



NATIONAL
ARBITRATION
FORUM

DECISION

Vanguard Industries East, Inc. v. Ira Green
Claim Number: FA0205000113969

PARTIES

Complainant is **Vanguard Industries East, Inc.**, Carlsbad, CA (“Complainant”) represented by **Jeffrey L. Eichen**, of **Schnader, Harrison, Segal & Lewis, LLP**. Respondent is **Ira Green**, Providence, RI (“Respondent”) represented by **Jeffrey Schwartz**, of **McKenna Long & Aldridge, LLP**.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<nsmeyer.com>**, registered with **Verisign - Network Solutions, Inc.**

PANEL

The undersigned certify that they have acted independently and impartially and to the best of their knowledge have no conflict in serving as Panelists in this proceeding.

Panelists are Peter L. Michaelson, Esq., James A. Carmody, Esq. and Judge Karl V. Fink (Ret.), as Chair

PROCEDURAL HISTORY

The Complainant submitted a Complaint to the National Arbitration Forum (the “Forum”) electronically on May 13, 2002; the Forum received a hard copy of the Complaint on May 15, 2002.

On May 17, 2002, Verisign - Network Solutions, Inc. confirmed by e-mail to the Forum that the domain name **<nsmeyer.com>** is registered with Verisign - Network Solutions, Inc. and that the Respondent is the current registrant of the name. Verisign - Network Solutions, Inc. has verified that Respondent is bound by the Verisign - Network Solutions, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On May 20, 2002, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of June 10, 2002 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on the Respondent’s registration as technical, administrative and billing contacts, and to postmaster@nsmeyer.com by e-mail.

A timely Response was received and determined to be complete on June 11, 2002.

The Complainant made a timely additional submission, which was received on June 14, 2002. The Respondent made a timely additional submission, which was received on June 19, 2002.

The Complainant’s second additional submission was received after the deadline for submission on June 24, 2002. It and the Respondent’s response to that submission were not considered by the Panel.

On July 8, 2002, pursuant to the Complainant’s request to have the dispute decided by a three-member Panel, the Forum appointed Karl V. Fink as Panelist and Chair, James A. Carmody as Panelist, and Peter L. Michaelson as Panelists.

RELIEF SOUGHT

The Complainant requests that the domain name be transferred from the Respondent to the Complainant.

PARTIES’ CONTENTIONS

A. Complainant

For more than 60 years, N.S. Meyer, Inc., Vanguard Industries, Inc., and Ira Green all competed in the same business—manufacturing and selling medals, patches and military insignia for people serving in the United States armed forces, National Guard and local fire and police forces. Of the three, N.S. Meyer was the oldest—it had been in continuous operation since 1868.

For at least the past 5 years, all three companies—N.S. Meyer, Vanguard and Ira Green—have also used web sites to promote their respective businesses:

N.S. Meyer: www.nsmeyer.com
Vanguard: www.vanguardmil.com
Ira Green: www.iragreen.com

On July 17, 2000, Vanguard purchased substantially all the assets of N.S. Meyer—including, among other things, all of N.S. Meyer’s goodwill, inventory, customer lists,

names, trademarks and other intellectual property. The transaction also included the purchase of N.S. Meyer's domain name, <**nsmeyer.com**>.

Vanguard took all steps appropriate to transfer N.S. Meyer's name, customers and goodwill to Vanguard.

Vanguard also took appropriate steps to transfer N.S. Meyer's web site traffic to Vanguard's web site.

From the time that Vanguard purchased N.S. Meyer's assets on July 17, 2000 until the fall of 2001, Vanguard's announcement on the Meyer website regarding its purchase of Meyer appeared without problem or interruption at <**nsmeyer.com**> domain name) and N.S. Meyer's customers were forwarded automatically to Vanguard's web site.

In the winter of 2001, Vanguard learned that its announcement had disappeared from N.S. Meyer's web site and that customers visiting <**nsmeyer.com**> were now being redirected automatically to Ira Green's web site at <iragreen.com>.

Vanguard never received any renewal notices from Network Solutions and did not learn that the registration of the disputed domain name expired in September 2001 until well afterwards.

