

Marvel Manufacturing Co. v. Koba Internet Sales LP, 87 USPQ2D 1276 (W.I.P.O. 2008)

**Marvel Manufacturing Co. v. Koba Internet Sales LP**

**World Intellectual Property Organization**  
**87 USPQ2D 1276**  
**No. D2008-0265**

**Decided May 5, 2008**

**Headnotes**

**TRADEMARKS AND UNFAIR TRADE PRACTICES**

**[1] Infringement; conflicts between marks — Likelihood of confusion — Particular marks — Confusion likely (§335.0304.03)**

**Infringement; conflicts between marks — Tests generally (§335.06)**

Respondent's disputed Internet domain name "marvelsawparts.com" is confusingly similar to complainant's "Marvel" trademarks for metal cutting machines and related goods, since generic top-level domain name ".com" is ignored in assessing confusing similarity, and since addition of generic words "saw parts" to "Marvel" mark is insufficient to confer on domain name distinctiveness required to avoid confusion among Internet users.

**[2] Acquisition, assignment, and maintenance of marks — Acquisition through use — In general (§305.0501)**

**Infringement; conflicts between marks — Defenses — Fair use (§335.1003)**

Respondent has established rights and legitimate interests in disputed Internet domain name "marvelsawparts.com," which incorporates complainant's "Marvel" trademark for metal cutting machines and related goods, since respondent's use of domain name predates notice of present dispute, since respondent is actually offering for sale goods at issue, namely, replacement wear parts for complainant's band saws and other machines, since there is no evidence that respondent offers goods other than such wear parts, or that respondent's parts are inferior, lacking in quality, or not suited for their intended use, since respondent's site offers only "trademarked goods," even though "Marvel" mark may not be affixed to part or its container, in that respondent's site uses mark to identify brand and model for which each part is intended, since site carries prominent disclaimer accurately informing visitors that respondent independently offers aftermarket replacement parts for "Marvel"-brand saws only, since there is no evidence that respondent has intended or attempted to "corner the

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market" so as to prevent complainant from using "Marvel" mark in domain names of its own, and since it is not evident from record how respondent's domain name, without using term "Marvel," could adequately describe product offerings suited only for use with "Marvel"-brand saws.

### Case History and Disposition

Administrative proceeding pursuant to Uniform Domain Name Dispute Resolution Policy, in which complainant Marvel Manufacturing Co. seeks transfer of disputed Internet domain name "marvelsawparts.com" from respondent Koba Internet Sales LP to complainant. Transfer denied.

### Attorneys:

Davis & Kuelthau, Milwaukee, Wis., for complainant.

Sutherland Asbill & Brennan, Washington, D.C., for respondent.

### Opinion Text

#### Opinion By:

Michaelson, panelist.

#### 1. The Parties

The Complainant is Marvel Manufacturing Company Inc., Oshkosh, Wisconsin, United

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States of America, represented by Davis & Kuelthau s.c., United States of America.

The Respondent is Koba Internet Sales, LP, Texas, United States of America, represented by Sutherland Asbill & Brennan, LLP, United States of America.

#### 2. The Disputed Domain Name and the Registrar

The disputed domain name <marvelsawparts.com> is registered with Network Solutions, LLC (the "Registrar").

#### 3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the "Policy"), which was adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on August 26, 1999, and approved on October 24, 1999, and in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") as approved on October 24, 1999, and the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999, (the "Supplemental Rules").

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The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") in both email and hard-copy form on February 21, 2008 with the latter being accompanied by Annexes 1-9. In response to a Notice of Deficiency issued by the Center on March 3, 2008, the Complainant filed an Amended Complaint by email on March 3, 2008 and in hard-copy form on March 11, 2008. For simplicity, the term "Complaint" will hereafter refer to the Complaint, as amended, unless the specific context of the discussion dictates otherwise.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a single-member panel.

