

COMPLAINT TRANSMITTAL COVERSHEET

Attached is a Complaint that has been filed against you with the World Intellectual Property Organization (**WIPO**) Arbitration and Mediation Center (the **Center**) pursuant to the Uniform Domain Name Dispute Resolution Policy (the **Policy**) approved by the Internet Corporation for Assigned Names and Numbers (**ICANN**) on October 24, 1999, 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**).

The Policy is incorporated by reference into your Registration Agreement with the Registrar(s) of your domain name(s), in accordance with which you are required to submit to a mandatory administrative proceeding in the event that a third party (a **Complainant**) submits a complaint to a dispute resolution service provider, such as the Center, concerning a domain name that you have registered. You will find the name and contact details of the Complainant, as well as the domain name(s) that is/are the subject of the Complaint in the document that accompanies this Coversheet.

You have no duty to act at this time. Once the Center has checked the Complaint to determine that it satisfies the formal requirements of the Policy, the Rules and the Supplemental Rules, it will forward an official copy of the Complaint to you. You will then have 20 calendar days within which to submit a Response to the Complaint in accordance with the Rules and Supplemental Rules to the Center and the Complainant. You may represent yourself or seek the assistance of legal counsel to represent you in the administrative proceeding.

- The **Policy** can be found at <http://arbiter.wipo.int/domains/rules/>
- The **Rules** can be found at <http://arbiter.wipo.int/domains/rules/>
- The **Supplemental Rules**, as well as other information concerning the resolution of domain name disputes can be found at <http://arbiter.wipo.int/domains/rules/>
- A **model Response** can be found at <http://arbiter.wipo.int/domains/respondent/index.html>

Alternatively, you may contact the Center to obtain any of the above documents. The Center can be contacted in Geneva, Switzerland by telephone at +41 22 338 8247, by fax at +41 22 740 3700 or by e-mail at domain.disputes@wipo.int.

You are kindly requested to contact the Center to provide the contact details to which you would like (a) the official version of the Complaint and (b) other communications in the administrative proceeding to be sent.

A copy of this Complaint has also been sent to the Registrar(s) with which the domain name(s) that is/are the subject of the Complaint is/are registered.

By submitting this Complaint to the Center the Complainant hereby agrees to abide and be bound by the provisions of the Policy, Rules and Supplemental Rules.

Before the:

**WORLD INTELLECTUAL PROPERTY ORGANIZATION
ARBITRATION AND MEDIATION CENTER**

BMEzine.com, LLC,
1802 N. Carson Street
Carson City, Nevada 89701
COMPLAINANT

Disputed Domain Name:

-v-

BME.com

Gee Whiz Domains Privacy Service
[1370348]
848 N. Rainbow Blvd. Suite #2330
Las Vegas, Nevada 89107
RESPONDENT

COMPLAINT
(Rules, para. 3(b))

I. Introduction

1. This Complaint is hereby submitted for decision in accordance with the Uniform Domain Name Dispute Resolution Policy (the **Policy**), approved by the Internet Corporation for Assigned Names and Numbers (**ICANN**) on October 24, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the **Rules**), approved by ICANN on October 24, 1999 and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the **Supplemental Rules**).

II. The Parties

A. The Complainant

(Rules, para. 3(b)(ii) and (iii))

2. The Complainant in this administrative proceeding is BMEzine.com, LLC., a Nevada Limited Liability Company. The Complainant operates a tattooing, piercing, and body art information and social networking empire that includes fifty (50) websites, the URLs of which all contain the designation “BME.” See Declaration of Rachel Larratt, attached as Exhibit U.

3. The Complainant’s contact details are:

BMEzine.com, LLC.

Address: 1802 N. Carson Street
Carson City, Nevada 89701

Telephone: (866) 796-2704

Fax: (847) 620-0789

E-mail: legal@bmezine.com

4. The Complainant’s authorized representative in this administrative proceeding is:

Marc J. Randazza, Esq.
Weston, Garrou, Walters & Mooney
781 Douglas Ave.
Altamonte Springs, FL 32714-2566

5. The Complainant’s preferred method of communications directed to the Complainant in this administrative proceeding is:

Electronic-only material

Method: e-mail

Address: mrandazza@firstamendment.com

Contact: *Marc J. Randazza, Esq.*

Material including hardcopy

Method: post

Address: *781 Douglas Ave., Altamonte Springs, FL 32714-2566*

Fax: *(407) 774-6151*

Contact: *Marc J. Randazza, Esq.*

B. The Respondent

(Rules, para. 3(b)(v))

6. The Respondent in this proceeding is “1370348” (hereinafter “Respondent”), which appears to be an account number with “Gee Whiz Domains Privacy Service.” This registration occurred on or about May 9, 2008.

