

ADMINISTRATIVE PANEL DECISION

Groupe BMTC Inc. v. Domain Admin, Whois Privacy Corp. / Star Access, Inc.
Case No. D2016-2610

1. The Parties

The Complainant is Groupe BMTC Inc. of Montréal, Québec, Canada, represented by Goudreau Gage Dubuc, Canada.

The Respondent is Domain Admin, Whois Privacy Corp. of Nassau, Bahamas, / Star Access, Inc. of Florida, United States of America (“United States”), represented by Muscovitch Law P.C., Canada.

2. The Domain Name and Registrar

The disputed domain name <economax.com> is registered with TLD Registrar Solutions Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 22, 2016. On December 23, 2016, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 27, 2017, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 4, 2017. In accordance with the Rules, paragraph 5, the due date for Response was January 24, 2017. The Response was filed with the Center on January 16, 2017.

The Center appointed Dr. Clive N.A. Trotman as the sole panelist in this matter on January 20, 2017. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the

Rules, paragraph 7.

An unsolicited Supplemental Filing from the Complainant, dated January 23, 2017, was sent to the Center on that date and forwarded to the Panel. The Panel issued Procedural Order No. 1 on January 26, 2017, granting the Respondent until February 2, 2017 to make any Supplemental Filing in response, after which no further Supplemental Filings would be accepted by the Panel. A Supplemental Filing from the Respondent was forwarded to the Panel on January 28, 2017.

4. Factual Background

The Complainant, Groupe BMTC Inc., also known as Brault & Martineau, was founded in the early 1960s and sells items including furniture, beds, appliances and electronic goods. The Complainant has stores in Quebec, Canada, variously branded as Brault & Martineau, Economax and Galerie du Sommeil.

The Complainant owns a number of trademarks including:

ECONOMAX and design, Canadian Intellectual Property Office (CIPO), filed September 17, 2014, registered October 23, 2015, registration number TMA918185;

ECONOMAX, CIPO, filed January 31, 2012, registered September 22, 2014, registration number TMA886339.

The Complainant has also owned the domain name <economax.biz> since February 28, 2012.

The Respondent Star Access, Inc. is a Florida Corporation that invests in saleable domain names, including expired domain names, as a business. The disputed domain name appears to have been created on April 7, 2003; its date of registration by the Respondent was contended by the Parties.

5. Parties' Contentions

A. Complainant

The Complainant's contentions include the following and refer initially to Whois Privacy Corp., as the Respondent.

The Complainant contends that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has not authorised the Respondent to use the Complainant's trademark or to register a domain name containing the trademark. The Respondent cannot satisfy any of the criteria in paragraph 4(c) of the Policy. The disputed domain name resolves to a website that provides pay-per-click links to competitors of the Complainant selling goods in the same field of business.

The Complainant further contends that the disputed domain name was registered in bad faith. The Complainant says or implies that the use of a proxy service, in circumstances intended to hide the identity of the true Respondent, may be evidence of registration in bad faith. Whois Privacy Corp., has been named as a respondent in approximately 87 previous UDRP cases and most have been decided against Whois Privacy Corp. which has engaged in a pattern of the registration of trademarks as domain names.

The Complainant says that the true date of transfer of the disputed domain name to the Respondent was around June 2015. Furthermore the Complainant contends that registration of a disputed domain name may be established retroactively following subsequent bad faith use. Paragraph 2 of the Rules requires a

registrant to warrant in effect that a domain name is not being registered or used in bad faith, and the Respondent did not comply with this requirement at the time of renewal. The Respondent's state of mind at the time of initial registration is not a consideration when there is subsequent use in bad faith.

The Complainant says both constructive and actual knowledge of the Complainant's trademarks by the Respondent should be inferred.

The Complainant contends that the disputed domain name is being used in bad faith.

The Complainant says the website of the disputed domain name displays links in connection with household furniture, household appliances, electronics, beds and mattresses, giving the confusing impression that it is related to and endorsed by the Complainant. The disputed domain name resolves to a parking page that capitalises on the Complainant's goodwill. The disputed domain name was registered and is being used by the Respondent for commercial purposes, or at least to disrupt the Complainant's activities.

The Complainant has cited a number of previous cases decided under the Policy that it considers to support its position, and has quoted extensively from the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0").

The Complainant requests the transfer of the disputed domain name.

B. Respondent

The Respondent's contentions include the following.

