



NATIONAL ARBITRATION FORUM

DECISION

HAI Logan Gym, LLC v. Domain Manager / Affordable Webhosting, Inc., Advertising
Claim Number: FA1411001588715

PARTIES

Complainant is **HAI Logan Gym, LLC** (“Complainant”), represented by **Michael A. DiNardo** of **KELLY & KELLEY, LLP**, California, USA. Respondent is **Domain Manager / Affordable Webhosting, Inc., Advertising** (“Respondent”), represented by **Zak Muscovitch** of **The Muscovitch Law Firm**, Canada.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<kubex.com>**, registered with **Name.com, Inc.**

PANEL

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

Terry F. Peppard as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on November 5, 2014; the National Arbitration Forum received payment on November 5, 2014.

On November 6, 2014, Name.com, Inc. confirmed by e-mail to the National Arbitration Forum that the <kubex.com> domain name is registered with Name.com, Inc. and that Respondent is the current registrant of the name. Name.com, Inc. has verified that Respondent is bound by the Name.com, Inc. 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 November 7, 2014, the Forum served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of November 28, 2014 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@kubex.com. Also on November 7, 2014, 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 November 24, 2014.

An Additional Submission was received from Complainant on November 26, 2014, and deemed compliant.

An Additional Submission was received from Respondent on November 27, 2014, and deemed compliant.

On December 5, 2014, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Terry F. Peppard as sole Panelist in this proceeding.

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 name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

In its First Amended Complaint and Additional Submission, Complainant has alleged, among other things, that:

Complainant uses the KUBEX mark to market computer software and hardware as well as personal fitness and weight loss programs.

Complainant holds rights in the KUBEX trademark and service mark, which is registered with the United States Patent and Trademark Office ("USPTO") (Registry No. 4,573,170, registered July 22, 2014, application filed January 14, 2013, with a first use in commerce of August 1, 2013).

Respondent's <kubex.com> domain name is substantively identical to Complainant's KUBEX mark.

Respondent has not been commonly known by the <kubex.com> domain name.

Complainant has not authorized Respondent's use of the KUBEX mark.

The disputed domain name resolves to a website featuring a search engine and links to the websites of various unrelated businesses.

Respondent receives income from the operation of the hosted links.

Respondent's use of the domain name is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use.

Respondent has offered to sell the domain name to Complainant for the sum of \$100,000.00, an amount far in excess of its actual out-of-pocket costs to obtain and maintain the domain name.

Respondent has no rights to or legitimate interests in the domain name.

Respondent has held the domain name for twelve years without making any effort to put it to a legitimate use.

Respondent's only continuing enterprise is trafficking in domain names.

When registering contested the domain name, Respondent intended to sell it to a party with rights in the underlying mark for an amount far in excess of its out-of-pocket costs.

The search engine website resolving from the domain name produces results that offer goods and services sold in competition with Complainant's business.

Respondent has registered and uses the domain name in bad faith.

B. Respondent

In its Response to the First Amended Complaint and Additional Submission, Respondent has asserted, *inter alia*, the following:

Respondent is a dealer in generic non-infringing domain names.

Respondent registered the <kubex.com> domain name on May 21, 2002, which predates Complainant's first use of the KUBEX mark by eleven years.

Complainant came into existence as a limited liability company on April 2, 2012.

Domain names are registered on a first-come, first-served basis.

As the original registrant, Respondent enjoys rights in the domain name.

Respondent's business of trading in generic domain names creates a legitimate interest in the <kubex.com> domain name.

Respondent's use of the domain name for general advertising also constitutes a *bona fide* use of it.

Respondent's willingness to sell the disputed domain name to Complainant for a price does not show a lack of rights or of bad faith because Respondent is the rightful and legitimate holder of the domain name.

It was Complainant who first approached Respondent to initiate negotiations for the possible sale of the domain name.

The UDRP requires a finding of both bad faith use and bad faith registration of a domain name.

Respondent could not have registered the domain name in bad faith because Respondent's registration of the domain name predates by more than ten years any rights Complainant might now have in the KUBEX mark.

Complainant has misused the UDRP dispute resolution system as a tactic to obtain the domain name at little cost to itself.

Respondent objects to Complainant's filing of an Additional Submission because there was no cause for or request from the Panel to warrant it.

Complainant's use of the search bar at the website resolving from the domain name to generate hits for competing fitness services is of no evidentiary value.

Respondent requests a finding of reverse domain name hijacking because Complainant knew or should have known that it could not prove essential UDRP elements in support of its Complaint.

FINDINGS

Complainant has failed to show that Respondent registered the contested domain name in bad faith.

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 to or legitimate interests in respect of the domain name; and
- (3) the same domain name has been registered and is being used by Respondent in bad faith.

Identical and/or Confusingly Similar

The parties are in agreement that Complainant currently has rights in the KUBEX trademark and service mark by reason of its registration of that mark with a national trademark authority, the USPTO, and that the <kubex.com> domain name is confusingly similar, if not substantively identical, to the mark under the standards of Policy ¶ 4(a)(i). No further discussion of this head of the Policy is therefore necessary.