After receiving the original Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on February 22, 2008, the Center requested confirmation from the Registrar as to whether the Registrar received a copy of the Complaint from the Complainant and to confirm contact and registrant information set forth in the Complaint relative to the disputed domain name. The Center also requested the Registrar to specify for the domain name: (a) whether the Policy applies to that name, (b) whether the registrant has submitted, in its registration agreement, to the jurisdiction at the location of the principal office of the registrar for court adjudication of disputes concerning or arising from the use of that name, (c) the language of the registration agreement, and (d) whether that name will remain "locked" during the proceeding.

Subsequently, on February 22, 2008, the Registrar provided its response to the Center through which it specified name and contact information pertinent to the disputed domain name to the extent present in its WhoIs database and confirmed that the Respondent is listed as the registrant for that name. The response also stated that: (a) Network Solutions, LLC is the registrar, (b) the Respondent submitted to the jurisdiction of the courts at the location of the principal office of the Registrar, (c) the registration agreement is in English, and (d) the name will remain locked during the proceeding.

The Center verified that the Complaint satisfied the formal requirements of the Policy, the Rules and the Supplemental Rules.

On March 5, 2008, the Center formally notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to the Respondent, together with all its exhibits, by courier and email, and, without those exhibits, by facsimile. The Complaint and its accompanying documents, and all subsequent communications associated therewith, were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on March 5, 2008, under paragraph 4(c) of the Rules, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all the correspondence, including that between the Center and the Registrar, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on March 25, 2008, to file its Response with the Center and the Complainant.

Subsequently, on March 24, 2008, the Respondent timely filed its Response, together with Exhibits 1-35, by email with the Center and on March 26, 2008 by hard-copy, the latter also containing these same Annexes.

Pursuant to the Rules and Supplemental Rules, by an email letter dated April 1, 2008, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as a Sole Panelist for this dispute. Subsequently, on that same day, Mr. Michaelson accepted and returned, by e-mail to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Panel finds that it was properly constituted. The Center, through an email letter dated April 3, 2008, notified the Parties of the appointment of Mr. Michaelson as Sole Panelist.

Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before April 17, 2008. However, owing to unexpected time conflicts experienced by the Panel which constituted unforeseen circumstances, the Center, at the Panel's request, extended the due date to May 5, 2008.

This dispute concerns one domain name, specifically <marvelsawparts.com>.

The language of this proceeding is English.

#### *4. Factual Background*

As indicated in the WhoIs registration records provided in Annex 1 to the Complaint, the Respondent registered the disputed domain name on March 10, 2003.

##### *A. The Complainant's MARVEL Marks*

The Complainant owns two US trademark registrations for the term MARVEL, either in block letters or stylized, the latter being in conjunction with other stylized letters. The Complainant has provided, in Annexes 3 and 4 to the Complaint, a hard-copy printout of its registration certificates as issued by the United States Patent and Trademark Office. Pertinent details of these registrations are as follows:

1. MARVEL AB (stylized) United States registration 1,094,999; registered: July 4, 1978  
renewed: August 27, 1998

This mark is currently registered for use in connection with "metal cutting machines, namely band sawing machines; hack sawing machines; rod cutting machines; blades for band and hack sawing machines; band saw blade coil stock; hole saws; arbors, extensions and taper adaptors; and work supporting, conveying and feeding tables and discharge tables for said machines" in International class 7, and "hand hack saws and blades therefore" in

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International class 8. The registration certificate states that both first use and first use in commerce of this mark when used in conjunction with the goods in class 7 commenced as of August 8, 1975 and with the goods in class 8 commenced as of March 8, 1976.

2. MARVEL (block letters) United States registration 207,685; registered: January 5, 1926 latest renewal: June 28, 2006

This mark is currently registered for use in connection with "hack sawing machines, band sawing machines, hack saw blades, and band-saw blades" in International class 7. The registration certificate states that both first use and first use in commerce of this mark, when used in conjunction with these goods, commenced as of December 31, 1905.

