

ADMINISTRATIVE PANEL DECISION

The Black & Decker Corporation v. Giovanni Laporta, Yoyo.Email
Case No. D2014-1891

1. The Parties

The Complainant is The Black & Decker Corporation of Towson, Maryland, United States of America (“United States”), internally-represented.

The Respondent is Giovanni Laporta, Yoyo.Email of Traverse City, Michigan, United States, represented by Traverse Legal, PLC, United States.

2. The Domain Names and Registrar

The disputed domain names <blackanddecker.email> and <dewalt.email> 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 October 28, 2014. Later that day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On October 29, 2014, the Registrar transmitted by email to the Center its verification response confirming the Respondent as the registrant of both disputed domain names and providing contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and that the proceeding commenced on October 31, 2014. In accordance with the Rules, paragraph 5(a), the due date for Response was set to November 20, 2014. The Response was filed with the Center on November 20, 2014. Thereafter, an email, specifically a supplemental filing, was received from the Complainant on November 25, 2014.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on December 2, 2014. 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

As reflected in the registration records for the disputed domain names in the Registrar's Whois database (a copy of that record appears in Annex 1 to the Complaint), the disputed domain names <blackanddecker.email> and <dewalt.email> were created on March 29, 2014 and June 6, 2014, respectively, and are presently set to expire on March 29, 2015 and June 6, 2015, respectively.

A. The Complainant's Marks

As indicated in the Complaint, the Complainant owns a considerable number of trademark registrations worldwide for marks BLACK & DECKER and DEWALT, in block letters and stylized form, including in the United States, the United Kingdom and, via Community Trademark registrations, throughout the European Common Market. The Complainant has provided copies of some of its registration certificates in these particular geographic areas in Annexes 5-36 to the Complaint. Pertinent details of a few of these registrations are as follows:

1. BLACK & DECKER (block letters)
United States registration no.: 517,319
registered as of: November 8, 1949; filed: June 19, 1945

This mark is registered for use in connection with: "Hand manipulatable portable electric tools — namely, tool grinders, hammers, chippers, concrete breakers, drills, screw bolt and nut drivers, floor grinders, tool post grinders, aerial, *i.e.*, suspended grinders, stud setters, hand saws, polishers, sanding machines, flex disc grinders, socket wrenches, hole saws, and electric vacuum cleaners" all in international class 21. This mark claims a first use in commerce date as of January 1, 1915 and a first use in inter-state commerce date as of March 19, 1915.

2. DEWALT (block letters)
United States registration no.: 2,259,919
registered as of: February 14, 1956; filed: September 22, 1954

This mark is registered for use in connection with: "Power saws and wood-working machines, and parts thereof and attachments therefor" in international class 7 and claims first use and first use in commerce dates of January 1, 1923.

3. BLACK & DECKER (block letters)
United Kingdom registration no.: 00795994
registered as of: September 29, 1959

This mark is registered for use in connection with: "Grinding machines, machines for use in reconditioning parts of internal combustion engines, and portable tools, all electrically-operated and parts and fittings" in international class 7.

4. DEWALT (stylized)
United Kingdom registration no.: 002106876
registered as of: March 21, 1997

This mark is registered for use in connection with: "Hiring, maintenance and repair of machinery, tools and tool repair services" in international class 37.

5. BLACK & DECKER (block letters)
Community Trade Mark registration no.: 001239201
registered as of: July 11, 2000

This mark is registered for use in connection with: "Paper, cardboard and goods made from these materials; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists materials; paintbrushes; typewriters and office requisites; instructional and teaching material; plastic materials for packaging; playing cards; printers type; printing blocks" all in international class 16, and "Games and playthings; sporting articles; apparatus for games; toys in the form of power tools, such as jig-saws, circular saws, drills, work benches, sanders, planers; toys in the form of hand tools, such as hammers, saws, screwdrivers; parts and fittings for all the aforesaid goods" in international class 28.

6. DEWALT (block letters)
Community Trade Mark registration no.: 002838845
registered as of: March 26, 2005

This mark is registered for use in connection with: "Elbow and knee protectors for use when riding bicycles, bicycle crash helmets" in international class 9, "Bicycle lights and bicycle reflectors" in international class 11; "Bicycles, bicycle puncture repair kits, bicycle pumps, bells for bicycles, bottle cages for bicycles, stands for bicycles (parts of bikes)" in international class 12, "Bags" in international class 18, and "Water bottles for bicycles" in international class 21.

