

Research In Motion Limited v. DomainDoorman LLC / Pertshire Marketing, Ltd

Case No. D2009-0321

1. The Parties

The Complainant is Research In Motion Limited of Ontario, Canada, represented by Gowling Lafleur Henderson, LLP, Canada.

The Respondent is DomainDoorman LLC of Florida, United States of America.

As noted in Sections 3 and 4 below, the Registrar identified Pertshire Marketing, Ltd of Road Town, British Virgin Islands (an Overseas Territory of the United Kingdom of Great Britain and Northern Ireland) as the owner of the disputed domain names. However the Complainant declined to add the name of this party as a respondent or co-respondent.

2. The Domain Names and Registrar

The disputed domain names <bblackberry.com> and <blackberry.com> are registered with DomainDoorman, LLC.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 10, 2009. On March 11, 2009, the Center transmitted by email to DomainDoorman, LLC a request for registrar verification in connection with the disputed domain names. On March 11, 2009, DomainDoorman, LLC transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on March 16, 2009 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On March 30, 2009 the Complainant confirmed that it did not want to amend its Complaint as it was of the view that DomainDoorman, LLC was the proper Respondent in these proceedings. 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(a) and 4(a), the Center formally notified the Respondent and the Registrar-confirmed registrant of the Complaint, and the proceedings commenced on April 1, 2009. In accordance with the Rules, paragraph 5(a), the due date for Response was April 21, 2009. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 22, 2009.

The Center appointed John Swinson as the sole panelist in this matter on May 6, 2009. 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. The proper Respondent

As noted in paragraph 3 above, the Registrar sent an email to the Center stating that the true registrant of the disputed domain names was Pertshire Marketing, Ltd. The Center provided this information to the Complainant however the Complainant chose to continue these proceedings without amending the name of the Respondent. As the Complaint was not administratively deficient, the Center did not require the Complainant to amend the Complaint, and advised all parties that it took no particular position on what action should be taken by a complainant in these circumstances subject to the authority of the Panel to determine the proper Respondent.

The Complainant's reasons for declining to amend the Complaint were that:

- the Respondent was listed in the Whois information for the disputed domain names at the time proceedings were initiated (initiated meaning the time the Complaint was submitted);
- in accordance with the Policy and Rules, the proper Respondent is the domain name holder indicated in Whois information at the time the Complaint is filed;
- any change to registration details after the Complaint was filed should be questioned as contrary to the Policy;
- the Respondent had ample notice of the Complainant's dispute in light of a cease and desist letter which was sent to the Respondent; and
- amending complaints due to the use of a privacy or proxy registrant would unfairly cause the Complainant to incur additional expense.

The Center in any event prudently forwarded a copy of the Complaint to both the named Respondent, and Pertshire Marketing, Ltd, and no response was received by either party.

The Whois information provided by the Complainant demonstrates that the Respondent was the domain name holder at the time these proceedings were initiated. The Panels construe "initiated" in this context as being the time at which the Complainant filed its Complaint with the Center. However, at the time the proceedings were formally commenced and the Complaint notified to the parties by the Provider, and also at the time of writing this decision, the registrant details provided by the Registrar and available from the publicly accessible Whois service, lists Pertshire Marketing, Ltd as the registrant of the disputed domain names.

The Panel finds that the Complainant's election not to amend its Complaint to add "Pertshire Marketing, Ltd" as a respondent or co-respondent does not affect the administrative validity of the Complaint in the present case. The Panel is satisfied that the Complainant was entitled to rely on the Whois information at the time the Complaint was filed to identify the domain name holder, and the relevant entity at that time was the DomainDoorman LLC. However, the Center quite appropriately brought the identity of Pertshire Marketing, Ltd to the attention of the Complainant, who may for example have chosen to amend its substantive pleadings in light of this new information. The fact that the Complainant chose not to do so does not

render the Complaint administratively deficient, and the Complainant is clearly entitled to rely on the location of DomainDoorman LLC for mutual jurisdiction purposes should it choose to do so. See “mutual jurisdiction” as defined in the Rules. The Center correctly forwarded a copy of the Complaint to both DomainDoorman LLC and to Pertshire Marketing, Ltd. The latter therefore had a fair opportunity to participate in these proceedings if it had wished. See *Mrs. Eva Padberg v. Eurobox Ltd.*, [WIPO Case No. D2007-1886](#). If a response had been received from either entity, the Panel would have considered it. As it was, no response was received. Although the Panel is satisfied that DomainDoorman LLC is in a formal sense the appropriate Respondent, the Panel also regards Pertshire Marketing, Ltd as a relevant Respondent in substance, and the Panel has accordingly included the latter in the present Decision.

