

## **ADMINISTRATIVE PANEL DECISION**

**BlackBerry Limited v. Farhood Saadat (or Farhad Saadat; f sadat, mrc)**  
**Case No. D2023-4057**

### **1. The Parties**

The Complainant is BlackBerry Limited, Canada, represented by Davis Wright Tremaine LLP, United States of America ("United States").

The Respondent is Farhood Saadat (or Farhad Saadat; f sadat, mrc), United Kingdom.

### **2. The Domain Names and Registrar**

The disputed domain names <blackberrypartdirect.com>, <blackberrypartsuk.com>, <blackberryrepaircentre.com>, <blackberryrepairs.com>, <blackberryrepairus.com>, and <parts4blackberry.com> 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 September 27, 2023. On September 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On the same day, the Registrar transmitted by email to the Center its verification response confirming that the 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 the Respondent of the Complaint, and the proceedings commenced on October 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 2, 2023. The Response was filed with the Center on October 26, 2023. On November 3, 2023, the Center notified the Parties that it will proceed to Panel Appointment.

The Center appointed Assen Alexiev as the sole panelist in this matter on November 21, 2023. 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

The Complainant designs and manufactures wireless solutions for the worldwide mobile communications market. It previously produced the well-known BlackBerry wireless handheld devices. The Complainant's business currently focuses on cybersecurity, encrypted voice and digital communications, automotive safety, connected and Internet of Things (IoT) systems and devices.

The Complainant is the owner of a number of trademark registrations for the mark BLACKBERRY, including the United States trademark BLACKBERRY with registration No. 2844340, registered on May 25, 2004, for goods and services in International Classes 9, 38, and 41, with first use in commerce on January 19, 1999 (the "BLACKBERRY trademark").

The Complainant is also the owner of the domain name <blackberry.com>, which resolves to its official website.

The details about the registration and use of the disputed domain names as the following:

Disputed domain name	Registration date	Current use
<blackberryrepairs.com>	December 8, 2005	On the date of notification of the Complaint to the Respondent, it redirected to the website at "www.mobilerepaircentre.com", which offers repair services for various mobile devices of different manufacturers.  Currently resolves to the website at "www.blackberryrepairs.com", which offers repair services for various models of Blackberry devices.
<blackberryrepaircentre.com>	September 13, 2008	Redirects to the website associated to the disputed domain name <blackberryrepairs.com>, which offers repair services for various models of Blackberry devices.
<blackberryrepairus.com>	September 21, 2009	Redirects to the website associated to the disputed domain name <blackberryrepairs.com>, which offers repair services for various models of Blackberry devices.
<blackberrypartsuk.com>	July 11, 2011	Redirects to the website associated to the disputed domain name <blackberryrepairs.com>, which offers repair services for various models of Blackberry devices.
<blackberrypartdirect.com>	July 11, 2011	Redirects to the website associated to the disputed domain name <blackberryrepairs.com>, which offers repair services for various models of Blackberry devices.
<parts4blackberry.com>	July 11, 2011	Inactive

#### 5. Parties' Contentions

##### A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

The Complainant states that the disputed domain names are confusingly similar to its BLACKBERRY trademark, because they all contain this trademark in its entirety.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainant submits that it has continuously and extensively used the BLACKBERRY trademark in connection with its products for 24 years and has spent millions of dollars in advertising the BLACKBERRY trademark and promoting its products. According to the Complainant, as a result of its marketing efforts and the quality of its products, the BLACKBERRY trademark has become famous under the laws of the United States and has acquired the status of a notorious trademark enjoying liberal protection worldwide under the Paris Convention.

The Complainant points out that the Respondent registered the disputed domain names after the registration of the BLACKBERRY trademark in the United States and approximately six years after the Complainant's first use of this trademark in commerce. According to the Complainant, the Respondent had knowledge of the Complainant's BLACKBERRY trademark when it registered the disputed domain names, and the Respondent's decision to register the disputed domain names cannot be explained but as a misappropriation of the Complainant's trademark for the Respondent's own benefit. The Complainant maintains that since the websites to which the disputed domain names redirect display the Complainant's BLACKBERRY trademark and the Complainant's products in a commercial manner, but fail to disclose that they are not authorized by the Complainant, this shows that the Respondent has sought to create an impression of association with the Complainant or authorization by it for the use of the BLACKBERRY trademark in connection with the Respondent's services, where there is none.

The Complainant contends that the disputed domain names were registered and are being used in bad faith.

According to it, as the disputed domain names are confusingly similar to the BLACKBERRY trademark, it is likely that Internet users would hold the Complainant responsible for the websites at the disputed domain names or would assume that some affiliation exists between the Respondent and the Complainant. In the Complainant's view, the Respondent intended to provoke confusion with the Complainant's BLACKBERRY trademark and to take advantage of such confusion as to the source of the websites at the disputed domain names or their affiliation in order to attract, for commercial gain, Internet users to the websites at the disputed domain names.