B. The Parties and Their Interactions

The Black & Decker Corporation is a wholly-owned subsidiary of Stanley Black & Decker, Inc. (SBD) which itself is a diversified global provider of, *inter alia*, hand tools, power tools and related accessories.

SBD was formed in 2010 from the merger of The Stanley Works and The Black & Decker Corporation, both over 100 years old. In 2013, SBD's global revenue was USD 11 billion and had a market capitalization of USD 5.48 billion. SBD employs over 48,000 people and operates in over 175 countries.

SBD received notification from the Trademark Clearinghouse (TMCH) that the Respondent registered the disputed domain names <blackanddecker.email> and <dewalt.email>. Although, through the TMCH Claims Notification process, Respondent had received prior notification of the existence of the earlier trademark rights held by SBD in its marks BLACK & DECKER and DEWALT; it proceeded, in spite of that notice, to register the disputed domain names. Following the TMCH notifications, SBD's counsel wrote a letter (a copy of which appears in Annex 2 to the Complaint) to the Respondent on September 23, 2014 requesting transfer of the two domain names.

In an email response to the September 23 letter and on the same day, the Respondent (a copy of its response appears in Annex 39 to the Complaint) stated that YoYo.Email is providing a "new email recorded delivery service" through which the "domain names are not being used in any trademark way. The <.email> will be used an invisible 'mechanical link' to track and document the sending and receiving of emails in a lawful and controlled way." The Respondent also pointed to a declaratory judgment, discussed shortly below, then being sought regarding whether the Respondent's business model is lawful and would not violate the Policy and the United States Anticybersquatting Consumer Protection Act (ACPA). It refused to transfer the disputed domain names.

Subsequently, on September 24, 2014, the Complainant's counsel sent an email (a copy of which appears in Annex 40 to the Complaint) to the Respondent's counsel through which the former objected to the Respondent's registration of both disputed domain names and reiterated his demands to transfer the domain names to the Complainant. In an email reply (a copy of which also appears in Annex 40 to the Complaint), the Respondent's counsel on October 1, 2014 stated that the Respondent will not transfer either of the disputed domain names and that the Respondent intends, with respect to each name, to:

“only use the domain as a back-end email server to route and store email meta-data.
not to use the domain to host any website.
not to use the domain for as a public facing email address.
to make no trademark use of the domain name.”

The Respondent has registered several thousand “.email” domain names, which incorporate third-party marks. A list of those registrations appears in Annex 42 to the Complaint.

The Respondent stated, in the Response, that its intended business model is to use domain names in conjunction with a back-end, non-public email server to route emails for storing metadata in order to allow the Respondent to certify delivery and potentially receipt of those messages.

On August 29, 2014, the Respondent filed a complaint for a declaratory judgment against Playinnovation, Ltd. with the United States District Court for the District of Arizona for a ruling that the Respondent’s business model was not unlawful and that its domain name <playinnovation.email> does not violate either the Policy or the ACPA. On November 5, 2014 that Court issued a declaratory judgment (a copy of the judgment and the underlying complaint appears in an exhibit to the Response). That judgment, without providing any underlying reasoning, simply stated conclusions that the Respondent has “a good faith intent to register, use and traffic <playinnovation.email>”, has a legitimate purpose in seeking to certify the sending and receipt of emails, has not made any use of <playinnovation.email>, and its intended use of <playinnovation.email> is not trademark use. This judgment resulted from a consent motion for a declaratory judgment stipulated to by both parties (Yoyo.Email, LLC and Playinnovation, Ltd.) to the declaratory judgment action.

5. Parties’ Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name <dewalt.email> is identical to the Complainant’s corresponding mark DEWALT simply because the domain name incorporates that mark in its entirety, while the “.email” generic Top-Level Domain (gTLD) is ignored for the purposes of assessing identity or confusing similarity.

