

ADMINISTRATIVE PANEL DECISION

DISH Network L.L.C. v. Domain Protection Services, Inc. / Harold Seibert Case No. D2022-2895

1. The Parties

The Complainant is DISH Network L.L.C., United States of America (“United States”), represented by Adsero IP, United States.

The Respondent is Domain Protection Services, Inc., United States / Harold Seibert, Canada.

2. The Domain Name and Registrar

The disputed domain name <flextv.live> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 5, 2022. On August 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 8, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on August 9, 2022 providing the registrant and contact information disclosed by the Registrar and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on August 10, 2022.

The Center verified that the Complaint together with the amended 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 August 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 31, 2022. The Respondent sent an email to the Center on August 23, 2022, which the Panel treats as its informal Response to the Complaint.

The Center appointed Antony Gold as the sole panelist in this matter on September 16, 2022. 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 is a provider of paid-for TV services in the United States. Since 2011, it has provided pay-as-you-go television services through its brand FLEXTV. The Complainant owns United States service mark, registration number 4172891, for the mark FLEXTV in class 38, registered on July 10, 2012.

The disputed domain name was registered on January 20, 2020. It redirects to a third party website containing a notice; "Firmware of your STB is outdated. Please update it". "STB" is a well-known abbreviation for a set-top box, through which paid-for television services can be received.

5. Parties' Contentions

A. Complainant

The Complainant says that the disputed domain name is identical to a trade mark or service mark in which it has rights, in that it incorporates the entirety of its FLEXTV mark.

The Complainant says also that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent registered the disputed domain name many years after the Complainant began use of its FLEXTV mark. It is not a licensee of the Complainant, nor is it otherwise authorized to use its mark for any purpose, nor is it commonly known as FLEXTV. The Respondent does not offer any services via the disputed domain name. Rather, it intentionally trades on the goodwill of the Complainant's mark in order to attract Internet users looking for the Complainant's pay-as-you-go television broadcasting services for the purposes of redirecting them to its own passively-held website. Moreover, the Respondent's choice of the ".live" domain extension increases the risk of customer confusion because the term "live" relates to, or is associated with, the Complainant's broadcasting services.

Lastly, the Complainant says that the disputed domain name was registered and is being used in bad faith. The Respondent registered the disputed domain name almost a decade after the Complainant's FLEXTV mark was first used in commerce. The nature of the website to which it redirects establishes that it was registered in bad faith in order that the Respondent could take advantage of the goodwill associated with the Complainant's trade mark and secure a domain name that third parties would assume belonged to, or was affiliated with, the Complainant. The Respondent's use of the disputed domain name is also in bad faith in that he is intentionally seeking to attract Internet users looking for the Complainant's services, who are then redirected to a website, which references one of the Complainant's core goods, namely set-top boxes used in connection with its television services. Consumers may mistakenly believe that the Respondent's website is associated with the Complainant, thereby disrupting the Complainant's business, especially since the Respondent's website is non-functioning. Use of a domain name incorporating a third party trade mark by an unauthorized third party in order to redirect Internet users to a different respondent-owned website is, in itself, evidence of bad faith.

There is no plausible future use of the disputed domain name that would not interfere with the Complainant's FLEXTV mark. Finally, the Respondent's use of a privacy service is, in the circumstances of this Complaint, a further indicator of bad faith.

B. Respondent

The Respondent states that he is willing to transfer the disputed domain name to the Complainant at a price which is considered fair. He says that he has never sold a domain name previously so does not know what it is worth. He claims that he registered a number of domain names at a time when he was considering the

possibility of establishing a service in Canada, but the regulatory and financial hurdles proved too great and the service was never launched.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following three elements in order to succeed in its Complaint:

(i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

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

A. Identical or Confusingly Similar

The Complainant has provided details of its United States service mark registration for FLEXTV, as set out above, which establishes its rights in this mark. As a technical requirement of registration, the generic Top-Level Domain (“gTLD”), that is “.live” in the case of the disputed domain name, is typically disregarded when assessing confusing similarity. The remaining component of the disputed domain name is identical to the Complainant’s mark.

The Panel accordingly finds that the disputed domain name is identical to a service mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out circumstances, without limitation, by which a respondent might demonstrate that it has rights or a legitimate interest in a domain name. These are, summarized briefly: if the respondent has been using the domain name in connection with a *bona fide* offering of goods or services, if the respondent has been commonly known by the domain name, or if the respondent has been making a legitimate noncommercial or fair use of the domain name.