### *B. The Complainant*

The Complainant has been designing and manufacturing metal cutting saws and similar machine tools for nearly a century, including its MARVEL-branded band saws, including: vertical tilting band saws, horizontal band saws, double column band saws, vertical contour band saws, block and plate band saws; carbide circular saws and hydraulic ironworkers and metalworking equipment. The Complainant sells these tools, as well as replacement parts and equipment there for, worldwide through its own distribution network.

Apparently, the Complainant does not offer or sell replacement wear parts, including blades, for its saws, through the Internet and particularly through its own website at "www.sawing.com".

### *C. The Respondent*

The Respondent registered the disputed domain name, <marvelsawparts.com>, for use in implementing its website through which the

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Respondent provides Internet customers with aftermarket replacement wear parts for the Complainant's MARVEL-branded band saws. The Respondent specifically selected that name for, what it believes to have been, the descriptive characteristics of the name which are readily apparent to anyone in the sawing industry. The Respondent does not sell or market any band saws, including those manufactured by the Complainant. The Respondent's sole business, conducted through its website, is providing replacement wear parts for those saws – parts which the Complainant does not itself sell on-line.

The home page on the Respondent's website and most pages in that site contain the Marvel Marks, including in meta-tags, in connection with replacement wear items then being offered for sale for use with various models of the Complainant's saws (hard-copy printouts of various pages of the Respondent's website appearing in Annex 6 to the Complaint).

After it registered the name and commenced its sales, the Respondent traveled to various industry trade shows and visited with personnel of the Complainant including its President. Apparently, none of the Complainant's personnel, including its President, ever objected or complained to the Respondent about its use of the name, its website or its offering of

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aftermarket parts.

As early as July 9, 2007, the home page of the Respondent's web site (a copy of which appears in Annex 6 to the Complaint) contained the following text as the first two paragraphs on that page, with the second paragraph having been recognized (as noted below) by Complainant's counsel as a disclaimer:

"MarvelSawParts.com We Specialize in Blade Guides, 8-1205 Lower Band Wheels and Upper Band Wheels.

Marvel Saw Parts offers replacement band saw parts for Marvel band saw[s] and the expertise to accommodate all your band saw repair and service needs. Our goal is to provide quality after market replacement parts for your Marvel BandSaw." [first paragraph emphasized in original; error in original]

As of January 28, 2008, the Respondent had modified the home page of its site (a copy of which appears in Annex 2 to the Response) to recite the following as its first three paragraphs, presumably to supplement its original disclaimer which here appears as the third paragraph:

"This Site is not Affiliated with Marvel Mfg or Armstrong-Blum

We Specialize in Replacement parts for Marvel Band Saw Line Parts. Welcome to MarvelSawparts.com Replacement parts for the Marvel Band Saw Line such as Blade Guides, 8-1205 Lower Band wheels and Upper Band Wheels.

"Marvel Saw Parts offers replacement band saw parts for Marvel band saw[s] and the expertise to accommodate all your band saw repair and service needs. Our goal is to provide quality after market replacement parts for your Marvel Band Saw." [first two paragraphs emphasized in original ;error in original]

### *D. Interactions between the Parties*

On July 2, 2007, counsel for the Complainant sent the Respondent a cease and desist letter (a copy of which appears in Annex 7 to the Complaint) requesting that the Respondent change its domain name, and cease and desist from any further use of the MARVEL Marks.

In response and on July 9, 2007, counsel for the Respondent sent the Complainant's counsel a letter (a copy of which appears in Annex 8 to the Complaint) indicating that, while the Respondent does not claim any rights in the MARVEL Marks, it would not change its domain name or cease use of the MARVEL Marks as those marks and the name accurately describe the products which the Respondent then provides, i.e., replacement blades and parts for the Complainant's MARVEL-branded band saws, and thus Respondent was entitled to use those marks and its name in that fashion. The Respondent's counsel then argued in page 3 of this letter and with specific reference to the language which then appeared on the home page of the Respondent's web site, that the Respondent was using the Complainant's MARVEL mark as a part of a word group that describes the Respondent's service rather than to designate the source of those services, the latter being a function protected by a trademark, the former not:

"As to the website name, our client has used an apt descriptor of the exact services

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that it provides to the public: the provision of band saw parts for Marvel equipment. The website name does not use Marvel's sole trademark for its locator, but instead uses a combination of words that correctly and aptly describes the precise services offered and provided. The web address has not been used in 'bad faith' and is not 'identical' or 'confusingly similar' to the registered marks of 'Marvel' or 'Marvel AB'.... . The first paragraph of the website clearly describes this point and removes any arguable potential for any confusion:

Marvel Saw Parts offers replacement band saw parts for Marvel band saw[s] and the expertise to accommodate all your band saw repair and service needs. Our goal is to provide quality after market replacement parts for your Marvel Band Saw" [error in original]

Subsequently, on August 10, 2007, the Complainant's counsel sent the Respondent's counsel a letter (a copy of which appears in Annex 9 to the Complaint) rebutting the contentions set forth in Respondent's July 9th letter. Further, in that letter, the Complainant's counsel recognized that the specific language, which the Respondent's counsel referenced in the home page of the Respondent's website, constituted a disclaimer and apparently one that was adequate by stating:

"Lastly, we disagree with your assertion that use of the disclaimer on your client's website somehow relieves your client of its infringing uses of Marvel's marks.

...

We further demand that Koba use a disclaimer, the language of which may be identical to Koba's current disclaimer but in any case should specifically indicate that Koba's parts are not replacement parts that originate from Marvel." (from the last paragraph on page 2 bridging over to page 3 of that letter).

Thereafter, on August 17, 2007, Respondent's counsel apparently sent a letter back to Complainant's counsel (though a copy of that letter is noted in the Complaint as appearing in Annex 10 thereof, no such copy or even Annex 10 for that matter exists in the Annexes provided to the Panel) through which the Respondent apparently agreed to at least negotiate, with the Complainant, over appropriate changes to the Respondent's web-site. However, the parties were unable to reach agreement.

**5. Parties' Contentions**

**A. Complainant**

**(i) Identical or Confusingly Similar**

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's MARVEL Marks.

In essence, the Complainant states that the name incorporates its mark MARVEL followed by descriptive words "saw" and "parts", those words being insufficient to reduce any confusion resulting between the Respondent's use of the name and the Complainant's MARVEL Marks.

Hence, the Complainant believes that it has satisfied the confusing similarity or identity requirement in paragraph 4(a)(i) of the Policy.

*(ii) Rights or Legitimate Interests*

The Complainant contends that, for any of several reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

First, the Respondent is neither affiliated with or related to the Complainant in any way, nor has the Complainant licensed or authorized the Respondent to use the MARVEL marks. Further, the Respondent is not authorized by the Complainant to act as a reseller of parts for the Complainant's band saws and the parts which the Respondent does sell do not originate with the Complainant. Consequently, those Internet consumers who seek MARVEL-branded replacement parts and encounter the disputed domain name are led to believe that an affiliation or connection of some sort exists between the Complainant and the Respondent when in fact no such relationship exists –thus causing confusion.

Second, the Respondent is not commonly known by the disputed domain name.

Lastly, the Respondent is not making a non-commercial fair use of the MARVEL marks.

*(iii) Registered and Used in Bad Faith*

The Complainant contends that the Respondent registered and is now using the disputed

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domain name in bad faith under paragraph 4(a)(iii) of the Policy.

Specifically, even though the Respondent is aware of the Complainant's MARVEL Marks, the Respondent is using the disputed domain name, as well as those marks and the look and feel of "an authorized reseller of the Complainant's MARVEL-branded parts that originate with the Complainant", to create confusion in Internet consumers who seek parts for the Complainant's products and there through mislead and divert those consumers from the Complainant's website to the Respondent's site for the Respondent's own commercial gain.

