



# **WIPO Arbitration and Mediation Center**

## **ADMINISTRATIVE PANEL DECISION**

**Toilets.com, Inc. v. Rons Porta Johns**

**Case No. D2007-0952**

### **1. The Parties**

The Complainant is Toilets.com, Inc., Utica, Michigan, United States of America, represented by Earl J. Braxton, United States of America.

The Respondent is Rons Porta Johns, Marietta, Ohio, United States of America.

### **2. The Domain Name and Registrar**

The disputed domain name <ronsportajohns.com> is registered with Network Solutions, LLC (“Registrar”).

### **3. Procedural History**

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the “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 Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) as approved on October 24, 1999, and the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999, (the “Supplemental Rules”).

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) in email form on June 28, 2007, and in hard copy form, along with accompanying Annexes A-E, on July 2, 2007. The Complainant filed an amendment to the Complaint on July 9, 2007 regarding the remedy it sought. In an email message to the Center dated July 13, 2007, the Complainant confirmed that the remedy it sought, through its amended complaint, is transfer of the disputed domain name. To simplify the ensuing decision, all references to the Complaint will be to the Complaint, as amended, unless the specific

context mandates otherwise.

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, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on June 29, 2007, the Center requested confirmation from the Registrar as to whether the Registrar received a copy of the Complaint from the Complainant and to confirm contact and registrant information set forth in the Complaint relative to the disputed domain name. The Center also requested the Registrar to specify, for the domain name: (a) whether the Policy applies to that name, (b) whether the registrant has submitted, in its registration agreement, to the jurisdiction at the location of the principal office of the registrar for court adjudication of disputes concerning or arising from the use of that name, (c) the language of the registration agreement, and (d) whether that name will remain “locked” during the proceeding.

Subsequently, on June 29, 2007, the Registrar provided its response to the Center through which the Registrar specified name and contact information pertinent to the disputed domain name to the extent present in its WhoIS database, and confirmed that the Respondent is listed as the registrant for the name. The response also confirmed that: (a) Network Solutions, LLC is the registrar of the disputed domain name, (b) the Registrant has submitted to jurisdiction at the location of the principal office of the Registrar for court adjudication, (c) the registration agreement is in English, and (d) the name will not be transferred, deactivated or its status changed during the pendency of this proceeding.

The Center verified that the Complaint, as amended, satisfied the formal requirements of the Policy, the Rules and the Supplemental Rules.

On July 16, 2007, the Center formally notified the Respondent, by email letter, of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to the Respondent, together with all its Annexes, by both courier and email. 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), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on July 16, 2007, under paragraph 4(c) of the Rules, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all the correspondence, including that between the Center and the Registrar, 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 August 5, 2007, to file its Response with the Center and serve a copy of the Response on the Complainant.

As of August 5, 2007, the Center had not received a formal Response to the Complaint from the Respondent; hence, the Center, in an email letter August 9, 2007, notified the Respondent of the default of the Respondent.

Accordingly, pursuant to the Rules and Supplemental Rules, by email letter dated August 15, 2007, the Center contacted the undersigned, Mr. Peter L. Michaelson, requesting his service as a Sole Panelist for this dispute. Subsequently, on the same day, Mr. Michaelson accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Panel finds that it was properly constituted. The Center, through an email letter dated August 17, 2007, notified the Parties of the appointment of Mr. Michaelson as Sole Panelist.

Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before August 31, 2007.

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

The language of this proceeding is English.

#### **4. Factual Background**

A copy of the WhoIS registration record for the disputed domain name appears in Annex A-1 to the Complaint. As indicated on this record, the disputed domain name was registered on January 24, 2001.

##### **A. Complainant's "PORTA-JOHN" Mark**

The Complainant owns a United States trademark registration for the term PORTA-JOHN in block letters. The Complainant has provided, in Annex C to the Complaint, a copy of the record for its registration for that mark as it appears in the public web-accessible Trademark Electronic Search System (TESS) provided by the US Patent and Trademark Office (PTO). Pertinent details of this registration are as follows:

PORTA-JOHN  
United States registration 1,975,634; registered: May 28, 1996  
filed: November 15, 1993

This mark is registered for use in connection with "transportable enclosed toilets" in international class 11. The entry states that both first use and first use in commerce of this mark, when used in conjunction with these goods, commenced as of March 19, 1985.

