



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

William M. Krings v. Hugo Hernandez

Case No. D2006-0237

1. The Parties

The Complainant is William M. Krings, Inviro Inc. d/b/a Inviro, Asheville, United States of America.

The Respondent is Hugo Hernandez, San Juan, Puerto Rico, United States of America represented by Manuel A. Quilichini of United States of America.

2. The Disputed Domain Name and Registrar

The disputed domain name <inviro.com> is registered with Catalog.com.

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").

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") in email form on March 3, 2006, and in hard copy form on February 23, 2006, along with the Annexes.

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 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 24, 2006, the Center requested confirmation from the Registrar of information set forth in the Complaint relative to the disputed domain name; specifically, contact and registrant information for that domain name, as well as whether the Registrar received a copy of the Complaint from the Complainant. The Center also requested the Registrar to specify: (a) whether the Policy applies to the disputed domain 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 the domain name, (c) the language of the registration agreement, and (d) whether the domain name will remain “locked” during the proceeding.

Subsequently, on February 24, 2006, the Registrar provided its response to the Center through which the Registrar specified name and contact information pertinent to the disputed domain name, to the extent present in its WhoIS database, confirmed that Catalog.com is the registrar of that name and stated that: it had received a copy of the Complaint, the Policy applied to the disputed domain name and the name was then held in a “locked” status. The Registrar also indicated that the Respondent has submitted, for court adjudication, to the jurisdiction at the location of the principal office of the Registrar, and that the registration agreement is in English.

In response to a notification from the Center dated February 27, 2006, that the Complaint was administratively deficient, the Complainant filed an amended Complaint in both email and hard copy form on March 3, 2006.

The Center verified that the Complaint and the amended Complaint (collectively hereinafter the “Complaint”) satisfied the formal requirements of the Policy, the Rules, and the Supplemental Rules.

On March 3, 2006, the Center notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint, by courier, facsimile and email to the Respondent. 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 3, 2006, under paragraph 4(c) of the Policy, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all preceding and succeeding correspondence 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 23, 2006, to file its Response with the Center and serve a copy of the Response on the Complainant.

The Complainant, through an email received by the Center on March 24, 2006, requested the Center to suspend this administrative proceeding to enable the parties to directly negotiate a resolution of the underlying dispute. In response, the Center, through an email letter dated March 24, 2006, suspended this administrative proceeding for one month, i.e., until April 23, 2006. Subsequently, at the request of the

Complainant, received in e-mail form on March 30, 2006, the Center reinstated this proceeding.

As of March 31, 2006, the Center had not received a Response to the Complaint from the Respondent; hence, the Center, in an email letter dated March 31, 2006, notified the Complainant and Respondent of the default of the Respondent.

Accordingly, pursuant to the Rules and Supplemental Rules, by email letter dated April 4, 2006, the Center contacted the undersigned, Mr. Peter L. Michaelson, requesting his service as a Sole Panelist for this dispute. Subsequently, on the same day, Mr. Michaelson accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an email letter dated April 5, 2006, 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 19, 2006.

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

The language of this proceeding is English.

4. Factual Background

A copy of the WhoIS registration records for the disputed domain name appears in Annex A to the Complaint. As indicated on these records, the Respondent registered the disputed domain name on April 2, 2002.

A. Complainant's INVIRO Marks

The Complainant claims that it owns 3 United States trademark registrations for its marks that contain the term "INVIRO", in block letters or stylized form (collectively the INVIRO Marks) and on which this dispute is based. The Complainant has provided, in Annex E to the Complaint, hard-copy printouts of its registration certificates for these marks. These marks are as follows:

- (a) INVIRO (stylized lettering but with an eye pattern in lieu of the second I in the term INVIRO)
United States registration 2,915,966; registered: January 4, 2005, filed: June 19, 2002

This service mark was registered for use in connection with "franchising, namely, offering technical assistance in the establishment and/or operation of real estate brokerages" in international class 35. The registration states that first use and first use in commerce of the mark for these services commenced as of June 7, 1982, and June 7, 1984, respectively.

- (b) INVIRO (block letters)
United States registration 1,829,575; registered: April 5, 1994
filed: July 7, 1993

This service mark was registered for use in connection with "franchising, namely, offering technical assistance in the establishment and/or operation of real estate

brokerages” in international class 35. The registration states that both first use and first use in commerce of the mark for these services commenced as of July 2, 1993.

- (c) INVIRO (block letters)
United States registration 1,771,827; registered: May 18, 1993
filed: June 11, 1992

This service mark was registered for use in connection with “real estate brokerage services” in international class 36. The registration states that first use and first use in commerce of the mark for these services commenced as of March 20, 1984, and June 11, 1984, respectively.