The Respondent identifies itself as Star Access, Inc., with an address in Florida, United States, and denies the Complaint. A Declaration under penalty of law for making false statements has been produced, signed by J. Ford as the President, Secretary and sole shareholder of the Star Access, Inc., dated January 13, 2017.

The Respondent contends that it has held the registration of the disputed domain name since May 19, 2008, compared with the Complainant's earliest trademark registration on September 22, 2014. The Respondent has produced a copy of an email receipt from SnapNames for the purchase of the disputed domain name, dated May 19, 2008, addressed to the email address "domainking@...". The Respondent says the business name "Domain Kingdom" was an unregistered name used by the Respondent for domain name registrations.

The Respondent contends that its ownership of the disputed domain name since May 19, 2008 has been continuous. It has produced in evidence a Whois record in respect of the disputed domain name dated June 2, 2008, in the name of Domain Kingdom with the same "domainking@..." email address, and a street address. A 2008 Star Access, Inc., official corporation annual report dated July 2, 2008 records the same street address and the name of J. Ford as Director.

The Respondent says the disputed domain name was acquired as a desirable and valuable domain name, being a contraction of the common words "economical" and "maximum", with a view to its development or sale. The Respondent has acquired other generic domain names, such as <elderlyjobs.com> and <yourphotogifts.com>. The Respondent says the disputed domain name was acquired at auction after having expired and has cited previous decisions under the Policy to the effect that in similar circumstances, "any trademark claim to the domain name was abandoned and that the domain name could be registered in good faith".

The Respondent says its advertising through the disputed domain name has never targeted the Complainant or any other company, trademark or industry. The Complainant only entered the marketplace in 2012. The Respondent's advertisements are placed by external algorithm without instruction from the Respondent and conflicted with the Complainant only from November 2016, but have now been disabled.

The Respondent contends that notwithstanding the Complainant's claimed first use of its design trademark in 2012, no evidence of common law trademark rights dating back to 2012 has been produced.

The Respondent denies that it is without rights or legitimate interests in the disputed domain name. The Respondent could not have required any authorisation from the Complainant in 2008, when the ECONOMAX brand did not exist and the Complainant had no rights in that trademark. Domain name registration is, in general terms, first come, first served.

The Respondent contends that its use of the disputed domain name for general advertising constitutes a legitimate interest. Furthermore the registration and sale of brandable domain names is legitimate and common.

The Respondent denies bad faith registration and use of the disputed domain name and denies that any change of ownership has occurred since May 19, 2008. The Respondent's use of privacy services has not been to hide or to hinder legal proceedings and is unexceptionable.

The Respondent disagrees with the Complainant's argument that any principle of retroactive registration in bad faith can be inferred and says the accepted principle is that bad faith must be shown both at the time of registration and subsequently.

The Respondent says the question of any warranty to the registrar by a registrant in the terms of paragraph 2 of the Policy is irrelevant because it is pursuant to a contract between the registrant and the registrar.

The Respondent has cited a number of previous cases decided under the Policy that it considers to support its position, and has quoted extensively from the WIPO Overview 2.0.

C. Complainant's Supplemental Filing

The Complainant says it is aware for the first time that the identity of the underlying Respondent is Star Access, Inc., (referred to as the Respondent below) and is thereby aware of new information.

The Complainant addresses the Respondent's assertion of a legitimate interest in the generic or descriptive disputed domain name for the purpose of development or sale, and says for its use to be *bona fide*, it must be used for generic purposes, whereas the trademark ECONOMAX is distinctive of the Complainant's business activities and not a generic term. Because the disputed domain name resolves to a parking page with links that include competitors of the Complainant, its use is not related to the generic meaning of "economax" and is not *bona fide*.

The Complainant says the Respondent has produced no evidence of any preparations to develop the disputed domain name for itself.

In terms of registration in bad faith, the Complainant says there is no evidence to support the Respondent's assertion that Domain Kingdom, as the registrant in May 2008, was an unregistered name used by the present registrant Star Access, Inc.

The Complainant contends that moving the disputed domain name between successive privacy services may constitute fresh registrations. A change of privacy service happened around February 2015, a transfer of name server occurred in June 2015, and the disputed domain name was last renewed in April 2016, these dates being after the Complainant's trademark was in use in Canada. In the absence of a proven connection between Domain Kingdom and Star Access Inc., transfer of the disputed domain name should be construed as having been in 2015. The Respondent did not comply with paragraph 2 of the Policy by verifying that it did not infringe any third-party rights. In certain circumstances, the renewal of a domain name has been held to be equivalent to a new registration for the purposes of registration in bad faith.

