Decision for dispute CAC-UDRP-103223

Case number	CAC-UDRP-103223
Time of filing	2020-08-26 10:02:10
Domain names	mypebbleflex.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Landscape Structures Inc.

Complainant representative

Organization	Kelly, Holt & Christenson, PLLC

Respondent

Organization	Bay State Builders

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following trademark registration covering the jurisdiction of the Registrar:

US trademark PEBBLEFLEX registered on 13th January 2004, duly renewed, and covering goods in international class 17 (US classes 001, 005, 012, 013, 035, 050).

The Complainant additionally owns the domain name <pebbleflex.com> which resolves to the Complainant's corporate website.

FACTUAL BACKGROUND

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

Paragraph 11(a) of the Rules provides that, subject to the authority of the Panel, the language of the proceedings shall be the same as the language of the Registration Agreement unless the Parties have otherwise agreed to proceeding in a different language. To the best of the Complainant’s knowledge, the language of the Registration Agreement is English, a copy of which is provided as annex to this Complaint. The Complaint has therefore been submitted in English.

A. The domain name(s) is(are) identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
(Policy, Paragraph 4(a)(i); Rules, Paragraphs 3(b)(viii), (b)(ix)(1))

In accordance with Rules, Paragraph 3(b)(viii), the trademark on which this Complaint is based on is US Trademark Registration No. 2804631, PEBBLEFLEX, for “plastic in pellet form for general industrial use”. The application for this trademark was filed March 13, 2003 and has a date of first use in commerce May 1, 2002. Attached as Annex F is a copy of the registration certificates for the relevant mark. Also attached in Annex F is the Assignment record showing that Landscape Structures Inc. is the present owner of the PEBBLEFLEX trademark.
In accordance with Rules, Paragraph 3(b)(ix)(1), the domain name <mypebbleflex.com> is nearly identical and confusingly similar to the trademark PEBBLEFLEX in which the Complainant has rights. The domain name wholly incorporates the trademark without modification which supports a conclusion of being confusingly similar. (see Six Continent Hotels, Inc. v. The Omnicorp, WIPO Case No. 2005–1249 and Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903). The only difference is the minor inclusion of a possessive, non-distinct word MY.
Inclusion of the possessive MY does not modify the use of PEBBLEFLEX in any distinctive way that would reduce consumer confusion. The inclusion of the MY does not lower the confusion element but rather increases it by implying a relationship between the domain holder and the trademark owner that does not exist.
Also, the addition a TLD to a mark may not negate any confusing similarity between a disputed domain name and mark per paragraph 4(a)(i). See Microsoft Corporation v. Thong Tran Thanh, FA 1653187 (Forum Jan. 21, 2016) (determining that confusing similarity exists where [a disputed domain name] contains Complainant’s entire mark and differs only by the addition of a generic or descriptive phrase and top-level domain, the differences between the domain name and its contained trademark are insufficient to differentiate one from the other for the purposes of the Policy).

