

ADMINISTRATIVE PANEL DECISION

Scribe Opco, Inc. d/b/a BIC Graphic v. Ryan Ramsey
Case No. D2019-2543

1. The Parties

Complainant is Scribe Opco, Inc. d/b/a BIC Graphic, United States of America (“United States”), represented by Taft, Stettinius & Hollister, LLP, United States.

Respondent is Ryan Ramsey, United States, represented by Millen, White, Zelano & Branigan, P.C., United States.

2. The Domain Name and Registrar

The disputed domain name <koozies.com> is registered with Wild West Domains, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 16, 2019. On October 16, 2019, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On October 17, 2019, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on October 25, 2019. In accordance with the Rules, paragraph 5, the due date for Response was November 14, 2019. On November 5, 2019, the Center received an email communication from Respondent. On November 12, 2019, the Center received a second email communication from Respondent, requesting an automatic four-day extension in which to submit its Response pursuant to paragraph 5(b) of the Rules. The Center granted the automatic extension and the new Response due date was November 18, 2019. On November 13, 2019, the Parties agreed to a further

Response extension until November 25, 2019, pursuant to paragraph 5(e) of the Rules. The Response was filed with the Center on November 25, 2019.

The Center appointed Georges Nahitchevansky as the sole panelist in this matter on December 16, 2019. 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

Complainant, Scribe Opco, Inc. d/b/a BIC Graphic, is a supplier of promotional products. Complainant markets a variety of promotional products, such as insulated beverage containers, bags, chairs, custom imprinting and portable coolers, under the name and mark KOOZIE. The KOOZIE mark was originally registered in the United States on December 16, 1980 in a stylized form by an entity called Concept Enterprises, Inc. for “insulated containers for beverage cans” (Registration No. 1143428). Complainant asserts that Concept Enterprise, Inc., later known as Radio Cap Corporation, was acquired by Norwood Promotional Products, Inc. in 1989, and that Complainant subsequently acquired Norwood Promotional Products, Inc. through a series of transactions. The original trademark registration for KOOZIE (Registration No. 1143428) was cancelled on December 22, 2001, as it was not renewed by Norwood Promotional Products, Inc. Currently, Complainant owns a number of trademark registrations in the United States for the name and mark KOOZIE, or formatives thereof, the earliest of which was filed on February 3, 2004 and issued to registration on May 15, 2007.

The disputed domain name was registered by Respondent on December 19, 1998. From 2008 through 2010, Respondent appears to have used the disputed domain name for a website offering insulated covers for sale and describing them as “koozies”. That use appears to have ceased in 2010 and since that time the disputed domain name has not resolved to an active website. In early 2012, a demand letter was sent to Respondent from a representative of Norwood Promotional Products. The parties had some communications thereafter, but no resolution of the matter appears to have occurred. The disputed domain name does not currently resolve to an active website, but to a “404 error” page.

5. Parties’ Contentions

A. Complainant

Complainant asserts that KOOZIE is a coined term and that the KOOZIE mark has been in continuous use since 1979 by Complainant and its predecessors-in-interest. Complainant maintains that it has rights in the KOOZIE mark by virtue of the use of the mark since 1979, the prior United States registration for the KOOZIE mark that expired in December 22, 2001, and by virtue of Complainant’s extant registrations for the KOOZIE mark.

Complainant contends that the disputed domain name is virtually identical or confusingly similar to Complainant’s KOOZIE mark as the disputed domain name merely adds the letter “s” to the KOOZIE mark to create an indistinguishable plural version of the KOOZIE mark.

Complainant argues that Respondent has no rights or legitimate interests in the disputed domain name as Respondent (i) has never been authorized by Complainant or its predecessors to register or use the KOOZIE mark, (ii) is not commonly known by the disputed domain name, (iii) used the disputed domain name from 2008 through 2010 to lure Internet traffic to a website in direct competition with Complainant to offer for sell goods similar or identical to those under Complainant’s KOOZIE mark, and (iv) had constructive notice of Complainant’s rights in the KOOZIE mark in view of the existing and valid United States trademark registration that was owned by Complainant’s predecessor-in-interest at the time the disputed domain name was registered in 1998.

