

ADMINISTRATIVE PANEL DECISION

We Sell Businesses, Inc. v. Paul Yates

Case No. D2013-0584

1. The Parties

The Complainant is We Sell Businesses, Inc. of Kent, Washington, United States of America, represented by Foster Pepper LLP, United States of America.

The Respondent is Paul Yates of Miami, Florida, United States of America.

2. The Domain Name and Registrar

The disputed domain name <wesellbusinesses.com> is registered with Network Solutions, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 31, 2013. On April 2, 2013, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 8, 2013, 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 for the Respondent.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), 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(a) and 4(a), the Center formally notified the Respondent on April 15, 2013, of the Complaint. The proceedings commenced on that day. In accordance with the Rules, paragraph 5(a), the due date for Response was May 5, 2013. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 7, 2013.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on May 14, 2013. 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.

4. Factual Background

The Complainant registered the domain name on or about June 10, 2000. Shortly after the Complainant's registration expired and the Respondent registered the disputed domain name in November 17, 2004. During November 2012, the Respondent subsequently renewed its registration. The registration will once again expire on December 1, 2013. A copy of the Whois record for this disputed domain name appears in Annex 1 to the Complaint.

A. Complainant's registered mark

The Complainant owns a United States trademark registration for the WE SELL BUSINE\$\$ES, in a stylized fashion. The Complainant has provided a copy of its registration certificate in Annex 4 to the Complaint. Pertinent details of this registration are as follows:

WE SELL BUSINE\$\$ES

United States registration No. 3,085,705

registered: April 25, 2006; filed (intent to use basis): November 12, 1997

This mark is registered for use in connection with: "Franchising, namely, offering technical assistance in the establishment and/or operation of business brokerages", in international class 35. The registration indicates that both first use of the mark in conjunction with these services and first use in commerce commenced as of December 9, 2005.

B. The parties' actions

The Respondent registered the disputed domain name after the Complainant's registration for the domain name lapsed. Apparently, the Complainant's web hosting service (BISC) failed to renew the registration in spite of the Complainant having timely paid an appropriate renewal fee to BISC on November 16, 2004.

On or about January 13, 2005, the Complainant offered to purchase the domain name from the Respondent for US D 500,-- a sum which then exceeded the Respondent's likely out-of-pocket expenses related to acquiring or maintaining the disputed domain name. The Respondent refused the offer but, in doing so, indicated that he had an interest in possibly using the disputed domain name in the field of brokering business and refused to specify a price -- presumably anticipating that the Complainant would increase its offer. Such a use would be directly competitive with the Complainant's activities and in conjunction with which it uses its registered mark. The Complainant refused to raise its offer. No further discussions occurred between the parties.

From at least November 20, 2007 through the present, the Respondent has not used the disputed domain name as either an address of an operating web site, as indicated appearing in Annex 5 to the Complaint by a hard-copy printout of an error message stating that a requested web page to which the disputed domain name should resolve is unavailable, or in any other way.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is identical or confusingly similar to its registered mark simply because the name WE SELL BUSINE\$\$ES substitutes two successive dollar signs (\$) for two successive standard letters "S" in the mark. As a dollar sign is not a permitted character in a domain name, the Complainant views the disputed domain name as being identical to its mark.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that, for various reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

First, there is no evidence that the Respondent is either using or making demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. In that regard, the name does not resolve to an operational web site.

Second, the Respondent is not and has not been commonly known by the disputed domain name.

Lastly, the Respondent is not using the disputed domain name in either a fair use or a legitimate non-commercial manner.

(iii) Registered and Used in Bad Faith

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

Prior to registering the disputed domain name, the Respondent knew of the Complainant and the Complainant's ownership at the time of the name. Subsequently, when the Respondent renewed its registration, it also knew of the Complainant's registered mark.

