



NATIONAL
ARBITRATION
FORUM

DECISION

Batesville Services, Inc. and Batesville Casket Company, Inc. v.
All County Funeral Home
Claim Number: FA0406000289006

PARTIES

Complainant is **Batesville Services, Inc. and Batesville Casket Co., Inc.** (“Complainant”), represented by **Erin Roth Bohannon**, of **Barnes & Thornburg**, 11 South Meridian Street, Indianapolis, IN 46204. Respondent is **All County Funeral Home** (“Respondent”), 1107 Lake Ave., Lake Worth, FL 33460.

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are <**batesvillecasket.com**> and <**batesvillecaskets.com**>, registered with **Network Solutions, Inc.**

PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Mr. Peter L. Michaelson, Esq. as Presiding Panelist, and Hon. Tyrus R. Atkinson and Hon. Daniel B. Banks, Jr. (Ret.) as Co-Panelists.

PROCEDURAL HISTORY

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (“Policy”), available at <icann.org/services/udrp/udrp-policy-24oct99.htm>, 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 ICANN Rules for Uniform Domain Name Dispute Resolution Policy (“Rules”) as approved on October 24, 1999, as supplemented by the National Arbitration Forum Supplemental Rules for Uniform Domain Name Dispute Resolution Policy then in effect (“Supplemental Rules”).

The Complainants submitted a Complaint to the National Arbitration Forum (the "Forum") electronically on June 22, 2004; the Forum received a hard copy of the Complaint, together with Exhibits A-D, on June 24, 2004. On June 25, 2004 and at the Forum's request, the Complainants slightly amended the Complaint.

On June 24, 2004, the Registrar, Network Solutions, Inc. (NSI), confirmed by e-mail to the Forum that the domain names <batesvillecasket.com> and <batesvillecaskets.com> are registered with NSI and that the Respondent is the current registrant of both names. NSI has verified that the Respondent is bound by the NSI 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 June 28, 2004, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of July 19, 2004 by which could file a Response to the Complaint, was transmitted to the 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@batesvillecasket.com and postmaster@batesvillecaskets.com by e-mail.

A timely Response, together with Exhibits A-I, was received and determined to be complete on July 19, 2004.

Subsequently and pursuant to Supplemental Rule 7, the Complainants timely filed an additional submission, together with Exhibits E-N, on July 26, 2004.

Thereafter and also pursuant to Supplemental Rule 7, the Respondent timely an additional submission, together with Exhibits A-G, on August 2, 2004.

On August 5, 2004, pursuant to the Respondent's request to have the dispute decided by a three-member panel, the Forum appointed Mr. Peter L. Michaelson, Esq. as Presiding Panelist and Hon. Tyrus R. Atkinson and Hon. Daniel B. Banks (Ret.) as Co-Panelists and set a due date of August 19, 2004 to receive the decision from the Panel.

On August 17, 2004 and owing to unforeseen and exceptional circumstances, the Panel extended the due date for the decision by two weeks to September 2, 2004.

RELIEF SOUGHT

The Complainants request that the disputed domain names be transferred from the Respondent to the Complainants.

PARTIES' CONTENTIONS

A. Complainants

1. Confusing similarity/identity

Though Complainants do not expressly address this issue in the Complaint (however they did so in their Additional Submission), it is clearly implicit in the Complaint that Complainants contend that each of the disputed domain names is identical or confusingly similar to Complainants' registered "BATESVILLE" mark inasmuch as each name incorporates that mark in its entirety.

Hence, the Panel infers that Complainants believe that the requirements of paragraph 4(a)(i) of the Policy are satisfied with respect to each of the two disputed domain names.

2. Rights and legitimate interests

Complainants contend that Respondent has no rights or legitimate interests in either of the disputed domain names under paragraph 4(c) of the Policy.

Specifically, Complainants state that the Respondent has no license, either oral or written, to use the Complainants' marks, and hence has no trademark or other intellectual property rights in the terms "BATESVILLE," "BATESVILLECASKETS," or "BATESVILLECASKET."

3. Bad faith use and registration

Complainants contend that Respondent has registered and is using both of the disputed domain names in bad faith, hence in violation of paragraph 4(b) of the Policy.

