



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-1400671
Complainant:	Chris Duane
Respondent:	Rob Gray
Disputed Domain Name(s):	<silverbulletssilvershield.com>

1. The Parties and Contested Domain Name

The Complainant is Chris Duane, of 5142 Center Rd., Brunswick, Ohio, 44212, United States.

The Respondent is Rob Gray, of 2902 Wren Lane, Richardson, Texas, United States.

The domain name at issue is <silverbulletssilvershield.com>, registered by Respondent with Network Solutions LLC, of 12808 Gran Bay Parkway West, Jacksonville, Florida 32258, United States.

2. Procedural History

On November 26, 2014, the Complainant submitted a Complaint in English to the Hong Kong Office of the Asian Domain Name Dispute Resolution Center (the ADNDRC) and selected this case to be heard by a one-member panel, in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy) approved by the Internet Corporation for Assigned Names and Numbers (ICANN), the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the ADNDRC Supplemental Rules). On the same date, the ADNDRC sent to the Complainant by email an acknowledgement of the receipt of the Complaint and reviewed the format of the Complaint in compliance with the Policy, the Rules and the ADNDRC Supplemental Rules.

On November 26, 2014, the ADNDRC transmitted by email to ICANN and the Registrar, Network Solutions LLC, a request for registration verification of the disputed domain name and inquired “Whether the Respondent ‘Rob Gray’ is the Registrant or holder of the disputed domain name”.

On December 9, 2014, the Registrar transmitted, by email to the ADNDRC, its verification response confirming the identity of the Registrant as “Rob Gray” and indicating that “[t]he language used at the time of registration was English.”

On December 10, 2014, the ADNDRC notified the Complainant that there are certain deficiencies in the Complaint and requested it to resubmit the revised Complaint according to Paragraph 4 (b) of the Rules along with the required documents and the relevant supporting documents (if applicable) on or before December 15, 2014, failing which the Complaint will be deemed withdrawn without prejudice to submission of a different Complaint by the Complainant.

On December 13, 2014, the Complainant submitted a Revised Complaint to the ADNDRC and on December 16, 2014 the ADNDRC sent to the Complainant, by email, an acknowledgement of its receipt of the Complaint and a further acknowledgement that the revised Complaint is in administrative compliance with the Policy, the Rules and the ADNDRC Supplemental Rules.

On December 16, 2014 the ADNDRC transmitted the Written Notice of the Complaint to the Respondent, which stated that the Complainant had filed a Complaint against the Respondent over the disputed domain name and that the ADNDRC had sent the Complaint and its attachments to the Respondent through email according to the Rules and the ADNDRC Supplemental Rules. The ADNDRC notified the Complainant that the Complaint had been confirmed and transmitted to the Respondent, ICANN and Registrar and that the case was officially commenced on December 16, 2014.

On January 4, 2015, the ADNDRC notified the Complainant that a Response was received.

On January 15, 2015, the ADNDRC notified the Proposed Panelist, Mr. Steven M. Levy, Esq., to inquire whether he is available to act as the Panelist in this case and if so, whether he is in a position to act independently and impartially between the parties. Having received a Declaration of Impartiality and Independence and a Statement of Acceptance from Mr. Levy, on January 16, 2015 the ADNDRC informed the Complainant and the Respondent of the appointment of the Panelist, and transferred the case file to the Panelist on the same day asking the Panel to submit a decision on or before January 30, 2015.

On January 19, 2015, the Panel issued Administrative Panel Order No. 1 seeking further documents and information from the parties. On January 20, 2015 Complainant submitted its response to the Order and on January 22, 2015 the Respondent submitted its response. On January 22, 2015 Complainant submitted a further response to the Order.

The Panel finds that it was properly constituted and appointed in accordance with the Rules and the ADNDRC Supplemental Rules. The language of the proceeding is determined to be English, as this is the language of the Domain Name Registration and Service Agreement for the disputed domain, pursuant to Paragraph 11(a) of the Rules, and also in consideration of the fact that there is no express agreement to the contrary by the Parties.

3. Factual background

Complainant is the owner of a U.S. trademark registration for SILVER BULLET SILVER SHIELD in relation to “Precious metals, namely, silver.” This registration issued on July 1, 2014 and the application therefor was filed on November 5, 2013. The registration claims that the mark was first used on February 25, 2011. This February, 2011 date is also when Complainant first published an article entitled “The Silver Bullet And The Silver Shield” on a website called “Don’t Tread On Me”. The article expresses Complainant’s thoughts

on the benefits of buying physical (metallic) silver as a way to “overthrow the Elitist system that enslaves us with debt” and to bring about political and economic change. A number of advertisements appear on the page but none of them are for the sale of silver under the Complainant’s trademark.

