

ADMINISTRATIVE PANEL DECISION

PacketVideo Corporation v. PacketVideo Corporation Case No. D2023-2702

1. The Parties

Complainant is PacketVideo Corporation, United States of America (“United States”), internally represented.

Respondent is PacketVideo Corporation, United States.

2. The Domain Names and Registrar

The disputed domain names <packetvideo.com> and <pv.com> are registered with Network Solutions, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 23, 2023. On June 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 30, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (UKNOWN) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 3, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant sent an email on July 6, 2023, stating its desire to not amend the Complaint.

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 July 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 1, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on August 2, 2023.

The Center appointed Georges Nahitchevansky as the sole panelist in this matter on August 10, 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

Complainant, PacketVideo Corporation, is a digital media services company based in San Diego, California. Complainant has used the names and marks PACKETVIDEO and the short form PV in connection with its services, although it is not clear whether that use ceased or continues to this day. Complainant owns and has owned registrations for the PACKETVIDEO mark both as a word mark and as part of a logo mark. Notably, Complainant's logo mark registrations for PACKETVIDEO, which issued to registration in 2003, both expressly disclaim "PacketVideo" (Registration Nos. 2676211 and 2735117). In addition, one of Complainant's logo mark registrations for PACKETVIDEO lapsed on August 4, 2023, as such registration was not renewed by Complainant (Registration No. 2676211). Complainant also owns, according to the United States Patent and Trademark Office ("USPTO") database, a registration for the word mark PACKETVIDEO on the Supplemental Register (Registration No. 2805921). Lastly, Complainant owns a registration for PV as part of a logo (Registration No. 2830336, which issued to registration on April 6, 2004) without any disclaimer.

Complainant appears to have owned and used the disputed domain names in connection with a website at some point in time, although it is not clear when the use occurred and for how long. The current WhoIs records for the disputed domain names show them as registered under the name PacketVideo Corporation with a Tokyo, Japan address.

Respondent's identity is either unknown or is also using the name PacketVideo Corporation. According to Complainant, in March 2023 Complainant lost control of the disputed domain names. Complainant maintains that a hacker gained "complete access and control over the disputed domain names." Thereafter, Complainant contacted the Registrar regarding its loss of control over the domain names and a few days later Complainant received an email from an unknown individual asserting he was a hacker and had accessed Complainant's operating system and secured the disputed domain names. The email requested the payment of "[USD]17,000 in Bitcoin" for the return of the disputed domain names and provided a Bitcoin wallet address for such payment. Complainant then continued to contact the Registrar to regain control of the disputed domain names without success.

The disputed domain names currently do not resolve to an active website or page.

5. Parties' Contentions

A. Complainant

Complainant maintains that it is a well-known San Diego-based company and "the owner of the famous brand names 'PV' and 'PACKETVIDEO'." Complainant also asserts rights in the names and marks PV and PACKETVIDEO by virtue of its United States trademark registrations for, and use, since 1998, of these trademarks.

Complainant argues that the disputed domain names are identical or confusingly similar to Complainant's PV and PACKETVIDEO marks.

Complainant contends that Respondent has no rights or legitimate interests in the disputed domain names as Respondent is a hacker who improperly secured the disputed domain names for Respondent's profit. Complainant also argues that Respondent (i) is not commonly known by the disputed domain names or the PACKETVIDEO and PV marks, (ii) has no relationship with Complainant and (iii) has no authorization from Complainant to register or use the disputed domain names.

Lastly, Complainant asserts that Respondent has registered and used the disputed domain names in bad faith given that Respondent "hacked the disputed Domain Names primarily for the purpose of demanding payment from the complainant" or to otherwise improperly profit from them.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

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

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names were registered and are being used in bad faith.

A. Identical or Confusingly Similar

The inquiry under the first element can be broken down into two parts, namely (i) whether a complainant has UDRP-relevant rights in a trademark, and (ii) whether the disputed domain names are identical or confusingly similar to the complainant's claimed trademark. Not satisfying either of these two parts can result in a failure to meet the requirements of paragraph 4(a)(i) of the Policy.