B. The Respondent has no rights or legitimate interests in respect of the domain name(s);
(Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2))
Complainant need only to make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), the burden then shifts to Respondent to show it does have rights or legitimate interests. See Advanced International Marketing Corporation v. AA-1 Corp, FA 780200 (FORUM Nov. 2, 2011); see also Neal & Massey Holdings Limited v. Gregory Ricks, FA 1549327.
First, Respondent is not commonly known by the disputed domain name. WHOIS information may be used to determine if a respondent is commonly known by the disputed domain name under Policy paragraph 4(c)(ii). See CheapCaribbean.com, Inc. v. Moniker Privacy Services, FA1411001589962 (Forum Jan. 1, 2015). The WHOIS information shows that “Bay State Builders” is the Domain Registrant. This is consistent with the phone number listed on MYPEBBLEFLEX.COM which when searched comes up as “Bay State Roof,” “Bay State Buyouts” and “Bay State Roof” on Facebook. Attached as Annex D is evidence of these other websites showing the common phone number going to the Bay State names and not a name incorporating PEBBLEFLEX.
Second, Respondent does not sell nor install PEBBLEFLEX branded surfacing products. Respondent sells a surfacing product provided from a competitor of the Complainant. It is well established that use of a disputed domain name to display competing goods and services is not considered a bona fide offering or legitimate noncommercial or fair use under Policy paragraph 4(c)(i) or (iii). See Ashley Furniture Industries, Inc. v. domain admin / private registrations aktien gesellschaft, FA1506001626253 (Forum July 29, 2015). Respondent’s surfacing installation services have no relationship to the PEBBLEFLEX mark because Respondent does not install PEBBLEFLEX branded surfacing products. Respondent only installs goods that compete with PEBBLEFLEX branded goods, thus they have no legitimate interests in the disputed domain name due to a bona fide offering of goods. This also means that their interest is commercial and thus not fair use.
Third, it appears Respondent is using the well-established PEBBLEFLEX mark to draw attention to their surfacing installation services. By using the PEBBLEFLEX name on their site and in their domain, the Respondents are confusing customers into believing they are purchasing PEBBLEFLEX branded products, when no such relationship exists with the Complainant. The use of a disputed domain name to divert Internet users to a Respondent’s site, and confuse them into believing that some sort of affiliation with a complainant exists, does not constitute a bona fide offering of goods or services or legitimate noncommercial or fair use under Policy paragraph 4(c)(i) or (iii). See Ripple Labs Inc. v. NGYEN NGOC PHUONG THAO, FA 1741737 (Forum Aug.21, 2017) (“Respondent uses the [disputed] domain name to divert Internet users to Respondent’s

website… confusing them into believing that some sort of affiliation exists between it and Complainant… [which] is neither a bona fide offering of goods or services under Policy paragraph 4(c)(i) nor a legitimate noncommercial or fair use under Policy paragraph 4(c)(iii)"); see also Summit Group, LLC v. LSO, Ltd., FA 758981 (Forum Sept. 14, 2006) (finding that the respondent's use of the complainant's LIFESTYLE LOUNGE mark to redirect Internet users to respondent's own website for commercial gain does not constitute either a bona fide offering of goods or services pursuant to Policy paragraph 4(c)(i), or a legitimate noncommercial or fair use pursuant to Policy paragraph 4(c)(iii)).
Lastly, Complainant has not authorized Respondent to use the PEBBLEFLEX mark. To ensure quality installation and maintain good faith in the brand, Complainant regulates the distributors and installers of the PEBBLEFLEX surfacing products and Respondent is not affiliated with any of these distributors or installers. Therefore, as best can be gleaned, the Respondent is using the <mypebbleflex.com> domain to false advertise the sale of PEBBLEFLEX products but instead providing a counterfeit or competing product during their installation.

C. The domain name was registered and is being used in bad faith.
(Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3))

In accordance with Rules, Paragraph 3(b)(ix)(3), the domain name should be considered as having been registered and used in bad faith by the Respondent for the reasons presented below.

Complainant or its assignors, United Surface Technology LLC and Pebble Soft Technologies, LLC, have owned the PEBBLEFLEX trademark since 2002 in common law and 2004 by United States Federal Registration. PEBBLEFLEX is one of very few products in the industry of playground surfacing. Complainant has invested significant amounts of money and resources in marketing and advertising the PEBBLESOFT brand of products, including over a dozen unique catalogues. Complainant also highly regulates the distributors and installers of their brands to ensure high quality installations and good faith in the PEBBLESOFT name. Complainant has incurred losses of sales in favor of making decisions that would ensure a high-quality installation. Undoubtedly, because of the very few brand alternatives any producer, distributor or installer of outdoor surfacing products knew of the PEBBLESOFT brand at domain registration.
Respondent had actual knowledge of Complainant's PEBBLEFLEX mark when registering the <mypebbleflex.com> domain name based on the Respondent's use of the disputed domain to divert Internet traffic to competing websites. Actual knowledge of the complainant's mark can be shown by a disputed domain name that uses complainant's well-known mark and redirects Internet traffic to competing websites. See iFinex Inc. v. xu shuaiwei, FA 1760249 (Forum Jan. 1, 2018) ("Respondent's prior knowledge is evident from the notoriety of Complainant's BITFINEX trademark as well as from Respondent's use of its trademark laden domain name to direct internet traffic to a website which is a direct competitor of Complainant"). Respondent had actual knowledge of Complainant's rights at the time the disputed domain name was registered since the PEBBLEFLEX mark has been well known for at least 6 years, the Respondent appropriated the entirety of the mark, and the website diverts Internet traffic to competing websites, including direct competitors of the Complainant or false advertises/counterfeits the sale of Complainant's products.
Further, due to the resources invested in marketing and the limited alternatives in the outdoor/playground surfacing industry, Respondent must have known of the existence of the PEBBLESOFT brand when registering the domain name. Respondent has not had a relationship with Complainant and does not sell nor install any of Complainant's goods that are sold under the PEBBLEFLEX mark. Respondent, in fact, sells products that compete with Complainant's PEBBLEFLEX brand.