7. The Respondent lists an address of 848 N. Rainbow Blvd. Suite #2330, Law Vegas, Nevada 89701.

8. Respondent is identified as the current registrant of this domain in the WHOIS database maintained by Moniker.com. A true and correct copy of the WHOIS search used to identify Respondent as the registrant of this domain is attached as Exhibit A.

9. All information known to the Complainant regarding how to contact the Respondent is as follows:

Privacy Admin privacy@geewhizdomains.com

Gee Whiz Domains Privacy Service

848 N. Rainbow Blvd. Suite #2330

Las Vegas, Nevada 89107

Phone: +1.6319955695

III. The Domain Name and Registrar

(Rules, para. 3(b)(vi) and (vii))

10. This dispute concerns the domain name *BME.com*.

11. The registrar with which the domain name is registered is:

Name: Moniker.com

Address: 20 SW 27th Ave. Suite 201
Pompano Beach, Florida 33069

Telephone: 800-688-6311

E-mail: support@moniker.com

12. This domain appears to have changed hands multiple times since the development of the Complainant's strong common law rights to the BME mark in 1994. See, e.g., Exhibit C. Under the UDRP each change of registrant or transfer of a domain name constitutes a new registration. See *Dreamgirls, Inc. v. Dreamgirls Entertainment*, WIPO Case No. D2006-0609; *HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*, WIPO Case No. D2007-0062 *Alpine Entertainment Group, Inc. v. Walter Alvarez*, WIPO Case No. D2007-1082.

13. The earliest registration record available for this domain on the Domain Tools database is dated December 27, 2003. At that time, the domain was registered to a corporation known as "Motherboards.com." See Exhibit D. At this time, as discussed below, the Complainant already had strong common law rights in the BME mark and 9 years of continuous use of the mark BME.

14. The next new registration of this domain occurred on or about June 7, 2005, when the domain was registered by Covanta Corporation of Casper, Wyoming. See Exhibit E.

15. The next new registration occurred on or about August 30, 2005, when the registration was changed to a private registration at Moniker Privacy Services. See Exhibit F.

16. The most recent registration occurred on or about May 9, 2008, when the domain was registered by the current registrant as noted above. See Exhibit A.

17. Given that the Complainant's common law rights were firmly established as early as 1994, and were globally famous by 1997, all of the above registrations were in bad faith. Therefore, the relevant registration of May 9, 2008, was absolutely in bad faith, as will be discussed below.

IV. Jurisdictional Basis for the Administrative Proceeding

(Rules, paras. 3(a), 3(b)(xv))

18. This dispute is properly within the scope of the Policy, and the Administrative Panel has jurisdiction to decide the dispute, because the registration agreement, pursuant to which the

domain name that is the subject of this Complaint is registered, incorporates the Policy. Pursuant to Article 1 of the Moniker.com Dispute Policy (“Dispute Policy”), a true and correct copy of which is attached hereto as Exhibit B, Respondent expressly agreed to be bound by the ICANN Uniform Dispute Resolution Policy as presently written and posted on <http://www.icann.org/udrp/udrp-policy-24oct99.htm> and as shall be amended from time to time.

V. Factual and Legal Grounds

(Policy, paras. 4(a), (b), (c); Rules, para. 3)

A. THE COMPLAINANT’S RIGHTS TO THE BME MARK

19. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has common law trademark rights and pending United States registration rights; (Policy, para. 4(a)(i), Rules, paras. 3(b)(viii), (b)(ix)(1)).

1. PENDING U.S. REGISTRATION RIGHTS

20. The Complainant filed an application with the United States Patent and Trademark Office (“USPTO”) on March 27, 2008 for registered rights in the common law mark “BME.” The application itself is *prima facie* evidence of rights under the Policy. See *David J. Joseph Co. v. Richard Barry*, WIPO Case No. D2000-1418; *Phone-N-Phone Svcs. v. Shlomi Levi*, WIPO Case No. D2000-0040 (Granting rights under the policy for an intent to use application); *American Anti-vivisection Society v. INA.net Web Services*, NAF Claim No. FA95685; *Ontrack Data International, Inc. v. Barbara Drewett*, NAF Claim No. FA99767; *La Francaise des Jeux v. L. Welsr*, WIPO Case No. D2002-0305.

21. This application, which represents *prima facie* evidence of rights under the UDRP, pre-dates the latest registration of the domain name, which occurred on or about May 9, 2008. However, the Complainant’s common law rights were established in 1994, many years prior to the submission of this application.