The Respondent has asserted that he intended to use the disputed domain name in connection with an unspecified “service in Canada”. As explained at section 2.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), a claim to be using or to have used a domain name in connection with a *bona fide* offering of goods and services requires to be supported by evidence. Section 2.2 provides examples of the nature of evidence which might be required and explains that; “While such indicia are assessed pragmatically in light of the case circumstances, clear contemporaneous evidence of *bona fide* pre-complaint preparations is required”. See also *Magna International Inc. v. Redacted for Privacy, WhoisGuard, Inc. / Ahmed Salamah*, WIPO Case No. [DCO2020-0094](#).

No evidence of any type about the Respondent’s plans for the disputed domain name has been provided by the Respondent and his explanation is accordingly not accepted. Moreover, it is evident from his Response that, not only is he not now using the disputed domain name in connection with a *bona fide* offering of goods and services, but he does not have any future intention to do so. Accordingly, there is no basis for finding that the Respondent has established a right or legitimate interest on the basis of the first circumstance set out above.

The Respondent does not assert that he is commonly known by the disputed domain name and the second circumstance is therefore inapplicable. The final circumstance is also inapplicable in that the use which the Respondent claims he had intended for the disputed domain name was commercial in character. Moreover,

the disputed domain name is identical to the Complainant's FLEXTV mark and liable to be associated with it. The fact that the disputed domain name is registered under the ".live" gTLD further increases the risk of deception because Internet users will be apt to associate the use of this gTLD with live transmission of television, of the type that might be provided by the Complainant; see *Fifth Street Capital LLC v. Fluder (aka Pierre Olivier Fluder)*, WIPO Case No. [D2014-1747](#).

The Complainant has made out a *prima facie* case under the second element and the Respondent has failed to meet his burden of production (see, for example, *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)). The Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

Before considering the third element, the Panel returns to the Respondent's assertion that he had registered the disputed domain name because he had been exploring "the possibility of establishing a service in Canada". The lack of particularity provided by the Respondent, as discussed above, renders the Respondent's claim inherently implausible.. Furthermore, the Respondent has failed to provide an explanation as to why the disputed domain name redirects to a webpage containing a notice asserting that "Firmware of your STB is outdated. Please update it", which has no evident purpose and would appear to relate specifically to the type of services provided by the Complainant.

For the above reasons, the Panel concludes that the most likely explanation for the Respondent's registration of the disputed domain name was his probable awareness by the Respondent of the Complainant and its FLEXTV trade mark as at the date of registration of the disputed domain name and an intention on his part to profit unfairly in some manner from its registration.

The fact that the webpage to which the disputed domain name redirects requests visitors to it to update the firmware on their set-top box has the capacity to mislead Internet users into believing that it is operated by, or with the authorization of, the Complainant, particularly because of the identity between the disputed domain name and the Complainant's service mark. Whilst the disputed domain name redirects to another website rather than hosting a website directly, the Respondent's use of it is closely analogous (if not applicable in itself) to the circumstance of bad faith registration and use set out at paragraph 4(b)(iv) of the Policy, which provides that evidence of bad faith registration and use will be found where a respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website. The fact that it is not possible to discern why the Respondent has chosen to redirect the disputed domain name to a webpage with no evident utility or purpose does not affect the assessment; the facts suggest that the Respondent is hoping to profit from his registration of the disputed domain name due to its identity with the Complainant's trademark and it is not necessary for the Panel to ascribe a precise motive to him. As explained at section 3.1.1 of the [WIPO Overview 3.0](#): "If on the other hand circumstances indicate that the respondent's intent registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant's trademark, panels will find bad faith on the part of the respondent".

The Panel notes the further additional factors that support his findings; (i) the Complainant's FLEXTV mark has been in use for over 11 years and is therefore established, while the disputed domain name was registered in 2020; (ii) the Respondent's assertion that he contemplated a good-faith use of the disputed domain name is not accepted, for the reasons expressed above; and (iii) the Respondent has sought to conceal his identity through use of a privacy service.

For the above reasons, the Panel finds that the disputed domain name was both registered and is being used in bad faith.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <flextv.live> be transferred to the Complainant.

/Antony Gold/

Antony Gold

Sole Panelist

Date: September 30, 2022