The Complainant alleges that the Respondent's conduct violates paragraph 4(b)(ii) of the Policy which requires the Respondent to have engaged in a pattern of conduct which prevented the Complainant from reflecting its registered mark in a corresponding domain name. Specifically, the Respondent, having prior knowledge of the Complainant and having registered the disputed domain name and then renewing its registration, intentionally prevented the Complainant, since November 16, 2004, from reflecting its registered mark in a corresponding domain name. Further, the Respondent's acts of having registered the disputed domain name and then, some eight years later, renewing its registration constitute two separate acts that qualify as a requisite "pattern of conduct" under paragraph 4(b)(ii).

Moreover, the Complainant alleges that the Respondent, in having renewed its registration of the disputed domain name with knowledge of both the Complainant and its registered mark, primarily did so to disrupt the Complainant's business, particularly since the Respondent previously expressed his interest in using the disputed domain name in the same field of business as the Complainant, *i.e.* brokering of businesses, and thus one that directly competes with the Complainant. As such, the Complainant alleges that Respondent's conduct also violated paragraph 4(b)(iii) of the Policy.

B. Respondent

In view of the lack of a Response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed factual representations.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar, if not, for all practical purposes,

identical to the Complainant's registered mark.

From a simple comparison of the disputed domain name to the Complainant's registered mark, no doubt for this Panel exists that the disputed domain name is certainly confusingly similar and, in all practicality, identical to the Complainant's mark. The primary difference between the disputed domain name and the mark is the substitution of two standard letters "S" for two adjacent dollar signs in the mark to form the term "wesellbusinesses", along with, secondarily, appending the gTLD (generic Top Level Domain) ".com" to that term to form the disputed domain name, with the last addition being irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored. As domain names are prohibited from including a dollar sign character; the letter "S" is realistically as close a substitute for that character as can be used.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation, such as adding a short letter or number group, or even generic or highly descriptive words, or geographic identifiers, such as a country name, to a mark, is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Here, substituting two standard textual characters, specifically the letter "S", for two dollar signs in the manner which the Respondent did, to the Complainant's registered mark clearly resulted in such a minor variation. See, particularly *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703; *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099; *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008; *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072; *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505; *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265; *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878; *BlackRock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627; *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359; *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064; *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952; *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334; *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317; *SPX Corporation v. Hevun Diversified Corporation*, NAF Claim No. FA 791657; *Google Inc. v. Jennifer Burns*, NAF Claim No. FA 726096; *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766; *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531; *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411; *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824; *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836; *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491; *Lane-Labs USA, Inc. v. Powell Productions*, NAF Claim No. FA 155896; and particularly *Cable News Network LP, LLP v. Elie Khouri d/b/a Channel News Network et al.*, NAF Claim No. FA 117876.

Therefore, the Panel finds that the disputed domain name is confusingly similar, and, for all practical purposes, identical to the Complainant's registered mark as to cause confusion. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize the Complainant's registered mark nor

