



NATIONAL ARBITRATION FORUM

DECISION

Vassilios Pantazopoulos v. Anthony Paolillo

Claim Number: FA1310001522817

PARTIES

Complainant is **Vassilios Pantazopoulos** (“Complainant”), represented by **Will Shanaberger**, Michigan, USA. Respondent is **Anthony Paolillo** (“Respondent”), represented by **Zak Muscovitch** of **The Muscovitch Law Firm**, Ontario, Canada.

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are <sellmyapp.com>, <sellmyapp.net>, <sellmyapplication.net>, and <sellmyapplication.org>, registered with GoDaddy.com, LLC.

PANEL

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

Kendall C. Reed has been appointed as the Chair of the three-member Panel along with The Honourable Neil Anthony Brown QC and David H. Bernstein as Panelists.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on October 3, 2013; the National Arbitration Forum received payment on October 3, 2013.

On October 4, 2013, GoDaddy.com, LLC confirmed by e-mail to the National Arbitration Forum that the <sellmyapp.com>, <sellmyapp.net>, <sellmyapplication.net>, and <sellmyapplication.org> domain names are registered with GoDaddy.com, LLC and that Respondent is the current registrant of the names. 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 October 9, 2013, the Forum served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of October 29, 2013 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@sellmyapp.com, postmaster@sellmyapp.net, postmaster@sellmyapplication.net, and postmaster@sellmyapplication.org. Also on October 9, 2013, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on October 29, 2013.

On November 11, 2013, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the National Arbitration Forum appointed David H. Bernstein, The Honourable Neil Anthony Brown QC, and Kendall C. Reed as Panelist.

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

PARTIES' CONTENTIONS

A. Complainant

Complainant sells and brokers the sale of various mobile software applications for third parties. Respondent also sells and brokers the sale of various mobile applications software for third parties.

On or about September 24, 2010, Complainant established and registered as a Massachusetts sole proprietorship under the trade name "sellmyapplication.com."

On or about October 14, 2010, Complainant launched its website under the domain name <sellmyapplication.com>.

On or about February 11, 2011, Complainant received consideration for the sale of goods and services through its website in the amount of \$9.99.

On or about July 6, 2012, Complainant filed an application for a trademark registration with the United States Patent and Trademark Office for the mark SELLMYAPPLICATION.COM in the amount of \$9.99.

On March 19, 2013, the United States Patent and Trademark issued a registration for the mark SELLMYAPPLICATION.COM (“Complainant’s Mark”).

On or about January 8, 2012, Respondent purchased the Disputed Domain Names <sellmyapp.com> and <sellmyapp.net>. Prior to Respondent’s purchase, the Disputed Domain Names <sellmyapp.com> and <sellmyapp.net> were not used by the original registrant thereof, and the Disputed Domain Name <sellmyapp.com> redirected to <godaddy.com>.

In March or April, 2012, Respondent launched its website under the Disputed Domain Name <sellmyapp.com>.

The website under Complainant’s domain name <sellmyapplication.com> and the website under the Dispute Domain Name <sellmyapp.com> have substantially the same look and feel, and Respondent’s website offers the exact goods and services offered on Complainant website.

On or about March 4, 2012, Complainant’s attorney sent to Respondent a Cease and Desist Demand. Respondent refused to comply with this demand, and thereafter, on or about April 8, 2012, Respondent offered to Complainant the right to purchase Respondent’s Disputed Domain Names. Further still, on or about October 4, 2013, and after Complainant filed the complaint in this instant

action, Respondent wrote to Complainant's attorney demanding that Complainant purchase Respondent's website.

Respondent's use of the Disputed Domain Names as stated misidentifies the origin of the service or products which Respondent is offering for sale and thereby creates the possibility of confusion for the consumer.

Further, Respondent's conduct makes it clear that Respondent acquired the Disputed Domain Names primarily for the purpose of selling or otherwise transferring them to the Complainant, the original owner of the trademark or service mark for consideration in excess of any costs directly related to Respondent's creation and/or use of such domains.

