in *Louis Vuitton Malletier S.A. v. Manifest Information Services c/o Manifest Hostmaster*, FA0609000796276 (FORUM Nov. 10, 2006) domain names that include two, three, and four letters that lend themselves to any number of enterprises and things, are considered generic:

"Furthermore, the disputed domain name is comprised only of two letters, which in theory may stand for several different things, with the addition of a gTLD. As evidence for its assertion, Respondent includes a listing of

several other companies that hold a mark registration with the USPTO for the LV mark. *See Energy Source Inc. v. Your Energy Source*, FA 96364 (FORUM Feb. 9, 2001) (finding that Respondent has rights and legitimate interests in the domain name where Respondent has persuasively shown that the domain name is comprised of generic and/or descriptive terms and is not exclusively associated with Complainant's business)."

53. It has been long held that where a domain name is generic, the first person to register it in good faith is entitled to the domain name. This is considered a "*legitimate interest*". *See, for example, CRS Technology Corporation v. CondeNet*, FA0002000093547 (FORUM MARCH 29, 2000), *Spherion Corporation v. Neal Solomon*, FA0204000112454 (FORUM JULY 24, 2002), and *HP Hood LLC v. hood.com*, FA0408000313566 (FORUM NOV. 17, 2004)

54. It is therefore submitted that based upon substantial precedent under the UDRP, Respondent's interest in a generic three-letter domain name that is a common acronym, *gives rise to "a" right or legitimate interest*, and therefore this is sufficient to deny Complainant the transfer of the Domain Name to itself, as has been requested. To hold otherwise would be to eliminate the very legitimate and well-established free marketplace for generic and descriptive domain names, with no juristic reason for so doing.

55. Speculating and investing in generic and descriptive domain names is a legitimate and well-established business, and that in and of itself, may confer 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)."

51. The fact is that at the time of registration, Respondent not only had never heard of Complainant or its marks, but as in *Banca Monte dei Paschi di Siena S.p.A v. Charles Kirkpatrick*, WIPO Case No. D2008-0260 (mps.mobi), held the “reasonable view” that no one company could claim exclusive rights in the short three-letter acronym.

52. Lastly, it should be noted that Complainant makes several incorrect and self-serving allegations in its Complaint as regards ‘legitimate interest’ (at Paragraph 5(b)(i)). Complainant expressly alleged that ‘sog’ has no “independent dictionary meaning”, which is false. As shown above, there is in fact a dictionary meaning for the term, although it is not particularly common.

53. Complainant also falsely alleges that there was “*no reason*” to register the Domain Name ‘*except to trade off of the goodwill of Complainant*’. As shown above through abundant evidence, Complainant is not solely or even primarily associated with the acronym, “SOG”, and Respondent is in the business of investing in common three-letter acronyms. Accordingly, Complainant has not met its onus of proving that Respondent has no legitimate interest in the Domain Name.

Part 3: Good Faith Registration

54. Pursuant to the Policy, the Complaint must prove bad faith registration and bad faith use. These are two distinct concepts and are both integral to a finding of bad faith as understood by the Policy.

55. The fact that the subject Domain Name is composed solely of a common a three-letter acronym weighs heavily against a finding of bad faith registration. Absent direct proof that a generic domain name was registered

solely for the purpose of profiting from Complainant's trademark rights, there can be no finding of bad faith registration and use.

56. Within the context of UDRP decisions related specifically to three and four-letter domain names, the Panel in *Hydrologic Services, Inc. v. Name Delegation c/o Steven Sacks*, FA0605000707617 (FORUM JULY 14, 2006), held that absent direct evidence that Respondent registered the domain name *specifically* because of Complainant, bad faith will not be found to exist.

57. There is absolutely no evidence that Respondent registered the Domain Name to sell to Complainant or that its value was derived exclusively from the fame of Complainant's marks.

58. In fact, the evidence shows the exact opposite; that Respondent was actively engaged in acquiring nearly 100 three-letter acronym domain names over the months both prior to, corresponding to, and subsequent to the registration of the Disputed Domain Name, thereby demonstrating through independent corroborative evidence, that there was no apparent intention whatsoever, to register the Domain Name because of Complainant.

59. Moreover, despite making the bald allegation of "fame and notoriety" (as expressly claimed at Paragraph 5(c)(iii) of the Complaint), there is not an iota of evidence submitted to establish any such fame or notoriety whatsoever. There is absolutely no evidence that even suggests that SOG is famous or that the value of the Domain Name is derived exclusively, or even primarily, from Complainant's marks. In fact, the evidence of numerous third party offers, and the evidence of numerous third party uses, shows exactly opposite.

60. As for Complainant's other alternative self-serving allegation, that Respondent had "at least constructive knowledge", previous panels have found that actual knowledge of a complainant and its mark must exist for a finding of bad faith (*See; Way Int'l Inc. v. Peters*, D2003-0264; "As to constructive knowledge, the Panel takes the view that there is no place for such a concept under the Policy. The essence of the complaint is an allegation of bad faith, bad faith targeted at Complainant. For that bad faith to be present, the cybersquatter must have actual knowledge of the existence of Complainant, the trade mark owner"). Moreover, even if Respondent had constructive knowledge which is denied, that would not have prevented Respondent from registering the Domain Name in good faith since the Domain Name corresponded to such a common acronym, without any monopoly or fame held by Complainant.

61. The lack of any factual basis to the allegation of bad faith registration in this case, aside from Complainant's mere self-serving inferences, was similarly found in *TMG Technologie Management Gruppe Unternehmensberatung für Markt und Innovation GmbH v. Whois Privacy Protection Service, Inc.*, WIPO Case No. D2005-0161.

