

DISPUTE RESOLUTION SERVICE

D00014844

Decision of Independent Expert

Booksfree.com Corporation t/a AudiobooksNow

and

DME Media LLC.

1. The Parties:

Lead Complainant: Booksfree.com Corporation
t/a AudiobooksNow
8453-P Tyco Road
Vienna
Fairfax
22182
United States

Respondent: DME Media LLC.
4259 Austin Ridge Dr.
St. Charles
Missouri
63304
United States

2. The Domain Name(s):

audiobooksnow.co.uk

3. Procedural History:

01 October 2014 19:04 Dispute received
02 October 2014 09:55 Complaint validated
02 October 2014 10:03 Notification of complaint sent to parties
21 October 2014 02:30 Response reminder sent
22 October 2014 08:59 Response received
22 October 2014 09:00 Notification of response sent to parties
23 October 2014 09:12 Reply received

30 October 2014 09:26 Notification of reply sent to parties
30 October 2014 09:26 Mediator appointed
05 November 2014 14:17 Mediation started
14 November 2014 11:18 Mediation failed
14 November 2014 11:18 Close of mediation documents sent
26 November 2014 01:30 Complainant full fee reminder sent
26 November 2014 13:05 Expert decision payment received

I confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

4. Factual Background

Both the Complainant and the Respondent maintain websites which provide retail access to audiobooks to Internet users.

On 1 March 1998 the gTLD domain name <audiobooksnow.com> was registered and subsequently the Complainant established a website at that address. The WhoIs notes that it is presently registered in the name of an employee of the Complainant.

On 10 September 2010 the disputed domain name <audiobooksnow.co.uk> was created.

In the months of December 2010, January 2011 and November 2012 email correspondence passed between the Parties which has no direct relevance to this Complaint as it relates to them making arrangements to speak about possible business co-operation between the companies. It does however demonstrate that the Parties were in contact with each other for a number of years prior to this dispute.

On 18 December 2013 the Complainant made email contact with the Respondent enquiring if it was interested in selling the disputed domain name <audiobooksnow.co.uk>. The correspondence continued for two days during which the Complainant offered to purchase the disputed domain name for \$150 and the Respondent stated that it would not consider selling it “for less than 5 figures (high 5, not low 5)”. The negotiations were not fruitful and in the final email the Respondent stated: “We’re not a ‘domainer’, we’re an audiobook company – just like you. Our expectations are higher because if we’re going to sell this domain we need to make enough money to justify the lost revenue from releasing it to you (or anyone else for that matter) versus building out a site behind the domain. Whether we have just this domain, 5 others or hundreds of others has absolutely nothing to do with our expectations related to this particular domain. This is a great domain, which is why we chose to purchase and use it. If you’re not interested in pursuing this further I understand, but please know there are is (sic) no ill will here. Remember... you reached out to me about buying it, I didn’t reach out to you about selling it.”

On 31 January 2014 the Complainant made an application for registration of USA service mark AUDIOBOOKSNOW design, registered on 16 September 2014 for services in international class 35 on the principal register with registration number 4,604,891.

5. Parties' Contentions

Complaint

The Complainants submit that Booksfree.com is the parent company of AudiobooksNow; that it holds a service mark for "the AudiobooksNow logo"; and that it has been providing a digital audiobook service called AudiobooksNow on its website at the <www.audiobooksnow.com> address since January 2012.

The Complainant submits that because it has an established business using the name AudiobooksNow for almost 2 years, and the website established at the <audiobooksnow.com> address and supporting apps, and the fact that it has registered its "logo/name" as a service mark with the US Patent and Trademark Office ("USPTO"), any use of the disputed domain name <audiobooksnow.co.uk> that is related to audiobooks in any way would confuse users and damage its business.

In 2013 the Complainant decided to expand its service to the United Kingdom and found that the disputed domain name <audiobooksnow.co.uk> was already registered by the Respondent. The Respondent was known to the Complainant as it had tried to establish a business connection in the past to promote the Complainant's websites.

The Complainant complains that the Respondent is currently "just sitting on" the disputed domain name <audiobooksnow.co.uk> and when approached by the Complainant about purchasing it, stated that it would not accept any less than high 5 figures for it (meaning in the high tens of thousands of US dollars).

The Respondent promotes services like the Complainant through websites such as <www.theaudiobookstore.com> and if it were to use the disputed domain name <audiobooksnow.co.uk> to promote the Complainant's competitors or any type of audiobook service that would be infringement of the Complainant's rights.

The Complainant states that the Respondent establishes websites that are store fronts on the web that drive traffic to specific websites and receives a commission on every sale that comes through one of its sites. The Complainant alleges that the Respondent's website at <www.TheAudiobookStore.com> is simply a store front for driving traffic to one of the Complainant competitors Audiobooks.com.

Response

The Respondent denies using the domain in question in any way that is abusive, competes with, harms, or disrupts the Complainant's business and asserts that it has not received any revenues from the disputed domain name.

The Respondent submits that it lawfully registered the disputed domain name on 10 September 2010 which was prior to any use by the Complainant of the <audiobooksnow.com> domain name and that it has since been simply holding the disputed domain name, which it has a legal right so to do.

The Respondent submits that it registered the disputed domain name <audiobooksnow.co.uk> on 10 September 2010 which was prior to the date in January 2012 on which the Complainant claims to have first used the <audiobooksnow.com> domain name.