Further still, Respondent's conduct constitutes an attempt to attract, for commercial gain, Internet users to Respondent's offending website or other on-line location by creating a likelihood of confusion with the Complainant's serviced marks and website as to the source, sponsorship, allocation, or endorsement of Respondent's website or a product or service sold and/or offered at Respondent's website.

B. Respondent

Respondent is the owner and operator of the nearly two-year old web-based business known as SELLMYAPP.COM, which offers a venue for app developers to buy and sell their apps.

Respondent's business began on or about January 6, 2012 with the acquisition of the Disputed Domain Name <sellmyapp.com>. This Disputed Domain Name was originally registered on September 21, 2008 by a third party. Respondent

also registered the Disputed Domain Name <sellmyapp.net> on January 7, 2012. On January 6 and January 7, 2012, there were no trademarks registered for SELLMYAPP or anything similar in the United Patent and Trademark Office. On or about April 7, 2012, Respondent issued a press release announcing the launch of his business offering “iPhone and Android source code buyers and sellers to connect via a classified style website” [sic]. To date, Respondent’s business has enjoyed significant success, and has received widespread praise, significant media coverage, users, visits, and sales. Respondent’s business has been favorably profiled in <killerstartup.com> as a “marketplace for source code...where developers of iPhone, Android, and Blackberry application can easily sell their own work.” Respondents’ business has also been featured on the industry website <appversal.com>, which stated that, “SellMyApp” is another popular mobile source code marketplace...”, and on <consolebit.com> where it was said that Respondent’s website is an “an awesome concept and a great way to get into the mobile app market.”

Respondent enjoys substantial web traffic, experiencing 31,348 unique website visits in the first seven months of 2013 and hundreds of daily visitors. Respondent’s business has achieved 3,325 registered users, over 207 app code sales, and sales totaling \$12,385.88 for the seven (7) months preceding the filing of the response. As such, Respondent has at all times had rights and legitimate interests with respect to the Disputed Domain Names.

At all times Respondent has been motivated only by a desire to operate a web-based business, without any intent to infringe upon Complainant’s Trademark, deceive consumers, or sell the Disputed Domain Names to the Complainant.

As a threshold consideration, Complainant does not possess trademark rights that can extend to the Disputed Domain Names <sellmyapp.com> and

<sellmyapp.net>. The words that make up these Domain Names are words of common usage that are being used by Respondent in their descriptive sense. In any event, the noted Disputed Domain Names are not in fact the same as Complainant's Trademark because the former includes only the term "app" and the latter includes the term "application." This is a dispositive distinction in the context of domain names as the public is accustomed to the significance of minor variations give the practical need for brevity with respect to domain names.

Also, Complainant cannot assert Complainant's Trademark against Respondent pursuant to the Policy because as of the dates on which Respondent registered the Disputed Domain Names **<sellmyapp.com>** and **<sellmyapp.net>** there was no then-existing trademark registration issued by the USPTO or an application pending before the USPTO for marks similar to these Disputed Domain Names. As such, Complainant cannot demonstrate that the Disputed Domain Names are identical or confusingly similar to Complainant's Mark. However, for purposes of this proceeding Respondent acknowledges that the Disputed Domain Names **<sellmyapplication.net>** and **<sellmyapplication.org>** are nearly identical to Complaint's Trademark.

With respect to Complainant's argument that the look and feel of Respondent's website is similar to the look and feel of Complainant's website, Respondent points out that Respondent's website was constructed using a WordPress template ("ClassiPress") that is owned and controlled by WordPress and is available to the general public without restriction. Respondent had no intention to copy the look and feel of Complainant's website.

Respondent did offer to sell the Disputed Domain Names to Complainant, but this was in the context of an offer to sell his entire internet business associated therewith and not was not in any sense in an effort to sell the Disputed Domain

Names for a sum in excess of his out-of-pocket costs as contemplated by the Policy.

The Respondent argued that the Panel should dispose of this matter by refusing to act. Complainant is asserting in this administrative forum claims that are in essence a trademark and unfair competition disputes. This is not the purpose of the Policy, which is intended only as a practical means to deal with the limited circumstances of abusive, bad faith cybersquatting, which is not the case here.

FINDINGS

On or about October 14, 2010, Complainant launched its website under the domain name <sellmyapplication.com>.

