



DECISION

BBY Solutions, Inc. v. David Costello

Claim Number: FA2201001979310

PARTIES

The Complainant is **BBY Solutions, Inc.** (“Complainant”), represented by **Giulio E. Yaquinto** of **Pirkey Barber PLLC**, Texas. The Respondent is **David Costello** (“Respondent”), Ireland.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<geek-squad-support.net>** (“Disputed Domain Name”), registered with **NameCheap, Inc.**.

PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

David L. Kreider, Chartered Arbitrator (U.K.), as Panelist.

PROCEDURAL HISTORY

The Complainant submitted a Complaint to the FORUM electronically on January 6, 2022; the FORUM received payment on January 6, 2022.

On January 6, 2022, NameCheap, Inc. confirmed by e-mail to the FORUM that the **<geek-squad-support.net>** domain name is registered with NameCheap, Inc. and that the Respondent is the current registrant of the names. NameCheap, Inc. has verified that the Respondent is bound by the NameCheap, Inc. registration

agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On January 7, 2022, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of January 27, 2022, by which the Respondent could file a Response to the Complaint, via e-mail, to all entities and persons listed on the Respondent's registration as technical, administrative, and billing contacts, and to postmaster@geek-squad-support.net. Also on January 7, 2022, the Written Notice of the Complaint, notifying the Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to the Respondent via post and fax to all entities and persons listed on the Respondent's registration as technical, administrative, and billing contacts.

A timely Response was received and determined to be complete on January 24, 2022.

On January 29, 2022, both the Claimant and the Respondent circulated their respective Additional Submissions. The Panel finds the Additional Submissions helpful and accepts the additional submissions of each of the Parties, in the exercise of his discretion under Rule 7 of the Supplemental Rules.

On January 28, 2022, pursuant to the Complainant's request to have the dispute decided by a single-member Panel, the FORUM appointed David L. Kreider as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the FORUM has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the

"Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2.

RELIEF SOUGHT

The Complainant requests that the domain name be transferred from the Respondent to the Complainant.

PARTIES' CONTENTIONS

A. The Complainant

The Complainant, BBY Solutions, Inc. (hereinafter "Best Buy" or "Complainant") has rights in the GEEK SQUAD trademark (the "Mark" or "Marks") through its registrations with the United States Patent and Trademark Office ("USPTO") (*e.g.*, Reg. No. 2,744,658, registered July 29, 2003), which include the following Geek Squad Logos:



Best Buy has been using the Marks, through a predecessor-in-interest, since at least as early as 1994 in connection with computer installation, maintenance, repair and design services and other technical support services. Since that time, Best Buy has continuously used the GEEK SQUAD Marks in commerce in the United States. For over twenty years, Best Buy and its predecessor have marketed its GEEK SQUAD services via websites using the domain name geeksquad.com (collectively the "Geek Squad Websites"). The GEEK SQUAD Marks are featured in Best Buy's print and television advertising, in-store signage and on Best Buy's GEEKMOBILE vehicles.

- a. The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

The Disputed Domain Name incorporates the mark GEEK SQUAD in its entirety and includes the generic term “support.” Numerous UDRP panels have reasoned that where “a disputed domain name contains Complainant’s entire trademark and differs only by the addition of a generic or descriptive phrase and top-level domain name, the differences between the domain name and its contained trademark are insufficient to differentiate one from the other for the purposes of the Policy.” *Microsoft Corporation v. Thong Tran Thanh*, FA 1653187 (Forum Jan. 21, 2016); accord *Arris Enterprises LLC v. Fateh Singh / Techboy Solutions*, FA2110001970427 (Forum Nov. 18, 2021); *Chevron Intellectual Property LLC v. Thomas Webber / Chev Ronoil Recreational Sport Limited*, FA 1602001661076 (Forum March 15, 2016). The Disputed Domain Name is, therefore, confusingly similar to the GEEK SQUAD mark.

- b. The Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant avers that it has no relationship with the Respondent; did not authorize the Respondent’s registration of the domain or use of the GEEK SQUAD Marks in any manner; and that the Respondent is not commonly known by the Disputed Domain Name.