With respect to the other disputed domain name <blackanddecker.email>, the Complainant contends that this domain name is confusingly similar to the Complainant’s corresponding mark BLACK & DECKER as the substitution of the word “and” for an ampersand (the ampersand being invalid as a character in a domain name) is an insignificant alteration which does not alter the connotation of the name relative to the mark.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends, for any of several reasons, that the Respondent has no rights or legitimate interests in either of the disputed domain names pursuant to paragraph 4(a)(ii) of the Policy.

Specifically, the Complainant has neither licensed the Respondent nor otherwise permitted the Respondent to use the Complainant’s marks or the disputed domain names whether or not in connection with any form of an email recorded delivery service. The Complainant has no business interest in the Respondent and has no business with it.

Also, the Respondent has failed to explain why its intended service requires use of domain names which specifically incorporate the Complainant’s marks. Moreover, the Complainant is in email correspondence

daily with third parties around the world, none of whom needs to own domain names with the Complainant's marks in order for communication between them and the Complainant to occur. As such, the Respondent has no legitimate interest in those domain names.

Further, the Respondent has no reputation in or under the Complainant's marks BLACK & DECKER or DEWALT.

(iii) Registered and Used in Bad Faith

The Complainant also contends that the Respondent has registered and is using both disputed domain names in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

Specifically, if the Respondent must use the disputed domain names for its intended service — as it seems to allege, then its use of the Complainant's marks in those domain names is somehow essential to furnishing that service. As such, then the Respondent stands to benefit in some fashion from exploiting the underlying value, *i.e.*, the goodwill, inherent in those marks. However, that value is just what permits the Complainant to identify itself as the sole source of its correspondingly branded goods and services. The Respondent, by exploiting that goodwill, will disrupt the Complainant's business. Either the use of the Complainant's marks in the disputed domain names is necessary to identify the Complainant's business (in which case the domain name registrations have been made in bad faith) or use of these marks is irrelevant (in which case bad faith is evident inasmuch as the Respondent does not need to own these domain names to furnish its intended service).

Moreover, the Respondent apparently ignored the TMCH warning it received prior to having registered the disputed domain names. This, in itself, reflects bad faith registration.

Further, the Respondent's intention in using the disputed domain names, as set forth in the October 1 message, signifies that its purpose in owning the domain names is to compel the Complainant to join its email recorded delivery service. As this goal can only be accomplished by the Respondent obtaining preemptive domain name registrations for disputed domain names, which incorporate the Complainant's marks to establish a service in which the Complainant becomes an unwilling participant, this also reflects bad faith.

Lastly, the Respondent has engaged in a pattern of abusive registrations by virtue of several thousand ".email" based domain name registrations, which incorporate third-party marks.

B. Respondent

Through its response, the Respondent contends that it registered both domain names in good faith. Though prior UDRP panels have held against the Respondent by virtue of the Respondent having included third-party trademarks in its ".email" domain names, those panels have engaged in little more than speculation and conjecture regarding the Respondent's business model and its intention, and based their views on unsupported statements appearing in prior decisions.

The November 5 declaratory judgment validated the Respondent's business model, *i.e.*, using domain names in conjunction with a back-end, non-public email server to route emails for storing metadata in order to certify delivery and potentially receipt of those messages. This model does not entail any trademark infringement or any intention to violate the Policy, and is legitimate under the Policy.

The Respondent has also made demonstrable preparations to use the disputed domain names in that its certification service will be "free for both the sender and receiver of e-mails". Further, by using the domain names as a back-end, non-public email server in order to route emails, the Respondent is not trying to divert traffic intended for the Complainant's website. Moreover, this service will not harm the Complainant's trademark rights.

In addition, though the Respondent intends to profit from its service, it has no intention to profit from its use of the disputed domain names as trademarks by deceiving Internet users. Further, the Respondent did not register the disputed domain names for the purposes of profiting from any sale, rental or transfer of the domain names to the Complainant.

C. Supplemental Filing

The Panel, while not required under the Rules and Supplemental Rules to consider any supplemental filing, has nonetheless exercised its sole discretion to consider the Complainant's Supplemental Filing. That filing provides additional, though ultimately inconsequential, argumentation to those already in the Complaint and a citation to a UDRP decision not previously available. That filing has not altered the outcome of this case.

