Decision for dispute CAC-UDRP-103256

Case number	CAC-UDRP-103256
Time of filing	2020-09-03 09:05:26
Domain names	dynacodoors.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	ENTREMATIC GROUP AB

Complainant representative

Organization	Coöperatieve Vereniging SNB-REACT U.A.

Respondent

Organization	Mike Fleck (r&s erection of tri county inc)

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the proprietor of inter alia the following trademarks:

European Union trade mark
Mark: DYNACO
Registration number: European Union trade mark 000718585
Entered on register: August 16, 1999
Classes 6 (Flexible, mechanically-operated doors of metal with frames entirely or partially of metal; industrial rolling doors of metal with frames entirely or partially of metal; the metal part being predominant) and 19 (Flexible, mechanically-operated doors not of metal with frames entirely or partially of metal; industrial rolling doors not of metal with frames entirely or partially of metal; the metal part being predominant).

United States Trademark
Mark: DYNACO
Registration number: USPTO registration number 2247544

Serial number of the application: 75438084
Entered on register: May 25, 1999
For class 19: “Flexible doors, not of metal, with mechanical control whereby the frame is entirely or partially of metal; industrial rollable doors, not of metal, whereby the frame is entirely or partially of metal”

International trademark
Mark: DYNACO
Registration number: 618453
Entered on the register: April 19, 1994
For countries including Norway, China, Russia, Belgium, the Netherlands, Luxembourg.
For classes 6, 19, and 37.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

Name of the Respondent (domain-name holder) and all information (including any postal and e-mail addresses and telephone and telefax numbers) known to the Complainant regarding how to contact Respondent or any representative of Respondent, including contact information based on pre-complaint dealings:

Representative of the Respondent which was contacted during pre-complaint dealings:

Name: Mike Fleck
E-mail address: mikef@rstricounty.com

In March 2020, the Complainant gained knowledge of the domain <dynacodoors.com>. According to WHOIS data, it was registered anonymously. When accessed, the domain redirected to <rstricountry.com>, for which WHOIS data states it in turn was registered to “R&S Erection of Tri County Inc”, and is forwarding to what appears to be their website offering doors, including competing brands (other than DYNACO doors).

The specific method of redirection is a double “HTTP 301 Redirect”, which was ascertained on April 9, 2020. It is a double redirect, first a redirection from <dynacodoors.com> to <rstricounty.com> (without the www subdomain) and then to http://www.rstricounty.com/.

The Respondent is a reseller of doors products under different brands, including among others DYNACO doors products.

After one of the Complainant’s directors (of the Entrematic High Performance Doors NA branch) approached the Respondent by phone in order to discuss the trademark infringement inherent in the used domain name, on May 26, 2020, Mike Fleck, President/CEO R&S Erection of Tri-County Inc. replied by e-mail with the subject of “[EXT] Re: Web site resolution”:

On May 26, 2020, 5:58 PM Mike Fleck <mikef@rstricounty.com> wrote:

“Good evening Bob,

I spoke with a couple of my board members and they felt that with the traffic and the way we are using the domain with Google they do not want to give it up. I did get them to agree that web would relinquish it if R&S could gain access to the [REDACTED by Complainant’s legal Representative] product line. Currently we sell [REDACTED] of dollars a year to a couple other [REDACTED] vendors like [REDACTED] Incorporated. I know that seems to be unattainable but that is still on the table. Outside of that if this is going legal please let me know.

Thank you,
Mike Fleck
President / CEO
R&S Erection of Tri-County Inc.“

The President / CEO of the Respondent accepted another invitation to “discuss use of domain” on June 4, 2020, but this did not end in the Respondent agreeing to transfer the domain name to the Complainant for a sum not in excess of documented out-of-pocket costs directly related to the domain name either.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

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According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

RIGHTS

The disputed domain name is confusingly similar to the Complainant’s DYNACO Trademarks. This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of

a) disregarding the top-level suffix in the domain name (i.e. ".com"); and

b) not finding that the addition of a generic word (such as "DOORS"), which describes the very goods sold under the mark, would be sufficient to distinguish a domain name from a trademark.