##### **B. The Parties and their Interaction**

The Complainant uses its mark to promote its goods and services in several market areas in the United States and worldwide on the Internet. The Complainant has spent significant sums of money to promote its mark and prevent its competitors from using the mark in connection with similar or identical goods to those currently offered by the Complainant.

On May 29, 2002, the Complainant sent the Respondent a cease and desist letter (a copy of which appears in Annex E to the Complaint), by certified postal mail, informing the latter that it was infringing on the Complainant's PORTA-JOHN Mark. The Complainant received no response to its letter.

The Respondent was featured in a publication dated January 2003 which described its business under the name "RON'S PORTA JOHN". The disputed domain name currently resolves to the home page of the Respondent's business (a copy of a hard-copy printout of that home pages appears in Annex A-7 to the Complaint) which depicts transportable toilets apparently similar to those currently offered by the Complainant.

## **5. Parties' Contentions**

### **A. Complainant**

#### **(i) Identical or Confusingly Similar**

The Complainant contends that the disputed domain name, <ronsportajohns.com>, is confusingly similar to the Complainant's PORTA-JOHN Mark.

The Complainant, though without explicitly stating, ostensibly contends that the only differences between the name and the mark is that the former contains a prefix "rons" and a suffix "s", and a hyphen has been deleted from the mark, all of which are insufficient to adequately distinguish the name from the mark and thus preclude confusion of Internet users.

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 paragraph 4(a)(ii) of the Policy.

Specifically, the Complainant states that it has never authorized the Respondent, in any fashion, to use the PORTA-JOHN Mark.

#### **(iii) Registered and Used in Bad Faith**

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

In particular, the Complainant alleges that the Respondent primarily registered the name for the purpose of using it in conjunction with its business of renting and servicing portable toilets competitive with the Complainant's offerings. Further, the Respondent, by trading on the goodwill of the Complainant's mark, is currently using the name to intentionally attract Internet users to its web site, <ronsportajohns.com>, by creating a likelihood of confusion, in the mind of Internet users, with the Complainant's mark as to the source,

sponsorship, affiliation, or endorsement of the Respondent's site and its products and services shown on that site.

## **B. Respondent**

The Respondent failed to file 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.

### **A. Identical or Confusingly Similar**

The Panel finds that the disputed domain name is confusingly similar to the Complainant's PORTA-JOHN Mark.

From a simple comparison of the name and the mark, no doubt exists that the disputed domain name is, for all practical purposes, confusingly similar to that mark. The only differences between the name and that mark is the addition of the term "rons", as a prefix, and the letter "s", as a suffix, to the mark; omission of a hyphen from the mark and the appending of a gTLD (generic top level domain) ".com" to the mark – with the last being totally irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that minor variations, such as adding short letter or number groups or even generic words to a mark, are each 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. Adding the common name "rons" and the letter "s" to the mark and omission of a hyphen from the mark here such that the term "PORTA-JOHN" becomes in the domain name "ronsportajohns" are clearly such minor variations. See, e.g., *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334 (June 28, 2007); *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317 (April 24, 2007); *SPX Corp. v. Hevun Diversified Corp.*, NAF Case No. FA791657 (November 13, 2006); *Google Inc. v. Burns*, NAF Case No. FA 726096 (August 16, 2006); *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766 (September 12, 2005); *Napster, Inc. v. Vinscani*, WIPO Case No. D2005-0531 (July 19, 2005); *Caesars Entertainment Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411 (June 22, 2005); *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824 (January 18, 2005); *Lockheed Martin Corp. v. Deborah Teramani*, WIPO Case No. D2004-0836 (December 1, 2004); and *National Collegiate Athletic Assoc. v. Dusty Brown*, WIPO Case No. D2004-0491 (August 30, 2004); and *Lane-Labs USA, Inc. v. Powell Productions*, NAF Case No. FA 155896 (July 1, 2003). While a sufficient number of variations or even one such significant variation itself made to a mark may suffice, under a specific factual situation, to

impart requisite distinctiveness to a resulting domain name and there through dispel user confusion (see, e.g., *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576 (March 14, 2007); and *CP Films, Inc. v. Solar Lunar Performance Film*, NAF Case No. FA861127 (February 6, 2007)), such is clearly not the case here when both the name at issue and the mark are viewed, as they must, in their entirety with respect to each other.