First, Complainants contend that Respondent directed Internet traffic, meant for at least one of the disputed domain names, to a web site that featured pornography.

Further, Respondent used each of the disputed domain names, without Complainants' permission, to sell Respondent's funeral home and crematory products and services via the Internet. Respondent purchases, for resale and from Complainants, branded caskets that carry the Complainants' registered mark. However, the Respondent's goods and services, with which it is using Complainants' mark, extend beyond sale of just Complainants' branded caskets. Accordingly, Complainants contend that Respondent, by using the disputed domain names in this fashion, is intentionally attempting to attract, for commercial gain, Internet users to its web sites by creating a likelihood of confusion with Complainants' registered BATESVILLE mark, as to the source, sponsorship, affiliation or endorsement of its web sites and the products offered thereon. A hard-copy printout of

Respondent's home page resolvable through each of the disputed domain names appears in Exhibit C to the Complaint.

Also, Complainants state that they have not granted Respondent the right to use their registered BATESVILLE mark in a domain name for any purpose, including Respondent's use in connection with the sale of Respondent's funeral home and crematory products and services. Furthermore, Complainants state that they have informed Respondent of their objections to the latter's use of the disputed domain names.

Lastly, Complainants contend that since Respondent knows that Complainants own the registered BATESVILLE mark for use with the sale of Complainants' burial caskets, then, a priori, Respondent's registration of the disputed domain names had to be done primarily for the purpose of disrupting Complainants' business.

Hence, Complainants conclude that Respondent's actions in registering and using the disputed domain name is in bad faith and contravenes paragraph 4(b) of the Policy.

B. Respondent

1. Confusing similarity/identity

Respondent contends that neither of the disputed domain names is identical or confusingly similar to Complainants' registered BATESVILLE mark.

In that regard, Respondent asserts that adding the words "CASKET" and "CASKETS" to Complainants' registered mark to form the disputed domain names sufficiently differentiates that mark from either of these names to ostensibly dispel any confusion.

2. Rights and legitimate interests

In stark contrast to Complainants' view, Respondent contends that, under paragraph 4(a)(ii) of the Policy, it has rights and legitimate interests in both of the disputed domain names.

Specifically, Respondent states that it has a license not only to use Complainants' registered mark, but also to use that mark in conjunction with certain products, images and text as specified in Complainants' license agreement ("License Agreement") (a copy of which appears in Exhibit D to the Response) and in Complainants' Marketing Material Usage Policy ("Sales Policy") (a copy of which appears in Exhibit E to the Response). Respondent states that the agreement allows it to use Complainants' mark in advertising and on Respondent's Internet web site. Moreover, Respondent contends that the License Agreement does not restrict the use of Complainants' registered mark within a domain name. In support of his view, Respondent points to three e-mails (a copy of which appear in Exhibit F to the Response) between Complainants' representative and Respondent and which date back to April 24, 2001. The Panel observes that these e-mails are directed to:

a procedure for Respondent to use in accessing various digital pictures provided by Complainants to its customers ostensibly for the latter's use in marketing Complainants' caskets; Respondent's login procedures to access a limited-access area on Complainants' web site; and providing an ID and password for Respondent to use in accessing Complainants' on-line product catalog, and the provision of on-line order e-mail confirmation messages.

Further, Respondent contends that, prior to its receipt of any notice of the dispute, it was offering for sale its services along with Complainants' goods. Also, Respondent states that it is an authorized re-seller of Complainants' caskets.

Lastly, Respondent asserts, as corrected by its Supplemental Submission and as understood by the Panel, that the disputed domain names provide a commonly used vehicle through which Internet users, employing, for example, the Google search engine, can readily access Respondent's web site.

3. Bad faith use and registration

Respondent contends that it did not register and use either of the disputed domain names in bad faith.

First, Respondent states that, as to Complainants' allegation that Respondent used the disputed domain names to divert Internet users to a web site that featured pornography: "Unless, Complainant views caskets being displayed without their protective plastic coverings as being 'naked', then Respondent has not and will not ever direct either of the disputed names to a site featuring pornography'."

