



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Surface Protection Industries, Inc.

v.

The Webposters a/k/a Mark's Paint Store, Inc.

Case No. D2000-1613

1. The Parties

The Complainant is Surface Protection Industries, Inc., a corporation of the State of California, 3411 E. 15th Street, Los Angeles, California 90023, USA.

The Respondent is The Webposters (a/k/a Mark's Paint Store, Inc.), P. O. Box 4278, North Hollywood, California 91617, USA. The administrative contact for the Respondent is Mr. Mike Umann, Mark's Paint Store, 4830 Vineland Avenue, North Hollywood, California 91601, USA.

2. The Domain Name and Registrar

Contested Domain Name: <mannbrothers.com>

The Registrar is Network Solutions, Inc. (NSI), 505 Huntmar Drive, Herndon, Virginia 20170, USA.

3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy ("Policy"), which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999 and approved on October 24, 1999 and in accordance with the ICANN Rules for Uniform Domain Name Dispute Resolution Policy ("Rules") as approved on October 24, 1999 as supplemented by the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999 ("Supplemental Rules").

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") by e-mail on November 21, 2000 and in hard copy, with Annexes A-D, as well as the appropriate payment on November 23, 2000. The Complainant's attorneys, Ms. Janet A. Marvel and Ms. Nerissa Coyle McGinn, state that on November 20, 2000 they served a copy of the Complaint on the Respondent, by overnight courier, facsimile and email and, in accordance with the methods set forth in paragraph 3(b)(xii) of the

Rules; and, on the same date, also provided a copy of the Complaint to the Registrar, NSI.

The Center acknowledged receipt of the Complaint by email dated November 24, 2000 to Ms. McGinn.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a single member panel.

After receiving the original Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, determined whether the Complaint fully complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on November 24, 2000, the Center requested confirmation from NSI of information set forth in the Complaint relative to the contested domain name; specifically, contact and registrant information for that domain name, as well as whether NSI received a copy of the Complaint from the Complainant. The Center also requested NSI to specify: (a) whether the ICANN Policy applies to the contested domain name, and (b) the current status of that domain name. On November 30, 2000, NSI provided its response to the Center through which NSI provided contact information pertinent to the contested domain name from its WHOIS database, confirmed that NSI is the registrar of the contested domain name, stated that the Policy is in effect (through Network Solutions' version 5.0 registration agreement) for the contested domain name, and that the contested domain name was then in an "active" status. The Center completed its review of the Complaint on December 1, 2000.

On December 1, 2000 the Center notified the Respondent of the filing of the Complaint, including providing a complete copy of the Complaint, with an explanatory cover sheet, to the Respondent, by email and in hardcopy form by post/courier (the latter including a copy of the Annexes supplied by the Complainant). The Complaint, and its accompanying documents, and all subsequent communications associated therewith were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on December 1, 2000 under paragraph 4(c) of the ICANN Policy, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and succeeding correspondence between the Center and NSI, in detail, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on December 20, 2000 to file its response with the Center and serve a copy of the response on the Complainant.

As of December 21, 2000 the Center had not received a response to the Complaint from the Respondent; hence, the Center, in an email letter dated December 21, 2000 notified the Complainant and Respondent of the default of the Respondent.

Accordingly, pursuant to the Rules and Supplemental Rules, on January 16, 2001, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service

as a sole panelist for this dispute. On January 16, 2001, Mr. Michaelson accepted and on January 19, 2001 returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an e-mail letter dated January 23, 2001 notified the parties of the appointment of Mr. Michaelson as the panelist.

Based on deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before February 5, 2001.

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

The language of this proceeding is English.

4. Factual Background

Inasmuch as the Respondent, The Webposters, has failed to respond to the Complaint as required by the Policy and Rules, all the factual representations alleged by the Complainant, Surface Protection Industries, Inc., will be accepted as undisputed. For convenience of the reader, factual allegations from the Complaint are reproduced below.

The Complainant currently owns a single valid and subsisting U.S. trademark registration, for a stylized logo that includes the term "MANN BROTHERS", on which this dispute is based. The Complainant uses its mark, the details of which are indicated immediately below, in connection with interior and exterior paints. In Annex C to the Complaint, the Complainant has provided a copy of this mark, as well as a listing of its abbreviated prosecution history and other related information, from the US Patent and Trademark Office web server.

MANN BROTHERS (stylized)

US registration 2,230,653; registered March 9, 1999.

This trade mark was registered, for use in connection with: "Interior and exterior paints", in international class 2. This mark claims first use and first use in interstate commerce of July 30, 1994.