Lastly, Complainant contends that Respondent registered and has used the disputed domain name in bad faith, as Respondent would have discovered Complainant's rights in the KOOZIE mark had Respondent made a good faith attempt to conduct a trademark search at the time Respondent registered the disputed domain name. Complainant also argues that Respondent has acted in bad faith by using the disputed domain name from 2008 through 2010 to divert web users to a website operated by Respondent that offered products in direct competition with Complainant for Respondent's commercial gain.

B. Respondent

Respondent rejects Complainant's contentions.

Respondent contends that Complainant does not have any trademark rights in the term "koozie", as the term has a generic meaning that is understood by the relevant public to refer to insulated container covers for beverage cans.

Respondent argues that it has rights and legitimate interests in the disputed domain name as Respondent made a *bona fide* offering of goods and services before Respondent received any notice of the dispute some 21 years after registering the disputed domain name. Respondent also maintains that Respondent has a legitimate business that was formed to aggregate and hold domains consisting of acronyms, dictionary words or common phrases and that Respondent has never been the subject of a UDRP proceeding. Respondent also notes that Complainant waited 21 years before initiating this proceeding and some 9 years after Respondent used the disputed domain name for anything other than a 404 error page. Respondent also maintains that Complainant's predecessor-in-interest sent Respondent a demand letter in February 2012 and that the Parties' respective representatives had communications thereafter in 2012, but did not resolve the matter. Respondent notes that Complainant then waited 7 years before filing this proceeding.

Finally, Respondent contends that it has not registered or used the disputed domain name in bad faith. Respondent asserts that at the time Respondent registered the disputed domain name, it was not aware that the term "koozie" was an alleged trademark or that it was even a registered mark in the United States. Respondent maintains that it was Respondent's understanding that the term "koozie" was a generic term used to refer to insulated container covers for beverage cans. Based on such understanding, Respondent asserts that it registered the disputed domain name in its generic sense as a common term and not based on some possible trademark meaning.

Respondent also argues that in light of the cancellation of Complainant's original registration of the KOOZIE mark in 2001, Complainant must rely on common law rights in the term "koozie" existing at the time Respondent registered the disputed domain name in 1998. Respondent maintains that Complainant has failed establish that it had common law rights in KOOZIE in 1998. Lastly, Respondent argues that given the fact that Respondent has owned the disputed domain name for 21 years, and that Complainant's predecessor-in-interest has known about Respondent's ownership of the disputed domain name for at least 7 years and has failed to take action, Respondent cannot be found to have acted in bad faith.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

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

A. Identical or Confusingly Similar

Respondent does not contest that the disputed domain name is identical or confusingly similar to Complainant's KOOZIE mark. Respondent's position is that Complainant cannot have any trademark rights in the term "koozie", as it is a generic reference for insulated container covers for beverage cans. In that regard, Respondent has produced a number of examples showing the use of the term "koozie" as a descriptive term or arguably generic reference for beverage insulator covers.

That being said, Complainant has produced evidence of several trademark registrations that it owns for the mark KOOZIE that issued to registration after the disputed domain name was registered and one registration for the KOOZIE mark in a stylized form that existed at the time Respondent registered the disputed domain name. The Panel notes that while Respondent has provided examples of descriptive or possibly generic uses of "koozie", the Panel is not in a position to assess whether Complainant's United States trademark registrations are somehow improper or could possibly be subject to cancellation on the basis that "koozie" is a generic term. The fact remains that Complainant owns trademark registrations in the United States for the mark KOOZIE. As the threshold for the first element is low, the Panel concludes that since the disputed domain name is nearly identical to Complainant's registered KOOZIE mark, with only the addition of the letter "s", Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Given that Complainant's Complaint fails on the third element, as discussed below, the Panel does not address whether Respondent has rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Under Paragraph 4(a)(iii) of the Policy, a complainant must establish the conjunctive requirement that the respondent registered and used a disputed domain name in bad faith. The assessment of whether a disputed domain name was registered in bad faith has to be assessed at the time of the registration of the disputed domain name, which in this case is December 19, 1998.