6. Discussion and Findings

A. Effect of Declaratory Judgment

The Respondent has devoted considerable argumentation in its Response as to the effect of the declaratory judgment issued on November 5, 2014 by the United States District Court for the District of Arizona.

The Panel is not persuaded by any of those arguments and, further, finds that judgment to be irrelevant to the present proceeding.

In particular, the judgment results from a motion consensually filed, most likely by stipulation, by both sides to the underlying action. The judgment merely binds the parties to that action and only to what those parties specifically agreed between themselves as embodied in the judgment. The judgment has no effect on the Complainant which was not party to the action. Also, the judgment is unreasoned; it is merely conclusory. Further, while the Court concluded that the Respondent's business model was lawful, that finding is irrelevant to this proceeding inasmuch as the Complainant here is not questioning the legality of the Respondent's intended business itself, *i.e.*, the provision of an email delivery certification service, but rather the use of the disputed domain names in conjunction with that service where each domain name includes a registered trademark of the Complainant — an issue which was not before the Court nor could be as the Complainant was not a party to that action.

B. Identical or Confusingly Similar

The Panel finds that the disputed domain names <blackanddecker.email> and <dewalt.email> are respectively confusingly similar and identical to the Complainant's marks BLACK & DECKER and DEWALT.

From simply comparing the disputed domain name <blackanddecker.email> to the Complainant's mark BLACK & DECKER, no doubt exists that the name is confusingly similar to the mark. The primary difference between the domain name and the mark is the substitution of the word "and" in the domain name for the ampersand in the mark to form a term along with, secondarily, appending the gTLD ".email" to that term to form the domain name, with the last addition being generally irrelevant in assessing confusing similarity or identity under paragraph 4(a)(i) of the Policy and thus ignored.

It has often been expressed in UDRP decisions that a minor variation, such as adding a short letter or number group including a generic or highly descriptive word, substituting one punctuation mark for another or adding a punctuation mark, to a mark, is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to avoid user confusion. Here, changing the ampersand to its equivalent word, in the manner which the Respondent specifically did, to the mark BLACK & DECKER clearly resulted in such a minor variation. See, *e.g.*, *Cofra Holding AG v. Mr Obada Alzatari*, WIPO Case No. D2014-1709; *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve*

Mart, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703; *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099; *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008; and *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072.

Further, an ampersand, as the Complainant correctly notes, is an invalid character in a domain name. A domain name must start with a letter or digit, end with a letter or digit, and have as interior characters only letters, digits and hyphen (see RFC 1035 and RFC 1123 of the Internet Engineering Task Force). Consequently, it stands to reason that a domain owner, *i.e.*, the Respondent, would readily use the equivalent word “and” in place of an ampersand to preserve whatever connotation the mark had. The word “and” is the most logical substitute using Internet naming grammar/conventions, and probably the only one that makes any sense to users by not changing any aspect of the connotation conveyed by the mark when incorporated into the disputed domain name <blackanddecker.email>.

As to the disputed domain name <dewalt.email>, simply comparing this domain name to the Complainant’s DEWALT mark leaves no doubt that the domain name is identical to the mark. The only difference between the two is the addition of the “.email” gTLD to the mark to form the domain name, with that addition being generally irrelevant in assessing confusing similarity or identity under paragraph 4(a)(i) of the Policy and thus typically ignored.

Thus, the Panel finds that the disputed domain name <blackanddecker.email> is confusingly similar to the Complainant’s mark BLACK & DECKER and the disputed domain name <dewalt.email> is identical to the Complainant’s mark DEWALT. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to suggest a claim of rights or legitimate interests by the Respondent to either of the disputed domain names under paragraph 4(c) of the Policy.

Specifically, for a respondent to acquire rights or legitimate interests to a domain name under paragraph 4(c)(i) of the Policy, the respondent must show that before any notice of a dispute involving the domain name it either used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services.

Here, the record is quite clear: while the Respondent intends to implement an email delivery certification service, it has yet to do so. All that the Respondent currently has is an intention, nothing more. Thus, for purposes of this paragraph 4(c)(i), the Respondent has not used either of the disputed domain names in connection with any (let alone *bona fide*) goods or services.