The Complainant states that, for many years, it has been in the business of manufacturing and selling a wide variety of paints including decorative, automotive, and theatrical paints. In that regard, the Complainant states that, since at least as early as 1994, it has been using the mark MANN BROTHERS in connection with interior and exterior paint.

The Complainant states that it has used the trade name "Mann Brothers" since at least as early as 1978.

The Complainant also states that it has registered and currently owns the following domain names: <mannbros.org>, <mannbrothers.net>, and <mannbrother.org>. However, the Panel, in an attempt to separately access each web site addressed by a URL containing a corresponding one of each of these names, was not directed to any active web site. Hence, the Panel can only assume that, although the Complainant may have registered these domain names (though the Annexes, as supplied with the

Complaint, do not contain copies of the corresponding registration records), the Complainant has not yet implemented a web site reachable by any of these names.

Additionally, the Complainant states that Mark's Paint Store sells a wide variety of paints, including theatrical paint, and directly competes with the Complainant. The Complainant believes that Mark's Paint Store, which is the administrative contact for the Respondent (see Annex A to the Complaint), is an alias for the Respondent. The Complainant further states that Mark's Paint Store and the Complainant are both located in the Los Angeles, California area.

The Complainant states that subsequent to the time it starting using its MANN BROTHERS mark for interior and exterior paints, the Respondent registered the contested domain name <mannbrothers.com>.

Furthermore, the Complainant states that the "mannbrothers.com" web site is inactive. In particular, as this Panel has determined, entry of the contested domain name, into a browser, as a domain name portion of a web address (URL) results in an error message (specifically "The page cannot be displayed") being returned indicating that no web page can be resolved to a URL containing that domain name.

On October 12, 2000, Complainant's attorney, Ms. McGinn, sent a letter and a facsimile to Mike Umann at Mark's Paint Store requesting that the Respondent cease and desist from any unlawful use of the contested domain name. A copy of that letter appears in Annex D to the Complaint. In response to the letter, the Respondent's attorney apparently offered to sell the contested domain name to the Complainant for USD 10,000 (however, the record before this Panel contains no proof substantiating this offer).

Lastly, the Complainant states that it has not licensed or otherwise permitted the Respondent to use the MANN BROTHERS mark or to apply to use any domain name that incorporates this mark.

5. Parties' Contentions

A. Complainant

i. Similarity

The Complainant takes the position that the contested domain name is identical or confusingly similar to its mark MANN BROTHERS presumably so as to likely confuse Internet users who may believe they are doing business with Complainant or with an entity whose services are endorsed by, sponsored by, or affiliated with Complainant; hence, satisfying the confusing similarity requirement in paragraph 4(a) of the Policy.

ii. Legitimacy

The Complainant contends, that the Respondent have no rights or legitimate interest in the contested domain name.

Specifically, the Complainant asserts that the Respondent does not conduct any legitimate commercial or non-commercial business activity using the contested domain name, and points to the fact that the Respondent's web site, accessible through the

contested domain name, is inactive. The Complainant views such inactivity as evidencing a lack of legitimate rights and interests in that name.

Further, the Complainant contends that the Respondent is not commonly known by the mark or name MANN BROTHERS and has never acquired any trademark or service mark rights to such mark or name. In that regard, the Complainant states that it has neither licensed nor otherwise permitted the Respondent to utilize the mark MANN BROTHERS in a domain name.

Hence, the Complainant concludes that the Respondent cannot demonstrate any rights or legitimate interests in the contested domain name pursuant to paragraph 4(a) of the Policy.

iii. Bad Faith

The Complainant contends that the Respondent has registered and is now using the contested domain name in bad faith.

Specifically, the Complainant contends that, in view of the competitive relationship existing between it and the Respondent, the Respondent had constructive, if not actual, knowledge of the Complainant's mark MANN BROTHERS when it registered the contested domain name. Given this, the Complainant contends that the Respondent intentionally registered the contested domain name to divert Internet users away from any of the Complainant's web sites and, in so doing, presumably create confusion among those users.

Furthermore, the Complainant contends that each of a number of factors further indicates the Respondent's bad faith use and registration, namely, as asserted by the Complainant:

- (a) the failure of the Respondent, Webposters, to provide the registrar with accurate and complete contact information, specifically an e-mail address, a telephone number or a facsimile number;
- (b) the failure of the Respondent to establish an active web site reachable through the contested domain name;
- (c) the offer made by the Respondent to transfer the contested domain name to the Complainant upon payment of USD 10,000 -- an amount the Complainant asserts exceeds the Respondent's out of pocket costs related to the domain name;
- (d) the lack of any legitimate commercial or non-commercial business activity conducted by the Respondent under the contested domain name; and
- (e) that the Respondent is neither commonly known by the contested domain name nor has acquired any trademark or service mark rights to that name -- as to the latter factor, the Complainant states that the Respondent has evidently neither applied for nor obtained any state or federal trademark or service mark registration for the contested domain name.

