

ADMINISTRATIVE PANEL DECISION

Cummins Inc. v. Dennis Goebel

Case No. D2015-1064

1. The Parties

Complainant is Cummins Inc. of Columbus, Indiana, United States of America, represented by Mayer Brown LLP, United States of America.

Respondent is Dennis Goebel of Kalispell, Montana, United States of America, represented by Not Just Patents, United States of America.

2. The Domain Name and Registrar

The disputed domain name <fordcummins.com> (the "Domain Name") is registered with DNC Holdings, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 19, 2015. On June 22, 2015, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 23, 2015, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified Respondent of the Complaint, and the proceedings commenced June 30, 2015. In accordance with the Rules, paragraph 5(a), the due date for Response was July 20, 2015. The Response was filed with the Center July 17, 2015.

The Center appointed Robert A. Badgley, Peter L. Michaelson and Sir Ian Barker as panelists in this matter on August 11, 2015. The Panel finds that it was properly constituted. Each member of the Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

Complainant, founded in 1919, is a leading designer and manufacturer of diesel and natural gas engines and related technologies. Complainant claims to be “the world’s largest independent engine manufacturer”, with customers in 190 countries and territories and global net income for the year 2013 of USD 1.48 billion. Complainant holds trademark registrations for the mark CUMMINS in scores of countries, including a 1953 registration with the United States Patent and Trademark Office for the word mark CUMMINS.

Respondent registered the Domain Name on June 26, 2001. The Domain Name is currently redirected to a website (“www.dieselconversion.com”) operated by Respondent. At that site, Respondent offers for sale conversion services and kits for Cummins engines. The website boasts: “DIESEL CONVERSION SPECIALISTS – We work hard to be leaders in the Cummins diesel conversion market, and we want to be the best. You be the judge!”

The site also states:

How did we get here?

It all started in a garage as fordcummins.com in 2002. Solving a problem by installing (you guessed it) Cummins engines in Ford trucks. Over time the need grew, as did the company. The product line was expanded beyond Ford and Cummins so the name was changed to Diesel Conversion Specialists to better reflect the broader product base we now offer. The name change was also encouraged by “legal” types to avoid future trademark clashes. So today while we maintain rights to the domain “fordcummins.com” we actively market our company under the Diesel Conversion Specialists banner. Fordsummins.com and Diesel Conversion Specialists are one in [sic] the same.

Many of the products listed on Respondent’s home page are or relate to Cummins products, but several of the items listed for sale are products manufactured by other companies in the engine and automotive sector, such as a Dodge power steering pump fitting.

According to Complainant, it never authorized Respondent to register the Domain Name or use its CUMMINS mark in any manner. Nor is Respondent an authorized reseller or distributor of Complainant’s engines or related products.

Complainant’s counsel sent Respondent a cease-and-desist letter on November 7, 2012, and Complainant’s counsel sent another cease-and-desist letter to Respondent on March 10, 2015. According to Complainant, Respondent refused Complainant’s request to transfer the Domain Name to Complainant.

On May 30, 2002, Respondent filed as a business with the Montana Secretary of State under the name “FordCummins Conversions”. That status expired on May 30, 2007. On February 22, 2012, Respondent filed as a business with the Montana Secretary of State under the name “FordCummins.com”. That status is active.

5. Parties’ Contentions

A. Complainant

Complainant asserts that it has satisfied the three elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent contends that he has been “commonly known” as “FordCummins” since May 30, 2002, the date

on which he filed as the business “FordCummins Conversions” with the Montana Secretary of State. Respondent also asserts that the addition of the trademark FORD to the mark CUMMINS vests the Domain Name with a “completely different connotation and completely different commercial impression” from the mark CUMMINS. According to Respondent, it operates in an “aftermarket that neither Ford nor Cummins can serve well.”

Respondent argues that there is no evidence of bad faith registration or use on its part.

