

Decision for dispute CAC-UDRP-100837

Case number CAC-UDRP-100837

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Domain names milpro.com

Case administrator

Name Lada Válková (Case admin)

Complainant

Organization ZODIAC MILPRO INTERNATIONAL

Complainant representative

Organization Nameshield (Anne Morin)

Respondent

Organization Annapolis Inflatables

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant owns the following trade marks:

International trade mark No. 1079435 - MILPRO registered 7 April 2011
International trademark No. 1134350 - ZODIAC MILPRO registered 17 August 2012
International trademark No. 1134349 - ZODIAC MILPRO registered 17 August 2012
International trademark No. 1134348 - ZODIAC MILPRO registered 17 August 2012
International trademark No. 1126497 - ZODIAC MILPRO registered 13 July 2012.

FACTUAL BACKGROUND

The Complainant, Zodiak Milpro International is a manufacturer of inflatable boats. In 1990 it set up Milpro to focus on military and professional customers.

The Complainant owns the following trade marks:

-- International trade mark No. 1079435 - MILPRO registered 7 April 2011

- International trademark No. 1134350 - ZODIAC MILPRO registered 17 August 2012
- International trademark No. 1134349 - ZODIAC MILPRO registered 17 August 2012
- International trademark No. 1134348 - ZODIAC MILPRO registered 17 August 2012
- International trademark No. 1126497 - ZODIAC MILPRO registered 13 July 2012.

The Complainant owns a number of domain names that incorporate the name MILPRO including milpro.fr, zodiacmilpro.us and zodiacmilprostore.com.

The disputed domain name, milpro.com was registered to the Respondent on 15 March 2014.

On 28 March 2014 a cease and desist letter was sent to the Respondent regarding the milpro.com domain. On 29 March 2014 the Respondent replied. A further email exchange took place on 1 April 2014 and 2 April 2014 between the parties. The Respondent confirmed that it 'was not interested in turning over or selling the milpro.com domain name'.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant submits that:

1. The domain name is identical to the Complainant's trade mark MILPRO.
2. The Respondent has no rights or legitimate interest in the domain name and that:
 - a) the domain name is used to direct Internet users to the Respondent's website which has no information to show that the website is not an official website of the Complainant;
 - b) the Respondent displays web content that creates a likelihood of confusion with the Complainant;
 - c) the domain name suggests a direct relationship with the Complainant rather than to communicate that the Respondent is an inflatable boat store at which one can purchase the Complainant's products;
 - d) the Complainant has not authorised the Respondent to use the Complainant's trade mark MILPRO; and asserts that a dealer has no right to register a domain name consisting of the Complainant's trade mark.
3. The domain name was registered and is being used in bad faith and asserts that:
 - a) the domain name contains the Complainant's trade mark which gives rise to the inference that the Respondent has registered the domain name in order to prevent the Complainant from reflecting its mark in the corresponding domain name;
 - b) there is a prior relationship between the parties;
 - c) by mentioning the Complainant on some pages of the website, the Respondent creates a risk of confusion with the Complainant and its trade mark;
 - d) there is a substantial similarity between the website associated with the disputed domain name and the website associated with the right holder's domain name;
 - e) at the time of the Complaint the website associated with the domain name referred to the MILPRO brand and stated '(c) 2011 Milpro Boats. All Rights reserved' although the company Milpro Boats does not exist;
 - f) by using the domain name the Respondent is attempting to attract for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website.

RESPONDENT:

The Respondent submits that:

1. The domain name is neither identical nor confusingly similar to the protected mark and -
 - a) asserts that the Complainant has failed to meet the standard of proof required; and
 - b) disputes the Complainant's evidence of confusion.

2. It has rights and/or legitimate interest in the domain name:

- a) the Respondent uses the domain name in connection with a bona fide offering of goods or services;
- b) the domain name was registered before the Complainant's protected rights and provides evidence of Boyd Tomkies purchase of milpro.com on 28 March 2011;
- c) the Respondent uses the milpro.com to advertise 'its professional line of business and has done so since it became an authorised Zodiac dealer';
- d) the Respondent only sells Zodiac Milpro boats to the military and professional market and offers these for sale on the Milpro website and therefore meets the definition of 'bona fide' offering;
- e) the website has now been updated so that no confusion is present on the milpro.com site and that the relationship between the Respondent and the Complainant is clearly defined;
- f) the Respondent refutes the Complainant's argument that 'a retailer must not corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name'; and
- g) the Respondent asserts it meets all the requirements in Oki Data America, Inc. v. ASD, Inc. WIPO case No.D2001-0903.

3. The domain name has not been registered and used in bad faith:

- a) the milpro.com domain name was registered prior to the trade mark right;
- b) the Complaint has failed to meet the standard of proof required to show that the domain name has been registered and used in bad faith;
- c) the Complainant's complaints about the milpro.com website have been satisfied and the reference to 'Milpro Boats' has been removed;
- d) the website terms and conditions page explains the use of the trade marks as well as the relationship between the Respondent and the Complainant; and
- e) the Respondent states: 'Annexes 5.6,7 show improvements made to the website store that refute the arguments made by the Complainant'.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the 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 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 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

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements:

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

1. Identical or confusingly similar

The disputed domain name, milpro.com, is comprised of the word 'milpro' and the suffix .com. It is well established that the

generic top level suffix .com may be disregarded when considering whether the disputed domain name is confusingly similar to the trade mark in which the Complainant has rights.