Therefore, the Complainant concludes that the Respondent's conduct in registering each of the contested domain names amounts to bad faith under paragraph 4(a) of the

Policy.

B. Respondent

The Respondent has not filed any response to the allegations raised in the Complaint.

6. Discussion and Findings

In view of the lack of a response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed representations. In that regard and apart from judging this proceeding through mere default of the Respondent, the Panel makes the following specific findings:

i. Similarity

It is eminently clear to the Panel that confusion would likely arise when and if the Respondent, or any third-party not affiliated with the Complainant to which the Respondent were to transfer the contested domain name, or were to start using the contested domain name in conjunction with goods, particularly paint products, similar to those of the Complainant -- particularly given the competitive relationship between the Complainant and the Respondent.

Such confusion, should it occur, would undoubtedly cause Internet users intending to access the Complainant's website, but who reach a website through the contested domain name, to think that an affiliation of some sort exists between the Complainant and the Respondent or its third-party transferee, when, in fact, no such relationship would exist at all. *See Dollar Financial Group, Inc. v VQM NET* FA 96101 (Nat. Arb. Forum January 24, 2000); *EBAY Inc. v. G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd.* D2000-1463 (WIPO January 10, 2001); *Treeforms, Inc. v. Cayne Ind. Sales Corp.* FA 95856 (Nat. Arb. Forum December 18, 2000) and *The Pep Boys Manny, Moe and Jack of California v. E-Commerce Today, Ltd.* AF-0145 (eResolution May 3, 2000).

Here, the Complainant's registered mark MANN BROTHERS incorporates both the words "MANN BROTHERS" and a stylized graphic design element (a drawing of portions of what appears to be a paint can that extend above and to either side of those words), with the word "MANN" in block letters being one of the principal design elements.

The Panel views that for confusing similarity to occur between a domain name and a mark, identity, ignoring de minimus differences such as inclusion of a top level domain, is not necessary. *See Playboy Enterprises International, Inc. v. Hector Rodriguez* D2000-1016 (WIPO November 8, 2000).

All that is necessary is that the domain name misappropriate sufficient textual components from the mark such that an ordinary Internet user who is familiar with the goods or services distributed under the mark would upon seeing the domain name likely think that owing to the visual and/or phonetic similarity between the mark and the domain name that an affiliation exists between the site identified by that domain name and the owner or licensed user of the mark.

With respect to a test for "confusing similarity", § 5.01[3], page 5-15 of J. Gilson, et al, Trademark Protection and Practice (© 1996, Matthew Bender & Co., Inc.) states:

"When one trademark is said to be 'confusingly similar to another', it is so similar to the other that, when it is used on products the purchasing public is likely to be confused. The term [confusingly similar] is simply another way to express the fact that confusion is likely."

In assessing whether sufficient similarity exists between two marks, Gilson, at § 5.02[1], states: "If a word trademark sounds similar to the plaintiff's mark courts often find likelihood of confusion, especially if the associated product is typically ordered orally. Visual similarity frequently causes confusion if there is sufficient resemblance in overall appearance. Even if word trademarks neither sound alike nor look alike, similarity in meaning may cause confusion." In its seminal decision on the issue, *In re E.I. du Pont de Nemours & Co.* 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973), the United States Court of Customs and Patent Appeals (predecessor to the United States Court of Appeals for the Federal Circuit), in its definitive listing of factors to assess in determining whether likelihood of confusion exists or not, enumerated as its first factor: "(1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression."

Currently, domain names are limited to text. As of yet, a domain name does not include any graphical element. Hence, any stylized trademark that is to serve as the basis of a domain name must be reduced to a textual term.

Societal naming conventions for Internet sites have evolved to the point where a member of the public seeking information on the Internet for a source identified by a particular mark will most likely start a search by simply forming a domain name constituted by that mark followed by a very common top level domain, such as ".com" and then enter that name into his(her) browser and see what results. Web site owners, recognizing a need to simplify and facilitate user navigation to their sites increasingly reflect their marks in their domain names. See *College Summit, Inc. v. Yarmouth Educational Consultants, Inc.* D2000-1575 (WIPO January 17, 2001).