5. Factual Background

The Complainant is a company which is listed on the Toronto Stock Exchange, with its headquarters in Ontario, Canada. The Complainant’s primary business involves developing wireless communication solutions. One of the Complainant’s most popular products is the BlackBerry smartphone.

The Complainant has registered a large number of trade marks around the world which consist of or include the word BLACKBERRY. Examples include Australian Trade Mark Registration No 801194 (BLACKBERRY), registered from July 22, 1999; United States Trade Mark Registration No. 2678454 (BLACKBERRY), registered from January 21, 2003 and Canadian Trade Mark Registration No. TMA554207 (BLACKBERRY), registered from November 21, 2001.

The Respondent is an ICANN accredited registrar, located in Florida.

The websites revolving from the disputed domain names contain sponsored listings provided by Google. Some links take a user to websites owned by the Complainant’s competitors (such as MOTOROLA). Other links redirect to the Complainant’s own official websites. The websites at the disputed domain names also provide a search function.

6. Parties’ Contentions

A. Complainant

The Complainant makes the following contentions:

The Complainant is a leading designer and manufacturer of innovative wireless solutions for the mobile telecommunications market.

The Complainant has developed and marketed a highly successful line of products, accessories and services in connection with the famous BLACKBERRY trade mark, including the famous BlackBerry smartphone. The BlackBerry smart phone is available on over 300 networks in over 100 countries, and the Complainant has spent hundreds of millions of U.S. dollars in promoting and advertising its BLACKBERRY trade marks. The Complainant’s BlackBerry products have received significant recognition in the media, and won numerous awards.

The Complainant owns over 1,500 trade mark registrations and applications throughout the world containing or comprised of the word BLACKBERRY. For example, the following registrations are all for the word mark BLACKBERRY:

- United States Trade Mark Registration No. 2672464, registered from January 7, 2003;
- United States Trade Mark Registration No. 2700671, registered from March 25, 2003;
- United States Trade Mark Registration No. 2678454, registered from January 21, 2003;
- Canadian Trade Mark Registration No. TMA638068, registered from April 21, 2006;
- Canadian Trade Mark Registration No. TMA554207, registered from November 21, 2001.

The BlackBerry brand was rated at number 51 in the Top 100 Global Brands ranking (by BrandZ); ranked the 73rd most valuable brand in the world by Interbrand's Best Global Brands 2008; and ranked the number 1 brand in Interbrand's Best Canadian Brands 2008. The BLACKBERRY trade marks enjoy widespread recognition, have generated significant goodwill and as a result of extensive use and publicity, have become famous.

The Complainant is a very successful company. For example, it generated revenues in excess of USD 6 billion for the year ending March 2008, and had a subscriber account base of over USD 21 million in 2009.

The Complainant has also registered and used <blackberry.com> and <shopblackberry.com> as its primary websites for information on BlackBerry products.

It is well established that typosquatting constitutes *prima facie* evidence of confusion. The disputed domain names constitute an intentional misspelling of the famous BLACKBERRY trade marks. The Respondent has added an extra "b" at the front of one domain name, and an extra "e" in the other domain name. Apart from these additional letters, the disputed domain names are visually and phonetically identical to the BLACKBERRY marks. The disputed domain names are therefore confusingly similar to the Complainant's trade marks.

A party cannot claim legitimate interest in a domain name that contains or is confusing with a person's trade mark, as the activities of such a party cannot be said to constitute a *bona fide* offering of goods or services. Use which intentionally trades on the fame of another cannot constitute a *bona fide* offering of goods or services. Diverting Internet traffic by way of typosquatting to a website offering sponsored links to competitors is *prima facie* evidence of no rights or legitimate interest. Further, directing a domain name that is confusing with a third party trade mark to a pay-per-click site does not constitute *bona fide* use of the domain name.