2. COMMON LAW RIGHTS

22. The Complainant has been using the “BME” mark (hereinafter the “BME mark”) in international commerce in connection with tattooing and piercing journalism since as early as 1994, when it was used on an Internet newsgroup, and as such its use pre-dates the World Wide Web. See Exhibit C, and Composite Exhibit G.

23. The Complainant owns overwhelming common law trademark rights to the mark “BME” established by fourteen (14) years of continuous and widespread use on the Internet and millions of daily visitors, as well as near ubiquitous recognition in the relevant channels of trade.
24. The Complainant has been using “BME” as a source identifier for its services since 1994. The use of “BME” (“Body Modification ‘Ezine”) has spanned across the internet; the website has been viewed in all countries, “BME” has been featured in numerous tattoo, body modification and mainstream print articles; and is clearly recognizable to anyone in the relevant marketplace and well beyond. See Exhibits H, C, and G.
25. The BME mark has achieved strong secondary meaning in both the mainstream press and in the relevant marketplace. “BME” is a famous mark, especially within the body art, tattooing, and piercing communities. This fact is supported by the attached Expert Witness Declarations. See Declarations of Kevin Wimberly, Exhibit I, David Vidra, Exhibit J, Elayne Angel, Exhibit K, and Allen Falkner, Exhibit L. See also Exhibits C, G, and H.
26. Additional acquired distinctiveness of this mark is apparent from the evidence attached in Composite Exhibit M to this Complaint. See also Exhibits C and G. This evidence consists of a representative sampling of unsolicited media attention bestowed upon BME. As shown in these Exhibits, BME is frequently mentioned in the mainstream media on a regular basis.
27. Further evidence of the BME common law rights exists on Wikipedia.com. See http://en.wikipedia.org/wiki/BME_%28website%29 and Exhibit N. While “facts” reported on Wikipedia are hardly conclusive evidence, as it may be edited by anyone at any time, the Wikipedia *history* shows that there has been a Wiki on BME since April of 2004, and that it has been edited many times by many users. See Exhibit O.
28. In 1995, “BME” won a Lydia Award for best World Wide Web site and Best Body Art Magazine (any medium) See Exhibit P.
29. BME is frequently mentioned in other sources of Body Art media. See Exhibits C, G, and M, which detail unsolicited media attention focused on BME from 1994 to 1998.
30. In July of 1998, *Playgirl Magazine* noted that BME is “a good place to learn about genital piercing!” See *Playgirl Magazine*, July 1998 at p. 42.
31. The Complainant’s flagship site, BMEZine.com, is linked to by 1,216 other websites. See Exhibit R.

32. The BME mark (especially in connection with the body art, tattooing, and piercing industry) can only identify the Complainant, and Internet users who navigate their browsers to the Infringing Domain would be misled to believe that the Infringing Domain (a true and correct copy appears at Exhibit S) is in some way connected to and affiliated with the Complainant. This is known as “initial interest confusion.” See *Covance, Inc. and Covance Laboratories Ltd. v. The Covance Campaign*, WIPO Case No. D2004-0206.¹

33. This misuse of the BME mark has created confusion between the Complainant’s and the Respondent’s domains, as shown in Exhibit T. See also Declaration of Rachel Larratt, Exhibit U, and Expert Witness Declarations, Exhibits I-L. Given the fact that the Complainant only does business online, this could create a crisis in the marketplace – and not only for the Complainant.

34. In 1994, the Complainant’s publication was launched on Usenet, and later on BME.freeq.com. See Composite Exhibit V, which consists of historical printouts of bme.freeq.com. Thereafter, BME has done business on a collection of websites on the World Wide Web, as discussed below. The Complainant operates, among others, the following websites:

- a. BMEfest.com a website that promotes the annual gathering for members of the community of the BME family of websites, a printout of which is attached hereto as Exhibit W.1;
- b. BMEvideo.com, an adult site displaying online videos of extreme and erotic body modification, a printout of which is attached hereto as Exhibit W.2 (graphic portions redacted);
- c. BMEhard.com, a site that allows users to post content on bonus galleries, a printout of which is attached hereto as Exhibit W.3 (graphic portions redacted);
- d. BMEboys.com, a blog-type site that allows user posted pictures and text, a printout of which is attached hereto as Exhibit W.4;
- e. TeamBME.com, a mailserver site which provides email accounts for members of "Team BME" (people with BME tattoos), a printout of which is attached hereto as Exhibit W.5;

¹ Once the user arrives at BME.com, the user will see links to Body Piercing, Body Art, Tattooing, as well as an image of a man performing a tattoo. See Exhibit S, which is a screen shot of the offending webpage.