Also, Respondent's website, attached as Annex C, includes reference to Jerry Saluti, a former employee of Landscape Structures Inc. Complainant has no knowledge of Jerry Saluti stating the quoted language on the website. Complainant submits that Jerry's employment was publicly available and the quote could have been falsely attributed to him by anyone trying to use Complainant's good faith. Complainant submits this not to allege Respondent as making false quote attributions, but rather that Respondent, at least when the quote was added to the website, had actual knowledge of the PEBBLEFLEX mark and brand of products.

The finding of bad faith is also supported by WIPO DECISION Case No. D2018-1299, Jones Lang LaSalle IP, Inc. v. Rob Monster, DigitalTown, Inc., ("In view of the fact that the disputed domain names fully includes the JONES LANG LASALLE mark, it is easy to infer that Respondent was likely aware of Complainant's rights in the JONES LANG LASALLE mark when Respondent registered the disputed domain name. In addition, given that Respondent registered and has used the disputed

domain name to redirect web traffic to a website at 'www.digitaltown.com' that promotes the services of Respondent's company, it appears more likely than not that Respondent registered the disputed domain name for Respondent's profit. As Respondent has chosen not to contest the matter, it appears unlikely that Respondent had any legitimate purpose for registering and using the disputed domain name either at the time of registration or going forward.") Similar to the facts in Jones Lang LaSalle IP, the present Respondent has fully incorporated the registered mark and has ignored Complainant's cease and desist letter received by Respondent via certified mail on June 19, 2020.
Additionally, Respondent's use of the Complainant's mark, in its entirety on competitive goods as Complainant, misleads consumers into believing there is a relationship between Respondent and Complainant. Bad faith under Policy paragraph 4(b)(iv) can be found where a respondent uses a confusingly similar domain name to falsely indicate an association with a complainant. See AOL LLC v. iTech Ent, LLC, FA 726227 (Forum July 21, 2006) (finding that the respondent took advantage of the confusing similarity between the <theotheraol.com> and <theotheraol.net> domain names and the complainant's AOL mark, which indicates bad faith registration and use pursuant to Policy paragraph 4(b)(iv)). There is no doubt that Respondent sells products that fall under the PEBBLEFLEX goods description "plastic in pellet form for general industrial use." Complainant also submits they have no relationship with Respondent and do not offer PEBBLEFLEX branded products through Respondent. Accordingly, Respondents use of the PEBBLEFLEX is improper and misleads consumers.

Further, use of a disputed domain name to divert Internet users to a site that offers competing and counterfeit products can evidence bad faith registration and use per Policy paragraph 4(b)(iii) and 4(b)(iv). See H-D U.S.A., LLC v. Linchunming / linchunming, FA 1589214 (Forum Dec. 22, 2014) ("As mentioned above, Respondent uses the domain name to promote counterfeit goods like those offered by Complainant. Doing so disrupts Complainant's business and demonstrates Respondent's bad faith under Policy paragraph 4(b)(iii)"). Here, Respondent seeks to capitalize on consumer recognition of the PEBBLEFLEX mark and is using the disputed domain name to sell apparent counterfeit products or at least products competitive with PEBBLEFLEX branded products.

Respondent's whole incorporation of Complainant's mark, intention to compete with Complainant or to seek commercial gain, along with the facts presented by the submitted evidence (i.e., screenshots of Respondent's website displaying the PEBBLEFLEX branded products for sale) supports a claim that Respondent registered and uses the disputed domain name in bad faith pursuant to Policy paragraph 4(b)(iii) and 4(b)(iv).

