



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE

DOMAIN NAME DISPUTE

ADMINISTRATIVE PANEL

DECISION

CIIDRC case number:	17918-UDRP	Decision date: September 11, 2022
Domain Name:	<boostcollective.com>	
Panel:	Alan L. Limbury	
Complainant:	Boost Collective Inc.	
Respondent:	Jacqueline Koch/ Boost! Collective	

1. PROCEDURAL HISTORY

On August 18, 2022, Mr. Damian Barbu filed a Complaint on behalf of Boost Collective Inc. via the CIIDRC online platform pursuant to the UDRP and the UDRP Rules.

The Registrar, FastDomain Inc., was notified of this proceeding and on August 19, 2022, the Registrar transmitted by email to CIIDRC its verification response naming the Respondent, Jacqueline Koch/ Boost! Collective as the Registrant of the <boostcollective.com> domain name (the "Domain Name"), which the Registrar confirmed had been placed on Registrar LOCK.

On August 19, 2022, CIIDRC advised the Complainant that the Complaint was not in administrative compliance with the UDRP Rules. In accordance with UDRP Rule 4 (d), the Complainant had five days, until August 24, 2022 to correct all instances on non-compliance.

On August 22, 2022, the Complainant submitted its revised Complaint.

On August 22, 2022, CIIDRC, confirmed compliance of the Complaint with the UDRP Rules and commencement of the dispute resolution process.

Pursuant to UDRP Rule 4 and Supplemental Rule 5, on August 22, 2022, CIIDRC notified the Respondent of this administrative proceeding and forwarded a Notice with a login information and the link to the Complaint to the Respondent.

The Respondent filed her response on August 31, 2022.

The Complainant and the Respondent in this administrative proceeding have elected for a Panel consisting of a single member.

CIIDRC appointed Alan L. Limbury as sole Panelist on September 7, 2022. The Panelist has provided a statement of acceptance and declaration of impartiality and independence, as required by the Rules.

This matter is conducted pursuant to the Uniform Domain Name Dispute Resolution Policy (the Policy) and the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules) of the Internet Corporation for Assigned Names and Numbers (ICANN).

2. FACTS ALLEGED BY THE PARTIES

The Complainant, Boost Collective Inc., was incorporated in Ontario, Canada, on June 5, 2019. On August 29, 2019, the Complainant filed an application with the United States Patent and Trademark Office (“USPTO”) to register the stylized mark BOOST COLLECTIVE. The application claimed first use and first use in commerce of the mark on November 23, 2017. The mark was registered on April 14, 2020, Reg. No. 6,032,704 in respect of entertainment marketing services, namely, marketing, promotion and advertising for independent recording artists. The Complainant uses the domain name <boostcollective.ca> for email and for its website.

The Respondent’s company, Boost! Collective was registered in Washington State in 2015. The Domain Name <**boostcollective.com**> was registered by the Respondent on February 12, 2015 and has been used for email and for a website promoting communications and marketing services.

3. CONTENTIONS OF THE PARTIES

- **Complainant**

We have spent a lot of time and money building up our goodwill and name – whereas the Respondent has none and is able to leverage our traffic, brand, likeness and goodwill we’ve built to drive traffic to the infringing website. We are currently only able to operate our site on <boostcollective.ca> as the Respondent is using our name and goodwill to gain traffic to her Domain Name and thus promote the

Respondent's services. This causes major confusion for US users as they look for boostcollective.com, and end up on a different site, selling marketing and promotional services as well.

There is not and has never been any relationship between the Complainant and the Respondent and the Respondent has never been licensed or otherwise authorized to register or use the Boost Collective trademark in any manner whatsoever, including as part of a domain name. The Respondent's Domain Name is therefore identical to our trademark, the trademark being what many more people know and recognize as 'Boost Collective'.

This has damaged our business by misleading customers and potential customers, losing us potential revenue. Customers or would-be customers with a question or in need of support type into their browser 'boostcollective.com' or search boostcollective on Google. They instead land on boostcollective.com's site and are misled to contact their support, which has been done many times. Jacqueline Koch (owner of boostcollective.com) even acknowledged this and offered to forward queries to us.

As of August 17, 2022, the infringing website does not contain any information regarding the owners or employees of the company or that can be used to contact the owner of the Domain Name. The contact page has been removed to prevent any misled customers, users, or visitors who are looking for our trademarked page and services from inquiring and understanding that they are on the wrong page. This makes it impossible for the Respondent to forward any customer complaints or inquiries and is further proof that there is no intention to prevent misleading page visitors. This is a clear display of bad faith.