*B. Respondent*

*(i) Identical or Confusingly Similar*

The Respondent provides considerable argumentation, includes supporting annexes, as to why it believes that the disputed domain name is not confusingly similar to the Complainant's MARVEL Marks. Distilled to its essence, the crux of its argument appears to be that the term "Marvel" is susceptible to such extensive third-party use, both as a mark and within a domain name – the latter including many such identical or highly similar names in use in the metal/band saw industry, which effectively and collectively precludes the Complainant from

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having any exclusivity in that term sufficient to impede the Respondent's use of the term "Marvel" in the disputed domain name. The fact that the Complainant has not taken any action to halt such third-party use evidences its recognition that, by virtue of such third-party dilution, it lacks sufficiently actionable trademark rights. Moreover, the Complainant has failed to show that any actual confusion has arisen through concurrent use of its MARVEL Marks and the Respondent's use of the disputed domain name.

### *(ii) Rights or Legitimate Interests*

The Respondent contends that, contrary to the Complainant's allegations, it possesses rights and legitimate interests in the disputed domain name.

First, the Respondent is using the name in connection with a *bona fide* offering of goods, namely sale, via the Internet, of aftermarket replacement wear parts, including blades, for the Complainant's band saws. Moreover, since the Complainant does not offer those parts through the Internet, including through its own web site, the Respondent and the Complainant do not compete.

Though the Respondent registered the name in March 10, 2003 and used the name in a *bona fide* business ever since, it was not until over four years later in June 2007 when the Respondent first received notice of this dispute, that notice being its receipt of a letter from the Complainant's counsel. Thereafter, both the Complainant and the Respondent corresponded, through their counsel, though both were unable to an agreement to resolve the dispute. Subsequently, during February 2008, the Complainant filed the present Complaint.

### *(iii) Registered and Used in Bad Faith*

The Respondent rebuts the Complainant's allegations that the former registered and used the disputed domain name in bad faith.

First, as noted above, inasmuch as the Complainant does not offer, through the Internet including its own web site, replacement wear part for its own saw products – parts which the Respondent provides through its site and has done so for over the prior four years, the Complainant and the Respondent do not compete. Hence, the Respondent did not register the name to disrupt the business of a competitor, or interfere with or dissuade any customer from purchasing any saw from the Complainant but rather as an instrumentality through which it would offer replacement parts for those saws on the Internet. In that regard by providing an easily accessible source of parts, the Respondent's efforts over the years have probably enhanced and/or broadened the acceptance of the Complainant's products than otherwise.

Second, the Respondent has never offered the name for sale or auction, nor did it register the name to prevent the Complainant from using a name that incorporated the MARVEL Marks. As to the latter, over the past four years, the Complainant and the Respondent both appeared at industry trade shows, and the President of the Complainant has discussed matters with the owner of the Respondent. Not once during those conversations did the Complainant object to the Respondent's use of the name. Additionally, the Complainant never told the Respondent that the Complainant wanted to use the name or that it had a

plan for the name should the Respondent ever decide to relinquish it.

Lastly and for the reasons noted above, no confusion is likely to arise between the name and the Complainant's MARVEL Marks.

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

[1] The Panel finds that the disputed domain name is confusingly similar to the Complainant's MARVEL Marks.

Under UDRP precedent, a very simple test is used to assess whether a domain name is confusingly similar to a mark: compare the domain with the mark to assess differences there between and then determine whether those differences are sufficient in and of themselves to impart requisite distinctiveness to the name that would reasonably preclude Internet users from becoming confused when faced with concurrent use of both the name and the mark. This does not involve ascertaining whether any third-party rights exist, and assessing both the extent of those rights and any dilution of the mark arising there from. Though the Respondent would like this Panel to conclude otherwise, all those factors are simply immaterial.

From a simple comparison of the disputed domain name, <[marvelsawparts.com](http://marvelsawparts.com)>, to the Complainant's MARVEL Marks, no doubt exists that the name is confusingly similar to the marks, and particularly the mark MARVEL.