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

Notwithstanding the fact that no Response has been filed, the Panel shall consider the issues present in the case based on

the statements and documents submitted by the Complainant.

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following elements:

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

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

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

A. Identical or Confusingly Similar

The Complainant must establish that it has a trademark or service mark and that the disputed domain name is identical or confusingly similar to that trademark or service mark for the Complainant to succeed.

The Complainant, Landscape Structures Inc., is a manufacturer of playgrounds and play areas active since 1966. The Complainant has provided evidence of ownership of the following registration for the mark "PEBBLEFLEX":

US trademark PEBBLEFLEX registered on 13th January 2004, duly renewed, and covering goods in international class 17 (US classes 001, 005, 012, 013, 035, 050).

As regards the question of identity or confusing similarity for the purpose of the Policy, it requires a comparison of the disputed domain name with the trademarks in which the Complainant holds rights. According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), "this test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name".

Also, according to section 1.7 of the WIPO Overview 3.0, "in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing".

The disputed domain name wholly incorporates the Complainant's PEBBLEFLEX trademark in addition to the word "my". This addition does not prevent a finding of confusing similarity with the Complainant's trademark. The fact that a domain name wholly incorporates a complainant's trademark is sufficient to establish identity or confusing similarity for the purpose of the Policy, despite the addition of other words to such marks.

It is well accepted by UDRP panels that a generic Top-Level Domain ("gTLD"), such as ".com", is typically ignored when assessing whether a domain name is identical or confusing similar to a trademark.

This Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademark and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, any of the following circumstances, if found by the Panel, may demonstrate the respondent's rights or legitimate interests in the disputed domain name:

(i) before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent has been commonly known by the disputed domain name, even if it has acquired no trademark or service

mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The consensus view of UDRP panels on the burden of proof under paragraph 4(a)(ii) of the Policy is summarized in section 2.1 of the WIPO Overview 3.0, which states: "[…] where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

Although the Respondent has been using the disputed domain name in connection with an active website for numerous years, the evidence on record does not show that the Respondent was commonly known, as an individual or an organization, by the disputed domain name.

Past Panels have developed case law on the grounds of which the respondents may be granted rights of legitimate interests in a disputed domain name even where the respondents sold third-party trademarked goods. See Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903. However, the Panel discards such reasoning as nothing from the record of the case shows that the Respondent was in fact an authorized distributor of the Complainant.

On the contrary, the record shows that the Respondent uses the Complainant's trademark in the disputed domain name and on the content of the website associated to that domain name without authorization from the Complainant.

The Panel concludes that the Respondent has no right or legitimate interests in the disputed domain name and therefore finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registration and Use in Bad faith

For the purpose of Paragraph 4(a) (iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of the domain names in bad faith:

(i) circumstances indicating that the holder has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of the holders documented out-of-pocket costs directly related to the domain name; or

(ii) the holder has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the holder has engaged in a pattern of such conduct; or

(iii) the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on the holder's website or location.

The Panel finds the third and fourth elements of Paragraph 4(b) of the Policy applicable in the present case. The evidence on the record shows that the Respondent was certainly aware of the existence of the Complainant and of the rights of the Complainant, and that the Respondent, by registering and using the disputed domain name has intentionally attracted internet users by creating a likelihood of confusion with the Complainant's trademark.

The record shows that the Respondent is using the disputed domain name in connection with a website offering competing

products, presented under the Complainant's trademark, which in fact appear not to be the Complainant's products. The Respondent is using the disputed domain name to promote counterfeit goods. Doing so disrupts the Complainant's business and demonstrates the Respondent's bad faith under Paragraph 4(b)(iii) of the Policy. The Panel sides with the Complainant in that the Respondent seeks to capitalize on consumer recognition of the PEBBLEFLEX mark.

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

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MYPEBBLEFLEX.COM**: Transferred

PANELLISTS

Name	**Arthur Fouré**

DATE OF PANEL DECISION 2020-09-19

Publish the Decision