Complainant also points to a series of 48 videos on YouTube.com, all under the playlist title “Silver Bullet Silver Shield.” The first of these was posted on Jan 24, 2012 and is a reading of the 2011 Don’t Tread On Me article accompanied by a changing array of moving and still images. Further videos in the series display the SILVER BULLET SILVER SHIELD playlist name at the upper right and similarly provide the Complainant’s perspectives and recommendations with respect to physical silver and a variety of political and economic issues. In the area just below each of these videos are links to other websites which appear to sell silver. The last video in this series was published on June 27, 2012.

At some point prior to August 2, 2012, Complainant met the Respondent who was then preparing to testify before a US Congressional Subcommittee on Domestic Monetary Policy & Technology. Complainant entered into some type of business relationship with Respondent and his now-bankrupt company called Mulligan Mint, Inc. to sell specially designed silver medallions and, on August 29, 2012, Respondent registered the disputed <silverbulletsilvershield.com> domain name. Just a few days later, on September 1, 2012, the parties created an unsigned, hand-written document entitled “The Deal” containing financial business terms, including shared profits from medallion sales, but making no mention of the SILVER BULLET SILVER SHIELD mark or any domain name.

Complainant exited this business relationship in April of 2013 and there have since been various formal disputes between the parties including a civil action by Complainant claiming Respondent’s failure to pay certain monies and deliver certain coins; Respondent filing an opposition to Complainant’s US trademark application (the opposition was ultimately dismissed for failure to state a claim); and Complainant filing a complaint against Respondent with the Consumer Protection Division of the Attorney General of Texas.

Through all of this time the website at the <silverbulletsilvershield.com> domain has offered for sale silver medallions bearing, on the back, the name SILVER BULLET SILVER SHIELD and, on the front, various designs whose ownership also seems to be in dispute between the parties.

4. Parties’ Contentions

A. Complainant

The Complainant’s contentions may be summarized as follows:

- i. Complainant asserts that he is the sole owner of all trademark rights in the phrase “SILVER BULLET SILVER SHIELD” in relation to the sale of silver medallions.
- ii. In characterizing their business relationship, Complainant asserts that Respondent was nothing more than a vendor for his silver medallions.
- iii. He claims that he never licensed his trademark or otherwise gave permission for its use to Respondent or Mulligan Mint.

- iv. In light of the above, Complainant asserts that the <silverbulletssilvershield.com> domain was registered in violation of the Uniform Dispute Resolution Policy and should be transferred to Complainant.

B. Respondent

The Respondent's contentions may be summarized as follows:

- i. Respondent asserts that Complainant's trademark application was filed in bad faith and after their business relationship ended.
- ii. He claims he "ran a business together" with Complainant before any trademark rights existed and that Complainant had no such business until Respondent created it.
- iii. Respondent variously characterizes his business relationship with Complainant as a "partnership" or a "joint venture".
- iv. He claims that he was granted all rights to the SILVER BULLET SILVER SHIELD assets held by Mulligan Mint when that company was dissolved in bankruptcy.
- v. In light of the above, Respondent asserts that the <silverbulletssilvershield.com> domain was registered in good faith.

5. Findings

This is a factually complex case in which both parties have submitted extensive evidence and made opposing claims regarding the existence of trademark rights in the SILVER BULLET SILVER SHIELD name and the nature of their business relationship through which they intended to market and sell specially designed silver coins or medallions.

The ICANN Uniform Domain Name Dispute Resolution Policy ("UDRP" or the "Policy") provides, at ¶4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

It is well settled that The Complainant has the burden of proof, by a preponderance of the evidence, in respect to each element in ¶4(a) of the Policy. See, e.g., *Arena Pharmaceuticals GmbH v. Alen Mironassyan*, WIPO Case No. D2014-1776.

