



**NATIONAL
ARBITRATION
FORUM**

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DECISION

ImageShack Corp. v. RegisterFly.com-Ref#17592297 c/o Whois Protection Services-
ProtectFly.com
Claim Number: FA0505000473833

PARTIES

Complainant is **ImageShack Corp.** (“Complainant”). Respondent is **Steven Baxt** (“Respondent”), represented by **John Berryhill**, of **Dann, Dorfman, Herrell, and Skillman P.C.**, 1601 Market Street, Suite 2400, Philadelphia, PA 19103.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**imageshack.com**>, registered with **Enom, Inc.**

PANEL

The undersigned certify that they have acted independently and impartially and to the best of their knowledge have no known conflict in serving as Panelists in this proceeding.

Jeffrey M. Samuels, Chair
Honorable Nelson A. Diaz
Peter L. Michaelson

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on May 9, 2005; the National Arbitration Forum received a hard copy of the Complaint on May 16, 2005.

On May 10, 2005, Enom, Inc. confirmed by e-mail to the National Arbitration Forum that the domain name <**imageshack.com**> is registered with Enom, Inc. and that the Respondent is the current registrant of the name. Enom, Inc. has verified that Respondent is bound by the Enom, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On May 24, 2005, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of June 13, 2004, by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@imageshack.com by e-mail.

A timely Response was received and determined to be complete on June 13, 2005.

On June 16, 2005, Complainant filed a timely "Additional Submission." Respondent, thereafter, submitted an "Additional Submission" which did not meet the timeliness requirement of Supplemental Rule #7. However, the Panel, exercising its discretion under Rule 10 of the Rules for Uniform Domain Name Dispute Resolution Policy, has determined to consider the contents of such submission.

On June 27, 2005, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the National Arbitration Forum appointed Jeffrey M. Samuels, the Honorable Nelson A. Diaz, and Peter L. Michaelson as Panelists.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

Complainant ImageShack Corp. provides image hosting on the Internet at its website located at www.imageshack.us. According to the Complaint, the ImageShack syndication allows webmasters to place the ImageShack image upload form directly onto their respective web sites. In this way, the webmaster's visitors who upload images see the "ImageShack" trademark upon upload completion and, thus, become familiar with the "ImageShack" name and mark.

On August 16, 2004, Complainant filed an intent-to-use application (Serial No. 78/467863) with the United States Patent and Trademark Office (USPTO) seeking registration of the "ImageShack" mark as intended to be used in connection with "Internet digital media content hosting and distribution."

Complainant alleges that the <imageshack.com> domain name is confusingly similar to the "ImageShack" mark because it incorporates the mark in its entirety and simply adds the generic top-level domain ".com."

Complainant further alleges that Respondent has no rights or legitimate interests in the disputed domain name. Complainant asserts that Respondent intentionally obtained ownership of the <imageshack.com> domain name from a third party without any means or connection with a *bona fide* offering of goods or services. It further maintains that

Respondent has not been commonly known by the <imageshack.com> domain name and that Respondent knew of Complainant's business, as well as of the imageshack.us domain name, at the time (i.e., August 27, 2005) it obtained ownership of the disputed domain name.

Complainant also contends that Respondent is not making a legitimate or noncommercial fair use of the domain name. Complainant indicates that Respondent has "parked" the <imageshack.com> domain name on a third party advertisement provider. By doing so, Complainant argues, Respondent receives commercial profit from these advertisement providers and tarnishes the "ImageShack" mark by associating it with profit-generating parking pages.

With respect to the issue of "bad faith" registration and use, Complainant maintains that Respondent purchased the <imageshack.com> domain name from a third party in order to prevent Complainant from reflecting the mark in a corresponding domain name. It further urges that Respondent has intentionally attempted to attract, for commercial gain, Internet users to the <imageshack.com> domain by creating a likelihood of confusion with the "ImageShack" mark.

In support of the requirement to establish "bad faith" registration and use, Complainant also contends that Respondent is using the disputed domain name passively and that Respondent has attempted to conceal its correct contact information.