The only differences between the disputed domain name and the mark MARVEL are the addition of the generic words "saw parts" as a suffix to that mark to form a composite term "marvelsawparts", along with appending the gTLD (generic top level domain) ".com" to that term to form the name – with the last addition being totally irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation, such as adding short letter or number groups or even generic or highly descriptive words to a mark, is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Here, adding the generic words "saw parts", to the mark MARVEL is clearly one such minor variation. See, e.g., *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878 (March 12, 2008); *BlackRock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627 (January 4, 2008); *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359 (November 14, 2007); *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064 (September 24, 2007); *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952 (August 27, 2007); *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334 (June 28, 2007); *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317 (April 24, 2007); *SPX Corp. v.*

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*Hevun Diversified Corp.*, NAF Case No. FA791657 [81 USPQ2d 1621] (November 13, 2006); *Google Inc. v. Burns*, NAF Case No. FA 726096 (August 16, 2006); *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766 (September 12, 2005); *Napster, Inc. v. Vinscani*, WIPO Case No. D2005-0531 (July 19, 2005); *Caesars Entertainment Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411 (June 22, 2005); *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824 [74 USPQ2d 1486] (January 18, 2005); *Lockheed Martin Corp. v. Deborah Teramani*, WIPO Case No. D2004-0836 (December 1, 2004) and *National Collegiate Athletic Assoc. v. Dusty Brown*, WIPO Case No. D2004-0491 (August 30, 2004); *Lane-Labs USA, Inc. v. Powell Productions*, NAF Case No. FA 155896 (July 1, 2003); and particularly *Cable News Network LP, LLP v. Elie Khouri d/b/a Channel News Network et al.*, NAF Case No. FA 117876 [68 USPQ2d 1570] (December 16, 2002).

Therefore, the Panel finds that the disputed domain name <marvelsawparts.com > is confusingly similar to the Complainant's MARVEL Marks as to cause confusion; hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

### *B. Rights or Legitimate Interests*

[2] The Panel finds that the Respondent has established rights and legitimate interests in the disputed domain name under paragraph 4(c)(i) of the Policy.

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Under this paragraph, a respondent can demonstrate that it has rights or legitimate interests in a disputed domain name by showing that, before it received any notice of an underlying dispute over the name, it either used or made demonstrable preparations to use the name in connection with a *bona fide* offering of goods or services.

Inasmuch as the Respondent's use of the name clearly predates its notice of the present dispute, here by some four years, the only remaining question is whether the Respondent's use of the name, which incorporates the Complainant's trademark, in connection with its web site offerings was *bona fide* and specifically in light of the fact that the Respondent had no contractual or other relationship with the Complainant authorizing the Respondent's use of the mark.

A clear line of decisions has emerged in UDRP jurisprudence which sets forth a pragmatic test to use in determining whether such use in a given situation is *bona fide*. Specifically, in the seminal case of *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903 (November 6, 2001), the panel articulated the following set of factors, which if fully met, signified that an offering of goods or services through use of a complainant's mark, by in that case a respondent who was an authorized dealer/reseller, was *bona fide* within the meaning of paragraph 4(c)(i) of the Policy:

- (a) the respondent must actually be offering the goods or services at issue;
- (b) the respondent must use the site to sell only the trademarked goods; otherwise it

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could be using the trademark to bait Internet users and then switch them to other goods;

(c) the respondent's site must accurately disclose the registrant's relationship with the trademark owner; it may not, for example, falsely suggest that it is the trademark owner, or that the website is the official site, if, in fact, it is only one of many sales agents; and

(d) the respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.

The *Oki Data* factors were applied not only in other instances where as there authorization to use the mark existed, but also and more importantly to the present dispute, in instances where no such authorization existed, whether by contract or otherwise, such as in *Dr. Ing h.c. F. Porsche AG v. Del Fabbro Laurent*, WIPO Case No. D2004-0481 (August 20, 2004) and more recently in *Volvo Trademark Holding AB v. Auto Shivuk*, WIPO Case No. D2005-0447 (June 8, 2005) – cases which provided fact patterns which closely paralleled that of the present dispute. In particular, the *Porsche* case presented a situation where respondent Laurent, though not being an authorized distributor of complainant's *Porsche* vehicles, nevertheless registered and used the domain names <porschebuy.com> and <porsche-buy.com> which each incorporated the mark *PORSCHE* for a web site that provided a marketplace for used *Porsche* vehicles. Since the site was established prior to the date the respondent received notice of the dispute and the sales activities provided through the site were *bona fide*, the panel found that respondent Laurent had legitimate rights and interests in that name under paragraph 4(c)(i).