In respect of use in bad faith, the Complainant contends that the Respondent cannot absolve itself from responsibility for advertising placed on its website algorithmically. The Respondent's present undertaking to eliminate advertisements that conflict with the Complainant's business shows an ability to control the advertising content to some extent.

The Complainant has quoted further from previous decisions under the Policy in support of its position.

D. Respondent's Supplemental Filing

The Respondent records at length its objection to the Complainant's Supplemental Filing except insofar as it addressed the identity of the underlying registrant.

The Respondent contends in effect that its use of the email address for Domain Kingdom from May 19, 2008, and the sharing of the same corporate address by Domain Kingdom and Star Access, Inc., since May, 2008, are supportive of the Respondent having been the sole uninterrupted and beneficial owner of the disputed domain name throughout that period.

The Respondent says Domain Kingdom was an unregistered business name but that J. Ford has owned the disputed domain name continuously, either *via* his corporation or personally, since 2008.

The Respondent says there is no reason why it should not use and change privacy services, and has done so since well before the Complainant's trademark was first registered. A quotation by the Complainant from the WIPO Overview 2.0, to the effect that in certain circumstances a change of privacy service can constitute a new registration, is selective and omits immediate context referring to ownership by a single entity and the possible reason for the change.

The Respondent contends that the above are the only matters properly within the scope of the Complainant's Supplemental Filing.

The Respondent has quoted further from previous decisions under the Policy in support of its position.

6. Discussion and Findings

A. Procedural Matters

Paragraph 4(a) of the Policy states that the Respondent is required to submit to a mandatory administrative proceeding in the event that the Complainant asserts to the applicable dispute-resolution provider, in compliance with the Rules, that:

“(i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) you have no rights or legitimate interests in respect of the domain name; and

(iii) your domain name has been registered and is being used in bad faith”.

The Complainant has made the relevant assertions as required by the Policy. The dispute is properly within the scope of the Policy and the Panel has jurisdiction to decide the dispute.

A privacy service was initially named as the Respondent by the Complainant. It is noted that the communication from the Registrar on December 27, 2016 in reply to the Center's verification enquiry of December 23, 2016, did not disclose an underlying registrant. The underlying registrant has, however, responded with its name, Star Access, Inc., and contact details. The intituling of the Decision has been amended accordingly. References henceforth to the Respondent are to Star Access, Inc.

Having read the Complainant, the Response, and all annexes, the Panel did not find any need to call for further information from the Parties. Nevertheless an unsolicited Supplemental Filing was received from the Complainant. Proceedings under the Policy are expected to be conducted expeditiously in accordance with paragraph 10(c) of the Rules. As the distinguished panelist stated in the decision in *Grove Broadcasting Co. Ltd v. Telesystems Communications Limited*, WIPO Case No. D2000-0703: “A Complainant should “get it right” the first time and should have provided all the information necessary to prove its case from the material contained in the Complaint and its annexes alone. There is no right of reply under the Rules.”

Exceptionally, the Panel decided to admit the Complainant’s Supplemental Filing in this instance, principally because the Complainant said it had not previously been appraised of the true identity of the Respondent and had directed its Complaint against a privacy service. In the interests of natural justice the Respondent was invited to submit a Supplemental Filing.

B. Identical or Confusingly Similar

The Panel is satisfied by the evidence that the Complainant has rights under the Policy in the trademark ECONOMAX. It is no consequence as to whether the disputed domain name may have predated the Complainant’s rights since paragraph 4(a)(i) of the Policy is stated in the present tense.

The disputed domain name is <economax.com>, of which the generic Top-Level Domain (“gTLD”) designation “.com” may be disregarded in the determination of confusing similarity. The remainder of the disputed domain name, “economax”, is identical to the Complainant’s trademark ECONOMAX and accordingly the Panel finds for the Complainant in the terms of paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

The Complainant states a *prima facie* case to the effect that the Respondent has no rights or legitimate interests in respect of the disputed domain name; has not been authorised to use the Complainant’s trademark or to register a domain name containing the trademark; and cannot satisfy any of the provisions contained in paragraph 4(c) of the Policy.