In addition, Respondent contends that by virtue of its License Agreement with Complainants, Respondent is using Complainants' registered mark in conjunction with a bona-fide offering of goods and services. Moreover, Complainants' customer base consists of funeral homes, and at no time has Respondent misleadingly diverted or tried to divert funeral homes (which are Complainants' customers) away from Complainants or to tarnish Complainants' mark, nor has Respondent disrupted Complainants' business.

Also, Respondent states that it has not engaged in any conduct, nor have Complainants shown any indication of Respondent having either registered or acquired either of the disputed domain names:

- (a) primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to Complainants;
- (b) to prevent Complainants, as owner of a registered trademark or service mark, from reflecting the mark in a corresponding domain name;
- (c) to disrupt the business of a competitor, i.e., Complainants here; or
- (d) to intentionally attempted to attract, for commercial gain, Internet users to Respondent's web site or other on-line location by creating a likelihood of confusion with Complainants' registered mark. Specifically, Complainants' License Agreement and

Batesville's Marketing Material Usage Policy grant permission to the Respondent for it to include Complainants' registered mark in Respondent's Internet web site. Respondent contends that "there is no confusion as authorized re-sellers (funeral homes) know how to contact the Complainant via the telephone and/or web site name BATESVILLE.COM. The trademark is used in an attempt to describe the product being marketed by the Respondent for the Complainant."

C. Additional Submissions

Inasmuch as both Complainants and Respondent timely filed their respective additional submissions, the Panel has fully considered both of these submissions.

1. Complainants' Additional Submission

a. Confusing similarity/identity

Complainants specifically contend that each of the disputed domain names is identical or confusingly similar to a trademark or service mark in which Complainants have rights. In essence, Complainants assert that appending the generic terms "casket" or "caskets" to Complainants' "BATESVILLE" mark to form the disputed domain names does not differentiate the resulting names from the mark to sufficiently ameliorate any resulting confusion.

b. Rights and legitimate interests

Complainants advance the following arguments to counter Respondent's position that the latter has rights and legitimate interests in both domain names.

First and to amplify their prior position, Complainants state that despite Respondent's contractual relationship with Complainants as reseller of Complainants' burial caskets, Complainants have never licensed nor authorized Respondent to use Complainants' registered mark in any domain name. In particular, the License Agreement grants Respondent "a non-exclusive, non-transferable limited license to...use the [Complainants'] Trademarks...in advertising to promote the sale of Batesville products ('Advertising')." However, all of Respondent's "Advertising," must be reviewed and approved by Complainant Batesville Services, Inc. [See Response, Exhibit D, para. 5] Since "Advertising" includes any type of promotion of Batesville products for sale, Respondent's use of Complainants' "BATESVILLE" mark in its web site seeking to sell the Complainants' burial caskets and Respondent's services collectively constitute "Advertising." Accordingly, Respondent was required to seek approval for use of Complainants' mark in the disputed domain names. Complainants assert that: (a) Respondent did not do so, and (b) Complainants never approved of Respondent's use of those names. Indeed, Complainants contend that their filing of the Complaint evidences Complainants' objection to Respondent's use of the mark "BATESVILLE" in the disputed domain names. Furthermore, Complainants state that Respondent and

Complainants have not entered into any other agreement that would allow Respondent to use Complainants' "BATESVILLE" mark in any domain name.

Further, since Complainants have never agreed to allow Respondent to use their registered marks in the disputed domain names, Respondent cannot retain those domain names. The fact that Respondent is a re-seller of Complainants' goods does not, in and of itself, authorize or permit Respondent to use Complainants' mark in those names.

Complainants then state that without evidence that Complainants specifically allowed Respondent to use Complainants' registered mark in a domain name, Respondent bears the burden of demonstrating its rights and legitimate interests in those names. Complainants assert that Respondent has simply not met this burden. In that regard and illustratively, Complainants contend, that pursuant to paragraph 4(c)(i) of the Policy, Respondent has no rights or legitimate interests in the domain names because Respondent's use of either of the domain names does not occur in conjunction with a bona fide offering of Complainants' goods (burial caskets). Complainants cite to *Oki Data Americas, Inc. v. ASD Inc.*, Case No. D2001-0903 (WIPO Nov. 6, 2001) wherein the panel held: an authorized re-seller's or licensee's use of a domain name in connection with the sale of the licensor's products is only deemed to be "use in conjunction with a bona fide offering of goods or services" if Respondent is: (1) actually selling the goods or services at issue; (2) selling only Complainants' products on the web site in question; (3) accurately disclosing the relationship between Complainant and the Respondent; and (4) not attempting to corner the market in all domain names incorporating Complainants' mark and thereby prevent Complainant from reflecting its mark in its own domain name. Under this test, Respondent's use of the disputed names is not in conjunction with a bona fide offering of Complainants' goods, because Respondent is selling not only the Complainants' products on Respondent's web site but also, as admitted by Respondent in its Response, Respondent's own services (e.g., burial and crematory).

