

ADMINISTRATIVE PANEL DECISION

Redbox Automated Retail, LLC d/b/a Redbox v. Akshay Sati
Case No. D2022-0311

1. The Parties

The Complainant is Redbox Automated Retail, LLC d/b/a Redbox, United States of America (“United States”), represented by McDonald Hopkins LLC, United States.

The Respondent is Akshay Sati, India.

2. The Domain Name and Registrar

The disputed domain name <redboxtv.website> (the “Domain Name”) is registered with Hostinger, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 29, 2022. On January 31, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 18, 2022, 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 sent on February 2, 2022, an email communication to the Parties regarding the additional registrant information.

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 February 4, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 24, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 25, 2022.

The Center appointed Mathias Lilleengen as the sole panelist in this matter on March 2, 2022. 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 offers rental and sale of movies, TV shows, on-demand streaming of movies, and other entertainment content. It has provided over six billion digital movies and games online and through over 41,000 kiosk locations throughout the United States and elsewhere since opening in 2002.

The Complainant owns trademark registrations based on the mark REDBOX, such as United States federal trademark registration No. 2919854, registered on January 18, 2005; the United States federal trademark registration for REDBOX No. 2988869, registered on August 30, 2005; the United States federal trademark registration for REDBOX No. 3082012, registered on April 18, 2006; the United States federal trademark registration for REDBOX No. 3229436, registered on April 17, 2007; the United States federal trademark registration for REDBOX No. 4418938, registered on October 15, 2013; the United States federal trademark registration for REDBOX No. 4418939, registered on October 15, 2013; the United States federal trademark registration for REDBOX.COM No. 4672047, registered on January 13, 2015; and, the United States federal trademark registration for REDBOX No. 4988910, registered on June 28, 2016.

The Complainant also has registered the domain name <redbox.com>.

The Domain Name was registered on June 27, 2021. At the time of filing the Complaint, the Domain name resolved to a website, which offered the Complainant's services for download, and at the time of drafting the Decision, the Domain Name resolves to an error page.

5. Parties' Contentions

A. Complainant

The Complainant provides evidence of trademark registrations, and argues that the Domain Name is virtually identical and confusingly similar to the Complainant's trademark REDBOX, because the Domain Name consists of the Complainant's trademark plus the generic term "tv". The additional element does not add any distinctiveness from the Complainant's trademark.

The Complainant asserts that it has no association with the Respondent and has never authorized or licensed the Respondent to use its trademark. There is no evidence of *bona fide* use.

The Complainant argues that the Respondent has deliberately chosen the Complainant's trademark in the Domain Name to mislead Internet users. Given the fame of the Complainant and the fact that the Complainant's trademark predate the registration of the Domain Name, it is not plausible that Respondent innocently registered the Domain Name.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has established that it has rights in the trademark REDBOX. The test for confusing similarity involves a comparison between the trademark and the Domain Name. The Domain Name

incorporates the Complainant's trademark in its entirety and it is different to the trademark by only the addition of the term "tv". This addition does not prevent a finding of confusing similarity between the Domain Name and the trademark.

For the purpose of assessing under paragraph 4(a)(i) of the Policy, the Panel may ignore the generic Top-Level Domain ("gTLD"), see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11.1.

The Panel finds that the Domain Name is confusingly similar to a trademark in which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant has made unrebutted assertions that it has not granted any authorization to the Respondent to register a domain name containing the Complainant's trademark or otherwise make use of the Complainant's mark. There is no evidence that the Respondent has registered the Domain Name as a trademark or acquired unregistered trademark rights. The Respondent has not offered any explanation as to the registration of the Domain Name, and therefore not provided any evidence of good-faith use.

The Domain Name consists of the Complainant's trademark along with the addition of "tv", which is descriptive of entertainment services offered by the Complainant's on-demand streaming platform. Accordingly, the Domain Name carries a risk of implied affiliation to the Complainant, contrary to the fact, which cannot constitute fair use. See section 2.5.1 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name in accordance with paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds it probable that the Respondent was aware of the Complainant when the Respondent registered the Domain Name and used the Domain Name with the intent to profit from the misdirection caused by the confusingly similar Domain Name. The Complainant's trademarks predate the registration of the Domain Name and the Domain Name was used to allegedly offer for download the Complainant's services and featured the Complainant's mark in various instances in the content of the website at the Domain Name.

The fact that the Domain Name does not currently resolve to an active website does not prevent a finding of bad faith under the doctrine of passive holding, see [WIPO Overview 3.0](#), section 3.3. The Complainant's trademark has a degree of distinctiveness, the Domain Name is almost identical to the Complainant's trademark, and the Respondent has not provided any evidence of actual or contemplated good-faith use, failing to participate in this proceeding whatsoever. Furthermore, the Panel cannot see any plausible good faith use to which the Domain Name may be put by the Respondent. Based on the case file, the Panel agrees with the Complainant that the Respondent most likely has chosen the Complainant's trademark in the Domain Name to mislead Internet users.

For the reasons set out above, the Panel concludes that the Domain Name was registered and is being used in bad faith, within the meaning of paragraph 4(a)(iii) 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 Domain Name <redboxtv.website> be transferred to the Complainant.

/Mathias Lilleengen/
Mathias Lilleengen
Sole Panelist
Date: March 7, 2022