As to “demonstrable preparations” to use the disputed domain names, this Panel believes that such preparations must constitute some degree of affirmative action taken by the Respondent towards transforming its intention, *i.e.*, an bald idea without more, into an actual implementation. The implementation need not be fully operational or even complete, or ultimately even successful. But the action taken must have advanced the Respondent’s intention, in some fashion, toward its actual realization. Merely having an intention is not enough. The Policy does not define the nature or scope of that action, but rather leaves both to the discretion of the Panel to assess under the particular facts of a dispute. Here, the Panel need not specifically define the metes and bounds of the Respondent’s action, *i.e.*, whether what the Respondent did sufficed, simply because, based on the evidence of record presently before the Panel, the Respondent has provided absolutely no proof that it has proceeded any further toward implementing its email delivery

certification service beyond just having an intention to do so. The record is simply devoid of all such details. Even if those details were provided, such use would not in the Panel's view be *bona fide* under the Policy.

Furthermore, the Respondent has not demonstrated at all why, for its intended service, it needs to own domain names that incorporate the Complainant's registered marks. To that end, under the analysis set forth in *Starwood Hotels & Resorts Worldwide, Inc., Sheraton LLC, Sheraton International IP, LLC v. Giovanni Laporta / yoyo.email*, WIPO Case No. D2014-0686 — with which the Panel completely agrees, any such ownership would adversely affect or tarnish the Complainant's marks by conveying to Internet users a false impression that the Respondent's service is somehow affiliated with, endorsed by or related to the Complainant — when, in actuality, it is not.

Moreover, assuming that the Respondent will necessarily establish some sort of internal email address directory or other such data structure or construct, or some other intermediate functionality as part of an eventual implementation of its email delivery certifying service, in which it will store, subsequently access and/or process domain names of its potential recipient organizations — though the record is entirely remiss on all such details, the Respondent has not shown any reason whatsoever why it must, as an essential element of that implementation, obtain and retain any ownership of domain names that incorporate marks of that recipient organization.

Consequently, the Panel is left to infer that the only reason underlying the Respondent's registration and retention of the disputed domain names is simply to coerce the Complainant, through some manner which the Respondent has yet to manifest, to utilize the Respondent's forthcoming email confirmation service, which is an illegitimate use of the disputed domain names under the Policy.

Hence, the Respondent's conduct simply cannot give rise to any right or legitimate interest, consistent with any plausible reading of paragraph 4(c)(i) of the Policy, in either of the two disputed domain names.

In addition, the Complainant has never authorized the Respondent to utilize any of its marks nor does the Complainant apparently have any relationship or association whatsoever with the Respondent. Given the exclusive trademark rights that reside in the Complainant, the Respondent could not legitimately acquire any public association between itself and either of the marks BLACK & DECKER and DEWALT or even any mark similar thereto, at least for the goods and services or those sufficiently similar thereto, provided by the Complainant under those marks.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by either of the disputed domain names or more generally the marks BLACK & DECKER or DEWALT. Nor could the Respondent likely ever become commonly known by either of the disputed domain names or the marks, at least with respect to the goods and services provided by the Complainant under each mark, without infringing on the exclusive trademark rights of the Complainant. This is so in light of the Complainant's exclusive trademark rights which date back nearly a century for the marks BLACK & DECKER and for DEWALT — which is well prior to March 29, 2014 and June 6, 2014 on which the Respondent registered <blackanddecker.email> and <dewalt.email>, respectively. Needless to say, these rights and the Complainant's substantial worldwide reputation and goodwill which it developed over time in its marks substantially predate the date when the Respondent registered the disputed domain names. See, e.g., *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703. Hence, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Further, the Respondent's intended use of the disputed domains for its email certification service, which the Respondent acknowledges is to ultimately be a commercially profitable endeavor, does not constitute either a legitimate noncommercial or fair use of either of the domain names under paragraph 4(c)(iii) of the Policy.

