

ADMINISTRATIVE PANEL DECISION

BCI Acrylic, Inc. v. Jason Chon, JC ALLIANCE LLP (a/k/a MB Mobility Bathworks)

Case No. D2022-4102

1. The Parties

The Complainant is BCI Acrylic, Inc., United States of America (“United States”), represented by Lorium Law, United States.

The Respondent is Jason Chon, JC ALLIANCE LLP (a/k/a MB Mobility Bathworks), United States.

2. The Domain Names and Registrar

The disputed domain names <bciwalkintub.com> and <bciwalkintubs.com> are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 1, 2022. On November 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 2, 2022, the Registrar 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 November 3, 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 amendment to the Complaint on November 7, 2022.

The Center verified that the Complaint together with the amendment to 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 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 28, 2022. The Respondent sent an informal email to the Center on November 3, 2022. On the same day, the Center informed the Parties that the proceeding could be suspended for purposes of exploring settlement negotiations; however, the Complainant declined to suspend the proceedings to explore a possible settlement.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on December 8, 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 corporation organized under the laws of the State of Illinois and headquartered in Libertyville, Illinois, United States. It operates a website (the "Complainant's website") at "www.bciacrylic.com". According to the Complainant's website, the Complainant was established in 1999. The Complainant manufactures acrylic bath liners, shower liners, shower doors, and tub and shower walls. It also produces walk-in bathtubs for ease of access. A page on the Complainant's website is devoted to "Walk-in Tubs", "keeping those with limited mobility safe". The Complainant sells its products through a nationwide network of dealers.

The Complainant holds United States Trademark Registration Number 2903007 (registered November 16, 2004) for the word mark BCI.

The Registrar reports that both disputed domain names were created on February 17, 2015. They were registered in the name of a domain privacy service, but after receiving notice of the Complaint in this proceeding, the Registrar identified the underlying registrant as the Respondent Jason Chon, listing the organization as JC Alliance LLP with a postal address in Quakertown, Pennsylvania, United States and using an email address including the name "mobilty bathworks". According to the online database of the Pennsylvania Secretary of State, JC Alliance LLP was a Pennsylvania limited liability partnership formed in 2009 in Quakertown, Pennsylvania, but it was terminated in January 2017. The Panel notes that the LinkedIn profile for Jason Chon describes him as presently the owner of "JC Alliance int. LLC" and also "Owner / President" of Mobility Bathworks. The Panel also notes that the online database of the Pennsylvania Secretary of State shows that "Mobility Bathworks" is a fictitious name filed in 2009 and owned by Jason Chon, JC Alliance LLP, and another individual.

The disputed domain name <bciwalkintub.com> redirects to the website of "Mobility Bathworks" at "www.mbtubs.com". The Panel notes that screenshots archived by the Internet Archive's Wayback Machine show that the other disputed domain name, <bciwalkintubs.com>, also formerly redirected to the Mobility Bathworks website. At the time of this Decision, the disputed domain name <bciwalkintubs.com> resolves instead to a "free" parking page hosted by the Registrar with a link to "get this domain" and several pay-per-click ("PPC") third-party advertising links, including those for unrelated suppliers of bathtubs and showers.

The Mobility Bathworks website advertises the products of a direct competitor of the Complainant, a manufacturer of walk-in bathtubs and showers with a contact address in Quakertown, Pennsylvania, where the disputed domain name registrant is located.

The Complaint named "MB Mobility Bathworks" as a Respondent because the disputed domain names resolved to the Mobility Bathworks website, which is headed "MB Mobility Bathworks". As the Pennsylvania Secretary of State database shows that "Mobility Bathworks" is merely a fictitious name for Mr. Chon and the now-inactive JC Alliance, LLP, Mr. Chon (the underlying registrant of the disputed domain names) is referred to hereafter as the "Respondent" in this Decision.

5. Parties' Contentions

A. Complainant

The Complainant asserts that the disputed domain names are confusing similar to its registered BCI trademark, which the disputed domain names incorporate in its entirety. The Complainant states that the Respondent does not have permission to use the Complainant's mark and is not known by a corresponding name. The Respondent has used the disputed domain names only to redirect Internet users to the Respondent's competing business, which does not reflect a *bona fide* offering or legitimate fair use.