- f. AskBME.com, a question and answer site for members of the body art, tattooing, and piercing community, a printout of which is attached hereto as Exhibit W.6;
 - g. BMEworld.com, a site offering free homepages and anonymous e-mail for members of the body modification community, a printout of which is attached hereto as Exhibit W.7;
 - h. BMEink.com, a site designed to give the tattoo-specific members of the BME community a separate forum, a printout of which is attached hereto as Exhibit W.8;
 - i. BMEzine.com, a printout of which is attached hereto as Exhibit W.9;
 - j. BMEjapan.com, a site designed for Japanese-speaking members of the body modification community, a printout of which is attached hereto as Exhibit W.10;
 - k. BMEscholarship.com, a website that accepts donations to provide academic scholarships to members of the body modification community, a printout of which is attached hereto as Exhibit W.11;
 - l. BMEshop.com, a website that sells merchandise specific to the body art, tattooing, and piercing community, a printout of which is attached hereto as Exhibit W.12;
35. The Complainant has created a genuine commodity in the BME trademark.
36. David Vidra, Allen Faulkner, and Elayne Angel are experts in the fields of Body Piercing and Body Art. They confirm the obvious – that the mark BME can only identify the Complainant and any other use of the mark will result in a strong likelihood of confusion in the relevant marketplace. See Declarations of Vidra, Angel, and Faulkner, attached as Exhibits J, K, and L. See also, Declaration of Kevin Wimberly, at Exhibit I.

**B. THE RESPONDENT HAS NEITHER RIGHTS
NOR LEGITIMATE INTERESTS IN THE DOMAIN NAME**

(Policy, para. 4(a)(ii), Rules, para. 3(b)(ix)(2))

37. Bad faith registration and use of domain names does not establish rights or legitimate interests. *N.C.P. Marketing Group, Inc. v. Entredomains*, WIPO Case No. D2000-0387.
38. Nonetheless, “Proving a negative fact is always a very difficult task.” See *Dr. Ing. H.C.F. Porsche AG v. Meechai*, WIPO Case No. D2006-1116. It is for this reason, that under the UDRP, once the Complainant asserts that the Respondent has no rights or legitimate interest

with respect to the domain, the burden shifts to the Respondent to provide “concrete evidence that it has rights to, or legitimate interest in the domain name at issue.” (Emphasis added). See *Do the Hustle, LLC v. TropicWeb*, WIPO Case No. D2000-0624.

39. The Respondent will be unable to provide non-fabricated evidence, let alone concrete evidence, that it has legitimate rights or a legitimate interest in the domain. It is well established that pay-per-click sites and domain parking pages are not *bona fide* offerings of goods or services. See *Air Deccan v. Premium Domain*, WIPO Case No. D2005-0895; *Societe Air France v. Bing G. Glu*, WIPO Case No. D2006-0834 (use of pay-per-click domain parking sites is neither a *bona fide* offering of goods or services under the Policy nor a non-commercial or fair use). Even if they were, creating a pay-per-click website that has the sole purpose and function of trading off the good name of a competitor could never be anything but bad faith under the policy.

40. The substance of the Respondent’s domain name and the substance of the Complainant’s trademarks are identical. While the Respondent will no likely offer many fanciful explanations as to how the domain was registered in good faith, the fact is that even if “BME” might have some other hypothetical meaning, there is no need for hypothesis nor conjecture once the Panel examines the Respondent’s website. See **Exhibit S**.

41. BME has but one function in the tattooing, piercing, and body art industries and communities – and that is to identify the Complainant. The Respondent’s website, BME.com, has but one purpose and function –to make money through advertising fees by misdirecting Internet users who are looking for one of the Complainant’s websites.

42. There are no facts that could bring a reasonable person to the conclusion that the Respondent has any rights or legitimate interests in the domain name at issue. The Respondent most likely had actual knowledge of the Complainant’s mark when he registered the domain on May 9, 2008, and at least had constructive knowledge of it on that date, and likely well before. The Respondent registered the domain in defiance of this knowledge, and did so because of the likelihood of confusion with the Complainant’s mark, which would bring a significant amount of typographical error traffic to the Respondent’s site.

43. The Respondent’s disputed domain name infringes upon the Complainant’s rights and resolves to a website that directly infringes upon the Complainant’s rights. This is analogous to the facts in *Societe Air France v. Bing G. Glu*, WIPO Case No. D2006-0834, in which the Panel

found the “*disputed domain name www.sfr.org is being used by the respondent in a way that could derive revenue from the internet traffic generated through the Complainant’s investments.*”

44. The Respondent has made neither a good faith nor a legitimate use of the domain name. The Respondent has selected the name to intentionally attempt to attract, for commercial gain, Internet users to the pay-per-click website hosted at this domain by creating a likelihood of confusion with the Complainant’s mark and the Complainant’s URL as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website location or of the products or services on the Respondent’s website or location. When an Internet user navigates to BME.com, the user finds himself looking at a website that appears to be affiliated with the Complainant. See Declaration of Kevin Wimberly, Exhibit I. The offending website displays images of tattooing and body art. See Exhibit S. It has done so since at least 2006. A composite of historical screen shots of the site are attached as Exhibit X.²

45. Once the initially confused web surfer finds her way to BME.com, the surfer is treated to a page with sponsored links to tattooing, piercing, and body art services. However, no matter how many times one may click the links on BME.com, the user will never arrive at any of Complainant’s websites. See Exhibit S.