62. In the present case, Complainant even admits that it "*presumes*" bad faith registration (see Complaint at 5(b)(v)), since it has no direct evidence of registration in bad faith. This presumption however, is entirely unsupported and self-serving. The fact that the Domain Name was registered along with numerous similarly generic acronyms, demonstrates that there was likely no intent to register this particular Domain Name *because* of the existence of Complainant's trademark rights, but rather, the intention was purely to register generic domain names in good faith.

63. Complainant's reliance on the fact that Respondent had parked the Domain Name is insufficient, in and of itself, to warrant the transfer of the domain name for 'bad faith'. As shown above, the advertising that related to Complainant was inadvertent and appeared along with other totally unrelated advertising, thereby showing that it is unlikely that it was intentional. In any event, at most this would constitute only 'bad faith use', and not 'bad faith registration', since there is clear evidence of an intention to register a common three-letter domain name because it was a common acronym.

64. Lastly, the fact that Respondent had an automated and general 'for sale tag line' associated with the Domain Name, is not evidence of bad faith. If a registrant has a legitimate interest in a domain name, and indeed if it is in the business of investing in common three-letter acronyms as Respondent does in this case, the registrant 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). An offer to sell a domain name that a party otherwise has rights to, is not bad faith; rather, it is nothing more than a legitimate effort to sell property properly owned by the party (*See Personally Cool v. Name Administration*, FA1212001474325 (FORUM JAN 17, 2013)).

65. It has long been held that speculating in and trading in generic domain names can be perfectly permissible under the Policy (*See Audiopoint, Inc. v. eCorp*, D2001-0509 (WIPO June 14, 2001) and *also see; Havanna S.A. v. Brendhan Hight, Mdnh Inc.* WIPO Case No. D2010-1652. As held in *Allocation Network GmbH v. Steve Gregory*, WIPO Case No. D2000-0016, "such a practice 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)". Where as here, Respondent has proven that it is in the business of selling generic and descriptive domain names such as the Disputed Domain Name, a legitimate interest may be found since Complainant's arguments as

to a lack of a legitimate interest, will have been rebutted (*See; General Machine Prods Co. v. Prime Domains*, FA 92531 (FORUM Jan. 26, 2000)).

66. Moreover, at no time in the over 10 years that Respondent has owned the Domain Name, did Respondent even once solicit Complainant. Surely this indicates the implausibility of Complainant's contention that Respondent registered the Domain Name in bad faith to sell to Complainant.

67. In fact, *it was Complainant who solicited Respondent*, and Respondent did not even respond to the solicitation. Complainant tried to purchase the Domain Name and then brought this UDRP to try to get it for free as a "Plan B". Complainant thereby implicitly recognized that Respondent had rights in the Domain Name and therefore had a right to sell it. Had Complainant believed otherwise, it would not have tried to purchase the Domain Name, but would have merely offered to reimburse the registration fee.

68. Complainant's contumelious delay (i.e. over 10 years from the Domain Name registration date) raises the inference, to say the least, that Complainant 'was not confident in the merits of its claim' for entitlement to the Domain Name (*See; Vanguard Trademark Holdings USA LLC v. Nett Corp.*, (FORUM July 26, 2009); "if Complainant were confident in its allegation of bad faith registration of the domain name it would not have delayed so long in bringing this Complaint").

FINDINGS

Respondent, an investor in three-letter acronym domain names, purchased the Domain Name through his company, Poise Media, Inc., on February 28, 2007 for the sum of USD \$33,146.85, along with nearly a hundred other three-letter

domain names, during the months preceding and subsequent to Respondent's registration of the Domain Name.

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

It is common ground between the parties that the Domain Name is identical to Complainant's registered SOG Mark.

Paragraph 4(a)(i) of the Policy is satisfied.

Rights or Legitimate Interests

As referenced in the Panel's findings above, the evidence shows that Respondent purchased the Domain Name as an investment, through his company, Poise Media, Inc., on February 28, 2007 for the sum of USD \$33,146.85, along with nearly a hundred other three-letter domain names.

The Panel accepts Respondent's evidence that, prior to its registration of the Domain Name, neither Respondent, nor its principal, had ever heard of Complainant or its trademarks. At the time of registration, Respondent held the reasonable view that it was entitled to register the Domain Name because no one party had a monopoly on such a commonly used acronym.

Speculating in and trading in generic domain names can be a perfectly permissible and bona fide use under the Policy. The Panel finds that Complainant has not met its obligation of proving that Respondent has no legitimate interest in the Domain Name.

Complainant has not satisfied Paragraph 4(a)(ii) of the Policy.

Registration and Use in Bad Faith

The Policy requires Complainant to prove bad faith registration and use. Especially given that the Domain Name is composed solely of a common three-letter combination, absent direct proof that the generic Domain Name was registered solely for the purpose of profiting from Complainant's trademark rights, there can be no finding of bad faith registration and use. *See, e.g., Ultrafem, Inc. v. Warren Royal, supra.* Complainant has failed to make the required showing.

Complainant has not satisfied Paragraph 4(a)(iii) of the Policy.

DECISION

Having not established all three elements required under the ICANN Policy, the Panel concludes that relief shall be DENIED.

Accordingly, it is Ordered that the <sog.com> domain name REMAIN WITH Respondent.

A handwritten signature in black ink, appearing to read 'DK', is positioned above a horizontal line.

David L. Kreider, Esq.
Panelist

David L. Kreider as the Chair,
along with The Honourable Neil Anthony Brown QC
and Sandra J. Franklin, Panelists.

Dated: May 23, 2017