



NATIONAL ARBITRATION FORUM

DECISION

AMSOIL INC. v. Turvill Consultants
Claim Number: FA0512000616726

PARTIES

Complainant is **AMSOIL INC.** ("Complainant"), represented by **Andrew S. Ehard**, of **Merchant & Gould, P.C.**, P.O. Box 2910, Minneapolis, MN 55402-0910. Respondent is **Turvill Consultants** ("Respondent"), 265 Port Union Rd, 15525, Scarborough, ON M1C 4Z7, Canada.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**amsoiloil.com**>, registered with **Moniker Online Services, 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.

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on December 29, 2005; the National Arbitration Forum received a hard copy of the Complaint on December 29, 2005.

On December 29, 2005, Moniker Online Services, Inc. confirmed by e-mail to the National Arbitration Forum that the <**amsoiloil.com**> domain name is registered with Moniker Online Services, Inc. and that Respondent is the current registrant of the name. Moniker Online Services, Inc. has verified that Respondent is bound by the Moniker Online Services, Inc. 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 December 30, 2005, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of January 19, 2006 by which Respondent could file a response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@amsoiloil.com by e-mail.

Having received no response from Respondent, the National Arbitration Forum transmitted to the parties a Notification of Respondent Default.

On January 25, 2006, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent." Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the National Arbitration Forum's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant makes the following assertions:

1. Respondent's <**amsoiloil.com**> domain name is confusingly similar to Complainant's AMSOIL mark.
2. Respondent does not have any rights or legitimate interests in the <**amsoiloil.com**> domain name.
3. Respondent registered and used the <**amsoiloil.com**> domain name in bad faith.

B. Respondent failed to submit a Response in this proceeding.

FINDINGS

Complainant, AMSOIL Inc., develops, produces, and markets synthetic lubricants, oils, and greases for use in various automotive fluids. Complainant has registered the AMSOIL mark (Reg. No. 1,474,708 issued February 2, 1988) with the United States Patent and Trademark Office ("USPTO") for use in connection with these products.

Respondent registered the <**amsoiloil.com**> domain name on November 13, 2005. Respondent's disputed domain name resolves to a website featuring links to various competing websites.

DISCUSSION

Paragraph 15(a) of 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."

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. *See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Paragraph 4(a) of the Policy requires that 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 Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) 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

Complainant has established rights in the AMSOIL mark through registration with the USPTO and the Canadian Intellectual Property Office. *See Men's Wearhouse, Inc. v. Wick*, FA 117861 (Nat. Arb. Forum Sept. 16, 2002) ("Under U.S. trademark law, registered marks hold a presumption that they are inherently distinctive [or] have acquired secondary meaning"); *see also Vivendi Universal Games v. XBNetVentures Inc.*, FA 198803 (Nat. Arb. Forum Nov. 11, 2003) ("Complainant's federal trademark registrations establish Complainant's rights in the BLIZZARD mark.").

Complainant alleges Respondent's <amsoiloil.com> domain name is confusingly similar to Complainant's mark. Respondent's disputed domain name features Complainant's entire AMSOIL mark and adds the generic term "oil," a term that has a direct connection to the products that Complainant provides. The Panel finds the addition of such a term fails to sufficiently distinguish Respondent's domain names from Complainant's mark pursuant to Policy ¶4(a)(i). *See Space Imaging LLC v. Brownell*, AF-0298 (eResolution Sept. 22, 2000) (finding confusing similarity where the respondent's domain name combines the complainant's mark with a generic term that has an obvious relationship to the complainant's business); *see also Brambles Indus. Ltd. v. Geelong Car Co. Pty. Ltd.*, D2000-1153 (WIPO Oct. 17, 2000) (finding that the domain name

<bramblesequipment.com> is confusingly similar because the combination of the two words "brambles" and "equipment" in the domain name implies that there is an association with the complainant's business).

The Panel finds Policy ¶4(a)(i) satisfied.

Rights or Legitimate Interests

Complainant has alleged Respondent does not have rights or legitimate interests in the <amsoiloil.com> domain name. Once Complainant makes a *prima facie* case in support of its allegations, the burden shifts to Respondent to prove that it does have rights or legitimate interests pursuant to Policy ¶4(a)(ii). Due to Respondent's failure to respond to the Complaint, the Panel infers Respondent does not have rights or legitimate interests in the disputed domain name. See *G.D. Searle v. Martin Mktg.*, FA 118277 (Nat. Arb. Forum Oct. 1, 2002) (holding that, where the complainant has asserted that respondent does not have rights or legitimate interests with respect to the domain name, it is incumbent on respondent to come forward with concrete evidence rebutting this assertion because this information is "uniquely within the knowledge and control of the respondent"); see also *Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, D2000-1228 (WIPO Nov. 28, 2000) (finding that, under certain circumstances, the mere assertion by the complainant that the respondent does not have rights or legitimate interests is sufficient to shift the burden of proof to the respondent to demonstrate that such a right or legitimate interest does exist).