Therefore, the Panel recognizes that an ordinary Internet user familiar with the Complainant's products provided under its stylized mark "MANN BROTHERS" and who seeks information on those services, would, in all likelihood, first think to form a domain name by simply concatenating the words "MANN" and "BROTHERS" together and justifiably ignore the stylized element of the Complainant's registered mark. The user would enter that name into his(her) browser expecting to fetch a page associated with the Complainant and providing information on, inter alia, the various paint products offered by the Complainant.

However, once entered, that user would not be transported anywhere for the simple reason that the contested domain name is held by the Respondent and, as yet, does not resolve to any web page. While this lack of a reachable web site does not in and of itself lead to consumer confusion, such confusion could well arise if, at some point in the future, the Respondent, particularly given its competitive relationship with the Complainant, or any third party to which it were to transfer the contested domain name were to implement such a site.

Therefore, the Panel finds that the contested domain name <mannbrothers.com>

sufficiently resembles the Complainant's stylized MANN BROTHERS mark as to cause confusion.

Accordingly, the Panel also finds that sufficient similarity exists under paragraph 4(a)(i) of the Policy for the contested domain name <mannbrothers.com>.

ii. Illegitimacy

Based on its federal trademark registration, the Complainant has acquired exclusive rights to use its mark MANN BROTHERS. Furthermore, by virtue of the registration of this mark, the US PTO has implicitly recognized that this mark has acquired appropriate secondary meaning in the marketplace.

The Respondent has yet to provide any basis that would legitimize any claim it has to the contested domain name. In fact, it is extremely unlikely that the Respondent can even make such a claim.

The simple reason is that the contested domain name includes the Complainant's mark MANN BROTHERS (apart from its stylistic elements) under which the Complainant provides its products and has been doing so for some time. The Complainant has never authorized the Respondent to utilize the mark MANN BROTHERS -- whether in block letters or in the specific stylized form shown in the Complainant's registration, nor does the Complainant have any relationship or association whatsoever with the Respondent. Hence, any use to which the Respondent were to put of the term MANN BROTHERS in connection with the goods with which the Complainant is using its mark, in block letters, as well as those listed in the Complainant's registration, with which the Complainant is using its stylized mark, would directly violate the exclusive trademark rights now residing in the Complainant.

In light of the above findings, the Panel is not persuaded that the Respondent has any or, based on current facts provided to the Panel, is likely to acquire any legitimate interests in the contested domain name, whether on a commercial or non-commercial basis.

In that regard, the Panel finds that the Respondent's efforts in registering the contested domain name <mannbrothers.com>, particularly in light of the competitive relationship existing between it and the Complainant, does not constitute, under paragraph 4(c) of the Policy, a legitimate non-commercial or fair use without any intent to misleadingly divert consumers or tarnish the trademark or service mark at issue. In fact, the Panel believes such use constitutes just the opposite.

The Respondent has put forth no proof at all that would legitimize any possible use it is making or would make for the contested domain name.

Furthermore, the Panel is cognizant of the heavy burden that would be placed on complainants if in support of their cases on illegitimacy each of those complainants were to be impressed with a burden of providing detailed proof of any lack of rights or legitimate interests on behalf of their respondents. Such a burden is particularly problematic given that the underlying facts more than not are in exclusive or near exclusive possession and control of the respondents, particularly if they have not in fact made publicly discernible use. As such, the Panel believes that where allegations of illegitimacy are made, particularly as here, when coupled with conduct of respondents that evidences bad faith, it is quite reasonable to shift the burden of proof to each such

respondent to adequately show that its use of the contested domain name is legitimate, such as by showing that, in conjunction with the contested domain name, it is making a bona fide commercial offering of goods or services or preparations for such offerings, or non-commercial or fair use. Given the situation now facing the Panel, it is beyond question that the Respondent's conduct here falls far short of meeting this burden. *See Playboy Enterprises International, Inc., cited supra, and MSNBC Cable, LLC v. Tsys.com* D2000-1204 (WIPO December 8, 2000). Under the present facts, there is simply no proof whatsoever of any such usage.

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

iii. Bad Faith

The Panel believes that the Respondent, being a competitor of the Complainant, chose the contested domain name, which contains the Complainant's mark MANN BROTHERS, as an attempt to intentionally attract Internet users, for commercial gain and at some future date, away from the Complainant's sites and to the Respondent's future site by creating a likelihood of confusion with the Complainant's mark MANN BROTHERS as to source, sponsorship, affiliation or endorsement of the Respondent's web site with the Complainant; when, in fact, no such relationship exists. This conduct directly contravenes paragraph 4(b)(iv) of the Policy.

Alternatively, the Panel believes that, given the competitive relationship between and geographic proximity of the Complainant and the Respondent, the Respondent likely registered the contested domain name with an intent of disrupting or causing injury of some sort, resulting from subsequent user confusion, to the Complainant's business. This conduct directly contravenes paragraph 4(b)(iii) of the Policy.