Furthermore, as to whether Respondent is commonly known by the disputed domain names, Complainants point to a search made through the corporate records of the state of Florida which indicates that the registered business name of Respondent is "All County Funeral Home & Crematory Gold Coast Chapel Inc." (a copy of the search results appears in Exhibit G to the Complainants' Additional Submission).

In addition, a newspaper article (a copy of which appears in Exhibit H of Complainants' Additional Submission) posted to Respondent's web site and attached to the Response, refers to Respondent as "All County Funeral Home" and lists Respondent's web address as <www.allcounty.com>. Moreover, Respondent lists itself in telephone directories as "All County Funeral Home," but not through either one of the disputed domain names (copies of search results from on-line telephone directory switchboard.com appears in Exhibit I to the Complainants' Additional Submission). Further, a search using the Internet search engine Google for the names BATESVILLECASKETS.COM and BATESVILLECASKET.COM did not reveal that Respondent is commonly known by

either of these names (a copy of those search results appears in Exhibit J to the Complainants' Additional Submission).

Finally, Complainant asserts that Respondent's use of the domain names, as admitted by Respondent in its Response, is not for legitimate noncommercial or fair use without intent for commercial gain. In that regard, Respondent's use of the domain names is for commercial purposes.

Accordingly, the Complainants conclude that the Respondent cannot demonstrate that it meets any of the circumstances listed in Paragraphs 4(c)(i)-(iii) of the Policy and as such has not and cannot demonstrate that it has rights or legitimate interests in respect of either of the disputed domain names.

c. Bad faith use and registration

Complainants further argue that Respondent has registered and is using both domain names in bad faith.

First, Complainants assert, pursuant to Paragraph 4(b)(iii) of the Policy, that Respondent registered the domain names primarily for the purpose of disrupting the business of Complainant. In that regard, Respondent knows that Complainants license other entities to sell their burial caskets, each of which are granted rights to sell those caskets with, at least, use of the BATESVILLE mark, as evidenced by, e.g., the terms of the License Agreement and the Sales Policy. Further, Respondent knows that, as a licensee of Complainants and as an authorized re-seller of Complainants' burial caskets, Respondent's use of Complainants' registered mark is restricted to the terms of the License Agreement. The License Agreement is a non-exclusive license and limits, through paragraph 5 thereof, Respondent's use of Complainants' trademarks to only those uses approved by Complainant, Batesville Services, Inc. In addition, the License Agreement prohibits licensees from using Complainants' trademarks "for price comparisons...with competitor's products." Nevertheless, Respondent is using the domain names in violation of the License Agreement because: (a) Respondent did not secure approval of its use of Complainants' mark BATESVILLE in those names, and (b) Respondent uses those names to resolve to Respondent's website where Respondent declares, in part, that it is the "Low Cost Leader when it comes to merchandise" on a web page that displays Complainants' burial caskets (a hard-copy printout of various pages from that site appear in Exhibit K of Complainants' Additional Submission). Hence, Complainants conclude that such registration and use of the domain names disrupts Complainants' business and the business of Complainants' other licensees/authorized re-sellers.

Second, Complainants assert, pursuant to Paragraph 4(b)(iv) of the Policy, that Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with Complainants' mark as to the source, sponsorship, affiliation or endorsement of Respondent's website or location of a product or service on its website or location.

Specifically, Respondent is using the disputed domain names, which are confusingly similar to Complainants' BATESVILLE mark, to sell Respondent's funeral home crematory products and services, including products and services not sponsored by, endorsed by or affiliated with Complainants.