Paragraph 4(c) of the Policy provides for the Respondent to contest the Complainant’s *prima facie* case under paragraph 4(a)(ii) of the Policy and to establish rights or legitimate interests in a disputed domain name by demonstrating, without limitation:

- “(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue”.

According to the evidence and the Respondent’s statements, the disputed domain name may be developed in the future by the Respondent, is available for sale, and has been used for the purpose of pay-per-click advertising that was recently suspended in reaction to the Complaint. The Respondent asserts that its acquisition of the disputed domain name was legitimate at a time when it was not in conflict with the Complainant’s trademark and that its current modes of use are *bona fide*. Noting the Panel’s findings under the following element, the Panel finds it unnecessary to make a finding on the question of the Respondent’s possible rights or legitimate interests.

D. Registered and Used in Bad Faith

The Complainant must prove under paragraph 4(a)(iii) of the Policy that the disputed domain name has been registered and is being used in bad faith. The Panel applies the conjunctive interpretation to this requirement, that is to say, registration in bad faith and use in bad faith must each be proven.

Although previous decisions under the Policy do not have precedential status *per se*, a principle widely adopted by panels, as summarised in WIPO Overview 2.0 at paragraph 3.1, is that “when a domain name is registered by the respondent before the complainant’s relied-upon trademark right is shown to have been first established (whether on a registered or unregistered basis), the registration of the domain name would not have been in bad faith because the registrant could not have contemplated the complainant’s then non-existent right”. There may be exceptions where, for instance, a respondent was in a privileged position to anticipate the impending registration of a trademark.

The earliest filing of the Complainant’s trademark was on January 31, 2012 and the earliest date of its registration was September 22, 2014. The effective registration date of the disputed domain name by the Respondent is in contention. The Respondent says it was acquired and registered on May 19, 2008, which would have been more than three years before the Complainant’s trademark was filed, whereas the Complainant says a change of privacy service around February 2015 and a transfer of name server in June 2015 indicate that the present Respondent became the registrant in 2015, well after the Complainant’s trademark was registered. The Complainant challenges the purported connection between the registrant of the disputed domain name on May 19, 2008 and the Respondent.

An examination of the available evidence reveals the following chronology.

Star Access, Inc., was founded in 1997. According to active links in the Sunbiz.org record of company details produced by the Respondent, the Star Access, Inc., Florida street address (“4300”) remained the same from 1997 until after its 2009 annual report, following which other Florida addresses were recorded until the present address was adopted in 2015. J. Ford was recorded as an officer of the company as from the 2004 annual report and has remained so continuously.

On May 19, 2008, the SnapNames receipt for transfer of the disputed domain name, produced in evidence, was addressed to a “domainking@...” email address. On June 2, 2008 a Whois record was sent to the same “domainking@...” email address, showing the May 19, 2008 update and naming the registrant, administrative and technical contacts as Domain Kingdom with the same “4300” street address as above. The Star Access, Inc., annual report for 2008 was signed by J. Ford as president and provided the same “4300” street address.

John Ford, in a Declaration dated January 13, 2017, made under penalty of law for making false statements, said Domain Kingdom was an unregistered business name used for the Whois record.

Upon weighing the evidence, the Panel finds it more probable than not that at all material times since May 19, 2008, J. Ford has been the guiding mind behind the ownership of the disputed domain name. Whilst a one-person company is a separate entity from the person, the Panel does not find, in this particular case, a sinister significance in J. Ford having chosen to register the disputed domain name through Domain Kingdom, an unregistered manifestation of Star Access, Inc. Neither does the Panel find any significance in the disputed domain name having been moved between privacy services or servers since May 19, 2008. As summarised in WIPO Overview 2.0 at paragraph 3.7, in part, “Panels have tended to the view that formal changes in registration data are not necessarily deemed to constitute a new registration where evidence clearly establishes an unbroken chain of underlying ownership by a single entity or within a genuine conglomerate, and it is clear that any change in Whois registrant data is not being made to conceal an underlying owner’s identity for the purpose of frustrating assessment of liability in relation to registration or use of the domain name”. The Panel finds, on the balance of probabilities, an unbroken chain of underlying ownership of the disputed domain name since May 19, 2008, under the ultimate control of J. Ford at all times, and can find no evidence that the Respondent, which submitted a prompt Response, has intended to

frustrate any proceedings.