The Respondent submits the Complainant has failed to meet the standard of proof that the domain name is identical or confusingly similar to the Complainant's mark MILPRO. The Respondent disputes the Complainant's evidence of confusion and provides Google search results for 'milpro' which has links to the Complainant, and other Zodiac dealers in the US.

Paragraph 4(a)(i) of the Policy requires the Complainant to prove that the domain name is identical or confusingly similar to the Complainant's mark. Ignoring the .com suffix, the remainder of the domain name is identical to the Complainant's trade mark MILPRO. Evidence of confusion submitted by the parties may be relevant to the assessment of bad faith under Paragraph 4(a)(iii) of the Policy.

The Respondent also presents evidence that Boyd Tomkies purchased the domain name on 28 March 2011, before the Complainant's registration of the MILPRO trade mark on 7 April 2011. Although this is raised under the Respondent's submissions on rights and legitimate interests for completeness it is also dealt with here.

Paragraph 4(a)(i) of the Policy does not require that the trade mark be registered prior to the domain name. When the trade mark was registered may be relevant to the assessment of bad faith under Paragraph 4(a)(iii). (See Digital Vision, Ltd v Advanced Chemill Systems (WIPO Case No D2001-0827).

The Complainant owns the registered trade mark MILPRO and thus satisfies the standard of proof required to show it has rights in the trade mark. The Panel finds that the disputed domain name, milpro.com is identical to the Complainant's MILPRO trade mark.

Thus, the Complainant has satisfied the requirements of Paragraph 4(a)(i) of the Policy.

2. No rights or legitimate interest

The second element which the Complainant must prove is that the Respondent has no rights or legitimate interests in respect of the domain name (Paragraph 4(a)(ii) of the Policy).

The Respondent acknowledges that it uses the domain name to sell Zodiac Milpro boats and says it has done so since it became an authorised Zodiac dealer. The Respondent argues that this is a 'bona fide' offering of goods and services and claims it meets all the requirements of *Oki Data America, Inc v. ASD, Inc.* WIPO case No.D2001-0903.

The *Oki Data* case established that a reseller or distributor can have rights or legitimate interests in a domain name that contains a trade mark provided certain minimum requirements are met. In summary, to be a 'bona fide' offering:

- a) the Respondent must actually be offering the goods and services at issue;
- b) the Respondent must only use the site to sell the trade marked goods;
- c) the site must accurately disclose the registrant's relationship with the trade mark; owner and must not falsely suggest it is trade mark owner or the website is the official website; and
- d) the Respondent must not try and corner the market in all domains thus depriving the trade mark owner of reflecting their own mark in the domain name.

The Respondent can meet some of these minimum requirements, but not all. It has not established that the site accurately discloses the registrant's relationship with the trade mark owner and that it must not falsely suggest that it is the trade mark owner's official website. By its own admission the Respondent has had to change the website to accurately disclose the relationship with the Complainant.

Before the Complaint was filed the site suggested it was owned by Milpro Boats. Although this reference has now been removed it still appears in Google search results, as appears from Annex 2 of the Response submitted by the Respondent.

Originally there was no suggestion that the site was not an official website of the Complainant. The Respondent states it has

made improvements to the website in response Complainant's complaints and states the 'website has been updated such that no confusion is present on the milpro.com site'. This in itself is tacit acknowledgment by the Respondent that there was a likelihood of confusion.

The Complainant has not authorised the Respondent to use the MILPRO trade mark. As stated in *Motorola, Inc v NewGate Internet, Inc* (WIPO Case No. D2000-0079) 'the right to resell products does not create the right to use a mark more extensively than required to advertise and sell the product. The use of a mark as a domain name clearly goes further than what is required merely to resell products'.

The Panel finds on the balance of evidence presented that the Respondent has no rights or legitimate interest in the domain name. Thus the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

3. Registered and used in bad faith

To satisfy the third element of Paragraph 4(a) of the Policy the Complainant must show both bad faith registration and use. Paragraph 4(c) of the Policy sets out how the Respondent might show it had rights or legitimate interests in the domain name.

The domain name reflects the Complainant's trade mark entirely. The Respondent states that the domain name was registered before the MILPRO trade mark and has submitted evidence of its purchase by Boyd Tomkies on 28 March 2011.

Although Boyd Tomkies' purchase of the domain name was prior to the Complainant's registration of the MILPRO trade mark on 7 April 2011, the Respondent's acquisition of the domain name was not until 15 March 2014. The Respondent does not detail its relationship with Boyd Tomkies nor provide information of his use of the domain name.

Generally, when a domain name is registered before the trade mark the domain name registration is not in bad faith because the registrant could not have contemplated the Complainant's non-existent right. This is not the situation in this case as there is a prior relationship between the parties and the domain name was registered to the Respondent on 15 March 2014, after the Complainant's registration of the MILPRO trade mark on 7 April 2011.

There is a substantial similarity between the Complainant's website and the website associated with the .milpro.com domain name. The content of the website creates a risk of confusion with the Complainant. The Respondent's acknowledgement that it has updated the website to remove the reference to Milpro Boats and to disclose the relationship with the Complainant does not remedy a bad faith registration and use.

The Panel finds that by using the domain name the Respondent is attempting to attract for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the affiliation or endorsement of the Respondent's website.

The Panel finds that the Complainant has established bad faith registration and use of the domain name.

Thus the Panel finds that the requirements of Paragraph 4(a)(iii) have been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. MILPRO.COM: Transferred

PANELLISTS

Name
Mrs Veronica Bailey

DATE OF PANEL DECISION 2014-08-28

Publish the Decision