Within the past half-year, a number of other UDRP decisions addressed this same Respondent and its registration of “.email” domain names incorporating registered marks and ultimately reached the same result as this Panel has. See, specifically: *Arla Foods amba v. Giovanni Laporta, Yoyo.email Ltd*, WIPO Case No. D2014-0724; *Mejeriforeningen Danish Dairy Board v. Domain Manager, Yoyo.email*, WIPO Case No. D2014-0730; *NVIDIA Corporation v. Giovanni Laporta, Yoyo.email Ltd.*, WIPO Case No. D2014-0770; *Government Employees Insurance Company v. G La Porta, yoyo.email / Yoyo.Email Ltd*, WIPO Case No. D2014-0805; *The Royal Bank of Scotland Group plc, National Westminster Bank plc, and Coutts & Co. v. Domain Manager / yoyo.email / Giovanni Laporta*, WIPO Case No. D2014-0825; *Arla Foods amba v. G. La Porta / yoyo.email*, WIPO Case No. D2014-0855; *Sanofi v. Giovanni Laporta*, WIPO Case No. D2014-1145; *L’Oréal SA v. Yoyo.email, Giovanni Laporta*, WIPO Case No. D2014-1172; *Groupama SA v. Giovanni Laporta, yoyo.email*, WIPO Case No. D2014-1287; *Maplin Electronics Limited v. Yoyo.Email*, WIPO Case No. D2014-1346; *Stuart Weitzman IP, LLC v. Giovanni Laporta, Yoyo.Email Ltd.*, WIPO Case No. D2014-1537; *Bank of Scotland Plc v. Giovanni Laporta, Yoyo.Email*, WIPO Case No. D2014-1539; *Lloyds Bank Plc v. Giovanni Laporta, Yoyo.Email Ltd*, WIPO Case No. D2014-1540; *Accor, SoLuxury HMC v. Giovanni Laporta, Yoyo.Email*, WIPO Case No. D2014-1650; and most recently *M.F.H. Fejlesztő Korlátolt Felelősségű v. Giovanni Laporta, Yoyo.Email*, WIPO Case No. D2014-1743. These decisions form a consistent line of well-reasoned UDRP jurisprudence from which the Panel sees no reason whatsoever to depart from under the facts of record here.

Therefore, the Panel concludes that the Respondent has no right or legitimate interest in either of the disputed domain names.

D. Registered and Used in Bad Faith

The Panel finds that the Respondent’s actions, with respect to each of the disputed domain names, constitute bad faith registration and use.

The Panel finds that not only was the Respondent well aware of the Complainant’s marks BLACK & DECKER and DEWALT when it registered the disputed domain names but also, with that knowledge and for no other reason apparent from the facts of record, it intentionally registered the disputed domain names to exploit the Complainant’s reputation in its marks. In doing so, the Respondent was evidently using the registrations — which it failed to prove were necessary to the rendition of its intended service — on some pre-emptive basis to evidently coerce the Complainant into using its service. The Respondent provided absolutely no reason whatsoever as to why it needed to register and retain ownership over the disputed domain names containing the Complainant’s marks and specifically why it could not substitute different domain names which did not include those marks.

The Panel observes from the Complaint that the domain name which the Complainant uses for its email service is neither <blackanddecker.email> nor <dewalt.email>. Therefore, if the Respondent were to implement, as it alleges it intends to do, an email certifying service that somehow operates (though the Respondent has failed to provide any description at all of how its service will specifically operate or how it will be implemented) along with the Complainant’s own email service, then it stands to reason that the Respondent’s service risks confusing the respective recipients. This further buttresses the Panel’s inference that the Respondent registered the disputed domain names not for any essential purpose in rendering its service, but rather to exploit the marks therein for the Respondent’s own commercial gain, such as, e.g., by coercing the Complainant to purchase the Respondent’s service at some future date.

This conduct reflects bad faith use and registration under the general bad faith provision of paragraph 4(a)(iii) of the Policy.

Further, not only has the Respondent denied the Complainant the opportunity to register “.email” based domain names which reflect its registered marks, the Respondent has similarly done so on many repeated occasions by registering “.email” domain names that incorporate third-party marks, thus establishing a pattern of such conduct. By doing so, the Respondent violated a specific manifestation of bad faith delineated in paragraph 4(b)(ii) of the Policy.

As such, the Panel concludes that the Respondent registered and used both of the disputed domain names in violation of paragraphs 4(a)(iii) and 4(b)(ii) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain names, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant. The disputed domain names <blackanddecker.email> and <dewalt.email> are ordered to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: December 23, 2014