

Resolution Institute

ADMINISTRATIVE PANEL DECISION

Wolf & Moon Products, Inc. v M. J. Pillinger and R. B. Turner

Case No. auDRP 17-01

1. The Parties

Complainant: Wolf & Moon Products, Inc, 2045 Burton Drive, Cambria, CA 93428, United States of America.

The authorised representative of the Complainant is Brooke Branning of 2501 Newport Ave, Cambria, CA 93402, United States of America.

Respondents: M. J. Pillinger and R. B. Turner.

The contact person for the Respondents is Michael Pillinger, 6 Cressbrook Ct, Meadowbank, Queensland 4131. Email: redemp55@hotmail.com

2. The Domain Name and Registrar

The disputed domain name <bugoffscreens.com.au> is registered with Crazy Domains.

3. Procedural History

The Complaint was filed with the Resolution Institute dispute resolution centre (Institute) on 18 January 2017. On 24 January 2017, the Institute transmitted by email to Crazy Domains a request for registrar verification in connection with the domain name at issue.

On 24 January 2017, Crazy Domains transmitted by email to the Institute its verification response confirming that the Respondents are listed as the registrants and providing contact details for the administrative, billing and technical contact.

In response to a notification by the Institute that the original, earlier, Complaint was administratively deficient, the Complainant filed a new Complaint on 18 January 2017. The Institute verified that this new Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (Policy), the Rules for .au Dispute Resolution Policy (Rules) and the Institute's Supplemental Rules for .au Dispute Resolution Policy (Supplemental Rules).

In accordance with the Rules, the Institute formally notified the Respondents of the Complaint by email on 29 January 2017 and advised that the proceeding commencement date is 30 January 2017. In accordance with the Rules, paragraph 5(a), the due date for response was 19 February 2017.

There were a series of informal email communications between the parties. On 20 February 2107, the Respondents sent an email to the Complainant, copied to the Institute. The email attached a letter addressed 'To Whom It May Concern', which is referred to below.

On 24 February 2017, the Institute appointed Michael JF Sweeney as the sole panelist (Panel) in this matter.

The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Institute to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is an incorporated entity under the laws of the State of California, USA. The Complainant states that it is in the business of sale and supply of bug off insect screen doors.

The Respondents are the registrants of the domain name <bugoffscreens.com.au>. They operate as sole traders in a partnership with a registered Australian Business Number (ABN).

5. Parties' Contentions

A. Complainant

The Complainant contends:

- (a) It is entitled to the registered trade mark <Bug Off>.
- (b) It is the owner of the domain name <bugoffscreen.com>.
- (c) Its business is the sale and supply of insect screens, predominately in the United States of America, but also in Australia.
- (d) It has been selling Bug Off Screen Doors in stores, by catalogue and on the internet since 1992.
- (e) The Respondents' domain name incorporates the Complainant's trade mark in the domain name.
- (f) The Respondents' domain name is seen all over the world both through the domain name and through a presence on Facebook
- (g) The Respondents' domain name is confusingly similar to the Complainant's trade mark.
- (h) The Respondents have no rights or legitimate interests in respect of the domain name and have registered it or subsequently used it in bad faith.
- (i) The Respondents continue to use the domain name.
- (j) The remedy it seeks and is entitled to is the transfer to it of the Respondent's domain name.

B. Respondents

The Respondents did not formally reply to the Complainant's contentions by complying with the procedures, including as set out in paragraph 5 of the Rules.

The Respondents did engage in several informal exchanges including by emails on or about 31 January 2017 and on or about 20 February 2107, the last email attaching a letter addressed 'To Whom It May Concern'.

In the email and letter, the Respondents contend that they intend to, or are in the process of, taking steps to complete a business name change so that it no longer reflects anything with the Bug Off name to avoid customer confusion as asserted by the Complainant. The Respondents assert in their letter that this process has been completed.

6. Discussion and Findings

Pursuant to paragraph 10 of the Rules, the Panel is required to conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and Rules.

Given that it remains in issue whether the Respondents continue to offend in the manner described in the Complainant's complaint, with the Respondents saying that they have completed the process of removing references to the trade mark, but the Complainant saying that Respondents continue to offend, it is necessary for the Panel to proceed to a determination of the Complaint.

The Complainant is required, pursuant to the Rules, paragraph 3(b):

sub paragraph (viii), to specify certain matters, relevantly, the trade mark on which the Complaint is based and the goods or services with which the mark is used;

sub paragraph (ix), to describe (in accordance with the Policy) the grounds on which the Complaint is made;

sub paragraph (x), to specify (in accordance with the Policy) the remedies sought.

The Panel is satisfied on the material before it that the Complainant has demonstrated that it is the current owner of the trade mark <Bug Off>. The Complainant has provided copies of relevant documentation showing that the Complainant is the holder of the registered trade mark <Bug Off>, that it is registered with the Patent and Trademark Office USA, that it was transferred to the Complainant on 30 January 2008 and remains current until 2022.