The Complaint alleges that the Respondent is using the Disputed Domain Name in connection with competing services. The Complainant offers, *inter alia*, technical support and installation services relating to computer software, hardware, electronics, and other products, while the Respondent’s website to which the Disputed Domain Name resolves (“Respondent’s Website”) claims:

“Are you looking for someone to fix any of your gadget’s issue? If yes, then your search stops right here. Our expert team of Geek Squad Support is at your service to provide you with top-notch services for your defective devices. Geek Squad Support has set standards when it comes to repairing web sites. Our experts are packed with some of the exclusive technologies for electronic or hardware device issues.”

The Respondent, the Complaint alleges, uses the Disputed Domain Name to advertise competing services to those of the Complainant. Such use does not show rights or legitimate interests in the disputed domain. See, *e.g., Clif Goggles, Inc. v. Duarte*, FA1006001327834 (Forum July 13, 2010) (use of confusingly similar mark in connection with “a site not affiliated with Complainant but offering similar competing products is not a *bona fide* offering of goods or services or a legitimate noncommercial or fair use”).

c. The Respondent registered and is using the domain name in bad faith.

The Disputed Domain Name incorporates the GEEK SQUAD Mark in its entirety. Such use of Complainant’s Mark in the Disputed Domain Name shows Respondent intends to confuse consumers and constitutes evidence of bad faith. See, *e.g., Bloomberg Finance L.P. v. Privacy Protection*, FA 2109001967145 (Forum Nov. 2, 2021) (bad faith found in registration of <bloombergbtc.com> where “Complainant operates one of the largest and most well-known financial news organizations in the world, and Respondent registered a domain name with the entirety of the BLOOMBERG mark, adding the related acronym ‘BTC’ [to refer to bitcoin]”).

The Respondent registered the Disputed Domain Name with knowledge of the Complainant’s trademark rights. A respondent is “presumed to have knowledge” of a complainant’s mark where the domain name “incorporates Complainant’s mark in its entirety.” *Transamerica Corp. v. Domain Manager / samirnet -domain*

names for sale, FA 1709001748623 (Forum Oct. 17, 2017). Moreover, “there is a legal presumption of bad faith when Respondent reasonably should have been aware of Complainant’s trademarks, actually or constructively.” *Digi Int’l v. DDI Sys.*, FA 124506 (Forum Oct. 24, 2002). As such, the Respondent cannot seriously contend it lacked knowledge of the GEEK SQUAD Marks when it registered the Disputed Domain Name or acted without bad faith in doing so. The Complainant’s trademark registrations alone establish the Respondent’s knowledge of the Complainant’s rights in the Mark. See, e.g., *American Council on Education and GED Testing Service LLC v. WA*, FA 1504001614043 (Forum June 1, 2015) (“Respondent is found to have had actual knowledge of Complainants’ rights in the GED® Mark pursuant to multiple federal U.S. trademark registrations for the GED® Mark.”); accord *Homer TLC, Inc. v. Issac Portis*, FA 1410001585480 (Forum Dec. 1, 2014).

In addition, the Respondent’s Website prominently features the logo shown below, which clearly mimics Complainant’s registered Geek Squad Logo.



The Respondent’s Logo



The Complainant’s Logo

Further, the Complainant argues, UDRP panels have found that the “notoriety” of the GEEK SQUAD Marks is such that actual knowledge, and thus bad faith, can be inferred. This is particularly true where, as here, the domain is being used to offer or promote competing services. See, e.g., *BBY Solutions, Inc. v. Online Geek Squad*, FA 1803001779194 (Forum May 3, 2019) (“Respondent must have had actual knowledge of the GEEK SQUAD mark in light of the obvious

connection between Complainant's mark and the services/content located at the resolving website for the <onlinegeeksqad.com> domain name.").

Finally, the Complainant alleges, the Respondent registered the Disputed Domain Name using a proxy service to conceal its identity. It is well-established that a respondent's use of a proxy service may support a finding of bad faith. See *Neuberger Berman Group LLC v. Becky Hoang / nb capital assets*, FA2109001964604 (Forum Oct. 22, 2021) ("[W]hen viewed as part of the totality of the circumstances which surround a respondent's activities, engagement of a privacy service may provide further support for a finding of bad faith registration and use.").

B. The Respondent

The Respondent purchased the Disputed Domain Name at auction on November 3, 2020. The Respondent represents that it registered the Disputed Domain Name because: "We are a squad of geeks and we wanted this as a news site to promote the various arms of our business which are all tech so therefore geeky!!"

The Respondent alleges that a junior employee was responsible for creating Respondent's Website, using a logo which, the Respondent admits, "was quite close to that of Best Buy's geek squad". The Respondent alleges that it has since replaced the branding on Respondent's Website.

