

ADMINISTRATIVE PANEL DECISION

TPI Holdings, Inc. v. Nikhil Jerath, Linxworks Solutions, LLC
Case No. D2016-1334

1. The Parties

The Complainant is TPI Holdings, Inc. of Norfolk, Virginia, United States of America (“United States”), represented by Kilpatrick Townsend & Stockton LLP, United States.

The Respondent is Nikhil Jerath, Linxworks Solutions, LLC of Los Angeles, California, United States.

2. The Domain Name and Registrar

The disputed domain name <equipmenttrader.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 30, 2016. On June 30, 2016, the Center transmitted to the Registrar, by email, a request for registrar verification in connection with the disputed domain name. On July 1, 2016, the Registrar transmitted to the Center, by email, its verification response confirming that the 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”), 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 and 4, the Center formally notified the Respondent of the Complaint and that the proceeding commenced on July 8, 2016. In accordance with the Rules, paragraph 5, the due date for Response was set to July 28, 2016. The Respondent did not submit any response. Accordingly, on July 29, 2016, the Center notified the parties of the Respondent’s default.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on August 3, 2016. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

As reflected in the registration record for the disputed domain name in the public Whois database (a copy of the record appears in Exhibit A to the Complaint), the disputed domain name <equipmenttrader.com> was registered on April 15, 1998 and is due to expire on April 14, 2017.

A. The Complainant's HEAVY EQUIPMENT TRADER Mark

As indicated in the Complaint, the Complainant owns a United States trademark registration for the words HEAVY EQUIPMENT TRADER. The Complainant has provided, in Exhibit D to the Complaint, a copy of its United States registration certificates for this mark, the details of which are:

HEAVY EQUIPMENT TRADER

United States Registration No.: 1,473,136
Registered: January 19, 1988; filed: June 11, 1987

This mark is registered for use in connection with: "Periodic magazines" in international class 16. The registration indicates that both first use of the mark in conjunction with these goods and first use in commerce commenced as of May 19, 1987.

The Complainant also has United States trademark registrations for other marks that include the words EQUIPMENT TRADER (copies of the corresponding registration certificates also appear in Exhibit D to the Complaint); however, none of the rights granted on these registrations predates the April 15, 1998 registration date of the disputed domain name. Thus, these additional registrations are irrelevant and will be ignored hereinafter.

B. The Parties' Activities

During 1974, if not earlier, the Complainant started distributing a periodic magazine throughout the United States under the mark AUTO TRADER. The magazine contained classified advertising for automobiles and information about goods and services related to automotive vehicles. In light of the success which the Complainant quickly achieved with its "Auto Trader" magazine, it soon expanded its magazine offering to include additional nationally distributed magazines directed to other vehicle- and equipment-related goods and services, with each magazine having as its mark a different vehicle-related term, indicative of the name of the goods and services to which that particular magazine was directed, followed by the term "trader", including "equipment trader", "heavy equipment trader", and "equipmenttraderonline.com". A copy of the front cover of a May 27, 1987 edition of "Heavy Equipment Trader" magazine appears in Exhibit E to the Complaint.

During 2000, if not earlier, the Complainant first began using its mark EQUIPMENT TRADER online, to disseminate information and advertising. A copy of early pages from the Complainant's website at <equipmenttraderonline.com> showing use of its mark EQUIPMENT TRADER appears in Exhibits F and G to the Complaint. Over the ensuing years, the Complainant's website at <equipmenttraderonline.com> has posted millions of ads, spanning over 35,000 different items of equipment, and had tens of millions of visitors with now tens of thousands of visitors per month.

Since 1987, the Complainant has expended over a million USD in marketing and promoting its goods and services under its marks that include the term "equipment trader", including under its mark HEAVY EQUIPMENT TRADER and has distributed millions of copies of its magazines under those marks nationwide.

The Respondent, which operates under the name Linxworks Solutions, LLC, uses the disputed domain name to divert Internet users to its own website at "www.usediron.com" through which the Respondent offers goods and services that are essentially identical to those offered by the Complainant through both its website

and its “Heavy Equipment Trader” magazine. A copy of the home page of the Respondent’s website appears in Exhibit H to the Complaint.