Complainants state that they have not granted Respondent any rights to use the BATESVILLE mark in a domain name to sell Respondent's products and services. Complainants have granted Respondent limited rights to use Complainants' mark, as described in the License Agreement and Sales Policy, to sell Complainants' burial caskets. These rights do not extend to Respondent's use of that mark within a domain name, without permission and approval from Complainant, Batesville Services, Inc., or to Respondent's use of the mark to sell Respondent's products and services other than Complainants' burial caskets. Despite this, Respondent has registered and is using the names to sell products and services other than Complainants' burial caskets. In that regard, Respondent uses the domain names to direct Internet users to its home page, which lists its crematory and chapel locations (hard-copy printouts of Respondent's web site appear in Exhibits L and M of Complainants' Additional Submission). Specifically, upon clicking on the "HOME" link on Respondent's web site pages, an Internet user is directed to a web page (a hard-copy of which appears in Exhibit N to the Complainants' Additional Submission) that lists the prices for particular funeral services (e.g., "\$325 Simple Cremation" and "\$980 Cremation with Viewing/Service") and states that Respondent offers "Payment Plans" and "Financing Available." Hence, Complainants assert that Respondent uses the disputed domain names, which are confusingly similar to Complainants' mark, to attract Internet users to all of Respondent's web site pages, not just to the home page directly resolvable through each of the domain names.

Lastly, Complainants do not sponsor, endorse or affiliate themselves with Respondent's website. Respondent has created a likelihood of confusion with the Complainants' mark as to the source, sponsorship, affiliation or endorsement of Respondent's non-BATESVILLE products and services that Respondent offers for sale on its web site through which Respondent intentionally attempts to attract, for commercial gain, Internet users to its web site to sell its goods and services.

2. Respondent's Additional Submission

a. Confusing similarity/identity

Respondent re-iterates its position that adding the words "CASKET" and "CASKETS" to Complainants' registered mark to form the disputed domain names sufficiently differentiates the mark from either of these names.

b. Rights and legitimate interests

Respondent asserts that Complainants' License Agreement specifically grants Respondent the right to use Complainants' marks solely in advertising used to promote the sale of

Complainants' products. The license specifically states that Respondent may use the trademark in conjunction with websites. Furthermore, there are no restrictions as to the use of the trademark in the disputed domain names.

Further, Respondent contends that it is using Complainants' mark in conjunction with a bona-fide offering of the goods and services and as permitted by Complainants. In that regard, Respondent points to Complainants' marketing and usage policy as specified in: (a) a letter dated July 2, 2004 from Complainants to Respondent; (b) the "Batesville Casket Company, Inc., Sales Policy"; and (c) Complainants' "Sale Manual" (copies of which appear in Exhibits B, C and D, respectively, of Respondents' Additional Submission) -- with which Respondent is in full compliance. Respondent contends that, if it were not so compliant, then Complainants would have found Respondent to be in "breach of contract," therefore, terminating Respondent's right to sell Complainants' caskets. To date, Complainants and Respondent still conduct business together.

Respondent views Complainants as asserting that all of Respondent's advertising must be reviewed and approved by Complainants, and since advertising includes any type of promotion of Complainants' products for sale, Respondent's use of the "Batesville" mark in its website, through which Respondent seeks to sell Complainants' caskets and Respondent's services, constitutes advertising. As such, Respondent was required to seek approval for the use of the trademark and domain names. Paragraph 5 of the License Agreement expressly states: "Batesville reserves the right to review and approve the advertising upon written notice". However, Respondent has received no such notice to date nor have Complainants provided such as an exhibit.

c. Bad faith use and registration

Respondent, in furtherance of its assertion that it has neither registered nor used the disputed domain names in bad faith, provided the following arguments.

First, Respondent points to an e-mail dated April 15, 2002 from Joe Weigel, Director of Communication for Batesville Casket Company (a copy of which appears in Exhibit E to Respondent's Additional Submission), which states:

"Dear Vince, according to network solution, you are the owner of www.batesvillecasket.com and www.batesvillecaskets.com. What are your long term plans for these web sites?"

to which Respondent replied later that day:

"Joe, at some point I was planning on establishing a web site and using the [the] sites. What were you thinking, concerning the sites, please let me know. Vince".

Respondent views these e-mails as evidencing that it did not register the disputed domain names in bad faith and in fact, through Complainants' inclusion of the phrase "long term plans," reflected Complainants' tacit approval of Respondent's registrations.