According to Trademark Electronic Search System (TESS) and the Trademark Applications and Registrations Retrieval (TARR) databases which are publicly accessible through the web site of the United States Patent and Trademark Office (USPTO), the USPTO has cancelled the ‘575 registration on April 28, 2001, and the ‘827 registration on December 23, 2000, as a result of the Complainant’s failure to timely file a declaration of continued use under Section 8 of the Lanham Act (15 U.S.C. § 1058) for each of these two registrations. However and according to these databases, the ‘966 registration is currently active.

B. The Parties and their activities

As best understood from the Complaint, the Complainant provides services related to marketing, developing and licensing of real estate brokerages, and has done so under the stylized term INVIRO since June 1982 and the block letter version since July 1993 and evidently still continues to do so. The Complainant’s use of the block letter version of the term, since its use commenced in 1993, has involved distributing considerable amounts of advertising materials and also having advertised in various industry publications, and such use apparently continues to the present.

The Respondent is neither a real estate broker nor engaged in the real estate marketing industry.

On January 5, 2005, the Complainant sent the Respondent a letter (a copy of which appears in Annex E to the Complaint) demanding that the Respondent cease and desist from all further use of the disputed domain name. In response, the Respondent switched its domain name from the disputed name to a hyphenated version, specifically <in-viro.com>.

From the day the Respondent registered the disputed domain name until some time after January 5, 2005, the Respondent has not used the name to resolve to an operative web site and has parked that name with the Registrar. Currently, the Respondent uses the name to resolve to its commercial web site. On September 7, 2005, the Respondent renewed his registration to that domain name.

Though the parties engaged in settlement discussions in late March 2006 and immediately prior to the reinstatement of this proceeding, those discussions were ultimately unsuccessful.

5. Parties’ Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant appears to contend that the disputed domain name, by virtue of being <inviro.com>, is confusingly similar or identical to the Complainant's INVIRO Marks.

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

(ii) Rights or Legitimate Interests

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

First, after having been notified of this dispute by the Complainant, the Respondent changed its domain name from the disputed domain name to the hyphenated version, thus reflecting that, in light of the Complainant's INVIRO Marks, the Respondent never had a legitimate claim to that name.

Second, the Complainant has never licensed or authorized the Respondent to use any of the Complainant's INVIRO Marks.

(iii) Registered and Used in Bad Faith

The Complainant contends that the Respondent has registered and is now using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

First, the Complainant contends that the Respondent has not used the disputed domain name for nearly a three-year period starting from the date he registered the name in April 2002 until after the Complainant notified him of the dispute in January 2005, thus reflecting bad faith.

Second, the Respondent, knowing of the Complainant's rights in its INVIRO Marks, still proceeded in September 2005 and in spite of those rights, to renew his registration to that name, thus further reflecting bad faith.

Third, the Respondent's continued use of the disputed name is preventing the Complainant from operating and conducting its business through which this Panel infers the Complainant is contending that the Respondent, by virtue of its registration, is precluding the Complainant from using its INVIRO Marks in a corresponding domain name and/or is intentionally disrupting the Complainant's business.

B. Respondent

The Respondent failed to file any Response to the allegations raised in the Complaint.

6. Discussion and Findings

In view of the lack of a Response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this

administrative proceeding on the basis of the Complainant's undisputed representations. In that regard and apart from judging this proceeding through mere default of the Respondent, the Panel makes the following specific findings.

A. Identical or Confusingly Similar

Though the Complainant's two federal registrations for the block letter version of its mark INVIRO have been canceled, the Complainant continues to use the term INVIRO as a service mark in connection with his service offerings and has continuously done so since 1982. Consequently, the Complainant's common law trademark rights in this term, when used in connection with his services, commenced at least as of July 1993, and apparently continue unabated from then to the present. Those rights certainly predate the registration of the disputed domain name by approximately nine years.

Nowhere does the Policy contain a restriction that specifically limits its reach to only registered marks. Therefore, given the apparent inclusive nature of the Policy, whether the Complainant has rights to an unregistered mark and hence a protectable interest under the Policy, lies with national trademark law that governs the Respondent's actions that are the subject of the Complaint. Under American law, rights accrue in unregistered, so-called "common law", marks as a result of usage, though limited by geographic and product/service markets in which the mark is used. As evidence of this, one need turn no further than to §43 of the Lanham Act (15 U.S.C. §1125(a)) which states, in pertinent part: "Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof ... (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person ... shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act."