There is no evidence that the Respondent has ever used, or taken demonstrable preparations to use, the disputed domain names in connection with a *bona fide* offering of goods and services. There has never been a relationship between the Complainant and the Respondent. The Respondent has not been licensed or authorised to register or use the BLACKBERRY trade marks in any manner whatsoever. There is also no evidence that the Respondent has been commonly known by the disputed domain names, or that the Respondent is making or intends to make a legitimate noncommercial or fair use of the disputed domain names.

The Respondent registered the <bblackberry.com> domain name on June 23, 2006 and the <blackbeerry.com> domain name on April 10, 2006. These domain names are nearly identical to the Complainant's famous BLACKBERRY trade marks. The disputed domain names resolve to pay-per-click websites displaying links to websites of the Complainant's competitors, such as MOTOROLA, NOKIA, LG and SAMSUNG. The websites from the disputed domain names also provided a search feature, where a user could search for links to competitive websites. Such use has allowed the Respondent to reap a commercial benefit from creating a likelihood of confusion, and amounts to bad faith.

The Respondent did not reply to the Complainant's cease and desist letter (sent on October 7, 2008), although the Whois information for the disputed domain names was altered shortly after the letter was sent. The Respondent has also engaged in typosquatting, which is evidence of bad faith. Bad faith can also be evidenced from surrounding circumstances, such as the Respondent's actual or constructive knowledge of the Complainant's rights in a domain name (which can be inferred from the fame of the BLACKBERRY marks and the intentional misspelling of BLACKBERRY in the disputed domain names).

The Respondent registered the disputed domain names for the purpose of disrupting the business of the Complainant. The Respondent does not need to be a direct competitor - it is sufficient that the Respondent is providing a means for Internet users to access links to businesses that compete with or rival the Complainant.

The Respondent also registered the disputed domain names in an attempt to attract for commercial gain, Internet users to its websites by creating a likelihood of confusion with the Complainant as to source or sponsorship.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

7. Discussion and Findings

Paragraph 4(a) of the Policy provides that a complainant must prove each of the following:

- (i) that the disputed domain name are identical or confusingly similar to a trademark or a service mark in which the complainant has rights; and
- (ii) that the respondent has no rights or legitimate interests in the disputed domain name; and
- (iii) that the disputed domain name have been registered and are being used in bad faith.

Paragraph 4(a) of the Policy also states that the burden of proof lies with the complainant to establish that all these three elements are satisfied, in relation to each disputed domain name.

A. Identical or Confusingly Similar

The Complainant has produced sufficient evidence to prove that it has registered trade mark rights in the BLACKBERRY trade mark both in the United States, Canada, and in many other countries around the world. The BLACKBERRY trade marks have been used by the Complainant in Canada and the United States for over ten years.

The Complainant's evidence also shows that BLACKBERRY is a well known and valuable brand. A large number of people throughout the world would be aware of the Complainant's trade mark rights, due to the popularity and widespread use of BlackBerry devices.

The Panel therefore finds that the Complainant has sufficient registered trade mark rights in BLACKBERRY, and that BLACKBERRY is a well known trade mark around the world.

When comparing the disputed domain names to the Complainant's BLACKBERRY trade mark, the disputed domain names only differ by the addition of one extra letter – an extra “b” in the case of <bblackberry.com>, and an extra “e” in the case of <blackberry.com>.

These additional letters constitute only a minor difference to the Complainant's trade mark. Slight changes in a well known trade mark or word are often found to be purposeful misspellings, “designed to take advantage of mistakes that consumers are likely to make when intending to enter Complainant's web site address” (see for example *Infospace.com, Inc. v. Registrar Administrator Lew Blank*, [WIPO Case No. D2000-0069](#)).

Accordingly, the Panel finds that the disputed domain names are confusingly similar to the Complainant's BLACKBERRY mark and the first element has been satisfied.