On the day after N.S. Meyer's registration expired, Ira Green registered the name <**nsmeyer.com**> for itself.

When Vanguard learned of this registration in December 2001, it contacted Ira Green immediately.

In February 2002, Vanguard's counsel contacted Ira Green's counsel by telephone and in writing to demand that Ira Green stop its use of the <**nsmeyer.com**> domain name and return it immediately to Vanguard.

The domain name in question is identical to N.S. Meyer, the name of the business that Vanguard purchased in 2000. N.S. Meyer used and promoted this name in the military insignia business for over 130 years and was widely known and recognized by this name at the time of Vanguard's purchase.

Ira Green has no right or legitimate interest whatsoever in the name "N.S. Meyer." Ira Green has never used or been known by the name "N.S. Meyer" in commerce and has not registered any trademark rights in the name.

There is ample evidence in this matter to find that Ira Green registered and is using the domain name in bad faith.

Ira Green registered the domain name <**nsmeyer.com**> at a time when it knew that it had no rights or legitimate interests in the name and that the name was, in fact, owned by Vanguard.

Upon registering the name of one of its largest competitors as a domain name, Ira Green then programmed the web site associated with this domain name to divert potential customers automatically from <**nsmeyer.com**> to Ira Green's own web site at <iragreen.com>.

Ira Green registered the <**nsmeyer.com**> domain name with the knowledge and intention that the registration would disrupt Vanguard's acquisition of N.S. Meyer's assets and goodwill. Ira Green is now using the domain name to sow disorder and confusion as to the source, sponsorship or affiliation of the N.S. Meyer name. Customers who are attempting to reach N.S. Meyer's former web site are instead diverted to Ira Green's web site—creating the mistaken belief that N.S. Meyer is now associated with Ira Green, not Vanguard.

B. Respondent

The Complainant has abandoned whatever rights it may previously have acquired in the MEYER NEW YORK AND DESIGN mark. In addition, The Complainant does not own nor claims to own a valid mark in the name "N.S. Meyer" or the domain name <**nsmeyer.com**>. The Respondent's domain name <**nsmeyer.com**> is neither identical nor confusingly similar to the MEYER NEW YORK AND DESIGN mark.

Although Complainant relies upon a trademark formerly owned by N.S. Meyer, Inc., it presents no evidence that the trademark has been used since July 17, 2000 when the Complainant purchased the company. The Complainant has taken explicit and affirmative steps to abandon this mark. The Complainant does not own a valid mark in the name "N.S. Meyer" or the domain name <**nsmeyer.com**>. The Complainant has novated the contracts between N.S. Meyer and the government to reflect a new contractual relationship between Complainant (Vanguard) and the government.

The Complainant has removed all N.S. Meyer branded packages and labels at various military exchanges and military clothing stores and replaced them with Vanguard branded packages or has otherwise restocked with Vanguard branded packages once the N.S. Meyer stock was sold out. There are no goods or services sold or offered for sale under the N.S. Meyer name, which is one of the most basic requirements for trademark ownership.

The Respondent's domain name is not identical or confusingly similar to the MEYER NEW YORK AND DESIGN mark.

The overall impression of the domain name <nsmeyer.com> is simply an Internet address, perhaps based on the name of a person. In contrast, the MEYER NEW YORK AND DESIGN mark imparts a geographic limitation of a person or company based in New York.

The Complainant has not met its burden of proof with regard to the first element required for relief, i.e., that the Respondent's domain name is identical or confusingly similar to a trademark in which the Complainant has rights. This failure to meet the threshold requirements is fatal to its case. It is, therefore, not necessary to discuss the remaining two elements.

C. Additional Submissions

1. Complainant's Additional Submission

In its Response, Ira Green does not present evidence to contradict any of the essential facts established by the Complainant.

Ira Green does not offer any explanation as to how its use of the domain name <nsmeyer.com> could be considered legitimate or lawful when Ira Green has never been known by the name "N.S. Meyer."

Vanguard's rights in the N.S. Meyer name are not limited to the Federally registered "MEYER NEW YORK" trademark. There is no Federally registered trademark for the exact name "N.S. MEYER," but that does not weaken or negate in any way the substantial rights that N.S. Meyer has built up in the name over its long history that Vanguard now owns.