Consequently, numerous panels including this one, when faced with unregistered marks, have upheld their protectable status in the United States under the Policy. In that regard, when faced with this issue, the panel in *Brooklyn Institute of Arts and Sciences v. Fantastic Sites, Inc.*, National Arbitration Forum Case No. FA 95560 held: "ICANN dispute resolution policy is broad in scope in that the reference to a trademark or service mark in which the complainant has rights means that ownership of a registered mark is not required, unregistered or common law trademark or service mark rights will suffice to support a domain name complaint under the policy". See, e.g., *Sound Unseen, Ltd.; Apple Bottoms, LLC; and Cornell Haynes p/k/a "Nelly" v. Patrick Vanderhorst*, WIPO Case No. D2005-0636 (August 18, 2005); *True Blue Productions, Inc. v. Chris Hoffman*, WIPO Case No. D2004-0930 (December 22, 2004); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, WIPO Case No. D2002-0605 (September 11, 2002), *Peter Frampton v. Frampton Enterprises, Inc.*, WIPO Case No. D2002-0141 (April 17, 2002); *America Online, Inc. v. John Deep d/b/a Buddy USA Inc.*, FA 96795 (Nat. Arb. Forum, May 14, 2001); *Missing Children Minnesota v. Run Yell Tell, Ltd.*, FA 95825 (Nat. Arb. Forum, November 20, 2000); *Mike Warner 2001 v. Mike Larson*, FA 95746 (Nat. Arb. Forum, November 15, 2000); *CMG Worldwide Inc. v. Naughty Page*, FA 95641 (Nat. Arb. Forum, November 8, 2000); *Home Properties v. SMSOnline*, FA 95639 (Nat. Arb. Forum, November 2, 2000); and *Bridal Rings Company v. Yemenian*, FA 95608 (Nat. Arb. Forum, October 26, 2000). Furthermore, the panel in *United States Postal Service v. Consumer Info. Org.*, FA 95757 (Nat. Arb. Forum, November 27, 2000) held: "The UDRP does not discriminate between registered and unregistered marks." In *Exario Network Inc. v. THE DOMAIN NAME YOU HAVE ENTERED IS FOR SALE*, AF-0536, (eResolution, December 11, 2000), the panel recognized: "It is well

established that a complainant need not own a registered trademark to invoke the policy. It is sufficient that a complainant have rights in an unregistered trademark.” In that regard, also see *Sand Hill Wholesale of Ohio v. Hatton*, FA 95970 (Nat. Arb. Forum, December 18, 2000), and *David Taylor Cadillac/Buick Co. v. Spider Works, Ltd.*, FA 95832 (Nat. Arb. Forum, November 30, 2000). Similarly, see *American Home Products Corp. v. Healthy Futures*, WIPO Case No. D2000-0454 (August 3, 2000); *Cho Yong Pil v. ImageLand, Inc.*, WIPO Case No. D2000-0229 (May 10, 2000); *SeekAmerica Networks, Inc. v. Tariq Masood and Solo Signs*, WIPO Case No. D2000-0131 (April 13, 2000); and *Bennett Coleman & Co. Ltd. v. Steven S Lalwani and Bennett Coleman & Co. Ltd. v. Long Distance Telephone Company*, WIPO Case No. D2000-0014 and D2000-0015 (March 11, 2000). The Complainant has such rights here.

With this in mind, the disputed domain name <inviro.com>, apart from its inclusion of the generic top level domain (gTLD) “.com” -- all gTLDs being uniformly ignored by ICANN Panels in assessing names for identity or confusing similarity under paragraph 4(a)(i) of the Policy -- is identical to the mark INVIRO.

Hence, the Complainant has met its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Panel believes that the Respondent has yet to provide any basis that would legitimize a claim to the disputed domain name under paragraph 4(c) of the Policy and moreover it is unlikely for the Respondent to be in a position to legitimately make such a claim.

Specifically, the Respondent simply made no use whatsoever of the domain name from the date he registered the name in April 2002 until after the Complainant notified him of the present dispute in early January 2005 which amounts to a period of approximately three years. During that time, the Respondent not only failed to use the name in connection with any *bona fide* offering of goods or services but also -- or so the Panel infers from the lack of any Response -- apparently made no demonstrable preparations to use the name in any such fashion. Thus, the Respondent can not show rights and legitimate interests under paragraph 4(c)(i) of the Policy. Nor, given the passive holding that occurred during this period coupled with the Respondent’s subsequent commercial use of the domain name, can the Respondent point to any of its activities surrounding the name as constituting either noncommercial or fair use of the name as would be required to qualify his activities, at least as a threshold matter, under paragraph 4(c)(iii) of the Policy.