B. Rights or Legitimate Interests

To succeed on this element, a complainant must make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. If such a *prima facie* case is established, the respondent then has the burden of demonstrating rights or legitimate interests in the domain name. Paragraph 4(c) of the Policy lists three ways in which a respondent may demonstrate rights or legitimate interests.

In this case, the Panel can draw certain inferences from the Respondent's failure to submit a response.

The Panel is satisfied, based on the case record before it, that the Respondent is not commonly known by either of the disputed domain names, and has no trade mark or other rights in the terms “bblackberry” or “blackberry”. Nor has the Respondent been authorised or licensed by the Complainant to use these terms, or the Complainant's trade mark.

The websites operating from the disputed domain names contain a list of sponsored links which are provided by Google. In one instance when the Panel viewed the “bblackberry.com” and “blackberry.com” websites from Australia, the following links (among others) were displayed:

- Official BlackBerry Site (“AU.BlackBerry.com/storm”)
- New BlackBerry Bold (“AU.BlackBerry.com”)
- eBayOfficial Site (“ebay.com.au”)

Being sponsored advertisements, the majority of the links have an obvious connection to BlackBerry devices, wireless communications (including mobile phones), computers and IT services. There is also a section in each of the websites which contain links to related search

categories, including the categories of “Blackberry”, “Handheld organizer” and “Handheld software tools”. Some of these links ultimately lead to providers of other wireless products, such as MOTOROLA and NOKIA.

The Respondent’s websites also contains automatic pop-up advertising windows, and a search facility.

It is clear from the advertising content that the websites are being used commercially, and the owner of such websites would be receiving a commercial gain on a pay-per-click basis. The Panel considers that such use does not constitute a *bona fide* offering of goods and services, because the disputed domain names comprises a misspelling of the Complainant’s mark (and own domain name) and the names appear to be have been deliberately chosen to redirect Internet users away from the Complainant’s website. It is well established that such use cannot constitute a *bona fide* offering of goods of services, or a noncommercial or fair use under paragraph 4(c) (see *The Coryn Group, Inc., Apple Vacations West, Inc. v. V.S. International*, [WIPO Case No. D2003-0664](#)).

The Complainant has established a strong *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names and as the Respondent did not submit a response, it has been unable to rebut the *prima facie* case established by the Complainant.

The Panel therefore finds that the second element has been met.

C. Registered and Used in Bad Faith

Generally, it is not difficult to make a finding of bad faith under paragraph 4(b) of the Policy, in cases where there has been a purposeful misspelling of a well known brand, and where the website is used to promote goods and services of the complainant, and/or the complainant’s competitors. This is because, as in this case:

- the disputed domain names closely resemble a well known and long standing brand, so it is reasonable to assume that the Respondent was aware of the brand at the time of registering the disputes domain names (which occurred in 2006);
- the disputed domain names do not consist of an ordinary, dictionary word or phrase with any particular meaning, so it is unlikely that the Respondent chose the names without having regard to the Complainant’s trade marks;
- the minor difference between the spelling of the disputed domain names and the Complainant’s trade mark will cause confusion amongst Internet users regarding the source of the Respondent’s websites, or any affiliation that may exist. Users are likely to visit the Respondent’s websites, when they were intending to visit the Complainant’s official website. This generates additional traffic for the Respondent;
- if an Internet user does visit the Respondent’s website by mistake, they will view a large number of website links, which can potentially redirect them to websites belonging to the Complainant’s competitors. The Respondent meanwhile receives a commercial profit from users clicking on these third party links.

In the Panel's view, this is a clear case of the disputed domain names being registered and used in bad faith.

Both the Respondent and Pertshire Marketing, Ltd were made aware of the Complaint, and the Complainant's allegations of bad faith, and chose not to respond. The Panel finds that the disputed domain names were used, and are being used in bad faith, but cannot be sure which entity is actually responsible. This should not affect the finding of bad faith, as both the Respondent and Pertshire Marketing, Ltd were given the opportunity to participate in these proceedings.

The third element has been met.

8. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain names <bblackberry.com> and <blackberry.com> be transferred to the Complainant.

John Swinson
Sole Panelist

Dated: May 14, 2009