B. Respondent

Respondent first notes that the mere existence of Complainant's intent-to-use trademark application is not evidence of a trademark. Respondent notes that such application has not yet been allowed by the USPTO.

With respect to the issue of legitimate rights or interests, Respondent notes that the disputed domain name was first registered in 2002, prior to Complainant's existence, and was operated by an English registrant for a photographic sales web site. In April 2005, Respondent, which is based in Australia, purchased the domain name for \$18,000. According to Respondent, the domain name was registered for use in connection with an amateur photographic site at which participants could post their photos for rating by other users of the site. Respondent asserts that, while it is true that the domain name has been "parked," it has been working on graphics and layouts to be used when the site is launched.

Finally, Respondent urges that there is no evidence of the requisite "bad faith" registration and use. As stated by Respondent:

...Respondent could not have imagined, after making an \$18,000 investment in a .com domain name existing since 2002, that a later .us domain registrant would spring out of the woodwork with a claim of entitlement to the domain name. The Respondent sought

to purchase an appropriate domain name for a photographic rating site the Respondent intended to develop, and indeed has been developing, Contrary to the Complainant's assertions concerning the Respondent's state of knowledge, it is a basic principle of law that Australians do not owe a duty to be aware of pending U.S. intent-to-use applications, much less in view of registration applications which, like the Complainant's, have been refused registration.

[***]

...If users of the Complainant's website mistakenly visit the .com website, that is certainly not a new development, but is a fact caused by the Complainant's original decision to use imageshack.us, when the Complainant knew full well at the time that <imageshack.com> was already registered to another party and might possibly never be available to the Complainant.

C. Additional Submissions

In its "Additional Submission," Complainant contends that the evidence submitted by Respondent in support of its contention that it is making demonstrable preparations to use the domain name indicates that Respondent proceeded to work on the site even after being notified of the filing of the instant ICANN proceeding. "It is ImageShack's Corp's belief that the Respondent created these documents for the sole purpose of providing proof, however misleading, that actions have been taken to create a bona fide provision of service, when in fact, no such actions would have been taken if ImageShack Corp. had not proceeded with its Complaint."

Focusing on the purchase price of the <imageshack.com> domain name and the fact that such site is still in development, Complainant argues that such price signifies that Respondent intends to profit off the popularity of the "ImageShack" mark and Complainant has established a meaning in connection with its services.

Complainant also contends that its pending trademark application has not been refused and argues that its mark is popular. In support, it notes that that a Google® search indicates that 1,270,000 pages reference the ImageShack Corp. web site, Complainant's services, as well as the "ImageShack" mark; that "Wikipedia," one of the largest encyclopedias on the internet, has a site dedicated to a description of Complainant's site, a listing of the services provided, as well as Complainant's mark; and that "Alexa"'s traffic rank shows that Complainant's web site holds a rank of 2,085 out of millions currently on the internet.

In its "Additional Submission," Respondent points out that Complainant's trademark application, indeed, has been refused. It also accuses Complainant of knowingly misusing

the ® symbol on its web site in connection with the “ImageShack” mark since the mark is not the subject of a federal registration.

Respondent also presents evidence that the file creation date for its logo was May 12, 2005, before any notification of the instant ICANN proceeding. It further contends that it has long been engaged in the business of photography and submitted as evidence thereof a May 23, 2003, certificate from the New York Institute of Photography attesting to Respondent’s completion of a course in professional photography.

FINDINGS

The Panel concludes that Complainant has not met its burden of proof on all three elements of the applicable Policy. More specifically, the Panel finds that: (1) Complainant has not established that it has rights in the “ImageShack” mark and, alternatively, (2) that Complainant has not established that Respondent does not have rights or legitimate interests in the <imageshack.com> domain name.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) instructs this Panel to “decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the Respondent has no rights or legitimate interests in respect of the domain name;
and
- (3) the domain name has been registered and is being used in bad faith.