46. A Respondent cannot claim to have rights or legitimate interests in a domain name where Respondent has notice that its domain is confusingly similar to Complainant’s mark or where Respondent registered or used the domain name in bad faith. “*One who has constructive knowledge of the trademark, and who contacts the trademark owner and advises the owner that he has acquired a confusingly similar domain name which he intends to use in competition with the trademark owner, has no rights or legitimate interests in the domain name.*” *Marconi Data Systems, Inc. v. IRG Coins and Inc Source, Inc.*, WIPO Case No. D2000-0090.

47. The Respondent has attempted, through an intermediary, to sell the domain name to the Complainant, stating that he would not entertain any offers of less than \$100,000. See Exhibit U.

48. The Respondent may contend that he simply “acquires three letter domains as a business model.” However, as the Panel noted in *Daimler Chrysler v. 3vNetworks*, WIPO Case No. D2006-0450, “*A term is not generic merely because it consists of 3 letters.*” Additionally, mass acquisition of three-letter domain names neither demonstrates rights to (nor demonstrates a legitimate interest in) a disputed domain name. See *Deutsche Lufthansa AG v. Future Media*

² Apparently, the prior registrant also registered and used the domain in bad faith.

Architects, Inc. NAF Claim No. FA0802001153492 (transferring <lh.com> in similar circumstances). In that case, the Panel noted “*Respondent’s business model involves the indiscriminate acquisition and use of as many such domain names as possible. The traditional analyses of the rights to or legitimate interests element should not apply in gross when a registrant is not seeking to use any particular domain name to conduct business, is not otherwise known by that name, and has no interest in the nature of the transferor’s rights there from.*” Even if we were to give the Respondent the benefit of doubt that he did not register BME.com in order to *intentionally* trade on the Complainant’s trademark (a sanctionable defense given the content on the website), his indiscriminate registration constitutes evidence of Bad Faith registration, and fails to demonstrate legitimate rights.

C. THE DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH.

(Policy, paras. 4(a)(iii), 4(b); Rules, para. 3(b)(ix)(3))

49. Section 4(b) of the UDRP leaves it open to the Panel to find bad faith either by applying the four factors enumerated in that section OR by looking outside the four factors. See, e.g., *Mansueto Ventures v. Jonathan Witte*, WIPO Case No. D2006-1479 (transferring the domain www.inc.mobi after engaging in a common-sense analysis of the Respondent’s pretextual arguments for registration); *Media General Communications, Inc. v. Rarenames, WebReg*, Case No. D2006-0964 (“The list of instances of bad faith in Policy, paragraph 4(b) is explicitly non-exclusive. The Panel must consider, as have several previous UDRP panels, whether the Respondent’s apparent disregard for the likelihood that the Domain Name corresponded to a distinctive trademark is itself evidence of bad faith in the registration and use of the Domain Name.”); *Thermo Electron Corporation v. Sven Camrath and Joachim Camrath*, WIPO Case No. D2001-1013 (“The circumstances enumerated in paragraph 4(b) of the Policy are not exhaustive: bad faith registration and use may be established in other ways. In *SportSoft Golf, Inc. v. Hale Irwin’s Golfers’ Passport* (NAF case FA94956) a finding of bad faith was made where the respondent “knew or should have known” of the registration and use of the trade mark prior to registering the domain name.”).

50. In this case, it appears that the Respondent’s conduct amounts to bad faith whether the Panel applies the four non-exclusive factors, all of which appear to apply, or whether the Panel simply applies common sense.

1. BAD FAITH REGISTRATION

51. The Complainant's common law rights were well established in 1994. At that time, the Complainant was internationally famous in the relevant marketplace, and thus overwhelming common law rights existed at least as early as 1997. Accordingly, any registration after 1994 was likely in bad faith, and any registration after 1997 was certainly in bad faith. The 2008 registration was undeniably in bad faith.³

52. As noted above, under the Policy, each new registration or transfer of a domain name constitutes a new registration. See *Dreamgirls, Inc. v. Dreamgirls Entertainment*, WIPO Case No. D2006-0609. The date on which the Respondent first registered the domain name, and not the date on which the domain was first registered by any prior owners, is the date of importance in the analysis under the UDRP. See, e.g., *Vanessa Minnillo v. Mike Morgan*, WIPO Case No. D2005-0813.