Furthermore, the Respondent submits that the USPTO Service Mark registration relied upon by the Complainant was only filed on 31 January 2014, with a registration date of 16 September 2014, claiming first use in commerce on 2 September 2011.

Reply

In a Reply, the Complainant adduced additional email correspondence between the parties and submitted that it proves that the Respondent intends to "use" the domain name to make money.

The Complainant repeated its assertion that the Respondent does not "run" an audiobook service, but is an affiliate marketer that simply puts up storefronts and drives traffic to real services for which the Respondent receives a commission "when someone goes from the Respondent's storefront website (<http://www.theaudiobookstore.com/>) to a real audiobook service (<http://www.audiobooks.com/>)".

6. Discussions and Findings

Paragraphs 2.a and 2.b of the DRS Policy provides that to succeed in a complaint, a complainant is required to prove to the Expert that on the balance of probabilities:

- i. The Complainant has Rights in respect of a name or mark which is identical or similar to the disputed domain name; and
- ii. The disputed domain name, in the hands of the Respondent, is an Abusive Registration.

Identical Mark and Domain Name

This Expert finds that the disputed domain name is identical to the <audiobooksnow.com> domain name and to the word elements AUDIOBOOKSNOW in the USA registered Service Mark registration number 4,604,891 relied upon by the Complainant. For the purposes of comparison the suffixes <co.uk> and <.com> may be ignored in the circumstances of the present Complaint.

Complainant's Rights

According to the Nominet Overview at paragraph 2.2 a Complainant is required to prove that it "has an enforceable right (i.e. a legally enforceable right)" in the mark relied upon.

The rights relied upon by the Complainant in the USPTO service mark registration were not acquired until four years after the date of registration of the disputed domain name. Furthermore for reasons given below, in the view of this Expert, the rights acquired by the Complainant by the USPTO registration are very narrow in scope and the registration expressly states that "No claim is made to the exclusive right to use "AUDIOBOOKS" apart from the mark as shown."

Furthermore while the Complainant asserts common law rights in use of the gTLD domain name <audiobooksnow.com>, it has not provided any evidence to show the extent if any of such rights. Furthermore the gTLD domain name <audiobooksnow.com> is registered in the name of a person other than the Complainant. While it appears from the file that the registrant is the executive dealing with this matter on behalf of the Complainant, it would be expected that there should be some statement to that effect or explanation in the pleadings or evidence of the connection between the Complainant and the registrant of the <audiobooksnow.com> domain name.

Nonetheless this Expert is prepared to accept that the bar to be met by a complainant in the first element of the test in paragraph 3 of the DRS Policy should be set sufficiently low as to allow the Complainant to succeed on the basis of non-exclusive rights in the USPTO registration. In making this finding this Panel is conscious that the addition of the element "NOW" adds a certain level of distinctiveness to the generic words "AUDIO" and "BOOKS".

This Expert finds therefore that the Complainant has narrowly succeeded in establishing the first element of the test in paragraph 2 of the DRS Policy.

Abusive Registration

"Abusive Registration" is defined in paragraph 2 of the DRS Policy as meaning a Domain Name which either:

- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or
- ii. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;

Firstly there is no evidence that the Complainant had any rights in the AUDIOBOOKSNOW name or mark on 10 September 2010 when the disputed domain name was registered. On the evidence the Complainant's rights in the mark, such as they are, were acquired subsequent to the registration of the disputed domain name.

While the Complainant had registered a corresponding <audiobooksnow.com> domain name on 1 March 1998, it did not use it for a number of years. The Complainant's USPTO Service Mark registration claims first use of the mark on 2 September 2011 and first use in commerce on 25 January 2012. It follows that on the date of registration of the disputed domain name the Complainant had no registered rights in the mark AUDIOBOOKSNOW and had not acquired any rights in the mark through use.

Secondly, the Complainant has failed to satisfy this Expert that the disputed domain name has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights. In the view of this Expert the Complainant's enforceable rights are very narrow. The Complainant's Service Mark is a device mark consists of the word "AUDIOBOOKS" with a capital letter "A" below which is the word "NOW" which also starts with a capital letter "N". To the left of these words is an image of a mobile device, with buttons on the bottom and a screen in the middle, draped over which is the image of a bookmark and there are bands radiating from the top of the device depicting wireless waves.

Thirdly, the Complainant's rights acquired by the USPTO Service Mark registration did not exist on the date of registration of the disputed domain name in 2010.

Fourthly, while the disputed domain name is inactive, in the view of this Expert, this is not a simple case of passive holding of a domain name for an abusive purpose. It is acknowledged by the Complainant that the Respondent is carrying on a commercial business and furthermore there was a period between 10 September 2010 and 2 September 2011 when both the Complainant and the Respondent simultaneously held their domain name registrations in an inactive status.

In the circumstances, this Panel finds that the Complainant has failed to prove on the balance of probabilities that the disputed domain name in the hands of the Respondent is an "Abusive Registration"

7. Decision

For the reasons set out above this Expert finds that the Complainant has failed to prove on the balance of probabilities that the disputed domain name <audiobooksnow.co.uk> is an Abusive Registration as defined by Paragraph 1 of the Policy.

The Complainant's application is refused.

Signed James Bridgeman, Expert

Dated 16 December 2014