Complainant contends Respondent is using the confusingly similar <amsoiloil.com> domain name to operate a website that features links to various competing websites, from which Respondent presumably receives click-through fees. The Panel finds such diversionary use is neither a *bona fide* offering of goods or services pursuant to Policy ¶4(c)(i) nor a legitimate noncommercial or fair use pursuant to Policy ¶4(c)(iii). See *Disney Enters., Inc. v. Dot Stop*, FA 145227 (Nat. Arb. Forum Mar. 17, 2003) (finding that the respondent's diversionary use of the complainant's mark to attract Internet users to its own website, which contained a series of hyperlinks to unrelated websites, was neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain names); see also *TM Acquisition Corp. v. Sign Guards*, FA 132439 (Nat. Arb. Forum Dec. 31, 2002) (finding that the respondent's diversionary use of the complainant's marks to send Internet users to a website which displayed a series of links, some of which linked to the complainant's competitors, was not a *bona fide* offering of goods or services).

No evidence has been set forth suggesting Respondent is either a licensee of Complainant's mark or commonly known by the disputed domain name. As such, the Panel finds no rights or legitimate interests exist pursuant to Policy ¶4(c)(ii). See *Compagnie de Saint Gobain v. Com-Union Corp.*, D2000-0020 (WIPO Mar. 14, 2000) (finding no rights or legitimate interest where the respondent was not commonly known by the mark and never applied for a license or permission from the complainant to use the

trademarked name); *see also Charles Jourdan Holding AG v. AAIM*, D2000-0403 (WIPO June 27, 2000) (finding no rights or legitimate interests where (1) the respondent is not a licensee of the complainant; (2) the complainant's prior rights in the domain name precede the respondent's registration; (3) the respondent is not commonly known by the domain name in question).

The Panel finds Policy ¶4(a)(ii) satisfied.

Registration and Use in Bad Faith

The Panel finds Respondent's use of the <amsoil.com> domain name to operate a website featuring links to various competing websites for Respondent's own commercial gain is evidence of bad faith registration and use pursuant to Policy ¶4(b)(iv). *See Drs. Foster & Smith, Inc. v. Lalli*, FA 95284 (Nat. Arb. Forum Aug. 21, 2000) (finding bad faith where the respondent directed Internet users seeking the complainant's site to its own website for commercial gain); *see also Associated Newspapers Ltd. v. Domain Manager*, FA 201976 (Nat. Arb. Forum Nov. 19, 2003) ("Respondent's prior use of the <mailonsunday.com> domain name is evidence of bad faith pursuant to Policy ¶4(b)(iv) because the domain name provided links to Complainant's competitors and Respondent presumably commercially benefited from the misleading domain name by receiving 'click-through-fees.'"). There is likely to be confusion among Internet users as to Complainant's affiliation with or sponsorship of the resulting websites. *See Am. Univ. v. Cook*, FA 208629 (Nat. Arb. Forum Dec. 22, 2003) ("Registration and use of a domain name that incorporates another's mark with the intent to deceive Internet users in regard to the source or affiliation of the domain name is evidence of bad faith."); *see also TM Acquisition Corp. v. Warren*, FA 204147 (Nat. Arb. Forum Dec. 8, 2003) ("Although Complainant's principal website is <century21.com>, many Internet users are likely to use search engines to find Complainant's website, only to be misled to Respondent's website at the <century21realty.biz> domain name, which features links for competing real estate websites. Therefore, it is likely Internet users seeking Complainant's website who end up at Respondent's website will be confused as to the source, sponsorship, affiliation or endorsement of Respondent's website.").

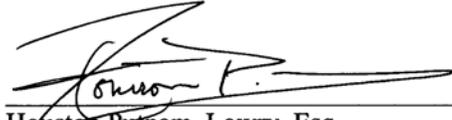
It also appears Respondent has engaged in a pattern of registering other persons' trademarks as domain names. There are seven reported cases on the National Arbitration Forum web site where Respondent has lost such proceedings (and none where it has prevailed).

The Panel finds Policy ¶4(a)(iii) satisfied.

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <amsoiloil.com> domain name be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: February 7, 2006

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