

ADMINISTRATIVE PANEL DECISION

BlackBerry Limited v. Adham Hassanin-Hagag, si14.space
Case No. D2024-1154

1. The Parties

The Complainant is BlackBerry Limited, Canada, represented by Davis Wright Tremaine LLP, United States of America (“United States”).

The Respondent is Adham Hassanin-Hagag, si14.space, Canada.

2. The Domain Name and Registrar

The disputed domain name <blackberry.software> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 16, 2024. On March 18, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 18, 2024, 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 (Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 19, 2024, 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 March 20, 2024.

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 March 28, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 17, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 18, 2024.

The Center appointed Christopher J. Pibus as the sole panelist in this matter on April 30, 2024. 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 designer, manufacturer and marketer of services and products in the field of worldwide mobile communications. Headquartered in Waterloo, Canada, the Complainant is best known for its handheld wireless device sold under the BLACKBERRY trademark in Canada, the United States and internationally, beginning in 1999.

The Complainant holds an international portfolio of BLACKBERRY trademarks, which includes Canada (where the Respondent resides) as well as the United States and many other jurisdictions.

Particulars of relevant registrations for the word mark BLACKBERRY include:

- United States registration no. 2,844,340, dated May 25, 2004, in classes 9, 38, and 41 (first use in commerce 1999);
- United States registration no. 4,916,352, dated March 15, 2016, in classes 16, 35, 37, 41, 42, and 45.
- Canadian registration no. TMA554,207, dated November 21, 2001, in classes 9 and 38.

In addition, the Canadian Trademark Register contains more than 30 other BLACKBERRY-formative marks, held by the Complainant.

The Complainant also owns a domain name registration for <blackberry.com> which it uses in association with its principal website.

The disputed domain name was registered by the Respondent on January 8, 2024. The Respondent appears to be an individual who resides in Canada. The disputed domain name was at filing of the Complaint parked with embedded hyperlinks to third-party websites which featured categories of products and services for which the Complainant is well known. The disputed domain name is currently inactive.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that its BLACKBERRY trademark is well known around the world due to the widespread adoption of BLACKBERRY-branded products initially in Canada and the United States and later in international markets. The Complainant relies on the widespread recognition of its trademark as a famous mark, resulting from millions of dollars of advertising and hundreds of millions of dollars in sales over the past 24 years. In the circumstances, the Complainant urges the Panel to find deliberate targeting of a famous mark for improper purposes.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, in order to succeed, the Complainant must establish each of the following elements:

- (i) The disputed domain name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights;
- (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

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves 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.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel notes the generic Top-Level Domain ("gTLD") ".software" is irrelevant for the confusion analysis as it is viewed as a standard registration requirement. See *Navasard Limited v. Ahmet Yilmaz*, work, WIPO Case No. [D2021-1064](#), and [WIPO Overview 3.0](#), section 1.11.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

The Complainant has established a plausible prima facie case by bringing forward evidence and submissions on the following points: (1) the Respondent has never been associated in any way with the Complainant nor has he ever been authorized to use the BLACKBERRY mark; (2) there is no evidence that the Respondent has been commonly known by the disputed domain name; (3) the disputed domain name prominently features and reproduces the distinctive BLACKBERRY mark and the addition of the gTLD ".software" only serves to increase the risk of implied affiliation; (4) the registration of a domain name incorporating another's famous mark in the circumstances of this case does not confer or create any rights or legitimate interests in the disputed domain name (see *PRL USA Holdings, Inc. v. Vivienne*

Westwood/Contact Privacy Inc. Customer 016347680, WIPO Case No. [D2011-1292](#)); (5) the Respondent's use of the disputed domain name to host a parked page with hyperlinks to competing third party websites does not evidence rights or legitimate interests in the disputed domain name (see *Les Parfumeries Fragonard v. Thanh Van Pham*, WIPO Case No. [D2020-2920](#)).

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The Panel finds that the disputed domain name has been registered and used in bad faith in light of the factors and circumstances set out below. The Panel finds that the Respondent knew or should have known of the Complainant's BLACKBERRY mark as he has adopted and used an identical domain name many years after the Complainant had established its rights and reputation in the BLACKBERRY mark around the world, including Canada where the Respondent appears to reside. Furthermore, the nature of the disputed domain name combining the BLACKBERRY mark with a gTLD relevant to the mobile industry (i.e., software) further indicates the Respondent's intent of targeting the Complainant.

Concerning the use of the disputed domain name, the Panel considers the fact that the disputed domain name previously resolved to a web page which displayed PPC links to websites related to mobile phone services. It has been well-established that where a domain name is used to generate revenue in respect of "click through" traffic, and that traffic has been attracted because of the reputation associated with the Complainant's mark, amounts to bad faith.

The disputed domain name is no longer active. Panels have found that the non-use of a domain name (including a parked page) would not prevent a finding of bad faith under the doctrine of passive holding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes: (i) the distinctiveness and long-standing reputation of the Complainant's trademark, as well as its status as a famous mark; (ii) the composition of the disputed domain name, namely the use of the BLACKBERRY mark in its entirety with the gTLD ".software"; (iii) the high likelihood that the Respondent, as a Canadian resident, was fully aware of, and was targeting, the Complainant's rights in its famous mark; and (iv) the failure of the Respondent to offer any explanation or justification for his choice of the disputed domain name. The Panel finds that in the circumstances of this case the current passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds that the Complainant has established the third element of the Policy.

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 <blackberry.software> be transferred to the Complainant.

/Christopher J. Pibus/

Christopher J. Pibus

Sole Panelist

Date: May 14, 2024