A. Scope of the UDRP

The evidence and assertions submitted by each party lead the Panel to find that this case is not one which is appropriate for resolution under the Policy. It is well accepted that the Policy is designed to address clear cases of cybersquatting, and not disputes where a trademark or domain name are the subject of a larger business dispute with a limited evidentiary record and potentially valid claims on each side. See, e.g., *Libro v. NA Global Link Limited*, WIPO Case No. D2000-0186 ("The [Policy] is very narrow in scope; it covers only clear cut cases of 'cybersquatting' and 'cyberpiracy'"); *Everingham Bros. Bait*

Co. v. Contigo Visual, NAF Claim No. FA 440219 (2005) (“The Panel finds that this matter is outside the scope of the Policy because it involves a business dispute between two parties. The UDRP was implemented to address abusive cybersquatting, not contractual or legitimate business disputes.”)

Here, although Complainant registered the SILVER BULLET SILVER SHIELD trademark with the United States Patent and Trademark Office and may also have a claim to common-law rights based on its YouTube playlist, and while the disputed domain is, apart from the .com TLD, identical to Complainant’s claimed trademark, there remains the open question of whether the Respondent had permission, either express or implied, to use the complainant’s trademark in the disputed domain. This directly impacts consideration of both the second and third elements of the Policy, ¶¶4(a)(ii) and (iii).

In the disagreement between the parties as to the nature of their business relationship Respondent claims it was a partnership or a joint venture and Complainant insists that Respondent was never more than a vendor whose primary role was to produce silver medallions and fulfill orders therefor. However, the evidence presented by the parties makes this issue anything but clear¹.

For example, in a January 10, 2013 email from Complainant to a representative from another mint, which may be in Thailand, Complainant refers to himself and Respondent as “we” (i.e., “In fact, *we* brought in 2 artists and another sculptress....”) and then states that “*our* sculptress took it to a whole another [sic] level.” (emphasis provided). However, other statements by Complainant refer to “Rob and his team” and may suggest a greater distinction between the parties.

Of particular interest is an undated promotional flyer which was supposedly produced by Respondent and included in completed orders for silver medallions. This shows a photograph of Complainant, discusses his history in the field of silver investing, and explains that “a strong *partnership* then turned to bringing the ideas of The Silver Bullet and the Silver Shield to the physical silver market.” (emphasis provided). It goes on to say that “[t]he first release of this new *partnership* is the in Debt and Death They Trust Silver Bullet and Silver Shield Medallion.” (emphasis provided). The bottom of this flyer shows the <silverbulletssilvershield.com> domain next to the words “Order Online Now”.

Finally, after the parties went their separate ways in April of 2012, both separately attempted to purchase certain medallion designs created by the mint in Thailand and in a May 2, 2013 email from that mint’s representative to Respondent he seems concerned about to whom he should sell the designs asking “[w]ho really is the captain of this particular ship/enterprise...?”

Apart from the unsigned, handwritten “Deal” mentioned above, and the promotional flyer, no documents were submitted by either party to clarify the nature of their business relationship. No relevant emails between them are of record and there is no indication of when Complainant learned of the <silverbulletssilvershield.com> domain or what communication, if any, he had with Respondent on this topic.

¹ The Panel’s January 19 2015 Administrative Order No. 1 specifically requested that the parties provide further documents and information concerning the business relationship between them and any terms thereof which relate to the SILVER BULLET SILVER SHIELD trademark.

As such, despite Complainant's present denial of any license or other grant of trademark rights to Respondent it is not possible, on this record, to determine if, by his actions or inactions, Complainant gave an implied license or at least the impression to Respondent or third parties, that use of the trademark by Respondent was within the scope of the parties' business relationship. Complainant states, in his pleadings, that "this started on a handshake" and that "I am at fault for not having a formal contract..." The record in this case thus does not answer, by a preponderance of the evidence, the question of whether Respondent has no legitimate right or interest in the disputed domain (e.g., whether his website is a bona fide use) or whether he acted in bad faith when registering or using the domain.

B. Conclusion

This Panel has concluded that, in this particular case and due to the unsettled issues surround the nature and terms of the parties' business relationship, the question of what rights, licenses, or other permissions were given by Complainant to Respondent, either express or implied, to the SILVER BULLET SILVER SHIELD trademark or the disputed domain, are beyond the scope of the Policy. Rather, these are best left to a legal forum in which all of the facts, testimony, and documents surrounding these issues can be fully vetted. The fact that in their respective pleadings Respondent accuses Complainant of lying and Complainant accuses Respondent of being "a crook" further supports the need here for more robust fact-finding than that provided under the UDRP.

6. Decision

For the foregoing reasons, the Complaint is denied.

Steven M. Levy, Esq.
Panelist

Dated: January 27, 2015