53. The Policy makes it clear that the term "registered" means registration on acquisition by the present registrant, and not the original registration of the domain name by an independent third party. *Asurion Corporation v. Hong Kong Names LLC*, WIPO Case No. D2007-0290 ("it is clear from the Policy and confirmed by decisions under it that "registration" for this purpose includes registration in the name of a new registrant") (citations omitted.)

54. The Respondent selected (and uses) the disputed domain name only because it is similar to the Complainant's trademark. Therefore, due to user confusion, the website will generate traffic "so that the *Respondent* can receive commercial gain from advertising to the Internet users who intend to visit the Complainant's website by use the disputed domain name by mistake. This is not bona fide within the meaning of paragraph 4(c) of the Policy." See *Digital Spy Limited v. Moniker Privacy Services and Express Corporation*, WIPO Case No. D2007-0160. This

³ Even if the Panel somehow disagrees that the Complainant's common law rights had not accrued at the date of registration, even speculative registration is bad faith. See *Facebook Inc. v. Privacy Ltd. Disclosed Agent for YOLAPT*, WIPO Case No. D2007-1193 ("As a general rule, a domain name is not registered in bad faith if it was registered before the trademark. Still, an exception must be made to this rule where the respondent registered the domain name with speculative intent in full knowledge of the likely use of the trademark by the complainant, and, more particularly, where the respondent hopes to either benefit from confusion and the diversion of web traffic or by selling the domain name to the trademark holder."). See also, *ExecuJet Holdings Ltd. v. Air Alpha America, Inc.*, WIPO Case No. D2002-0669; *Joe Cole v. Dave Skipper*, WIPO Case No. D2003-0843; *General Growth Properties, Inc., Provo Mall L.L.C. v. Steven Rasmussen/Provo Towne Centre Online*, WIPO Case No. D2003-0845; MADRID 2012, *S.A. v. Scott Martin-MadridMan Websites*, WIPO Case No. D2003-0598. Even if the Complainant's rights did not predate the registration, "the Respondent in all likelihood had such speculative intent and thus that the registration of the disputed domain name occurred in bad faith." *Facebook v. Privacy Ltd. Disclosed Agent for YOLAPT*, WIPO Case No. D2007-1193.

assertion is backed up by the fact that not only is the domain identical to the Complainant's common law mark, in use since 1994, but that the historical screen shots of the websites hosted at BME.com all show that the domain was used solely for sponsored, pay-per-click links pertaining to tattooing, body art, body piercing, and other services that would be identified with the Complainant. BME could theoretically have other meanings, but it can have no other meaning in the context of this relevant marketplace, and the Respondent's use shows that the registration was in bad faith.

55. The Respondent cannot claim that his registration or use was innocent. Even if the registration was made in some automated fashion, such methods of registration have been held to be bad faith. See *Mobile Communication Service Inc. v. WebReg, RN*, WIPO Case No. D2005-1304; C.f. *Grundfos A/S v. Texas International Property Associates*, Case No. D2007-1448 ("claim of "no actual knowledge" does not do anything to avoid the "willful blindness" difficulty the Respondent faces in terms of cases such as *Mobile General Communications and Media General Communications, Inc.*"); *HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*, Case No. D2007-0062 (willful blindness in use of automated registration system resulted in registration of "creditkeeper.com" domain).⁴ See also, arguments presented in Paragraph 48 of this Complaint.

56. The Complainant had a pending U.S. trademark registration on the date of registration. The Complainant had overwhelmingly famous common law rights on the date of registration (even as of the date of the original registration). In fact, if the Panel conducts a search on any search engine for "BME," one of the Complainant's websites will certainly be the first result. As such, it simply can not be credibly claimed by the Respondent that he did not have actual knowledge of the Complainant when registering the domain. Nevertheless, even if the Panel is

⁴ This concept comes into play for automated generation of websites on cybersquatting pages as well. See, e.g., *State of Florida, Florida Department of Management Services v. Bent Pettersen*, WIPO Case No. D2008-0039. ("Even if the content of that portal website was generated automatically - such that the Respondent was not directly aware of its precise content - the Respondent must, at least, have been aware that the website would be determined by search terms relating to the value of the mark that he wished to exploit. This would appear to be the natural result of 'parking' the disputed domain name at the website. Further, the Respondent is ultimately responsible for the content of the website within his control. As such, the Respondent could not avoid responsibility for the automatic generation of links at the subject website."); *Villeroy & Boch AG v. Mario Pingerna*, WIPO Case No. D2007-1912. ("The Respondent is responsible for the content of any webpage hosted at the disputed domain name. It cannot evade this responsibility by means of its contractual relationship with the Registrar. The relationship between a domain name registrant and the Registrar does not affect the rights of a complainant under the Policy"); *Port Aventura, S.A. v. Fred McCaw c/o Chelsey McCaw Publishing, Inc.*, WIPO Case No. D2008-0177.