The Complainant has cited certain previous decisions under the Policy in which bad faith registration was constructed retrospectively from a perception of subsequent use in bad faith. Notable and much debated cases include *Octogen Pharmacal Company, Inc. v. Domains By Proxy, Inc. / Rich Sanders and Octogen e-Solutions*, WIPO Case No. D2009-0786, commonly referred to as *Octogen*; and *City Views Limited v. Moniker Privacy Services / Xander, Jeduyu, ALGEBRALIVE*, WIPO Case No. D2009-0643, commonly referred to as *Mummygold*. There are other cases in which the concept of retrospective bad faith has been established on distinguishing facts, for instance *Rigol Technologies, Inc. v. John Brand*, WIPO Case No. D2012-1947.

The panelist in *Mummygold* said, among other things, “in this Panel’s view bad faith registration *can* occur without regard to the state of mind of the registrant at the time of registration, *if* the domain name is subsequently used to trade on the goodwill of the mark holder” (original emphasis) and, with reference to paragraph 2 of the Policy, said “If a party uses the domain name in the future so as to call into question the party’s compliance with the party’s representations and warranties, there may be retroactive bad faith registration”. The panel in *Octogen* supported an interpretation of paragraph 2 of the Policy as imposing upon registrants “a continuing duty to ensure that the domain name is not used in violation of another’s rights”, and supported the concept of retroactive bad faith registration.

Whilst accepting that the facts surrounding the subsequent use of a domain name may give some indication of a registrant’s intentions at the time of registration, and often do, the Panel does not accept that registration in good faith at the time can be reversed with retroactive effect by unanticipated events at some future time. The conjunctive requirement under paragraph 4(a)(iii) of the Policy, that the disputed domain name “has been registered and is being used in bad faith”, is clear and the Panel has no authority to change the impact of the Policy from “and” to “or”. As the three-member panel said in *Mile, Inc. v. Michael Burg*, WIPO Case No. D2010-2011, “In company with other panels that have critiqued the *Mummygold/Octogen* decisions, this Panel is unwilling to overlook the plain language of paragraph 4(a)(iii) of the Policy requiring a conclusion that the domain name has been “registered” *and* “used” in bad faith. See, e.g., *Validas, LLC v. SMVS Consultancy Private Limited*, WIPO Case No. D2009-1413; *Eastman Sporto Group LLC v. Jim and Kenny*, WIPO Case No. D2009-1688. In the Panel’s opinion, reading “registered” as a continuous act that can be abused at any time would appear to make it essentially synonymous with “use” and deprive the conjunctive phrase of its full meaning” (original emphasis); and later, “The fact that so many panelists have declined to follow the *Mummygold/Octogen* approach argues against an emerging consensus to overturn a long-established doctrine and provides yet another reason for this Panel to decline to adopt the *Mummygold/Octogen* reasoning”.

The panel in *Eastman Sporto Group LLC v. Jim and Kenny*, WIPO Case No. D2009-1688, said: “As this Panel sees it, whether intended or not, the *Mummygold* approach could impact an otherwise settled rule of decision on which “all parties” have relied for a decade. That rule of decision moreover defines a fundamental element of the Policy, and departing from our precedent in this matter could modify substantially Complainant’s burden of proof, especially under the third element of the Policy. That change in some cases could be the equivalent of an amendment to the Policy, in effect comparable to substitution of “or” for “and” in paragraph 4(a)(iii), that would result in changes in some subsequent cases. As noted, if fully extended (assuming a complainant had proven the other elements of the Policy) it might result in transfer of a domain name without any action by its owner, simply because someone subsequently acquired or registered a trademark”.

The last sentence above is especially pertinent to the present case: it would be a surely unintended consequence if the registration of the Complainant’s trademark created a retrospective right in the disputed domain name. It is not beyond the bounds of possibility that the Complainant, when deciding to register <economax.biz> on February 28, 2012, would have sought <economax.com>, but found it taken.

In summary the Panel finds no evidence whatsoever that the Respondent’s acquisition of the disputed domain name, at auction after it lapsed, some years before the Complainant’s first registration of its

trademark, was other than in good faith at the time. Any construction to the effect that the Respondent first registered the disputed domain name in 2015, later than the Complainant's trademark, or at the time of last renewal, or any retroactive construction of registration in bad faith in this particular case, is rejected by the Panel as being contrary to the evidence.

The question of use of the disputed domain name in bad faith in need not be considered in this case.

7. Decision

For the foregoing reasons, the Complaint is denied.

Dr. Clive N.A. Trotman

Sole Panelist

Date: February 2, 2017