On or about February 11, 2011, Complainant received consideration for the sale of goods and services related to the SELLMYAPPLICATION.COM trademark/service mark in the amount of \$9.99.

On July 6, 2012, Complainant filed a trademark application with the USPTO for the mark SELLMYAPPLICATION.COM. On March 19, 2013 a trademark registration was issued thereon.

On December 18, 2009, the domain name <sellmyapp.com> was registered by a third party and was acquired by Respondent on or about January 8, 2012.

On or about January 8, 2012, Respondent registered the domain name <sellmyapp.net>.

On or about November 15, 2012, Respondent registered the domain names <sellmyapplication.net> and <sellmyapplication.org>.

For the first seven months of 2013 Respondent website to which the Disputed Domain Name <sellmyapp.com> points experienced 31,348 unique website visits, 3,325 registered users, over 207 app code sales, and sales totaling \$12,385.88 for the seven (7) months preceding the filing of the response.

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.

Preliminary Issue

Respondent asserts that the Panel should not act on Complainant's complaint because the central features of the dispute are claims for trademark infringement and unfair competition, which are issues outside of the scope of the Policy and beyond the practical capacity of this Panel in this summary administrative format.

The Panel agrees that the scope of the Policy is limited; however, the Panel believes that it should act if it can do so within the scope of the Policy,

notwithstanding that the facts as alleged might also give rise to claims of copyright infringement and/or unfair competition.

In the present matter the Panel can render an award pursuant to and within the boundaries of the Policy.

Identical and/or Confusingly Similar

In order for a complainant to establish the first element of the Policy, she or he must demonstrate and establish that it has rights in a trademark and that the disputed domain names are either identical or confusingly similar thereto.

Trademark rights can be established by demonstrating ownership of a trademark registration issued by a national trademark office, including, but not limited to, the USPTO. *See Miller Brewing Company v. Miller Family*, FA 104177 (Nat. Arb. Forum April 15, 2010) (finding that the complainant had established rights to the MILLER TIME mark through its federal trademark registration; *see also Townmaster, Inc. v. Hale*, FA 973506 (Nat. Arb. Forum June 4, 2007) (finding that “Complainant’s timely registration with the USPTO and subsequent use of the BIG TOW mark established rights in the mark pursuant to the Policy ¶ 4(a)(i).”).

Complainant has established that it is the owner of USPTO trademark (*e.g.*, Reg. No. 4,304,654 registered March 19, 2013). As such, Complainant has established rights in a mark for purposes of Policy ¶ 4(a)(i).

Complainant argues that it also acquired trademark rights in Complainant’s Trademark prior to issuance of the noted trademark registration as the result of its use of the trademark in commerce. This use consisted of launching a website under the domain name <sellmyapplication.com> on October 14, 2010 and

receiving consideration for the sale of goods and services through this website on February 11, 2010.

Trademark rights can be acquired for purposes of the Policy through use in commerce and without a trademark registration, and for rights to be established in this way a complainant must show the establishment of secondary meaning in the minds of the public. *See AOL LLC v. DiMarco*, FA 1275978 (Nat. Arb. Forum Sept. 9, 2009) (“Secondary meaning’ is acquired when ‘in the minds of the public,’ the primary significance of a product feature . . . is to identify the source of the product rather than the product itself.”).

Secondary meaning can be established by a complainant by submitting evidence of its continuous use of the mark for a period of time as well as evidence of the amount of revenue generated under the mark, the amount of resources spent marketing the mark, or the number of complainant’s customers. *See Quality Custom Cabinetry, Inc. v. Cabinet Wholesalers, Inc.*, FA 115349 (Nat. Arb. Forum Sept. 7, 2002) (finding that the complainant established common law rights in the mark through continuous use of the mark since 1995 for the purpose of Policy ¶ 4(a)(i)); *see also Mary’s Futons, Inc. v. Tex. Int’l Prop. Assocs.*, FA 1012059 (Nat. Arb. Forum Aug. 13, 2007) (“A common law trademark must be shown by evidence such as sales figures, advertising expenditure, [and] numbers of customers.”). Additionally, the amount of evidence necessary to establish secondary meaning is generally proportional to the strength of the involved mark, with more evidence being necessary when the involved mark is weak. *See, e.g., Chicago Rest. & Entm’t Guide, Inc. v. Polat*, FA 1310901 (Nat. Arb. Forum Apr. 22, 2010) (failing to find common law rights as “the claimed mark is comprised of two common and generic, descriptive or geographic terms, requiring very strong evidence in order to establish secondary meaning” and Complainant failed to provide the required evidence to show secondary meaning).