## **B. Respondent**

The Respondent states that since 1997 it has operated in the United Kingdom a repair center for all makes and models of phone tablets and laptops. The Respondent notes that it has several domain names that are brand-specific, such as for the BLACKBERRY brand, and maintains that it has not infringed any trademarks. The Respondent confirms that it has no affiliation with the respective brands and only offers a non-warranty repair on their products and sells parts for them.

The Respondent asserts that it does not pretend to be part of the Complainant's company and does not create the impression that it is affiliated with the Complainant in any way. The Respondent submits that it has always stated on its websites and in its Privacy Policies that "All product names, logos, brands, trademarks and registered trademarks are property of their respective owners. All company, product and service names used in this website are for identification purposes only. Use of these names, trademarks and brands does not imply endorsement."

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between

the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of the BLACKBERRY trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds that the BLACKBERRY trademark is recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the BLACKBERRY trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, "repair", "repairs", "centre", "part", "parts", "direct", "uk", "us", or "4") may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the BLACKBERRY trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel therefore finds that the first element of the Policy has been established.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

As discussed in section 2.8.1 of the [WIPO Overview 3.0](#), UDRP Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the "Oki Data test", the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

The evidence in the case shows that the Respondent has not complied with two of the above requirements.

The disputed domain name <blackberryrepairs.com> previously redirected to the website at “www.mobilerepaircentre.com”, which offers repair services for various mobile devices of different manufacturers. The Respondent has thus used this disputed domain name to attract potential customers and offer them repair services for all brands of mobile devices and not only for those manufactured by the Complainant.

The Respondent asserts that it has included a disclaimer on its websites for the lack of relationship with the Complainant. It has however not submitted any supporting evidence, and the websites to which the disputed domain names redirect do not contain the statement cited by the Respondent or any other statement disclosing the lack of relationship with the Complainant. Moreover, even if the alleged disclaiming statement is included on the website to which the disputed domain names redirect, such statement does not specify the owner of the disputed domain name(s) or the relevant marks being displayed, which would hardly qualify as “accurate”. Given the prior redirection of the disputed domain name <blackberryrepairs.com>, and that the remaining disputed domain names now redirect to that disputed domain name, it seems clear to the Panel that the Respondent sought to mislead unsuspecting Internet users expecting to find the Complainant but ultimately were redirected to the Respondent’s website.

The disputed domain name <parts4blackberry.com> is inactive, but the Respondent has not distinguished it from the other disputed domain names in its Response and does not claim that it has registered and planned to use it for other purposes. The Panel therefore does not find a reason to treat it any differently.

Considering the above, the Panel finds no support for a conclusion that the Respondent is making a *bona fide* offering of goods and services through the disputed domain names giving rise to a legitimate interest in them.

Based on the available record, the Panel therefore finds that the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Respondent does not deny its knowledge of the Complainant and confirms that the disputed domain names refer to the Complainant’s BLACKBERRY trademark and its Blackberry devices. The evidence in the case shows that the Respondent has used the disputed domain name <blackberryrepairs.com> (which was registered years before the other disputed domain names) to offer repair services for any mobile devices and not only for those manufactured by the Complainant. The website at “www.blackberryrepairs.com”, to which all disputed domain names currently redirect (apart from <parts4blackberry.com>) does not disclose the lack of relationship with the Complainant, but contains minimum charges for repair of various electronic devices such as “Sat Nav”, “iPad”, “Large consoles”, and “Laptop repairs”, which shows that the Respondent uses the disputed domain names to offer repair services for devices of different manufacturers and not only for those of the Complainant.

The above supports a conclusion that it is more likely than not by registering and using the disputed domain names, the Respondent has intentionally targeted the BLACKBERRY trademark to attract, for commercial gain, Internet users by creating a likelihood of confusion as to the affiliation or endorsement of the repair services offered on the Respondent’s websites, which supports a finding of bad faith.

The disputed domain name <parts4blackberry.com> is inactive.

Panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3.

Having reviewed the available record, the Panel notes the distinctiveness and reputation of the Complainant’s BLACKBERRY trademark, and the composition of the disputed domain name <parts4blackberry.com>. The Panel also notes that the Respondent does not discuss this disputed domain name separately from the other disputed domain names and does not claim that it has any different plans in relation to it. The Panel therefore finds it justified to assume that the Respondent’s intentions and plans for use of this disputed domain name are the same as for the other disputed domain names.

Taking all the above into account, the Panel finds that in the circumstances of this case the passive holding of the disputed domain name <parts4blackberry.com> does not prevent a finding of bad faith under the Policy.

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain names <blackberrypartdirect.com>, <blackberrypartsuk.com>, <blackberryrepaircentre.com>, <blackberryrepairs.com>, <blackberryrepairus.com>, and <parts4blackberry.com> be transferred to the Complainant.

*/Assen Alexiev/*

**Assen Alexiev**

Sole Panelist

Date: December 5, 2023