Another way they are misleading our customers is by offering similar services that can confuse our customers. We offer promotion, distribution, and marketing services, and on boostcollective.com they offer that as well.

In summary, the negative impacts are lack of trust and purchase potential among our US customers and visitors; tarnishing our trademark by appearing in searches for 'Boost Collective' and the Respondent leveraging our time and money used to build our goodwill, name and awareness; and general loss in revenue worldwide.

The Domain Name is identical and confusingly similar to our mark. The Respondent has no rights or legitimate interests in the Domain Name, which is being used in bad faith. The Respondent is clearly seeking commercial gain by misleading and diverting customers as well as tarnishing our trademark. We have made numerous efforts to reach out to the Respondent for an amicable resolution by giving her a different domain that would NOT cause confusion (eg. boostcollective.org).

Millions of consumers, site traffic, users, and customers know Boost Collective and its likeness as ours, and with many being US-based, they assume that our TLD will be .com, causing them to land on her website. This gives her a free boost in traffic, helps her appear in our search terms for Boost Collective, and makes it appear as if she is the legitimate Boost Collective. This undoubtedly has led to our consumers, site traffic, users, and customers inquiring about her marketing and other agency services, clearly violating our trademark and using the Domain Name to seek commercial gain.

The Respondent intentionally attempts to attract for commercial gain traffic to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the affiliation and promotion of the Respondent's website and the marketing services on the Respondent's website – ambiguously similar to what we offer our consumers, site traffic, users, and customers. We have spent a lot of time building up our goodwill and name – whereas the Respondent has none and is able to leverage our traffic, brand, likeness and goodwill we've built to drive traffic to the infringing website.

Our traffic, impressions and SEO rankings (not to mention number of paid advertising impressions on Facebook advertising) is in the tens of millions – our trademark and likeness should be the only one appearing when searching 'boost collective' on Google so as not to mislead these millions of individuals looking for our likeness and ensure that they land on the right place. As it stands right now, they might end up on the Respondent's website where they could end up mistakenly purchasing the Respondent's marketing and agency services.

The Respondent is also refusing to move the Domain Name over even after multiple outreaches. We have reached out multiple times over email, LinkedIn, and phone number only to be rudely declined of any potential resolution. The Respondent is unwilling to cooperate or even talk to us. Alongside this, the Respondent has shown a blatant refusal to come to an agreement even after multiple attempts at a discourse in good faith.

If the Respondent were operating in good faith, she would make an effort to work with us to find an alternative domain name that is both identifiable to her brand and also not misleading the millions of impressions and tens of thousands of customers assuming that the Domain Name is ours. All these reasons make it evident that the Respondent is domain squatting – waiting for us to continue growing until we are forced unfairly to pay an enormous sum for the transfer of the Domain Name.

Having the Domain Name transferred to us will put an end to misleading users, visitors, customers and clients, prevent our trademark from being tarnished, and prevent us from losing revenue from traffic unfairly diverted to a different business that people aren't looking for.

- **Respondent**

Since 2015, I have been running a thriving, woman-owned small business, Boost! Collective. My Domain Name, **<boostcollective.com>**, reflects my company name, the nature of the work that I do and the strategic, proprietary approach I take toward working with my clients. Boost! Collective was registered in Washington State in 2015. The **<boostcollective.com>** Domain Name was also registered in 2015. This predates the Complainant's and is therefore protected as a common law trademark. I use the Domain Name **<boostcollective.com>** in my daily correspondence with clients, for all business operations, including billing and federal, state and local taxes. My business circumstances depend on my Domain Name and I have in no way infringed on the Complainant's business or business model. I work in an entirely different sector. I have a breadth of evidence that demonstrates my legitimate use of this Domain Name relating to the services my business provides and operational activities to run it since 2015.

The Complainant's trademark registration notes first use as November, 2017 and the Complainant did not apply for a trademark until August 2019. As a result, I am the senior user and have priority use, regardless of trademark registration. In applying for the trademark in August, 2019, the Complainant surely had to declare that it was not aware of any previous use. However, the Complainant first emailed me inquiring to purchase my Domain Name prior to registering the trademark.