In the present matter, Complainant supports his claim for common law rights by way of its launch of its website on or about October 14, 2010 and receipt of consideration for the sale of goods and services on or about February 11, 2011, in the approximate amount of \$9.99.

The Panel finds that this showing is insufficient to establish common law trademark rights in Complainant's Mark. This showing does not address the amount of advertising expenditures, if any, sales other than a single minimal sale, or the numbers of customers. Further, as Complainant's Mark consists of common words used in a descriptive sense in accordance with the dictionary definitions thereof, and in this type of situation very strong evidence would be needed to establish the requisite secondary meaning, which Complainant has not shown. As such, Complainant's rights in a trademark are limited to the registered mark, the application for which was filed on July 6, 2012 and the registration for which issued on March 19, 2013.

For purposes of Policy ¶ 4(a)(i), the question of whether a domain name is identical to a trademark is determined by a simple comparison between the two, while ignoring the generic top-level domain ("gTLD") contained within the involved domain name. *See Islewoth Land Co. v. Lost in Space, SA*, FA 117330 (Nat. Arb. Forum Sept. 2, 2002) ("[It is a well-established principle that generic top-level domains are irrelevant when conducting a policy 4(a)(i) analysis.>").

In the present matter the Panel has no difficulty finding that the Domain Names <sellmyapplication.net> and <sellmyapplication.org> are identical to Complainant's Trademark SELLMYAPPLICTION.COM, and Respondent so stipulated in his response.

The question of whether a domain name is confusing similar to, as opposed identical to, a trademark is also determined by making a comparison, but the comparison does not require a one-to-one correspondence. Confusingly similar can be found in situations in which the domain name abbreviates a word found in the mark. *See, e.g., Microsoft Corp. v. Montrose Corp.*, D2000-1568 (WIPO Jan. 25, 2001) (finding the domain name <ms-office-2000.com> to be confusingly similar even though the mark MICROSOFT is abbreviated).

In the present matter Respondent uses the expression “app,” which is commonly understood as an abbreviation for the word “application,” and as such the Panel finds that the Disputed Domain Names that employ the expression “app” are confusingly similar to Complainant’s Trademark.

Respondent argues that the first element of the Policy cannot be established in the present matter because Complainant’s Mark did not exist at the time Respondent registered the Disputed Domain Names; however, the Panel finds that this is not a relevant consideration under Policy ¶ 4(a)(i), although it can be for relevant purposes of analyzing the issue of bad faith under Policy ¶ 4(b). *See AB Svenska Spel v. Zacharov*, D2003-0527 (WIPO Oct. 2, 2003) (holding that the UDRP does not require a complainant to have registered its trademark prior to the respondent’s registration of the domain name under Policy ¶ 4(a)(i) but may prevent a finding of bad faith under Policy ¶ 4(a)(iii)); *see also Clear!Blue Holdings, L.L.C. v. NaviSite, Inc.*, FA 888071 (Nat. Arb. Forum Mar. 5, 2007) (“Although the domain name in dispute was first registered in 1996, four years before Complainant’s alleged first use of the mark, the Panel finds that Complainant can still establish rights in the CLEAR BLUE marks under Policy ¶ 4(a)(i).”).

As such, Complainant does establish the first element of the Policy.

Rights or Legitimate Interests

Pursuant to Policy ¶ 4(a)(ii) Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name, and then the burden shifts to Respondent to show it does have rights or legitimate interests. See *Hanna-Barbera Prods., Inc. v. Entm't Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006) (holding that the complainant must first make a *prima facie* case that the respondent lacks rights and legitimate interests in the disputed domain name under UDRP ¶ 4(a)(ii) before the burden shifts to the respondent to show that it does have rights or legitimate interests in a domain name); see also *AOL LLC v. Gerberg*, FA 780200 (Nat. Arb. Forum Sept. 25, 2006) (“Complainant must first make a prima facie showing that Respondent does not have rights or legitimate interest in the subject domain names, which burden is light. If Complainant satisfies its burden, then the burden shifts to Respondent to show that it does have rights or legitimate interests in the subject domain names.”).