inclined to be charitable and find that there was no actual knowledge, constructive knowledge of a mark is properly applied in UDRP proceedings. See *HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager*, Case No. D2007-0062; *Mobile Communication Service Inc. v. WebReg, RN*, WIPO Case No. D2005-1304. See also *Media General Communications, Inc. v. Rarenames, WebReg*, WIPO Case No. D2006-0964; *Facebook Inc. v. Privacy Ltd. Disclosed Agent for YOLAPT*, WIPO Case No. D2007-1193 (“The Respondent either knew or should have known of the Complainant’s prominent use of FACEBOOK.”); *National Hockey League And Lemieux Group Lp v. Domain For Sale*, WIPO Case No. D2001-1185 (“the Respondent should have been well aware of the NHL family of trade marks when he registered his trade marks. See *Ticketmaster Corporation. v. Spider Web Design, Inc.*, WIPO Case No. D2000-1551. (“The Respondent’s constructive knowledge of the Complainants’ marks establishes Respondent’s registration of the contested domain name as a patently illegitimate attempt to misleadingly divert NHL and Pittsburgh Penguins fans”); *RRI Financial, Inc., v. Ray Chen*, WIPO Case No. D2001-1242 (“Respondent had constructive notice of the RED ROOF Trademarks, as a trademark search on the date of the registration of the Domain Names would have revealed Complainant’s registrations the United States. Actual or constructive knowledge of the Complainant’s rights in the Trademarks is a factor supporting bad faith.”); In *SportSoft Golf, Inc. v. Hale Irwin’s Golfers’ Passport* (NAF case FA94956) (finding of bad faith was made where the respondent “knew or should have known” of the registration and use of the trade mark prior to registering the domain name.”).

2. BAD FAITH USE

57. The domain was used as a cybersquatting site prior to the current registration. It is clear that both the prior registrant and the current registrant registered the domain in bad faith and it should not take much in the way of persuasion that the Respondent has engaged in bad faith use of the domain. The term “BME,” if searched for on Google, Yahoo, or AskJeeves, will return the Complainant as the first result. In fact, given the minimal amount of effort required to determine that BME is a strong common law trademark, and the Respondent’s use of the domain name, it can not be seriously believed that the Respondent did not have the Complainant in mind when registering the domain name.

58. If the Panel examines the web page found at BME.com as it appears as of the date of this Complaint and on all cached dates prior, it is clear that the Respondent is trying to capitalize on

the Complainant's rights to the common law mark, BME. See Exhibits S and X. There is no explanation as to why a party would register BME.com and then use the domain to market piercing, tattooing, and body art links except that the registrant intended to infringe upon BME's intellectual property rights.

59. It is presumed that the domain was used in bad faith earlier than 2006. However, the current registrant has recently, since being approached by the Complainant to attempt to resolve this matter in a non-adversarial manner, employed the use of the robots.txt file on the page in an attempt to suppress the evidence of the bad faith registration and use in the past. See Exhibit Q. This, in itself, is evidence of bad faith. See, e.g., *The iFranchise Group v. Jay Bean / MDNH, Inc. / Moniker Privacy Services* [23658], WIPO Case No. D2007-1438.

60. Despite the Respondent's clever use of robots.txt to suppress evidence that could be used against him, screen shots of the web page at BME.com are still available on the Domain Tools website, and a historical record of them is attached as Composite Exhibit X. As the Panel can see, this domain has apparently only been used, even by the previous registrant, as a website whose sole function is to trade upon the BME mark by providing sponsored links pertaining to body art, piercing, tattooing, and the like. There is no evidence of it ever being used for any other purpose.

3. FALSE WHOIS INFORMATION

61. Providing false information at the moment of registering a domain name has been held to constitute bad faith. See e.g., *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003; *Quixtar Investments, Inc. v. Scott A. Smithberger and QUIXTAR-IBO*, WIPO Case No. D2000-0138.