Through an e-mail dated April 20, 2016, the Complainant wrote to the Respondent concerning the disputed domain name. By its responding e-mail dated May 3, 2016 (a copy of which appears in Exhibit I to the Complaint), the Respondent stated it would need an additional week to consider the matter. Since then, the Complainant received no further communication from the Respondent.

5. Parties’ Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to its HEAVY EQUIPMENT TRADER Mark.

Specifically, the disputed domain name <equipmenttrader.com> simply deletes the generic term “heavy” from the mark, with this deletion being incapable of adding sufficient distinctiveness whatsoever to the disputed domain name to mitigate any resulting user confusion between that name and the Complainant’s mark.

Hence, 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 the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraphs 4(a)(ii) and 4(c) of the Policy.

Specifically, the Respondent is not affiliated or connected with the Complainant and has never been licensed or authorized to use the Complainant’s HEAVY EQUIPMENT TRADER mark or to register a domain name containing that mark or one similar to that mark for the goods and services through which the Complainant has registered and uses its mark.

Further, the Respondent is not commonly known by the name “Equipment Trader” and has not conducted any business under that name. In this regard, the Respondent’s company name is Linxworks, and the disputed domain name reverts to the Respondent’s company website through which equipment is being advertised for sale – constituting services identical to those offered by the Complainant under its HEAVY EQUIPMENT TRADER mark. Such a use, which relies on exploiting user confusion between the name and the Complainant’s mark is also not a *bona fide* offering of goods or services. Furthermore, such a use, which is purely commercial in nature, is neither a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain.

Consequently, the Respondent fails to satisfy any of specific paragraph 4(c)(i)-(iii) of the Policy, and thus has no rights or legitimate interests in the disputed domain name under paragraphs 4(a)(ii) and 4(c) of the Policy.

(iii) Registered and Used in Bad Faith

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

Specifically, the Respondent not only registered the disputed domain name, which is confusingly similar to the Complainant’s mark HEAVY EQUIPMENT TRADER, but willfully did so in spite of having knowledge of

the mark. The Respondent then deliberately used the name to opportunistically exploit the Complainant's mark and its reputation for the Respondent's own pecuniary gain. It accomplished that latter by using the name as a means to intentionally divert Internet users, who sought out the Complainant's website, to the Respondent's own website instead. There, the Respondent offered essentially the same goods and services through its own website which the Complainant did through both its own site and its "Heavy Equipment Trader" magazine, thereby diverting potential sales away from the Complainant and, in turn, injuring its business.

The Complainant also contends that the lack of any substantive response by the Respondent to the Complainant's communication of April 20, 2016 further reflects bad faith.

B. Respondent

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(f), 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 factual allegations which are not inherently implausible.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's HEAVY EQUIPMENT TRADER mark.

From a simple comparison of the disputed domain name to the Complainant's mark HEAVY EQUIPMENT TRADER, no doubt exists that the disputed domain name is confusingly similar to it. The name consists of the mark from which the generic word "heavy" has been deleted to yield the term "equipmenttrader" to which the generic Top-Level Domain ("gTLD") ".com" has been appended. The addition of the gTLD is irrelevant in this case in assessing confusing similarity or identity under paragraph 4(a)(i) 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 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, the Respondent's deletion from the Complainant's mark HEAVY EQUIPMENT TRADER of the generic word "heavy" clearly resulted in such a minor variation. See, e.g., *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill*, WIPO Case No. D2015-1842; *Cummins Inc. v. Jamie Lent*, WIPO Case No. D2015-0188; *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, WIPO Case No. D2013-1687; *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703; *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099; *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008; *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072; *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505; *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265; *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878; *BlackRock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627; *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359; *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064; *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case

No. D2007-0952; *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334; *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317; *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766; *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531; *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411; *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824; *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836; *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491; and *National Association of Professional Baseball Leagues, Inc., d/b/a Minor League Baseball v. John Zuccarini*, WIPO Case No. D2002-1011.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's mark. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize the Complainant's mark HEAVY EQUIPMENT TRADER or one confusingly similar, at least for the goods for which the Complainant has registered and uses the mark, nor does the Complainant have any relationship, affiliation or connection whatsoever with the Respondent.