Identical and/or Confusingly Similar

There is no question that the disputed domain name <imageshack.com> is either identical or confusingly similar to the ImageShack mark. *See, e.g., Pomellato S.p.A. v. Tonetti*, D2000-0493 (WIPO July 7, 2000) (finding pomellato.com identical to complainant’s mark because the generic top-level domain “com” is not relevant). However, to prevail on this element, Complainant must also establish that it has rights in the mark in issue. The Panel concludes that Complainant has not met its burden of proof on this aspect of element one of the Policy.

As noted above, Complainant filed an intent-to-use trademark application with the USPTO to register the mark “Imageshack.” The exhibits attached to Complainant’s “Additional Submission” indicate that the application was initially refused on March 20,

2005, on grounds that the recitation of services was indefinite. Thereafter, on June 14, 2005, Complainant consented to the amendment of the recitation of services and the Examiner amended the application accordingly. Significantly, it does not appear that Complainant has filed any evidence of use of the “ImageShack” mark with the USPTO. Unless and until such evidence is submitted, no registration may issue.

While rights in a mark may be established under the common law absent a registration, the Panel determines that there is insufficient evidence of any common law rights in the “ImageShack” mark. In order to establish common law-based rights, a complainant must establish that the mark has become a distinctive identifier associated with the complainant or its goods and services. Relevant evidence on this issue would include length of use, amount of sales, the nature and extent of advertising, consumer surveys, and media recognition. *See, e.g., Australian Trade Commission v. Matthew Reader*, Case D2002-0786 (WIPO Nov. 12, 2002).

The Panel has reviewed the evidence submitted by Complainant in its apparent effort to establish common law rights in “Imageshack.” Suffice it to say, the Panel is not convinced that such evidence, including the results of the Google® search, establish sufficient use to create common law rights or, more fundamentally, that the relevant public would perceive the term “ImageShack” to function as a mark.. Hits alone do not establish trademark use. All a hit represents is the inclusion of the search term on a web page – and that term can be present for a wide variety of uses and for uses having nothing whatsoever to do with trademark usage. The fact that Complainant includes the ® symbol in connection with the term “ImageShack” is not controlling on whether such term functions as a mark. Complainant cannot bootstrap its contention regarding rights in the “ImageShack” term through improper reliance on the ® symbol.¹

Rights or Legitimate Interests

While the determination that Complainant does not have rights in the “ImageShack” mark is fatal to Complainant’s request for transfer of the domain name, the Panel further determines that Complainant has failed to establish that Respondent does not have rights or legitimate interests in the <**imageshack.com**> domain name.

It is not contested that the domain name was registered in 2002 by a third party, which was prior to the time Complainant was formed², and that the original owner of the domain name was using it for photographic services. Upon sale of the domain name to Respondent, Respondent undertook actions, though not yet complete, to use the name with a site that will offer bona fide services, also related to photography. Such actions appear to have commenced prior to the time this proceeding was brought.³ Thus, the

¹ As noted by Respondent, U.S. trademark law (15 U.S.C. §1111) provides that the ® symbol may only be used in connection with a mark that is registered with the USPTO.

² The evidence indicates that Complainant’s articles of incorporation were signed on July 13, 2004.

³ Exhibit C to Respondent’s “Additional Submission” indicates that work on Respondent’s logo took place no later than May 12, 2005. According to the “Complaint Notification Instructions” for the instant case, a hard copy of the

Panel finds that Respondent's actions, viewed in their totality, fall within paragraph 4(c)(i) of the Policy.

Registration and Use in Bad Faith

Given the Panel's conclusions with respect to the first two elements of the Policy, it need not determine whether the domain name was registered and used in "bad faith."

DECISION

Having concluded that Complainant has failed to establish all three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.

Jeffrey M. Samuels (Panel Chair)

Hon. Nelson A. Diaz

Peter L. Michaelson

Dated: July 8, 2005

complaint was submitted by ImageShack Corp. and received by the National Arbitration Forum on May 16, 2005. In a letter dated May 18, 2005, NAF notified ImageShack of certain deficiencies in the complaint. ImageShack's corrected complaint is signed and dated May 19, 2005. The instant proceeding was not commenced until May 24, 2005.