I was approached by the Complainant in Canada in June this year with a cease-and-desist letter based on false pretences. In my response, I noted that I have sought legal counsel and was advised that filing to register a trademark known to the applicant to be in commerce is fraudulent. I have the option to seek to cancel the Complainant's trademark and can file a petition to do so with the trademark office.

The Complainant responded as follows on July 15, 2022:

"I just want to be upfront – it means a lot to me to have this domain name. A lot more than you might ever imagine. And I truly understand that you were the first to have the 'Boost! Collective' name."

The mere desire to have the Domain Name **<boostcollective.com>** doesn't constitute a viable legal argument to challenge the domain owner for rights.

Moreover, I hold the common law trademark, which "provides protection for a symbol, logo, product name, or other words or marks that identify the source of goods or services before it is registered with the state or federal government." My company, Boost! Collective and my Domain Name **<boostcollective.com>** are associated with the communications and marketing consulting I provide

to clients in the non-profit sector. There is no evidence that I am in any way, directly or indirectly, impinging on the Complainant's business or customer base.

While not legally required to do so, I have offered and in good faith have forwarded all misdirected emails to the Complainant at the address info@boostcollective.ca. Any suggestion that I have refused to do so is simply false and misleading.

My Domain Name was registered to run my business and to reflect my business name. I use this every day in all my business dealings and any claim that is registered in bad faith is flat-out false and baseless. Upon refusal of the Complainant's unreasonable demands that I surrender my Domain Name, I began to receive a flood of unsolicited promotional SPAM emails, specifically hailing from the music industry. The targeted email campaign became so overwhelming that I was forced to remove my contact information from my website.

Currently, I don't have my contact information on my website to protect myself from the harassment of this ebombing campaign. This is costing my business in terms of visibility and marketing opportunities. Given that the Complainant is in the music industry, and the SPAM I am receiving hails from this specific industry, the targeted email campaign against me cannot be a mere coincidence.

The Complainant has filed this complaint, against me and my business, in bad faith. There is no legal basis for the claim, which follows a clearly documented pattern that would constitute reverse domain name hijacking: "when a trademark owner attempts to secure a domain name by falsely making claims of cybersquatting against a domain name owner."

- **Remedy Sought**

The Complainant seeks the transfer to it of the Domain Name.

The Respondent seeks the dismissal of the Complaint.

4. DISCUSSION AND FINDINGS

4.1 Requirements

Paragraph 15(a) of 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."

In accordance with Paragraph 4 of the Policy, the onus is on the Complainant to prove:

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1. That the Domain Name is Identical or Confusingly Similar to a trademark or service mark in which the Complainant has rights:
2. That the Registrant has no rights or legitimate interests in the Domain Name; and
3. That the Domain Name has been registered and being used in bad faith.

The Panel will consider each of these requirements in turn.

4.2 Analysis

4.2.1 That the Domain Name is Identical or Confusingly Similar to a Mark in which the Complainant has Rights

The relevant date at which the Complainant must show that it has rights in a trademark is the date of the filing of the Complaint, in this case August 18, 2022. See, e.g., *Philip Morris Products S.A. v. Timur Dzadzamiya*, D2021-0067 (WIPO March 22, 2021).

The Complainant has shown that it has rights in the stylized mark BOOST COLLECTIVE, registered on April 14, 2020 with the USPTO, Reg. No. 6,032,704, upon application filed on August 29, 2019, claiming first use in commerce on November 23, 2017. The Panel finds the Respondent's <boostcollective.com> Domain Name to be virtually identical and confusingly similar to the Complainant's mark, since it incorporates the mark in its entirety, omitting only the space between the words, and the inconsequential .com gTLD, which may be ignored.

The Complainant has established this element.

4.2.2 That the Respondent has No Rights or Legitimate Interest in the Domain Name

Paragraph 4(c) of the Policy sets out three illustrative circumstances as non-exhaustive examples which, if established by the Respondent, shall demonstrate rights to or legitimate interests in respect of the Domain Name for the purposes of paragraph 4(a)(ii) of the Policy, including:

- (i) before any notice to the Respondent of the dispute, the use by the Respondent of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services.

The Domain Name was registered on December 2, 2015, as verified by the Registrar. It resolves to a website offering a range of services to help people engage with their audiences. The Panel finds this to be a *bona fide* offering of services. Accordingly, the Panel finds that the Respondent has rights to and legitimate interests in respect of the Domain Name.

The Complainant has failed to establish this element.