Respondent also asserts that Complainant waited eleven years after Respondent registered the Domain name in 2001, and ten years after Respondent became “commonly known” by the Domain Name, to take action by way of the 2012 cease-and-desist letter, and hence Complainant should be denied the relief it seeks in this proceeding. Respondent also states that it complied with some of the demands in the 2012 cease-and-desist letter, such as putting up a disclaimer of affiliation with Complainant, even though it refused to transfer the Domain Name.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name at issue in this case:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

There is no dispute that Complainant holds rights in the mark CUMMINS. As respects confusing similarity, the Panel concludes that the Domain Name is in fact confusingly similar to the CUMMINS mark. The Domain Name wholly incorporates the CUMMINS mark, and adds a second trademark, FORD, not owned by Complainant. The addition of the FORD mark, however famous it is, does not sufficiently diminish the confusing similarity between the Domain Name and the CUMMINS mark. Indeed, Respondent’s very business – facilitating the placement of Cummins engines into Ford trucks – makes this point. Consumers may very well conclude from the Domain Name that there is some sort of formal affiliation or partnership or venture between Ford and Complainant.

Prior panels have reached similar conclusions where two unrelated trademarks were combined to form a domain name. See, e.g., *AT&T Corp v. Beomjoon Park*, WIPO Case No. D2001-0133 (finding the domain name <attviacom.com> confusingly similar to both the mark AT&T and the mark VIACOM; “The combination of two famous marks has a great potential to confuse Internet users into believing that the website is some sort of co-operative venture between the Complainants.”).

The Panel concludes that Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish his rights or legitimate interests in a Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or

- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

It is common ground that Complainant has not authorized Respondent to use its CUMMINS mark in a domain name and that Respondent is not an authorized reseller or distributor of Complainant's wares.

Respondent alleges that he is commonly known by the Domain Name, but the record does not support this contention. Respondent registered the Montana business name FordCummins Conversions in 2002, but that name lapsed in 2007. Respondent registered the Montana business name FordCummins.com in 2012, but the mere registration of a business name is not in itself evidence that a person is "commonly known" by that name. Although Respondent has displayed the term "Fordcummins.com" on his main website for several years, such a display is not, again, evidence of being "commonly known" by the Domain Name.

Respondent is not using the Domain Name in connection with a *bona fide* offering of goods or services. Rather, he is appropriating Complainant's well-known mark to lure consumers who may reach the mistaken conclusion that Respondent's business is somehow affiliated with, or endorsed by, Complainant.

The Panel concludes that Complainant has established paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation," are evidence of the registration and use of a Domain Name in "bad faith":

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other on line location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy. There is no doubt that Respondent had Complainant's CUMMINS mark in mind when registering the Domain Name.

The Domain Name is redirected to Respondent's main website, where consumers are offered a variety of products, some of which have no relationship to Complainant's CUMMINS products. Respondent benefits commercially from the false impression created by the Domain Name, which suggests to the consumer some

type of affiliation with, or endorsement by, Complainant.¹ Such conduct falls within the definition of bad faith in paragraph 4(b)(iv) of the Policy.

Respondent's change of Montana business name from "FordCummins Conversions" to "FordCummins.com" is also suggestive of his overall intent to create a false impression of association with Complainant: by deleting "Conversions" from this name, Respondent intentionally crossed the line between the (possible) nominative fair use of Complainant's mark to unfairly impersonating Complainant. This intent is all the more apparent in that Domain Name redirects to <dieselconversion.com>, under which Respondent apparently operates. This undercuts any claim of rights or legitimate interests in the Domain Name Respondent may seek to suggest. The Panel further notes that the present transfer order has no impact on <dieselconversion.com>.

The Panel concludes that Complainant has established paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <fordcummins.com> be transferred to Complainant.

Robert A. Badgley
Presiding Panelist

Peter L. Michaelson
Panelist

Sir Ian Barker
Panelist
Date: August 27, 2015

¹ The small disclaimer in the footer of the website is unlikely to cure the false impression of association created by the Domain Name.