Complainant asserts that KOOZIE is a coined term and that its predecessor-in-interest owned a trademark registration for the KOOZIE mark in 1998. Complainant also claims that the KOOZIE mark has been in use since 1979 and that because Complainant has extensively used and promoted the KOOZIE mark it has attained much public recognition. Unfortunately, what is missing in the record is evidence supporting Complainant's assertion that the KOOZIE mark has been in extensive and continuous use prior to and during the entire span of time since the disputed domain name has been in existence or that Complainant had such public recognition in KOOZIE as a trademark, as it claims, in December 1998. Surprisingly, the majority of Complainant's case rests on conclusory statements unsupported by specific evidence. To be sure, conclusory allegations or assertions that are unsubstantiated with specific evidence are entitled to little or no weight. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") at sections 1.3 and 3.1.

Respondent, in this case, has provided much evidence that the term "koozie" is, and has been, used as a descriptive and possibly generic reference for insulated beverage covers, including dictionary definitions that appear to date back to at least 2004. Respondent also asserts that it registered the disputed domain name in December 1998 because it believed it was a common term and that it was not aware of Complainant's claimed rights in KOOZIE. As Complainant has provided no evidence regarding the use of the KOOZIE mark and/or the extent of such use or notoriety of the KOOZIE name and mark prior to December 1998, it is difficult to assess 21 years after the fact whether Respondent was trying to take advantage of rights Complainant might have had in KOOZIE or was merely registering a common term, as Respondent contends it did, as part of its business of registering domain names based on acronyms, dictionary terms and common phrases. Indeed, there is no evidence in the record showing that Respondent's assertion might be pretextual, such as evidence showing, for example, that "koozie" was more likely than not perceived by

consumers to be a brand in 1998 or that Respondent had an established pattern of registering domain names based on the marks of others.

To overcome the gap in Complainant's case, Complainant argues that Respondent's bad faith is established by Respondent's use of the disputed domain name from 2008 through 2010 for a website that offered products that were competitive with those that were offered by Complainant under the KOOZIE mark. The problem with that argument is that Complainant is relying on events that occurred almost ten years after the disputed domain name was registered. Such use of the disputed domain name, in and of itself, does not establish without more whether Respondent originally registered the domain name in bad faith in December 1998, particularly if the term "koozie" was used as a generic or descriptive reference at that time, as Respondent contends. The Panel also notes that as Complainant's trademark registration for KOOZIE lapsed in 2001, and Complainant did not secure another registration for the KOOZIE mark until 2007, there is a genuine issue as to whether or not Respondent was acting in bad faith in 2008 when Respondent was selling insulated beverage covers and describing them as "koozies". This is particularly so given that Complainant has provided no evidence of what its use of KOOZIE might have been prior to or during that period of time.¹

In sum, Complainant has failed to establish that it is more likely than not that Respondent registered the disputed domain name in bad faith in December 1998 in order to take advantage of Complainant's claimed rights in the KOOZIE mark. Given that the domain name was registered 21 years ago, that the original trademark registration for the KOOZIE mark (albeit registered anew in 2007) lapsed in 2001 and that there are legitimate open questions as to whether or not the term "koozie" did, or does now, refer to a common term, it appears to the Panel that this is a case that should be adjudicated in a court action, where discovery and witnesses would be available, and not through a UDRP proceeding. In such an action, it would be assumed that (i) a full record as to the use and recognition of the KOOZIE mark by Complainant's predecessor-in-interest would be developed, (ii) the strength of Complainant's trademark rights in KOOZIE would be assessed, (iii) the Parties' prior dealings and actions would be considered, and (iv) the Parties would be cross examined as to their contentions. Here, however, as the evidence does not show that Respondent registered the disputed domain name in bad faith in 1998, Complainant's complaint fails.

7. Decision

For the foregoing reasons, the Complaint is denied.

Georges Nahitchevansky

Sole Panelist

Date: December 26, 2019

¹ The Panel notes that Complainant has also relied on a prior proceeding involving the domain name <koozie.com> in which Complainant prevailed. *Bic Corporation v. DVLPMNT Marketing, Inc.*, WIPO Case No. D2016-0557. In the present case, however, the Respondent provided substantial evidence contradicting Complainant's assertions, namely that the term "koozie" is often used as a common reference for insulated beverage covers. Complainant has provided no evidence of its claimed notoriety in the KOOZIE mark prior to December 1998 or showing that Respondent targeted Complainant when it registered the disputed domain name.