In the present matter Complainant has failed to carry its burden.

Complainant raises the issue that Respondent has not been known by the Disputed Domain Name <sellmyapplication.com>; however Complainant raises this issue only on the basis of “information and belief” and says nothing more about the subject.

Respondent asserts that it has been commonly known by the Disputed Domain Name <sellmyapp.com> for purposes of the Policy. To support this assertion the Respondent points to its website, the noted press coverage, the noted hit totals, and the noted revenue figures.

The Panel finds that such uses are sufficient to establish that Respondent is commonly known as SellMyApp. *See, e.g., VeriSign Inc. v. VeneSign C.A.*, D2000-0303 (WIPO June 28, 2000) (finding that the respondent has rights and a legitimate interest in the domain name since the domain name reflects the respondent's company name); *see also Am. Express Mktg. v. Planet Amex*, FA 1395159 (Nat. Arb. Forum Jan. 6, 2012) (finding that the continuous operation of a commercial website along with undisputed evidence of significant viewership and advertising revenue, makes it reasonable to conclude as the Respondent contends, that the Respondent is known by the Domain Names and has a legitimate interest in them).

With respect to the two disputed domain Names <sellmyapplication.net> and <sellmyapplication.org>, the Panel has already found that for purposes of Policy 4(a) that "app" is an abbreviation for "application" and for purposes of this analysis are equivalent, and consequently the Panel finds that Respondent is also commonly known as SellMyApplication.

Complainant argues that Respondent does not have rights or legitimate interests in the Disputed Domain Names because Respondent is not using them in connection with a *bona fide* offering of goods or services under Policy ¶ 4(c)(i). Complainant argues that, in essence, Respondent's use constitutes a use in bad faith. The Panel believes that such issues are better analyzed separately under Policy ¶ 4(b), and for the reasons set forth below the Panel does not find bad faith conduct on the part of the Respondent.

As such, the Complainant does not establish the second elements of the Policy.

Registration and Use in Bad Faith

With respect to the two Disputed Domain Names <sellmyapp.com> and <sellmyapp.net>, the Panel does not find bad faith in the present matter because these Disputed Domain Names were filed on or about January 8, 2012, which was before the Complainant filed its trademark application on July 6, 2012; it is not generally possible for any respondent to have the requisite bad faith intention under Policy ¶ 4(b) at the moment in time he or she registers a domain name when the complaint does not then have rights in an identical or similar trademark. *See Aptus Tech L.L.C. v. Name Administration Inc. (BVI)*, FA 503000 (Nat. Arb. Forum July 17, 2013)(finding that when the disputed domain names were registered six years prior to the complaint acquiring registration of its mark, "...it is inconceivable that Respondent may be found to have registered the domain name in bad faith...because registrant could not have contemplated the complainant's then non-existent right."), *see also Interep Nat'l Radio Sales, Inc. v. Internet Domain Names, Inc.*, D2000-0174 (WIPO May 26, 2000) (finding no bad faith where the respondent registered the domain prior to the complainant's use of the mark).

The Panel notes that the two Disputed Domain Names <sellmyapplicaton.net> and <sellmyapplicaton.org> were registered by Respondent after the dispute between the parties commenced and after Complainant filed its trademark application on July 6, 2013; however, the Panel finds that Complainant has failed to establish that Respondent acted with bad faith as contemplated by Policy ¶ 4(b)(i) through (iv) with respect to these two Disputed Domain Names.

Accordingly, Complainant has not established the third element 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 <sellmyapp.com>, <sellmyapp.net>, <sellmyapplication.net>, and <sellmyapplication.org> domain names **REMAIN WITH** Respondent.



Kendall C. Reed, Esq.
Arbitrator

David H. Bernstein, The Honourable Neil Anthony Brown, QC, and
Kendall C. Reed Panelists
Dated: December 2, 2013