Therefore, the Panel finds that the disputed domain name <ronsportajohns.com> is confusingly similar to the Complainant's PORTA-JOHN Mark as to cause confusion; hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

By virtue of its default, the Respondent has not provided any basis that, under the circumstances here, would legitimize a claim to the disputed domain name under paragraph 4(c) of the Policy.

There is absolutely no evidence of record that the Respondent has ever been commonly known by the domain name. Nor could the Respondent ever become so known, in light the Complainant's continuous use of its mark at least nearly six years prior to the date on which the Respondent registered the name, without infringing on the exclusive trademark rights of the Complainant. See, *Treeforms, Inc. v. Cayne Industrial Sales, Corp.*, NAF Case No. FA 95856 (December 18, 2000).

Further, no evidence exists of record that the Complainant has ever authorized the Respondent to utilize its PORTA-JOHN Mark or any mark confusingly similar thereto in conjunction with transportable toilets which the Complainant provides under its mark, nor does the Complainant apparently have any relationship or association whatsoever with the Respondent. As such, any use to which the Respondent were to put the PORTA-JOHN Mark or one confusingly similar thereto – such as “ronsportajohns”, in connection with the goods identical or similar to those currently provided by the Complainant would violate the exclusive trademark rights now residing in the Complainant. See, e.g., *Associated Bank*, cited *supra*; *GoDaddy.com, Inc. v. GoDaddysDomain.com*, *Clark Signs, Graham Clark*, WIPO Case No. D2007-0303 (May 7, 2007); *Citgo Petroleum Corporation v. Richard Antinore*, WIPO Case No. D2006-1576 (March 14, 2007); *New Destiny Internet Group, LLC and Xplor Media, Inc. v. SouthNetworks*, WIPO Case No. D2005-0884 (October 14, 2005); *The Cheesecake Factory Inc., Napster and Caesars Entertainment, Inc.*, all cited *supra*; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898 (December 28, 2004); *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360 (June 24, 2004); *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services Corp. v. ESJ Nutritional Products*, NAF Case No. FA 173362 (September 16, 2003); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, cited *supra*; *MPL Communications, Limited et al v. IWebAddress.com*, NAF Case No. FA 97092 (June 4, 2001); *America Online, Inc. v. Xianfeng Fu*, WIPO Case No. D2000-1374 (December 11, 2000); and *Treeforms*, cited *supra*. Consequently, the Respondent could not legally acquire any public association between it and the mark PORTA-JOHN or one similar thereto, at least for the goods rendered by the Complainant or those similar thereto. Hence, based on the evidence before the Panel, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) and specifically any applicable provisions of paragraph 4(c) of the Policy.

### **C. Registered and Used in Bad Faith**

The Panel believes that the Respondent's actions constitute bad faith registration and use of the disputed domain name.

In light of no evidence to the contrary, the Panel infers, based on the record and the default of the Respondent, that the Respondent was well aware of the Complainant and its PORTA-JOHN Mark when the Respondent registered the disputed domain name. Yet, in spite of that knowledge, the Respondent intentionally chose and registered the name to opportunistically exploit its potential to generate user confusion, for the Respondent's eventual pecuniary benefit and to the Complainant's ultimate detriment.

Moreover, nothing exists on the Respondent's website which would lead any Internet user to reasonably infer other than that a connection, affiliation or relationship of some sort likely exists between the Respondent's website and the Complainant – when, in actuality, none exists. Thus, the Respondent's use of the name is highly likely to confuse, if not deceive, Internet users who visit that site but do so with the intention of visiting the Complainant's site instead. See *Associated Bank*, cited supra; *Christian Dior Couture v. Alex Roché*, WIPO Case No. DTV2007-0004 (June 15, 2007) and *Gerber Childrenswear*, cited supra.

Hence, the Panel concludes that the Respondent violated paragraph 4(a)(iii) of the Policy and specifically paragraph 4(b)(iv) thereof.

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, <ronsportajohns.com>, is ordered transferred to the Complainant.

---

Peter L. Michaelson  
Sole Panelist

Dated: August 27, 2007