Rights or Legitimate Interests

Complainant and Respondent disagree on the point of Respondent's claim of rights to or legitimate interests in the disputed domain name under Policy ¶ 4(a)(ii). However, in light of the disposition made below of the question of Complainant's assertion that Respondent registered the domain name in bad faith, we need not examine this disagreement in detail. See *Creative Curb v. Edgetec Int'l Pty. Ltd.*, FA 116765 (Nat. Arb. Forum Sept. 20, 2002) (finding that, because a UDRP complainant must prove all three elements specified in Policy ¶ 4(a) in order to obtain relief from an administrative panel, a complainant's failure to prove any one of those elements makes inquiry into the others unnecessary); see also *Hugo Daniel Barbaca Bejinha v. Whois Guard Protected*, FA 836538 (Nat. Arb. Forum Dec. 28, 2006) (electing not to inquire into a respondent's rights

to or legitimate interests in a domain name or its registration and use of that domain name in bad faith where a UDRP complainant could not satisfy the proof requirements of Policy ¶ 4(a)(i).

Registration and Use in Bad Faith

Policy ¶ 4(a)(iii) provides that a UDRP complainant must prove to the satisfaction of an administrative panel both that a respondent registered a contested domain name in bad faith “and” that it now uses that domain name in bad faith. On the facts presented by the parties, it is evident that this dispute turns on the question whether Respondent registered the <kubex.com> domain name in bad faith. If we conclude that Respondent did not register the domain name in bad faith within the meaning of Policy ¶ 4(a)(iii), our inquiry ends. See the decisions in *Creative Curb* and *Hugo Daniel Barbaca Bejinha* cited above.

The uncontested facts which are determinative of this question are these:

1. Respondent first registered the <kubex.com> domain name on May 21, 2002;
2. that registration has remained with Respondent since its inception;
3. Complainant was created as a limited liability company on April 2, 2012;
4. Complainant has rights in the KUBEX trademark and service mark by reason of its registration of the mark with the United States Patent and Trademark Office (Registry No. 4,573,170, registered July 22, 2014, on an application filed January 14, 2013, with a first use in commerce dating from August 1, 2013); and
5. Complainant makes no claim of pre-existing common law rights in its KUBEX mark.

These facts permit of no other conclusion than that Respondent could not have registered the <kubex.com> domain name in bad faith. Respondent registered the domain name many years before Complainant existed and long years before the claimed mark was introduced in commerce. Respondent therefore could not have entertained bad faith intentions respecting the KUBEX mark because it could not have contemplated Complainant's then non-existent rights in it either at the moment the domain name was registered or at any point in the succeeding decade. *See, e.g., Telecom Italia S.p.A. v. NetGears LLC*, FA 944807 (Nat. Arb. Forum May 16, 2007) (finding that a respondent could not have registered a disputed domain name in bad faith where that respondent registered the domain name before a UDRP complainant began using the mark relied upon in its complaint); *see also Aspen Grove, Inc. v. Aspen Grove*, D2001-0798 (WIPO Oct. 5, 2001) (finding it "impossible" for a respondent to have registered a disputed domain name in bad faith where a UDRP complainant did not exist at the time of a respondent's domain name registration).

Further, *see Telecom Italia S.p.A. v. NetGears LLC*, FA 944807 (Nat. Arb. Forum May 16, 2007) (finding that a respondent could not have registered or used a disputed domain name in bad faith where that respondent registered the domain name before a UDRP complainant began using its mark); *Interep Nat'l Radio Sales, Inc. v. Internet Domain Names, Inc.*, D2000-0174 (finding no bad faith where a respondent registered a domain name before a UDRP complainant's first use of its mark); *Open Sys. Computing AS v. degli Alessandri*, D2000-1393 (finding no bad faith where a respondent registered a domain name before the filing of an application for registration of a trademark and commencement of its use in commerce by a UDRP complainant).

The Panel therefore finds that Complainant has failed to show that Respondent registered the disputed domain name in bad faith as provided in Policy ¶ 4(a)(iii).

Reverse Domain Name Hijacking

Respondent has requested of this Panel a finding of reverse domain name hijacking as to Complainant's conduct in bringing and pursuing its claim in this proceeding. In order to justify this request, Respondent must establish not only that Complainant's Complaint has no merit, but that Complainant has proceeded under the UDRP in bad faith. *See NetDepositVerkaik v. Crownonlinemedia.com*, D2001-1502 (WIPO Mar. 19, 2002):

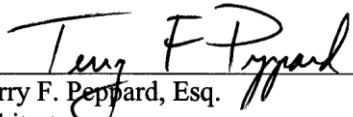
To establish reverse domain name hijacking, Respondent must show knowledge on the part of the complainant of the Respondent's right or legitimate interest in the Domain Name and evidence of harassment or similar conduct by the Complainant in the face of such knowledge.

Because Complainant has demonstrated in the record that it has rights in the KUBEX mark and that the contested <kubex.com> domain name is confusingly similar, if not substantively identical, to the KUBEX mark under Policy ¶ 4(a)(i), we decline to find that Complainant has engaged in reverse domain name hijacking in instituting and prosecuting this proceeding. *See Gallup, Inc. v. PC+s.p.r.l.*, FA 190461 (Nat. Arb. Forum Dec. 2, 2003) (finding no reverse domain name hijacking where a UDRP complainant prevailed on the identical-or-confusingly-similar prong of the Policy). *See also ECG European City Guide v. Woodell*, FA 183897 (Nat. Arb. Forum Oct. 14, 2003) ("Although the Panel has found that Complainant failed to satisfy its burden under the Policy, the Panel cannot conclude on that basis alone, that Complainant acted in bad faith.")

DECISION

Complainant having failed to establish an element required to be proven under the ICANN Policy, the Panel concludes that the relief requested must be, and it is hereby, **DENIED**.

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



Terry F. Peppard, Esq.
Arbitrator

Terry F. Peppard, Panelist

Dated: December 10, 2014