Respondent states that it has contracted with Complainants to exclusively sell Complainants' caskets and strictly adhered to Complainants' sales and marketing policies which require Respondent to be "a full service funeral provider offering to prepare and care for the deceased human body for burial, cremation, or other final disposition."

Furthermore, Respondent states that its website accurately discloses the relationship between Complainants and Respondent by stating that Respondent is an "authorized reseller of Batesville caskets". Respondent's web site also provides a link to Complainants' website, as allowed by the Batesville Casket Company Link Statement [a copy of which appears in Exhibit F to the Respondent's Additional Submission].

Moreover, Respondent states that it does not use Complainants' mark to promote or sell caskets manufactured by Complainants' competition; hence, Respondent is not disrupting either Complainants' business or for that matter Respondent's competition. In that regard, Complainant has offered no proof of any such disruption. Lastly, as to Complainants' allegations that Respondent, in offering price information on its website, is violating the License Agreement, Respondent simply states that he Complainants' License Agreement does not restrict the price at which Respondent re-sells the Complainants' caskets.

FINDINGS

A copy of the WhoIs registration record for each the disputed domain name appears in Exhibit A to the Complaint and Exhibit C to the Response. These records indicate that Respondent registered <**BATESVILLECASKETS.COM**> on May 15, 1999 and <**BATESVILLECASKET.COM**> on June 4, 1999.

A. Complainants' BATESVILLE Marks

Complainants currently own two federal trademark registrations for the term "BATESVILLE," and have provided, in Exhibit B to the Complaint, a copy of the pertinent record of each mark from the Trademark Electronic Search System (TESS) which is provided by the United States Patent and Trademark Office (USPTO) and is accessible through the Internet. The pertinent details are as follows:

1. **BATESVILLE** (stylized)
registration: 1,259,446; registered: November 29, 1983
section 8/15 affidavit filed
registration renewed: June 6, 2003
serial number: 73/302,661; filed: March 25, 1981

This mark was registered for use in connection with: "burial caskets " in international class 20. This mark claims a first use and first use in commerce date of August 31, 1980.

2. **BATESVILLE** (block letters)

registration: 1,347,930; registered: July 9, 1985
section 8/15 affidavit filed
serial number: 73/494,377; filed: August 10, 1984

This mark was registered for use in connection with: "burial caskets " in international class 20. This mark claims a first use and first use in commerce date of December 31, 1969.

B. Complainants' and Respondent's Activities

Complainant, Batesville Casket Company, Inc., engages in the business of, inter alia, manufacturing and selling burial caskets. It sells those caskets under its registered mark BATESVILLE and has been doing so since December 31, 1969. Complainant, Batesville Services, Inc., owns the BATESVILLE marks and has licensed those marks to Complainant, Batesville Casket Company, Inc.

Complainants have used their registered marks to the exclusion of others, in connection with the sale of burial caskets, for over thirty years and have devoted significant resources to advertising their products in connection with those marks. As such, those marks have acquired distinctiveness in the marketplace. Complainant Batesville Casket Company, Inc. is a significant supplier of burial caskets in the United States and has established itself as a leader in the burial casket market.

Respondent is Florida's largest funeral provider. Respondent provides both Complainants' branded burial caskets as well as Respondent's own services at drastically reduced prices relative to others in the markets which Respondent serves. Respondent provides its goods and services through various marketing channels, including the Internet. In doing so and by virtue of its attractive pricing, Respondent has become extremely successful.

Complainants and Respondent have enjoyed a mutually beneficial business relationship since 1987. In that regard, Respondent has a contract with Complainants which requires that Respondent only sell Complainants' caskets and no other. Complainants distribute their caskets on a wholesale basis to those funeral homes which are its authorized re-sellers, of which Respondent is one. Both Complainants and Respondent continue to have a working relationship through which Respondent continues to sell only Complainants' caskets.

The License Agreement currently in effect between Complainants and Respondent which governs Respondent's use of, inter alia, Complainants' BATESVILLE marks contains the following provisions, in pertinent part:

"By this letter, Batesville Services, Inc. ('Batesville') agrees to provide to you or to your company ... the use of Trademarks as defined in the attached Exhibit ... for your use in advertising to promote the sale of Batesville products ('Advertising').