does the Complainant apparently have any relationship or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the Complainant's mark or one confusingly similar thereto in connection with the identical or even similar services to those currently provided by the Complainant, in circumstances as are present here, may violate the exclusive trademark rights now residing with the Complainant. See, e.g., *GM, National Westminster, Amy Stran v. EzDomainSearch.com, Juan Curtis*, WIPO Case No. D2011-1710; *Tommy Bahama, Space Needle, Oakley, Burberry, HRB Innovations Inc., Dreamworks, MySpace, Blackrock, F. Hoffmann-La Roche AG, National Football League, Toilets.com, Inc.*, and *Associated Bank*, all cited *supra*; also *Starline Publications, Inc. v. Unity*, WIPO Case No. D2008-1823; *GoDaddy.com, Inc., v. GoDaddysDomain.com, Clark Signs, Graham Clark*, WIPO Case No. D2007-0303; *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576; *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884; *The Cheesecake Factory Inc., Napster and Caesars Entertainment, Inc., supra*; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898; *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360; *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615; *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Claim No. FA 173362; *MPL Communications, Limited et al v. 1WebAddress.com*, NAF Claim No. FA 97092; *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Claim No. FA 95856; and *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374. Consequently, in this Panel's view, the Respondent could not legitimately acquire any public association between himself and the Complainant's mark or even any mark similar thereto, at least for the services provided by the Complainant under its mark.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by the disputed domain name or more generally the mark WE SELL BUSINE\$\$ES. Nor could the Respondent likely ever become commonly known by either the disputed domain name or the mark without infringing on the exclusive trademark rights of the Complainant. This is so in light of the Complainant's exclusive trademark rights which date back to November 12, 1997 (the filing date of the Complainant's intent to use trademark application which underlies its registered mark) – approximately seven years prior to when the Respondent registered the disputed domain name. See, e.g. *National Westminster, Tommy Bahama, Amy Stran, Space Needle, Oakley, Burberry, Starline Publications, HRB Innovations Inc., MySpace and Treeforms, Inc.*, all cited *supra*. Hence, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Additionally, the Respondent has not used the disputed domain name to resolve to any operational website since at least November 2007 – a time period now stretching to approximately 5 and a half years which, by its length, negates any credible belief that the Respondent has made any reasonable and demonstrable preparations to use the disputed domain name in the manner he intends. In fact, other than a statement of his general intention to use the disputed domain name in the same business field as the Complainant, there is no specific evidence delineating any such preparations. Hence, it is reasonable for the Panel to infer that the Respondent's actions have not progressed any farther to fruition than simply being a statement of intentions. Intentions, devoid of actual implementational efforts, fall short of satisfying the requirements of paragraph 4(c)(i) of the Policy.

Lastly, there are no facts of record that appear to qualify the Respondent's actions as satisfying paragraph 4(c)(iii) of the Policy through showing a legitimate noncommercial or fair use of the disputed domain name.

As such, based on the evidence before the Panel, the Respondent does not fall within any of paragraphs 4(c)(i)(iii) of the Policy.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) and 4(c) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

In the absence of any evidence to the contrary and more generally the lack of any response, it is quite reasonable for the Panel to infer that the Respondent was well aware of the Complainant and its reputation in late 2004, when he registered the disputed domain name.

Yet, in spite of that knowledge, the Respondent intentionally proceeded to register the disputed domain name in November 2004 for the express purpose of reselling it to the Complainant at an excessive price. The latter motive is particularly evident inasmuch as the Respondent rejected the Complainant's USD 500,-- offer for what can only be assumed to be a much higher offer -- one which never came. The Respondent passively held the disputed domain name ever since, now amounting to some 5 and a half years, with most likely a continuing expectation that the Complainant would eventually raise its offer to a sufficiently high amount. Furthermore, rather than letting the registration expire in December 2012, the Respondent, fully aware of the Complainant and its registered mark, nonetheless renewed its registration with, as the Panel infers, but one principal purpose in mind: continue to passively hold the disputed domain name in the expectation that the Complainant will eventually acquiesce and offer an acceptably high price for it.

If the Respondent held the disputed domain name for a long enough period of time, the Complainant would eventually pay enough money for the disputed domain name in order to finally secure rights to use the disputed domain name -- which, for all practical purposes, is identical to its registered mark, if only to prevent further disruption to its business by its otherwise persisting inability to reflect its mark in its domain name.

The Panel need not address whether the Respondent's actions here constitute a "pattern" sufficient to invoke paragraph 4(b)(ii) of the Policy, as the Panel finds that those actions certainly meet the requirements of paragraphs 4(b)(i) and 4(b)(iii) -- either one of which alone will suffice to show bad faith use and registration.

Hence, the Panel concludes that the Respondent violated the general bad faith provision of paragraphs 4(a)(iii) and 4(b) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant. The disputed domain name <wesellbusinesses.com> is ordered to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: May 28, 2013