4.2.3 That the Respondent has Registered and Used the Domain Name in Bad Faith

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which, though not exclusive, shall be evidence of the registration and use of the Domain Name in bad faith for purposes of paragraph 4(a)(iii) of the Policy, i.e.

- (i) circumstances indicating that the Respondent has registered or acquired the Domain Name primarily for the purpose of selling, renting or otherwise transferring the Domain Name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the Domain Name;
- (ii) or the Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct;
- (iii) or the Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on its website or location.

As stated in the WIPO Jurisprudential Overview 3.0, section 3.8.1:

"Subject to scenarios described in 3.8.2 below, where a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent..."

3.8.2 As an exception to the general proposition described above in 3.8.1, in certain limited circumstances where the facts of the case establish that the respondent's intent in registering the domain name was to unfairly capitalize on the complainant's nascent (typically as yet unregistered) trademark rights, panels have been prepared to find that the respondent has acted in bad faith.

Such scenarios include registration of a domain name: (i) shortly before or after announcement of a corporate merger, (ii) further to the respondent's insider knowledge

(e.g., a former employee), (iii) further to significant media attention (e.g., in connection with a product launch or prominent event), or (iv) following the complainant’s filing of a trademark application.”

The Respondent registered the Domain Name on December 2, 2015, some 3½ years before the Complainant, Boost Collective Inc., was incorporated and applied for registration of its mark. There is no evidence of the kind mentioned in section 3.8.2 of the WIPO Overview from which it may be inferred that the Respondent had the Complainant in mind when registering the Domain Name, nor that the Respondent’s intent in registering the Domain Name was to unfairly capitalize on any nascent trademark rights of the Complainant, which did not then exist.

Hence the Domain Name cannot have been registered in bad faith.

The Panel accepts that Internet users searching for the Complainant may find themselves at the Respondent’s website. Given the similarity between the parties’ names and the fact that the **<boostcollective.com>** Domain Name was registered prior to the earliest use by the Complainant of its BOOST COLLECTIVE mark, the Panel is not persuaded that such confusion establishes bad faith use on the part of the Respondent. Indeed, the Respondent has shown that she has been subjected to increasing unwanted emails since declining the Complainant’s invitation to transfer the Domain Name to the Complainant.

Taking all the circumstances of this case into account, the Panel finds that the Complainant has failed to establish this element.

Reverse domain name hijacking

Paragraph 15(e) of the Rules provides that if “after considering the submissions the panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding”.

Reverse Domain Name Hijacking (RDNH) is defined under the Rules as “using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name”. The mere lack of success of the complaint is not itself sufficient for a finding of Reverse Domain Name Hijacking. Rather, as stated in the WIPO Jurisprudential Overview 3.0, paragraph 4.16:

“Reasons articulated by panels for finding RDNH include: (i) facts which demonstrate that the complainant knew it could not succeed as to any of the required three elements – such as the complainant’s lack of relevant trademark rights, clear knowledge of respondent rights or legitimate interests, or clear knowledge of a lack of respondent bad faith (see generally section 3.8) such as registration of the disputed domain name well before the complainant acquired trademark rights...”

The Respondent has exhibited a copy of an email sent by Mr. Damian Barbu on behalf of the Complainant, Boost Collective Inc, on August 22, 2019 to Jacqueline@boostcollective.com, enquiring as to whether a deal could be worked out to provide the Domain Name to the Complainant. This was a week before the Complainant filed its application to register its mark. Hence the Complainant was fully aware that the Domain Name was registered before the Complainant acquired any rights in its mark and that the Respondent’s registration of the Domain Name could not possibly have been in bad faith.

The Panel finds this to be a classic example of a “Plan B” case of RDNH. *Daniel Biro / RealtyPRO Network, Inc. v. Ben Kueh / Computerese*, FA 1929289 (FORUM March 29, 2021) (“here there is the added factor that Complainant had made unsuccessful attempts to purchase <realtypro.com> from Respondent. It would not have been exhausting to learn from a modicum of research that initiating a UDRP proceeding under these circumstances fits the definition of a Plan B scheme to deprive Respondent of his property.”)

5 DECISION and ORDER

For the above reasons, in accordance with Paragraph 4 of the Policy, Paragraph 15 of the Rules, and Rule 10 of the Supplemental Rules, the Panel concludes that relief shall be **DENIED** and orders that the <boostcollective.com> domain name **REMAIN WITH** the Respondent. The Panel also declares that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

Made as of September 11, 2022.

SIGNATURE OF PANEL