The Advertising may include print media or electronic media, such as radio, video, television, CD ROMS, electronic catalogues, displayed on a screen display of a stand-alone computer, on a computer networked only within your facility, or on your Internet web site.

...

1. License: Batesville grants to you ... a non-exclusive, non-transferable license to ... use the Trademarks solely as Advertising used to promote the sale of Batesville products.

...

4. Termination: If any terms or conditions of this Agreement are violated by you, Batesville may terminate this Agreement and the license herein by giving five (5) days prior written notice to you. ...

5. Reservation of right to Review and Approve: ... Batesville reserves the right to review and approve the Advertising upon written notice to you. Upon receipt of the written notice, you shall provide to Batesville copies of the requested Advertising. Should Batesville not approve of the Advertising, the Advertising shall, at the discretion of Batesville, be modified according to Batesville's instruction ... and Trademarks shall be withdrawn from use."

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; and
- (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, merely focusing on the domain names and Complainants' registered marks, finds that confusion is likely to arise as a result of Respondent's use of either of the two disputed domain names.

Specifically, the Panel finds that the terms "casket" and "caskets" are simply generic terms, each of which adds absolutely no distinctive element to either of the disputed domain names, let alone of any magnitude sufficient to distinguish that name from Complainants' BATESVILLE marks and thus, in and of itself, preclude user confusion.

See, e.g., Register.com, Inc. v. Wolfgang Reile et al FA208576 (Nat. Arb. Forum January 27, 2004); *Cable News Network LP, LLP v. Khouri*, FA 117876 (Nat. Arb. Forum Dec. 16, 2002); *Pfizer Inc. v. Order Viagra Online*, D2002-0366 (WIPO July 11, 2002); *Dell Computer Corp. v. MTO C.A.*, D2002-0363 (WIPO July 5, 2002); *Am. Online, Inc. v. Woods*, D2001-0555 (WIPO June 13, 2001); *Dell Computer Corp. v. Logo Excellence*, D2001-0361 (WIPO May 7, 2001); and *Quixtar Invs., Inc. v. Hoffman*, D2000-0253 (WIPO May 29, 2000).

Such confusion -- were it to arise -- would undoubtedly cause Internet users intending to access Complainants' website, but who reach a website through either of the disputed domain names, to think that an affiliation of some sort exists between Complainants and Respondent, when, in fact, no such relationship would exist at all. *See, also, e.g., Caesars World, Inc. v. Japan Nippon*, D2003-0615 (WIPO Sept. 30, 2003); *Leiner Health Servs. Corp. v. ESJ Nutritional Prods.*, FA 173362 (Nat. Arb. Forum Sept. 16, 2003); *Am. Family Life Assurance Co. of Columbus v. defaultdata.com*, FA 123896 (Nat. Arb. Forum Oct. 14, 2002); *AT&T Corp. v. Abreu*, D2002-0605 (WIPO Sept. 11, 2002); *Pfizer Inc., supra; L.F.P., Inc. v. B and J Props.*, FA 109697 (Nat. Arb. Forum May 30, 2002); *Frampton v. Frampton Enters., Inc.*, D2002-0141 (WIPO Apr. 17, 2002); *Spence-Chapin Servs. to Families and Children v. Wynman*, FA 100492 (Nat. Arb. Forum Dec. 10, 2001); *MPL Commun. v. LOVEARTH.net, supra; Meijer, Inc. v. Porksandwich Web Servs.*, FA 97186 (Nat. Arb. Forum July 6, 2001); *MPL Commun. v. IWebAddress.com*, FA 97092 (Nat. Arb. Forum June 4, 2001); *Am. Home Prods. Corp. v. Malgioglio*, D2000-1602 (WIPO Feb. 19, 2001); *Surface Prot. Indus., Inc. v. Webposters*, D2000-1613 (WIPO Feb. 5, 2001); *Dollar Fin. Group, Inc. v. VQM NET*, FA 96101 (Nat. Arb. Forum Jan. 25, 2001); *eBAY Inc. v. G L Liadis Computing, Ltd.*, D2000-1463 (WIPO Jan. 10, 2001); *Treeforms, Inc. v. Cayne Indus. Sales Corp.*, FA 95856 (Nat. Arb. Forum Dec. 18, 2000); *see also Pep Boys Manny, Moe and Jack of CA v. E-Commerce Today, Ltd.*, AF-0145 (eResolution May 3, 2000).