The Respondent admits that, at the time it registered the Disputed Domain Name, it was aware of a geek squad connected to the Carphone Warehouse, but unaware of Best Buy's geek squad.

The Respondent avers in its Response, and repeats in its Additional Submission, that the Respondent's business is that of web design and digital marketing, which is "vastly different" from the Complainant's consumer electronics business; that

the industries in which the Parties are respectively engaged are “vastly differentiated”; and that the Respondent did not know about Best Buy’s Geek Squad when it purchased the Disputed Domain Name.

C. Additional Submissions

In its Additional Submission, the Complainant explains that Carphone Warehouse and the Complainant were previously involved in a joint venture through which Carphone Warehouse was licensed to use the GEEK SQUAD Marks. In fact, the Geek Squad Logo appearing on the Respondent’s Website is the same as that used by Carphone Warehouse. Accordingly, the Complainant argues, the Respondent registered the Disputed Domain Name — and used Complainant’s Geek Squad Logo — with knowledge of the Complainant and its prior rights. Such knowledge, the Complainant avers, establishes the Respondent’s bad faith. See, *e.g.*, *BBY Solutions, Inc. v. Online Geek Squad*, FA 1803001779194 (Forum May 3, 2019).

Finally, the Complainant asserts that the remedial actions alleged to have been taken by the Respondent subsequent to notification of the filing of the instant complaint, *i.e.*, the removal of the Complainant’s GEEK SQUAD graphic logo, are irrelevant. Previous panels have held that a respondent’s removal of the complainant’s logo from a website after receiving a UDRP complaint shows the respondent lack rights or a legitimate interest in the domain. See *Snap Inc. v. ALI ALSHUMRANI / ALI ALERYANI*, FA1805001788602 (Forum June 14, 2018).

FINDINGS

The Panel finds that the Respondent registered and used the **<geek-squad-support.net>** domain name to intentionally confuse and mislead consumers and free ride on the notoriety and good will of the Complainant’s Marks to attract Internet users to Respondent’s Website for its own commercial gain. The

Respondent acted in bad faith, with knowledge of the fame of the Complainant's registered GEEK SQUAD Marks and brand, as is demonstrated by the Respondent's unauthorized use of the Complainant's Geek Squad Logo on Respondent's Website.

DISCUSSION

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."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

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

Identical and/or Confusingly Similar

The Complainant asserts rights in the GEEK SQUAD mark through its registration of the mark with the USPTO (*e.g.*, Reg. No. 2,744,658, registered on July 29, 2003). See *Recreational Equipment, Inc. v. Liu Chan Yuan*, FA 2107001954773 (FORUM Aug. 9, 2021) ("Registration of a mark with the USPTO is sufficient to demonstrate rights in the mark per Policy ¶ 4(a)(i)"). The Panel finds the Complainant has sufficiently established rights in the GEEK SQUAD Mark.

The Complainant argues Respondent's <geek-squad-support.net> domain name is identical or confusingly similar to the Complainant's GEEK SQUAD Mark, as it incorporates the mark in its entirety, only adding the generic term "support", which is indicative of the core services provided by the Complainant, and the ".net" gTLD. Merely adding a generic term that relates to the services provided and a gTLD is insufficient to differentiate the disputed domain name from the mark. See *MTD Products Inc v J Randall Shank*, FA 1783050 (FORUM June 27, 2018) ("The disputed domain name is confusingly similar to Complainant's mark as it wholly incorporates the CUB CADET mark before appending the generic terms 'genuine' and 'parts' as well as the '.com' gTLD."). The Panel agrees and finds the Disputed Domain Name is confusingly similar to the Complainant's GEEK SQUAD mark.

The Panel finds that the first element at Policy Paragraph 4(a)(i) is satisfied.

Rights or Legitimate Interests

The Panel notes the requirement in UDRP cases that the Complainant must first make out a *prima facie* case that the Respondent lacks rights and legitimate interests in the Disputed Domain Name under Policy ¶ 4(a)(ii). Only once this has been done does the burden shift to the Respondent to come forward with proof to show it does have rights or legitimate interests. See *Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its *prima facie* case and satisfy Policy ¶ 4(a)(ii)).

The Complainant contends the Respondent lacks rights and legitimate interests in the Disputed Domain Name because the Respondent is not authorized to use the GEEK SQUAD Mark, nor is the Respondent commonly known by the Disputed Domain Name. The Panel agrees and finds that the Complainant has

made out a *prima facie* case that the Respondent lacks rights and legitimate interests in the Disputed Domain Name.