It is undisputed that for purposes of the first element the disputed domain names are identical to Complainant's claimed PACKETVIDEO and PV trademarks. The issue here, however, is whether Complainant owns trademark rights in these marks.

Complainant bases its claim of owning rights in the PACKETVIDEO and PV names and marks by virtue of its ownership of trademark registrations in the United States and through the claimed use of those marks since 1998.

Complainant's rights in the PACKETVIDEO mark on the basis of its trademark registrations are questionable. The two logo registrations proffered by Complainant expressly disclaim "PacketVideo," and a third registration for PACKETVIDEO as a word mark that is in the USPTO database, but not relied on by Complainant, is on the Supplemental Register. In all, the registrations do not *per se* establish trademark rights for purposes of the Policy. The disclaimers and Complainant's registration on the Supplemental Register is tantamount to an acknowledgement that the PACKETVIDEO mark lacks distinctiveness and does not yet function as a valid trademark.

Facing such a challenge, Complainant nevertheless maintains that its PACKETVIDEO (and PV) marks are "famous brand names" and "enjoy widespread recognition since 2001". However, while Complainant makes these claims, Complainant's submissions lack specific evidence supporting the contentions or even showing that PACKETVIDEO has transcended its descriptive or non-distinctive character. Mere unsupported or conclusory statements without any supporting evidence does not satisfy this requirement of proof. The type of relevant evidentiary showing that typically would be necessary includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys. *Id.* at section 1.3. Here, Complainant merely claims fame and distinctiveness with no support.

But this does not end the analysis. While Complainant may have failed to prove that its PACKETVIDEO or PV marks are famous, enjoy wide recognition, or have become distinctive, this does not mean that Complainant does not enjoy rights in PACKETVIDEO or PV sufficient for purposes of the Policy. Complainant owns rights in PV as part of a logo trademark registration in the United States, without any disclaimer. In addition, Complainant has produced some evidence of the use of PACKETVIDEO and PV in social media on a LinkedIn page.

Moreover, the fact that Respondent who appears to be an unknown hacker, chose to target Complainant supports the notion that Complainant enjoyed some rights in PACKETVIDEO and PV, otherwise Complainant might have not been a target. Respondent's email to Complainant in March 2023 makes clear that prior to the hacking, Complainant had been using the disputed domain names for emails and other purposes. And the fact that the Whois records for the disputed domain names use Complainant's name as the registrant suggests, in connection with Complainant's trademark registrations, that Complainant was using and trying to build rights in its claimed PACKET VIDEO and PV marks. In all, although there are significant questions regarding the strength of Complainant's claimed rights in PACKETVIDEO and PV, the Panel based on the foregoing is prepared to accept that Complainant has some rights in those marks for purposes of the first element.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the complainant must make at least a *prima facie* showing that the respondent possesses no rights or legitimate interests in a disputed domain name. *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once the complainant makes such a *prima facie* showing, the burden of production of evidence shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

Here, the evidence before the Panel, none of which is contested by Respondent, is that Respondent hacked into Complainant's system and then managed to take control of the disputed domain names. Since that time, Respondent has only sought to blackmail Complainant into making a payment of "[USD]17,000 in Bitcoin" to obtain the return of the disputed domain names and presumably other illicitly obtained information. Such actions are tantamount to an attempt to sell a domain name to its legitimate owner and thus cannot be considered to reflect a right or legitimate interest. As such, the Panel concludes that Respondent does not have a right or legitimate interest in the disputed domain names and that none of the circumstances of Paragraph 4(c) of the Policy are evident in this case.

C. Registered and Used in Bad Faith

Given Respondent's above noted actions and failure to appear in this proceeding, it is not difficult for the Panel to conclude that Respondent has acted in bad faith. Hacking into the account of another to acquire domain names based on that party's claimed trademarks for purposes of reselling them at an exorbitant price back to their original owner is not only malicious but a pure bad faith act of cyberpiracy. As such, Complainant prevails on the third element.

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 <packetvideo.com> and <pv.com> be transferred to Complainant.

/Georges Nahitchevansky/

Georges Nahitchevansky

Sole Panelist

Date: August 24, 2023