Over the past two years, Vanguard has expended considerable amounts of time, money and effort to purchase and to transfer to Vanguard all of N.S. Meyer's goodwill, reputation, customer loyalty and name recognition. Vanguard has not abandoned the name N.S. Meyer for Ira Green to use.

Vanguard regards the N.S. Meyer name as so valuable that, since purchasing the company, Vanguard has begun using the N.S. Meyer name on its own packages to increase customer recognition of its products.

Vanguard still sells its N.S. Meyer merchandise in N.S. Meyer's packaging to a number of school stores.

Ira Green offers no evidence to show that it has any legitimate rights or interest in using the N.S. Meyer name as its domain name.

Ira Green offers no evidence to show its good faith in this matter. Its conduct in this matter was intentionally calculated and expressly aimed at causing confusion to customers and harm to Vanguard by wrongfully diverting customers from Vanguard's web site to Ira Green's.

2. Respondent's Additional Submission

The Complainant has not proved that it has rights in the domain name, which is fatal to its case.

There is no federally registered trademark for the name N.S. Meyer.

In light of Vanguard's express abandonment of the mark after it purchased the assets of N.S. Meyer, Inc., the alleged 140 years of use and the Federal trademark registration are irrelevant.

The Complainant asserts that it still sells merchandise in N.S. Meyer, Inc. packaging to school stores. The Complainant has not provided a scintilla of evidence of any kind, to support its assertion of such sales.

Complainant does not provide any evidence that it has rights in the <nsmeyer.com> domain name but instead relies on unsupported allegations.

FINDINGS

For the reasons set forth below, the Panel finds the Complainant has made its *prima facie* case for transfer of the domain name .

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the Respondent has no rights or legitimate interests in respect of the domain name;
and
- (3) the domain name has been registered and is being used in bad faith.

Identical and/or Confusingly Similar

The Panel finds Respondent's claim that Complainant has abandoned the N.S. MEYER mark to be without merit.

The domain name <**nsmeyer.com**> is identical or confusingly similar to the Complainant's mark. The addition of ".com" in the domain name is not a factor for the purpose of determining whether the domain name is identical.

Although the Complainant does not own a federally registered trademark for the N.S. MEYER mark, that does not weaken or negate the rights that N.S. Meyer accumulated in its name over its 130+ year history, rights which the Complainant now owns. The Complainant has common law rights in the N.S. MEYER mark, as well as rights in the federally registered MEYER NEW YORK mark. *See SeekAmerica Networks Inc. v. Masood*, D2000-0131 (WIPO Apr. 13, 2000) (finding that the Rules do not require that the Complainant's trademark or service mark be registered by a government authority or agency for such rights to exist; *see also British Broad. Corp. v. Rentieria*, D2000-0050 (WIPO Mar. 23, 2000) (noting that the UDRP "does not distinguish between registered and unregistered trademarks and service marks in the context of abusive registration of domain names" and applying the UDRP to "unregistered trademarks and service marks").

The Complainant has proven this element.

Rights or Legitimate Interests

The Respondent has never used or been commonly known by the name "N.S. Meyer" in commerce and has not registered any trademark rights in the name pursuant to Policy ¶ 4(c)(ii). Furthermore, N.S. Meyer did not sell its name, trademarks or any portion of its assets or goodwill to the Respondent. *See Gallup Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (finding that Respondent does not have rights in a domain name when Respondent is not known by the mark); *see also Compagnie de Saint Gobain v. Com-Union Corp.*, D2000-0020 (WIPO Mar. 14, 2000) (finding no rights or legitimate interest where Respondent was not commonly known by the mark and never applied for a license or permission from Complainant to use the trademarked name).

Over the past two years, the Complainant has invested significant amounts of time, money and effort in purchasing and transferring all of N.S. Meyer's goodwill, reputation, customer loyalty and name recognition. The fact that the Complainant unintentionally allowed the domain name to lapse does not legitimize the Respondent's rights in the domain name. *See Am. Anti-Vivisection Soc'y v. "Infa dot Net" Web Serv.*, FA 95685 (Nat. Arb. Forum Nov. 6, 2000) (finding that Complainant's prior registration of the same domain name is a factor in considering Respondent's rights or legitimate interest in the domain name).