Here, the Respondent's actions, as was the case with the respondent in the *Porsche* decision, fully comply with the *Oki Data* factors.

In that regard, the record indicates that Respondent here was indeed offering the aftermarket replacement wear parts for sale to its customers, thus satisfying the first factor. As to the second factor, there is no evidence of record to indicate that the Respondent was offering any goods other than its replacement wear parts intended for use with *MARVEL*-branded saws or that any of those parts was inferior or lacking in quality or not suited for their intended use which, otherwise, in turn, would tarnish the Complainant's mark and reputation. Avoidance of tarnishment appears to implicitly lie at the heart of this factor. In that regard, the parts being offered were indeed those exactly which the domain name <marvelsawparts.com> imply, i.e., parts for *MARVEL*-branded saws, and nothing else. The record indicates that those were the only parts which the Respondent offered through its site, with the Complainant offering no proof to the contrary. While the mark *MARVEL* may not have been imprinted or otherwise affixed directly to each of those parts or its container to specifically designate the source of that part as originating with the

Complainant as would be the case with "trademarked goods" – at least the record is remiss on any such proof to the contrary, nevertheless each such part was offered, through the Respondent's website, in conjunction with the mark but where, as this Panel finds and as amply evidenced in the hard copies of various pages from the Respondent's website provided in Annex 6 to the Complaint, the mark functioned to designate the field of use of that part,

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i.e., specifying the brand of saw for which the part was intended, and in conjunction with a particular one of those saws, e.g., MARVEL model 81, MARVEL model 15A and so forth. Being that Internet visitors to the Respondent's website nevertheless experienced the mark MARVEL in effectively much that same manner as if those parts or their containers actually carried the mark, the Panel, under the facts here, sees no reason to specifically limit the term "trademarked goods" under the second *Oki Data* factor to apply in, its traditional sense, to just those situations where the goods in question or their containers actually carry the mark, the goods originated with a complainant and the mark thus serves a source-indicating function. Legitimate use of the mark for any purpose in conjunction with the goods, either by, for example, signifying their source or, as under the present facts, their use, will suffice. Consequently, the Panel finds the second *Oki Data* factor is met here.

Further, as to the third factor, the Respondent's site carries a prominent disclaimer, at least as early as July 9, 2007 – before the Complaint was filed and in all likelihood, as this Panel infers from any evidence to the contrary, well before that date and certainly before this dispute first arose – on its home page which accurately informs its Internet visitors that the Respondent is independently offering aftermarket replacement parts for MARVEL-branded saws and nothing else. See the exchange of correspondence discussed above between the Respondent's and Complainant's counsel which appears in Annexes 8 and 9 to the Complaint. Now, whether the original disclaimer was legally sufficient to achieve its intended purpose, as the Respondent's counsel submits, of adequately precluding consumer confusion from occurring is an open issue. Fortunately, it is one which this Panel need not reach inasmuch as the Complainant's counsel in his letter of August 10, 2007 implicitly conceded the sufficiency of the original disclaimer by stating, in pertinent part: "We further demand that Koba use a disclaimer, *the language of which may be identical to Koba's current disclaimer* ... [emphasis added]. By viewing the disclaimer through the prism of this concession, the Panel finds that the Respondent's web site complies with the third factor. Lastly, as indicative of the Respondent's compliance with the fourth and final *Oki Data* factor, the record provides no evidence that the Respondent, through its activities, intended or attempted to "corner the market in domain names" and there through deprive the Complainant of an opportunity to reflect its mark MARVEL in any domain name, apart from that which the Respondent registered. For illustrative instances where a respondent did not satisfy all the *Oki Data* factors and hence failed to establish legitimate rights and interests in its disputed domain name, see *Berlitz Investment Corporation v. Pierre Hacopian, Mr. Cheap.com LLC*, WIPO Case No. D2007-0483 (May 31, 2007) and *Sanofi-Aventis v. Internet Marketing Inc./John Bragansa*, WIPO Case No. D2005-0742 (October 4, 2005).