The Complainant argues that the Panel should find bad faith because the Respondent registered the disputed domain names long after the Complainant, a competitor, registered its trademark and presumably sought to disrupt its competitor's business and misdirect consumers to the Respondent's website for commercial gain. The Respondent's use of a domain proxy service in registering the disputed domain names reinforces that conclusion. The Complainant also cites the "passive holding" doctrine of *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

B. Respondent

Following receipt of the Complaint in this proceeding, the Respondent communicated with the Center and the Complainant by email saying, "We already took our website off that domain name" and, "You can buy the domain name from us". The Respondent seems to be referring only to the disputed domain name <bcwalkintubs.com>. The Respondent did not submit a Response to the Complainant's substantive arguments.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest a respondent of a domain name, a complainant must demonstrate each of the following: (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and (ii) the respondent has no rights or legitimate interests in respect of the domain name; and (iii) the domain name has been registered and is being used in bad faith. Under paragraph 15(a) of the Rules, "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

A. Identical or Confusingly Similar

The first element of a UDRP complaint "functions primarily as a standing requirement" and entails "a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7. Both of the disputed domain names incorporate the Complainant's registered BCI trademark in its entirety. The addition of words ("walk in tub", "walk in tubs") does not prevent a finding of confusing similarity. See *id.* section 1.8. As usual, the addition of the generic Top-Level Domain ".com" is disregarded as a standard registration requirement (see *id.* section 1.11.1).

The Panel concludes that the Complainant has established the first element of the Complaint.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy gives non-exclusive examples of instances in which a respondent may establish rights or legitimate interests in a domain name, by demonstrating any of the following:

(i) before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods

or services; or

(ii) that the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Because a respondent in a UDRP proceeding is in the best position to assert rights or legitimate interests in a domain name, it is well established that after a complainant makes a *prima facie* case, the burden of production on this element shifts to the respondent to come forward with relevant evidence of its rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1.

The Complainant has demonstrated trademark rights, the lack of evident rights or legitimate interests, and the use of the disputed domain names only to redirect to a website selling competing products under an entirely different name. Thus, the Complainant has made a *prima facie* case, and the burden of production shifts to the Respondent. The Respondent did not provide a substantive response, and no rights or legitimate interests are evident from a perusal of the website linked to the disputed domain name <bcwalkintub.com> that features competing products for sale. See [WIPO Overview 3.0](#), section 2.5.3.

The Panel finds that the Respondent has failed to meet its burden of production and concludes that the Complainant prevails on the second element of the Complaint.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(b), furnishes a non-exhaustive list of circumstances that “shall be evidence of the registration and use of a domain name in bad faith”, including the following cited by the Complainant (in which “you” refers to the registrant of the domain name):

“(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

By the time the disputed domain names were registered, the Complainant's BCI mark had been registered for more than a decade, and in use longer than that, in precisely the same business as that in which the Respondent is engaged. Both parties advertise their walk-in bathtubs and showers online and sell them nationally through dealers or “partners”. The BCI mark is distinctive and not descriptive, and the disputed domain names add the relevant words “walkintub” or “walkintubs”. Thus, it is inconceivable that the Respondent was unaware of the Complainant.

The Respondent redirected the disputed domain names to a directly competing website associated with the Respondent. These facts are consistent with the illustrations of bad faith in the Policy, paragraphs 4(b)(iii) and (iv).

Confronted with the Complaint in this proceeding, the Respondent offered no legitimate reasons for registering and using the disputed domain names. Instead, the Respondent removed the redirect from one of the disputed domain names (with the result that it now resolves to PPC advertising for other third parties, which still implicates paragraph 4(b)(iv)), and offered to sell that disputed domain name. This does not cure the Respondent's bad faith.

The Panel concludes that the Complainant has established the third element of the Complaint, 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 names, <bciwalkintub.com> and <bciwalkintubs.com>, be transferred to the Complainant.

/W. Scott Blackmer/

W. Scott Blackmer

Sole Panelist

Date: December 24, 2022