Further, the Complainant has never authorized the Respondent to utilize its mark INVIRO or any mark confusingly similar thereto in conjunction with the specific services which the Complainant provides under its mark, nor does the Complainant have any relationship or association whatsoever with the Respondent.

Hence, any use to which the Respondent were to put the mark INVIRO or one confusingly similar thereto, in connection with the services provided by the Complainant or those similar thereto would directly violate the exclusive trademark rights now residing in the Complainant. See, e.g., *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884 (October 14, 2005); *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. Giovanni Vinscani*, WIPO Case No. D2005-0531 (July 19, 2005);

Caesars Entertainment, Inc. v. Nova Internet Inc., WIPO Case No. D2005-0411 (June 22, 2005); *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898 (December 28, 2004); *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360 (June 24, 2004); *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services Corp. v. ESJ Nutritional Products*, FA 173362 (National Arbitration Forum, September 16, 2003); *AT&T Corp. v. Roman Abreu d/b/a Smarttalk Wireless*, cited *supra*; *MPL Communications, Limited et al v. IWebAddress.com*, FA 97092 (National Arbitration Forum, June 4, 2001); *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374 (December 11, 2000); and *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, FA 95856 (National Arbitration Forum, December 18, 2000). Consequently, the Respondent could not legally acquire any public association between it and the mark INVIRO or one similar thereto, at least for the services rendered by the Complainant or those similar thereto, and hence could not be commonly known or recognized by that mark and thus could not fall within paragraph 4(c)(ii) of the Policy.

Thus, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name within Paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel believes that the Respondent's actions constitute bad faith registration and use of the disputed domain name.

As stated above and based on the record, it is established that the Respondent not only did not use the name for approximately three-years prior to when the Complainant placed him on notice of the present dispute but also, thereafter and despite that knowledge, intentionally renewed his registration to that name.

Quite a few panels, including this one, have held that, under appropriate circumstances, passive holding evidences bad faith use. Such circumstances, when viewed in their totality, exist here. See, e.g., *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360 (June 24, 2004); *Pfizer Inc. v. Order Viagra Online*, WIPO Case No. D2002-0366 (July 11, 2002); *Am. Home Products Corporation vs. Malgioglio*, cited *supra*; *JVC Americas Corp. v. Damian Macafee*, CPR Case No. CPR007 (November 10, 2000); *Pacific Investment Management Co. LLC v. Alex Szabo* NAF Case No. FA95614 (October 18, 2000); *National Australia Bank Limited v. Quality Systems Consulting -- QSC Pty Ltd.*, WIPO Case No. D2000-0765 (August 31, 2000); *Gonvarri Industrial, S.A. v. Gon Varr I An Sexo a Domicilio*, WIPO Case No. D2000-0637 (August 28, 2000); *Garage Records, Inc. v. Garage Records*, NAF Case No. FA95071 (August 17, 2000); *Dollar Financial Group, Inc. v. RXW Management*, NAF Case No. FA 95108 (August 4, 2000); *Lusomundo - Sociedad Gestora de Parcipacoes Sociais, S.A. and Lusomundo Audiovisuais, S.A. v. Inmo Soria and Andres Ceballos Moscoso*, WIPO Case No. D2000-0523 (August 2, 2000); *Valigene Corp. v. MIC*, NAF Case No. FA94860 (August 1, 2000); *Vertical Solutions Management, Inc. v. webnet-marketing, inc.*, NAF Case No. FA95095 (July 31, 2000); *Hewlett-Packard Co. v. High Performance Networks, Inc.*, NAF Case No. FA95083 (July 31, 2000); *CBS Broadcasting, Inc. v. Dennis Toeppen*, WIPO Case No. D2000-0400 (July 6, 2000); *August Storck KG v. Tony Mohamed*, WIPO Case No. D2000-0196 (May 3, 2000); *Recordati S.P.A. v. Domain Name Clearing Co.*, WIPO Case No. D2000-0194 (July 21, 2000); *Sanrio Company, Ltd. and Sanrio, Inc. v. Neric Lau*, WIPO Case No. D2000-0172 (April 20, 2000); and *Telstra Corp. Ltd. v. Nuclear Marshmallows*, WIPO Case No. D2000-0003 (February 18, 2000).

Since the specific grounds set forth in paragraph 4(b) of the Policy are illustrative and non-exclusive, the Panel finds that the Respondent's conduct constitutes bad faith under the general prohibition of paragraph 4(a)(iii).

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations to establish a case under paragraph 4(a) of the Policy upon which the relief he now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel now grants the relief sought by the Complainant.

The disputed domain name <inviro.com> is ordered transferred to the Complainant.

Peter L. Michaelson
Sole Panelist

Dated: April 18, 2006