As to the USD 10,000 offer made by the Respondent for sale of the contested domain name, the Panel, in the absence of any filed response and as permitted under paragraph 14(b) of the Rules, infers the existence of that offer. Such an offer clearly indicates, in the Panel's view, that the Respondent may have had yet another intention in acquiring the contested domain name. Apart from acquiring that name with an intent to eventually create a likelihood of confusion or to eventually injure the reputation of its competitor, the Complainant, or disrupt its business, the Panel also believes the Respondent likely acquired the name with an intent to eventually sell it to the Complainant, as the trademark owner, for a sum far in excess of the Respondent's "documented out-of-pocket costs directly related to the domain name". Hence, the Respondent's action in not only acquiring the domain name for this purpose but also in making the offer to sell it constitutes bad faith use and registration in contravention of paragraph 4(b)(1) of the Policy.

If the Respondent did not harbor any of these intentions, then one can reasonably ask the question: why would the Respondent have chosen to register a domain name that incorporates the mark of its competitor, i.e. MANN BROTHERS? The Panel believes it would probably have had no reason to do so and, in all likelihood, would not have done so.

In addition, the Panel is troubled by the Respondent's registration of the contested domain name followed by its continued retention, even in the absence of an operational web site resolvable through that name. The Panel views such passive holding by a competitor as being pernicious in nature -- with one of its affects here being a

continuing denial of a competitor of its right to reflect its mark in a domain name; hence, further reflecting bad faith registration and use. Numerous panels have held that, under appropriate circumstances, passive holding evidences bad faith use. Such circumstances, as discussed above and when viewed in their totality, exist here. See, e.g., *JVC Americas Corp. v. Damian Macafee* CPR007 (CPR November 10, 2000); *Pacific Investment Management Co. LLC v. Alex Szabo* FA95614 (Nat. Arb. Forum October 18, 2000); *National Australia Bank Limited v. Quality Systems Consulting -- QSC Pty Ltd.* D2000-0765 (WIPO August 31, 2000); *Gonvarri Industrial, S.A. v. Gon Varr I An Sexo a Domicilio* D2000-0637 (WIPO August 28, 2000); *Garage Records. Inc. v. Garage Records* FA95071 (Nat. Arb. Forum August 17, 2000); *Dollar Financial Group, Inc. v. RXW Management* FA 95108 (Nat. Arb. Forum August 4, 2000); *Lusomundo - Sociadada Gestora de Parcipacoes Sociais, S.A. and Lusomundo Audiovisuais, S.A. v. Inmo Soria and Andres Ceballos Moscoso* D2000-0523 (WIPO August 2, 2000); *Valigene Corp. v. MIC* FA94860 (Nat. Arb. Forum August 1, 2000); *Vertical Solutions Management, Inc. v. webnet-marketing, inc.* FA95095 (Nat. Arb. Forum July 31, 2000); *Hewlett-Packard Co. v. High Performance Networks, Inc.* FA95083 (Nat. Arb. Forum July 31, 2000); *CBS Broadcasting, Inc. v. Dennis Toeppen* D2000-0400 (WIPO July 6, 2000); *August Storck KG v. Tony Mohamed* D2000-0196 (WIPO May 3, 2000); *Recordati S.P.A. v. Domain Name Clearing Co.* D2000-0194 (WIPO July 21, 2000); *Sanrio Company, Ltd. and Sanrio, Inc. v. Neric Lau* D2000-0172 (WIPO April 20, 2000); and *Telstra Corp. Ltd. v. Nuclear Marshmallows* D2000-0003 (WIPO February 18, 2000).

Hence, the Panel finds that the Complainant has shown a sufficient basis to establish bad faith registration and use of the contested domain name under paragraph 4(a)(iii) of the Policy.

In this connection the Panel notes that in its opinion, the Respondent's actions in registering and now retaining the contested domain name also evince bad faith in violation of the Anti-Cybersquatting provisions of the US Lanham Act (15 USC § 1125(d)(1) with various factors indicative of 'bad faith' given in 15 USC § 1125(d)(1)(B)(i) though limited by 15 USC § 1125(d)(1)(B)(ii).

Thus, the Panel concludes that the Complainant, even apart from default of the Respondent, has provided sufficient proof of its allegations to establish a prima facie case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

In accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the relief sought by the Complainant is hereby granted.

The contested domain name, specifically <mannbrothers.com>, is ordered transferred to the Complainant.

Peter L. Michaelson, Esq.
Sole Panelist

Dated: February 5, 2001