The Respondent and the Complainant compete in the same industry, and the Respondent's intentional hijacking of the Complainant's domain name and corresponding goodwill is not a bona fide offering of goods or services under Policy ¶ 4(c)(i), nor is it a legitimate noncommercial or fair use of the domain name under Policy ¶ 4(c)(iii). See *Kosmea Pty Ltd. v. Krpan*, D2000-0948 (WIPO Oct. 3, 2000) (finding no rights in the domain name where respondent has an intention to divert consumers of Complainant's products to Respondent's site by using Complainant's mark); see also *Big Dog Holdings, Inc. v. Day*, FA 93554 (Nat. Arb. Forum Mar. 9, 2000) (finding no legitimate use when Respondent was diverting consumers to its own website by using Complainant's trademarks).

The Respondent has made no claim that it has rights or legitimate interests in the name; therefore the Complainant's allegations on this issue are undisputed.

The Complainant has proven this element.

Registration and Use in Bad Faith

The Panel finds that the Respondent had actual notice that, for over sixty years, one of its largest competitors in the military insignia market was named N.S. Meyer and that the Complainant purchased N.S. Meyer's assets and goodwill in August 2000. See *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1148 (9th Cir. Feb. 11, 2002) (finding that "[w]here an alleged infringer chooses a mark he knows to be similar to another, one can infer an intent to confuse"); see also *Samsonite Corp. v. Colony Holding*, FA 94313 (Nat. Arb. Forum Apr. 17, 2000) (finding that evidence of bad faith includes actual or constructive knowledge of a commonly known mark at the time of registration).

The Respondent, upon registering the name of one of its largest competitors as a domain name, intentionally programmed the website associated with the domain name to divert potential customers automatically from the Complainant's to the Respondent's website. Thus, the Respondent registered the domain name primarily to disrupt the Complainant's business, thereby evidencing bad faith registration and use under Policy ¶ 4(b)(iii). See *Surface Prot. Indus., Inc. v. Webposters*, D2000-1613 (WIPO Feb. 5, 2001) (finding that, given the competitive relationship between Complainant and Respondent, Respondent likely registered the contested domain name with the intent to disrupt Complainant's business and create user confusion); see also *Lubbock Radio Paging v. Venture Tele-Messaging*, FA 96102 (Nat. Arb. Forum Dec. 23, 2000) (concluding that domain names were registered and used in bad faith where Respondent and Complainant were in the same line of business in the same market area).

The Respondent's motivations for registering and using the domain name was to attract, for commercial gain, Internet users that are searching for the Complainant's products or the Complainant's newly acquired N.S. Meyer's products. The Respondent's actions represent bad faith registration and use under Policy ¶ 4(b)(iv). See *TM Acquisition Corp. v. Carroll*, FA 97035

(Nat. Arb. Forum May 14, 2001) (finding bad faith where Respondent used the domain name, for commercial gain, to intentionally attract users to a direct competitor of Complainant).

The Respondent's immediate registration of the Complainant's lapsed domain name, despite knowledge as to another's rights in the mark and corresponding domain name, also represents bad faith under the Policy. *See InTest Corp. v. Servicepoint*, FA 95291 (Nat. Arb. Forum Aug. 30, 2000) (finding that where the domain name has been previously used by Complainant, subsequent registration of the domain name by anyone else indicates bad faith, absent evidence to the contrary); *see also BAA plc v. Spektrum Media Inc.*, D2000-1179 (WIPO Oct. 17, 2000) (finding bad faith where Respondent took advantage of Complainant's failure to renew a domain name).

The Respondent does not dispute the Complainant's allegations on this issue.

The Complainant has proven this element.

DECISION

For the reasons stated above, the Panel directs that the domain name <nsmeyer.com> be **TRANSFERRED** to Complainant, Vanguard Industries East, Inc.

Peter L. Michaelson, Panelist

James A. Carmody, Panelist

Judge Karl V. Fink (Ret.), Chair

Dated: July 18, 2002