Therefore, the Panel finds that each of the two disputed domain names sufficiently resembles Complainants' BATESVILLE mark as to cause confusion; hence, Complainant has shown sufficient similarity between its marks and both of the disputed domain names under paragraph 4(a)(i) of the Policy.

Rights or Legitimate Interests

The Panel finds that Respondent has rights and legitimate interests in both of the disputed domain names.

Specifically, the License Agreement between the parties broadly defines "Advertising" as "may include print media or electronic media, such as radio, video, television, CD ROMS, electronic catalogues, displayed on a screen display of a stand-alone computer, on a computer networked only within your facility, or on your Internet web site" [emphasis added]. This list, being prefaced by the words "may include," is not exclusive.

Consequently, the Panel finds that the "Advertising," as defined under the agreement through a list of examples, is ambiguous by omission. The list is simply silent as to whether Respondent can use Complainants' BATESVILLE mark as part of Respondent's own domain names to resolve to its own web site through which Respondent will advertise both Complainants' goods and its own services -- as it has done so here. It is certainly reasonable given the broad nature of the list and its specific inclusion of Internet channels to infer, as Respondent attempts to do, from the "may include" language that such use is included and permitted. However, one need not resort to such inferences.

In the Panel's mind, Complainants simply resolved the ambiguity by reserving for themselves the right to review and approve of the Respondent's advertising. Paragraph 5 of the License Agreement states, in pertinent part: "*As such, Batesville reserves the right to review and approve the Advertising upon written notice to you. Upon receipt of the written notice, you shall provide to Batesville copies of the requested Advertising. Should Batesville not approve of the Advertising, the Advertising shall, at the discretion of Batesville, be modified according to Batesville's instruction or the Works and Trademarks shall be withdrawn from use.*" [emphasis added].

The Panel fails to see anywhere in the record before us where Complainants, having an affirmative duty under the reservation clause quoted above, expressly notified Respondent that they wanted to review Respondent's use of the disputed domain names and the content of the web site to which those names resolve. In that regard, all that exists in the record is an e-mail dated April 13, 2002 -- more than 2 years prior to the filing of the Complaint -- where Complainants inquired about Respondent's use of the disputed domain names. Respondent replied that it was then planning to establish a web site, presumably resolvable through those names. Complainants said nothing further until they filed the present Complaint over 2 years later. Hence, Complainants, if they truly objected to Respondent's registration of the disputed domain names, had a duty to undertake specific affirmative action, i.e., (a) to provide notice that they wanted to review and approve or object to the Respondent's planned site, and (b) to then actually review the intended content and either approve or object to it. Complainants simply failed to do so. Complainants knew about Respondent's use of the disputed names for over 2 years and at no instance during that time -- certainly after Respondent's web site became operational -- made any request to review and approve or disapprove the site content and use of the names. Therefore, Complainants simply acquiesced to Respondent's "advertising," i.e., which included its registration and use of the disputed domain names. Respondent is entitled to rely on that acquiescence as otherwise, after some 2 years, it would be patently unfair to Respondent for it to now be stripped of those names -- to its ultimate detriment.

Therefore, Respondent has sufficiently demonstrated that it has rights and legitimate interests in both of the disputed domain names, and, as such, has met the requirements of paragraph 4(c) of the Policy.

Registration and Use in Bad Faith

In view of the Panel's finding that Respondent has rights and legitimate interests in both of the disputed domain names, all issues of bad faith use and registration under paragraph 4(a)(iii) of the Policy are now moot. Consequently, the Panel has no need to consider any of these issues and thus declines to do so.

Hence, the Complainants have failed to meet their burden under paragraph 4(a) of the Policy.

DECISION

Consequently and in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the relief sought by the Complainants is hereby **DENIED**.

Peter L. Michaelson, Esq., Presiding Panelist
Dated: August 23, 2004

Hon. Tyrus R. Atkinson, Co-panelist

Hon. Daniel B. Banks (Ret.), Co-panelist