62. The Respondent, upon registration, used a privacy service. The use of a privacy protection service is not, per se, evidence of bad faith. However, it is reasonable to infer, that the Registrant has used a privacy service in order to mask his identity in order to make it more difficult for a lawsuit (which could result in damages of \$100,000) to be filed against him under the ACPA. The Respondent has knowledge of the Complainant's mark (as evidenced by the Respondent's use), and has used the robots.txt file in order to attempt to suppress relevant evidence. Suppression of evidence, plus knowledge of wrongdoing leads to the reasonable conclusion that this privacy service was not used for a legitimate reason, but that it was used in an attempt to evade liability. In the event that the Respondent appears in this case and is

revealed to be a serial cybersquatter, and/or there are other relevant arguments to make pertaining to his identity, the Complainant will request leave to file a supplemental filing in this case.

4. CONFUSION HAS OCCURRED AND WILL CONTINUE IF THE RELIEF IS DENIED

63. The Complainant does not need to show actual confusion; rather, the potential for reasonable confusion is sufficient. Where the domain is likely to cause "initial interest confusion" such that users might abandon their efforts to find Complainant's products, it is irrelevant that the users eventually realized that the site they reached is not the site they were seeking: *Tall Oaks Publishing, Inc. and Frank L. Slejko, Ph.D. v. National Trade Publications, Inc.*, NAF Claim No. FA94346 (ultrapurewater.com), *Mariah Boats, Inc. v. Shoreline Marina, LLC*, NAF Claim No. FA94392 (mariahboats.net).

64. Panels find a likelihood of confusion even though users may soon discover the unlikelihood of a business relationship between Complainant and Respondent because Respondent would have gained website traffic from the establishment of the link via the confusingly similar domain name. See *National Football League Properties, Inc. and Chargers Football Company v. One Sex Entertainment Co., a/k/a chargergirls.net*, WIPO Case No. D2000-0118 (chargergirls.com and chargergirls.net).

65. The UDRP only requires that confusion could reasonably occur when somebody looking for a Complainant's mark is directed to the Respondent's website, or any other on-line location, no matter which the actual destination may be. See *SGS Société Générale de Surveillance S.A. v. Inspectorate*, WIPO Case No. D2000-0025 (sgs.net). It is not only reasonable to presume that confusion could occur in this case, but confusion has verifiably occurred. See Exhibits T, U, I-L.

VI. Remedies Requested

(Rules, para. 3(b)(x))

66. In accordance with Paragraph 4(i) of the Policy, for the reasons described in Section V above, the Complainant requests the Administrative Panel appointed in this administrative proceeding issue a decision that the contested domain name be transferred to the Complainant.

VII. Administrative Panel

(Rules, para. 3(b)(iv))

67. The Complainant elects to have the dispute decided by a single-panelist Administrative Panel.

VIII. Mutual Jurisdiction

(Rules, para. 3(b)(xiii))

68. In accordance with Paragraph 3(b)(xiii) of the Rules, the Complainant will submit, with respect to any challenges that may be made by the Respondent, to a decision by the Administrative Panel to transfer or cancel the domain names that are the subject of this Complaint, to the jurisdiction of the courts in the Southern District of Florida – the principle place of business of the Registrar.

IX. Other Legal Proceedings

(Rules, para. 3(b)(xi))

70. None.

X. Communications

(Rules, paras. 2(b), 3(b)(xii); Supplemental Rules, paras. 3, 4)

76. A copy of this Complaint, together with the cover sheet as prescribed by the Supplemental Rules, has been sent or transmitted to the Respondent on June 9, 2008 by certified U.S. Mail.

A copy of this Complaint has been sent or transmitted to the concerned registrar on June 9, 2008 by certified U.S. Mail to Moniker.com, 20 SW 27th Ave. Suite 201, Pompano Beach, Florida 33069.

77. This Complaint is submitted to the Center in electronic form (except to the extent not available for annexes), and in four (4) sets together with the original.

XI. Payment

(Rules, para. 19; Supplemental Rules, Annex D)

78. As required by the Rules and Supplemental Rules, payment in the amount of USD \$1,500 has been made by check and transmitted via Federal Express along with the original of this Complaint to the WIPO Arbitration and Mediation Center, 34, chemin des Colombettes, 1211 Geneva 20, Switzerland.

XII. Certification

(Rules, para. 3(b)(xiv))

79. The Complainant agrees that its claims and remedies concerning the registration of the domain name, the dispute, or the dispute's resolution shall be solely against the domain name holder and waive all such claims and remedies against (a) the WIPO Arbitration and Mediation

Center and Panelists, except in the case of deliberate wrongdoing, (b) the concerned registrars, (c) the registry administrator, (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents.

80. The Complainant certifies that the information contained in this Complaint is to the best of the Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under the Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Date: June 9, 2009

Respectfully submitted,

A handwritten signature in blue ink that reads "Marc J. Randazza". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

Weston, Garrou, Walters & Mooney

Marc J. Randazza

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Massachusetts Bar No: 651477

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