This Panel finds, based on the record before it, that the Respondent, when it registered the disputed domain name, was likely well aware of the Complainant, its HEAVY EQUIPMENT TRADER Mark and the Complainant's exclusive rights in that mark, and the reputation of and the goodwill inherent in that mark. Yet, in spite of that knowledge, the Respondent intentionally registered the disputed domain name and uses it to redirect Internet users to its own website through which the Respondent offers essentially the same goods and services as does the Complainant through its both its own site and its HEAVY EQUIPMENT TRADER magazine. This use, which exploits confusion of Internet viewers to divert business to the Respondent and away from the Complainant to its financial detriment, is not a *bona fide* offering of goods or services under paragraph 4(c)(i) of the Policy.

The record before the Panel is simply devoid of any evidence which proves that the Respondent actually acquired any recognition in the marketplace to become commonly known by the disputed domain name or a name similar to it. Given the exclusive trademark rights that reside in the Complainant and the reputation now inherent in its HEAVY EQUIPMENT TRADER mark both through registration and prior use, the Respondent could not legitimately acquire any public association between itself and the Complainant's mark or even any mark similar thereto, at least for the goods and services provided by the Complainant under its mark. This is so in light of the Complainant's exclusive trademark rights which predate by some 11 years the date, April 15, 1998, when the Respondent registered the disputed domain name. See, e.g., *Dubizzle Limited BVI v. Rana Anabtawi*, WIPO Case No. D2016-0843; *Philip Morris USA Inc. v. Daniele Kanai, iKiss LLC*, WIPO Case No. D2015-1527; *Valero Energy Corporation and Valero Marketing and Supply Company v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID: 62520014085963*, WIPO Case No. D2015-0787; and *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill, Cummins Inc. v. Jamie Lent, Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen, Forideas Pty Limited v. Movember Organization, and National Westminster Bank plc v. Steve Mart, supra*, all *supra*. As such, the Respondent could not likely become commonly known by the disputed domain name or the Complainant's mark for any of the goods which are either identical or sufficiently similar to those listed on the Complainant's trademark registration or with which the Complainant uses its mark without infringing on the exclusive trademark rights of the Complainant. Hence, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Lastly, the Respondent's use of the disputed domain name clearly does not constitute either a noncommercial or fair use under paragraph 4(c)(iii) of the Policy.

As such, based on the evidence presently before the Panel, the Respondent does not fall within any of the circumstances listed in paragraph 4(c)(i)-(iii) of the Policy. Also, there is simply no evidence that the Respondent has acquired, through any other means, any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel concludes 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 finds on balance that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

The Panel infers, particularly from the lack of any Response, that it is likely that the Respondent was well aware of the Complainant, its reputation and its HEAVY EQUIPMENT TRADER mark and the exclusive rights which the Complainant then had in that mark when the Respondent registered the disputed domain name. Yet, in spite of that knowledge and in the absence of any authority to do so from the Complainant, the Respondent intentionally chose and registered the disputed domain name for its potential to cause confusion with that mark. In that regard, the Respondent very likely believed that Internet users, who sought the Complainant's website and were familiar with the Complainant's mark would be confused, upon entering the name into their browsers, by the similarity between the name and the mark, and consequently assume that a relationship of some sort exists, possibly a sponsorship, affiliation or endorsement of the Respondent's website by the Complainant, when, in fact, no such relationship exists at all. To actually exploit that confusion, the Respondent deliberately uses the name to redirect Internet traffic to its own website through which it offers goods and services that are essentially identical to those currently offered by the Complainant both through its "Heavy Equipment Trader" magazine and its website. Doing so likely diverts Internet traffic away from the Complainant's website, for which that traffic was otherwise destined, to the Respondent's website instead and consequently deprives the Complainant of resulting business, that would have arisen from that traffic, to its ultimate financial detriment. This conduct is a clear violation of paragraph 4(b)(iv) of the Policy.

In addition, the Panel again notes that the Respondent did not submit a response in this case.

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

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant. The disputed domain name <equipmenttrader.com> is to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: August 16, 2016