Moreover and with particular relevance to the present dispute, the panel, in the *Porsche* decision, observed as to the respondent's descriptive use of the complainant's mark PORSCHE in its domain names:

"Respondent is using the websites under the Domain Names as a market place for used PORSCHE cars only. No other brands are offered so that this case does differ from those where a respondent is abusing of a certain domain name to entice Internet users to its site.

The Domain Names are descriptive of the platforms conducted there under. In creating these websites, the use of the word "PORSCHE" has an evident logic, as "PORSCHE" is the normal term to signify the products offered. The Complainant did not produce any evidence according to which the Respondent would be able to describe in the Domain Names the

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goods offered under the Domain Names without making any reference to the trademark of the Complainant."

The very same observation applies equally to the present dispute. Here, the Respondent used the Complainant's mark MARVEL, in

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much the same sense as did the respondent in the *Porsche* case, as a descriptive term to signify the specific brand of saws for which the Respondent was offering replacement parts. It is certainly not evident to this Panel, nor did the Complainant advance any evidence, let alone credible, of how, by way of a substitute domain name, the Respondent could adequately and effectively describe its product offerings, which were apparently suited only for use in MARVEL-branded saws, in its domain name without making use of the mark MARVEL. Hence, this Panel infers that the use of any such name without inclusion of the mark MARVEL would fail to properly inform Internet users of the exact nature of the offerings available through the Respondent's website – which here is certainly a legitimate and highly beneficial goal of using that particular domain name or, generally speaking, any domain name that is highly descriptive of its corresponding website – and thus would be rather ineffective.

By virtue of the above findings, the Panel is led to only one unassailable conclusion, namely that although the Respondent was not authorized, whether by contract or otherwise, by the Complainant to sell aftermarket replacement wear parts for the Complainant's branded saws or use the Complainant's MARVEL Marks, the Respondent's use of the disputed domain name, which included the Complainant's MARVEL mark, in conjunction with its offering of those parts was *bona fide* and given that this use predated the Respondent's first notice of this dispute, the Respondent has sufficiently demonstrated, pursuant to paragraph 4(c)(i) of the Policy, that it has rights and legitimate interests in the disputed domain name.

Therefore, the Respondent has met the requirements of paragraph 4(c) of the Policy. Consequently, the Complainant is unable to satisfy its burden under paragraph 4(a)(ii) of the Policy.

### *C. Registered and Used in Bad Faith*

In light of the Panel's findings immediately above regarding paragraph 4(a)(ii), all issues concerning whether the Respondent registered and used the disputed domain name in bad faith are now moot. Hence, the Panel declines the Complainant's invitation to opine on such issues. See, e.g., *Groovr, Inc. v. Active Interactive, Inc.*, NAF Case No. FA 1103425 (December 18, 2007); *CPFilms, Inc. v. Solar Lunar Performance Film*, NAF Case No. FA 861127 (Feb. 6, 2007); *Hugo Daniel Barbaca Bejinha v. Whois Guard Protected*, NAF Case No. FA 836538 (Dec. 28, 2006); and *Pom Wonderful LLC v. Redavid*, NAF Case. No. FA 846577 (Jan. 8, 2006).

Inasmuch as Complainant has failed to meet its burden under paragraph 4(a)(ii) of the Policy, it has failed to establish a *prima facie* case for relief under paragraph 4(a).

### *7. Decision*

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Accordingly, under paragraph 15 of the Rules, the relief sought by the Complainant is hereby denied.

- End of Case -  
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