Therefore, the Panel comes to the conclusion that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

The Complainant has put forward that the Respondent is not commonly known by the disputed domain name. Neither is the Respondent in any way related to the Complainant. Nor has the Respondent been granted an authorization or license to use the disputed domain name by the Complainant. This has not been contested by the Respondent. Instead, the Respondent failed to provide any information and evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

On the contrary, the Respondent caused the domain name to be redirected to the domain <rstricounty.com> and upon being contacted by the Complainant, stated that there was no intention to give up the domain, due to the traffic it generated. However, transferring the domain would have been considered by the Respondent in return for being given access to a particular product line of the Complainant. The Respondent also refused to transfer the domain name for more than the costs related to the registration of the domain name.

Therefore, the Panel concludes that the Respondent did not establish any right or legitimate interest to the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainant has established that the disputed domain name was registered by the Respondent and is being used by the Respondent in bad faith. For this purpose, the Complainant has successfully put forward prima facie evidence that the Respondent has caused the domain name to be redirected by means of a double "HTTP 301 Redirect", first a redirection from <DYNACODOORS.COM> to <RSTRICOUNTY.COM> (without the www subdomain) and then to HTTP://WWW.RSTRICOUNTY.COM/.

The Respondent is not making use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services. The Respondent has not acquired trademark or service mark rights and the Respondent's use and registration of the disputed domain name was not authorized by the Complainant. In the absence of any license or permission from the Complainant to use its trademark, no actual or contemplated bona fide or legitimate use of the disputed domain name could reasonably be claimed. See LEGO Juris A/S v. DomainPark Ltd, WIPO Case No. D2010-0138; Sportswear Company S.P.A. v. Tang Hong WIPO Case No. D2014-1875 and WIPO Case No. D2019-1273 (Pandora A/S v. Yan Li) par 6.B.).

The Respondent is offering for sale products manufactured by third parties, some of which compete with those offered by

Complainant. Furthermore, the website fails to accurately disclose the registrant's relationship with the trademark holder, as there is no valid disclosure on the website RSTRICOUNTY.COM. There is no disclaimer on the website – let alone one that satisfies the WIPO Overview 3.0, Paragraph 2.8 criterion that "Respondent's website must accurately and prominently disclose […] the registrant's relationship with the trademark holder.".

HTTPS://WWW.RSTRICOUNTY.COM/ advertises "At R&S Erection of Tri County Inc., we offer all types of commercial doors. Among our offerings are: (…) High speed doors from all major brands". The brands listed are inter alia: R&S, DBCI, Clopay and other brands, Commercial pass door products from major brands. Furthermore, the page states: "We also provide and service all necessary hardware from all major brands." Thus the website mostly lists products from competitors of the Complainant.

In fact, there are few references to actual DYNACO products on the website, mainly in .pdf files uploaded, e.g. at https://www.rstricounty.com/ (DYNACO Slimline Pharma door for interior pharmaceutical environments), https://www.rstricounty.com/ (DYNACO Streamline High Speed Doors), www.rstricounty.com/wp-content/uploads/AWM2.AWM3-cut-sheet.pdf (DYNACO All Weather M2/M3 High Speed Doors) , https://www.rstricounty.com/ (DYNACO M2 Basic high speed doors) and https://www.rstricounty.com/ , but in any case the Respondent is not using the site to sell >only< the DYNACO trademarked goods.

As was held in WIPO Case No. D2002-0383 (All Packaging Machinery Supplies, Corp. v. Crystal Flex Packaging Corp.): "Moreover, there is no basis to believe that any arrangement involving distribution of Complainant's goods would also have authorized Respondent to register domain names corresponding to Complainant's mark. Accordingly, it appears that Respondent lacks any right or legitimate interest in the Domain Names."

In the absence of a Response and given the reputation of the Complainant and its trademarks, as supported by the Complainant's evidence, the Panel must conclude that the Respondent was fully aware of the Complainant's trademark "DYNACO" at the time of registering the disputed domain name <DYNACODOORS.COM>. Another reason for registering the trademark in conjunction with the goods for which it is used does not appear logical and has not been argued. On the contrary, the Respondent has referred expressly to these products in correspondence.

Therefore, it has been established to the satisfaction of the Panel that the disputed domain name was registered and is being used (at least passively) in bad faith, in order to prevent the Complainant from making proper use of the mark in the disputed domain name.

Therefore, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **DYNACODOORS.COM**: Transferred

PANELLISTS

Name	**Udo Pfleghar**

DATE OF PANEL DECISION 2020-10-12

Publish the Decision