There being no evidence to the contrary, the Panel is further satisfied that the trade mark is used in connection with the Complainant's business of the sale and supply of insect screen doors, predominately in the United States of America, but also in Australia.

The Panel is also satisfied that the Complainant has complied with the Rules above in stating the grounds on which the Complaint is made and the remedy sought.

Paragraph 4(a) of the Policy requires a complainant to prove:

- (i) the respondent's domain name is identical or confusingly similar to a name, trade mark or service mark in which the complainant has rights; and

- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the respondent's domain name has been registered or subsequently used in bad faith.

The Panel's discussion and findings in respect of the matters required to be proved under paragraph 4(a) are as follows.

A. Identical or Confusingly Similar

The test for establishing whether a domain name is confusingly similar to a trade mark necessarily involves a comparison between the trade mark and the domain name itself to determine, objectively, the likelihood of internet user confusion.

In the present case, the complained of domain name <bugoffscreens.com.au> includes the same words, bug off, as contained in the Complainant's trade mark <Bug Off>. Consistent with decisions made in respect of this question in similar cases¹, in the Panel's opinion, the addition of a descriptive term in the domain name, 'screens', is insufficient to avoid a likelihood of confusion on the part of an internet user. In the absence of any evidence to the contrary, a straightforward comparison of the trade mark with the word string in the domain name, on an objective assessment, is conducive to causing confusion.

For this reason, the Panel finds that the domain name is confusingly similar to the Complainant's trade mark.

B. Rights or Legitimate Interests

The Complainant has asserted that the Respondents have no rights or legitimate interests in the domain name.

For the reasons stated above, the Complainant has demonstrated that it is the registered owner of the trade mark and that it uses the trade mark in the pursuit of stated business interests both in the USA and in Australia. The Panel finds that, in respect of the Complainant's business interests in Australia, the pursuit of these interests in Australia is associated with the use of its trade mark.

The Panel finds that the Complainant has proved that the Respondents are the registered owners of the domain name <bugoffscreens.com.au> by providing proof of registration from the registrar, Crazy Domains.

The Respondents did not lodge a formal response against the Complaint with the Provider, the Institute. Whilst there were informal email communications as referred to earlier, the Respondents did not contest the allegation of the Complainant that they have no rights or legitimate interests in the domain name.

The Respondents have not asserted by way of defence or at all that they have used the trade mark contained in their domain name with the permission of the Complainant.

¹ The Panel must decide the issues for itself in any case on the evidence before it. Previous decisions made under the .auDA and under the Uniform Domain Name Dispute Resolution Policy have led to a body of decisions which, whilst in no way binding, demonstrate a broad consensus view on questions, such as the present, that regularly arise in domain name dispute resolution.

Moreover, the Respondents, in their email on or about 30 January 2017, stated that they had taken steps or were in the process of taking steps which included deactivating its website and ceasing the use of the domain name <bugoffscreens.com.au>. Further the letter addressed 'To Whom It May Concern' also advised that the Respondents had changed its business name so that it no longer reflects anything to do with the Bug Off trade mark.

It is not common ground that all these steps have been taken or completed and there is insufficient evidence before the Panel to make a conclusive finding. However, it is open to the Panel on this evidence to draw the inference that the Respondents do not have rights or legitimate interests in respect of the domain name, especially where they have not lodged a response by way of defence in accordance with the Policy and Rules.

For these reasons, the Panel finds that the Respondents do not have rights or legitimate interests in the domain name.

C. Registered or Subsequently Used in Bad Faith

Under paragraph 4(b)(iv) of the Policy, it is sufficient evidence of a domain name being registered or subsequently used in bad faith if the Panel finds the Respondents have used the domain name to intentionally attract for commercial gain internet users by creating a likelihood for confusion with the Complainant's trade mark.

The Complaint is that the Respondents registered and used the domain name with the intention of using the Complainant's trade mark to sell their screen door product because the Complainant's brand is a respected and long standing one used for selling Bug Off Screen Doors on the internet and elsewhere. The Respondent's competing product is called Bug Off Retractable Insect Screens.

As found above, the relationship between the trade mark and the Respondents' domain name is clear and likely to cause confusion to internet users. When coupled with use in circumstances where the product being promoted and sold is similar and where the Respondents have not sought to refute the allegation by lodging a response under the Policy and Rules, a reasonable inference may be drawn that the registration and subsequent use of the domain name was made in bad faith, with the intent of attempting to attract commercial gain.

For these reasons, the Panel finds that the domain name was registered or subsequently used in bad faith.

7. Decision

For the foregoing reasons, in accordance with paragraph 4 (i) of the Policy and paragraph 15 of the Rules, the Panel orders that the domain name <bugoffscreens.com.au> be transferred to the Complainant.

Signed: _____


Michael JF Sweeney
Sole Panelist

7 March 2017