On its part, the Respondent represents that it has rights and legitimate interests in the Disputed Domain Name because it uses the domain name in connection with a *bona fide* offering of technical services, which do not compete with those offered to the public by the Complainant. The Respondent avers in its Response and Additional Submission that the Respondent's business is that of "*web design and digital marketing*" and is, therefore, "*vastly different*" from the Complainant's technical services business.

The Panel notes, however, that as of 6 January 2022, the same date the Complaint was filed in these UDRP proceedings, Respondent's Website represented, *inter alia*, that the Respondent's Geek Squad Support will "fix any of your gadget's issue"; "provide top-notch services for your defective devices"; and are available "24/7 round the clock and 365 days" "supplying the services for your defective devices"; "tackling any kind of your device's issue irrespective of the brand". Respondent's Website proclaims: "Our experts are packed with some of the exclusive technologies for electronic or hardware device issues". Respondent's Website inquires rhetorically: "So, why sit with your broken or flawed devices? Call our Geek Squad Support experts now" and "get the best fixes to all of your technical issues and problems."

The Respondent's Website represents that the scope of Respondent's Geek Squad Support technical services extends, without limitation, to fixing or repairing "all" technical issues and problems relating to "any" make, model or kind of electronic "gadget", "device", "instrument", "appliance", or other "hardware", in addition to supplying SEO (Internet "search engine optimization"), online marketing, and other "web design and digital marketing" services.

Based on its review of Respondent's Website, the Panel rejects the Respondent's evidence that its business does not compete with the Complainant's technical support services business. The screenshot of Respondent's Website demonstrates, *prima facie*, that the Respondent competes with the Complainant. Accordingly, the Panel finds the Respondent is not using the <geek-squad-support.net> domain name for a *bona fide* offering of goods and services or legitimate noncommercial or fair use. See *Vanguard Trademark Holdings USA LLC v. Dan Stanley Saturne*, FA 1785085 (FORUM June 8, 2018) ("Respondent's use of the disputed domain name does not amount to a *bona fide* offering of goods or services or a legitimate noncommercial or fair use" where "Respondent is apparently using the disputed domain name to offer for sale competing services.").

The Panel finds that the Respondent lacks rights or legitimate interests in the Disputed Domain Name and that the second element at Policy Paragraph 4(a)(ii) is satisfied.

Registration and Use in Bad Faith

As of 6 January 2022, the same date the Complaint was filed in these UDRP proceedings, Respondent's Website prominently featured a logo which, the Panel finds, is virtually indistinguishable from the Complainant's registered Geek Squad Logo.

Against this background, the Panel finds that the Respondent registered and used the Disputed Domain Name to intentionally confuse and mislead consumers and free ride on the good will of the Complainant's Marks to attract Internet users to the Respondent's Website for its own commercial gain.

The Respondent registered and used the Disputed Domain Name in bad faith, with full knowledge of the fame and notoriety of the Complainant's Marks and brand, as is clearly demonstrated, *inter alia*, by the Respondent's unauthorized use of the Complainant's Geek Squad Logo on several web pages of Respondent's Website.

As additional evidence of the Respondent's intentional targeting of the Complainant's Marks and GEEK SQUAD brand, the Panel notes that the Complainant registered its "geek squad.com" domain name on 11 October 2015, and had additionally registered the domain name "geek-squad-support.com" on 11 October 2015.

The Panel considers it reasonable to infer that the Respondent registered the Disputed Domain Name <geek-squad-support.net> on 3 November 2020 for the simple reason that the same domain name under the more popular ".com" generic top-level domain (gTLD) had already been taken by the Complainant – a fact of which the Respondent must have been aware at the time.

Finally, under the circumstances of the present case, the Panel accepts the Complainant's evidence that the Respondent's use of a proxy service to mask its identity in connection with the Disputed Domain Name further demonstrates the Respondent's bad faith registration and use of the domain, with knowledge that the domain infringed the Complainant's Marks.

Based on the above facts and evidence, the Panel finds that the third element at Policy Paragraph 4(a)(iii) is satisfied.

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <geek-squad-support.net> domain name be **TRANSFERRED** from Respondent to Complainant.

David L. Kreider, Chartered Arbitrator (U.K.), Panelist

Dated: January 31, 2022