



NATIONAL ARBITRATION FORUM

DECISION

Cottman Transmission Systems, LLC v. Jonathan Bancroft
Claim Number: FA0707001045246

PARTIES

Complainant is **Cottman Transmission Systems, LLC** ("Complainant"), represented by **Alan L. Poliner**, 201 Gibraltar Road, Suite 150, Horsham, PA 19044. Respondent is **Jonathan Bancroft** ("Respondent"), 5610 Conica Court, Spring, TX 77379.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**cotmantransmissions.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.

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on July 25, 2007; the National Arbitration Forum received a hard copy of the Complaint on July 25, 2007.

On July 26, 2007, Network Solutions, Inc. confirmed by e-mail to the National Arbitration Forum that the <**cotmantransmissions.com**> domain name is registered with Network Solutions, Inc. and that Respondent is the current registrant of the name. Network Solutions, Inc. has verified that Respondent is bound by the Network Solutions, 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 July 30, 2007, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of August 20, 2007 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@cotmantransmissions.com by e-mail.

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

On August 26, 2007, 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:

- [a.] The Domain Names are Identical or Confusingly Similar to Trademarks in Which Complainant had Rights.
ICANN Rule 3(b)(ix)(1); ICANN Policy ¶4(a)(i).

The domain names are confusingly similar to the registered trademarks COTTMAN and COTTMAN TRANSMISSION. The trademark COTTMAN (reg. # 0817999) was first used in 1962, first used in interstate commerce in 1964, and registered with the United States Patent and Trademark Office (USPTO) since November 1, 1966. This trademark is incontestable pursuant to 15 U.S.C. §1065(b). The trademark COTTMAN TRANSMISSION (reg. # 2023747) was first used in interstate commerce in 1994, and registered with the United States Patent and Trademark Office (USPTO) since December 17, 1996. This trademark is incontestable pursuant to 15 U.S.C. §1065(b). The trademark COTTMAN TRANSMISSION (reg. # 2906318) was first used in interstate commerce in 2002, and registered with the United States Patent and Trademark Office (USPTO) since November 30, 2004.

The domain name **cotmantransmissions.com** uses the word COTMAN which is an intentional misspelling of the mark COTTMAN. It also uses the mark COTTMAN TRANSMISSION in its entirety. Simply dropping a letter from Complainant's registered trademark leaves the domain name clearly and intentionally, confusingly similar to Complainant's trademark. Estee Lauder, Inc. v. estelauder.com, estelauder.net and Jeff Hanna, WIPO Case No. D2000-0869 (Sept. 25, 2000). See also The Vanguard Group, Inc. v. John Zuccarini, WIPO Case No. D2002-0834 (Nov. 18, 2002). Removing a space

between the words and an addition of a “.com” do not alter this conclusion. Pacific Online, Inc., WIPO Case No. D2002-0628.

Additionally, the domain name **cotmantransmissions.com** is confusingly similar to Complainant’s trademark COTTMAN TRANSMISSION because it incorporates, in its entirety, the mark COTTMAN TRANSMISSION, but for an intentional mis-spelling omitting one letter. “When a domain name incorporate, in its entirety, a distinctive mark, that creates sufficient similarity between the mark and the domain name to render it confusingly similar.” EAuto, LLC v. Triple S. Auto Parts, WIPO Case No. D2000-0047 (March 24, 2000).

The website at the domain name **cotmantransmissions.com** is being used to advertise automotive repair businesses, which is precisely the same goods and services associated with the trademarks identified above. There is no other conclusion but that the domain names at issue are identical or confusingly similar to registered trademarks of Complainant.

Additionally, Complainant Cottman Transmission Systems, LLC is the registrant of several domain names, including **cotman.com** since October 31, 1996 and **cotmantransmission.com** since February 2, 2002. (Note: Cottman Transmission Systems, Inc. was the predecessor in interest to Complainant Cottman Transmission Systems, LLC).

[b.] Respondent has No Rights or Legitimate Interests in Respect of the Domain Name.
ICANN Rule 3(b)(ix)(2); ICANN Policy ¶4(a)(ii).

Complainant Cottman Transmission Systems, LLC is a franchisor of transmission repair Centers. Franchisees individually own and operate Cottman Transmission Centers. All trademarks involved in the business are owned and controlled by the franchisor, Complainant Cottman Transmission Systems, LLC. Complainant does permit franchisees to operate under the name “Cottman Transmission” under a written license agreement with Complainant. Respondent has no such license. Additionally, such license agreements specifically exclude permission to register domain names using any portion of Complainant trademarks.

Respondent Jonathan Bancroft is a former employee of Complainant, and now is an employee of a Cottman franchisee, Scott Furches. Each license agreement specifically excludes permission to register domain names using any portion of Complainant trademarks at section 11.c. The locations being advertised by the website at **cotmantransmissions.com** are the locations of franchisee Scott Furches. Mr. Furches is trying to evade the restrictions of the license agreements by having the domain names at issue registered in the name of his employee, Respondent Jonathan Bancroft.

Neither Respondent, nor his employer have any rights with respect to the domain names.

Respondent has not been commonly known by the domain name.

Respondent is not making a legitimate non-commercial or fair use of the domain names. Respondent's intent is for commercial gain and to misleadingly divert consumers. The website at **cottmantransmissions.com** advertises the Cottman Transmission Centers of Respondent's employer, and no other Centers. There are over 30 Cottman Transmission Centers in Texas and 13 in the Houston area. The website permits the input of a zip code and returns the nearest location of Respondent's employer, rather than the nearest Cottman Transmission Center.

Additionally, Complainant has its own website at www.cottman.com which it controls. Customers seeking a Cottman Transmission Center can find the nearest location from this website. Since the website is controlled by the franchisor, competing locations are not automatically excluded.

When a trademark owner licenses its marks to others, the trademark owner must control the quality of goods and services associated with the marks. Kentucky Fried Chicken Corp. v. Diversified Packaging Corp., 549 F.2d 368 (5th Cir. 1977); Dawn Donut Co. v. Hart's Food Stores, Inc., 267 F.2d 358 (2d. Cir. 1959); Lanham Trade-Mark Act, §§14, 45, 15 U.S.C.A. §§1064, 1127. One way Complainant controls the quality of its trademarks is to exclude franchised locations from the website www.cottman.com, if the franchised location is not meeting Complainant's quality standards, or is otherwise in violation of the license agreement permitting limited use of the trademarks. That is, if a Cottman Transmission Center is doing shoddy work, Complainant may exclude them its website. If Complainant does not control the domain names that feature its mark, it cannot control the quality provided by franchisees or others.

[c.] The Domain Name Was Registered and is Being Used in Bad Faith.
ICANN Rule 3(b)(ix)(3); ICANN Policy ¶4(a)(iii).

Respondent has used the domain name to intentionally attract, for commercial gain, Internet users to Respondent's web site, by creating a likelihood of confusion with Complainant's trademarks. The website at the domain name **cotmantransmissions.com** is being us to advertise automotive repair businesses, which is precisely the same goods and services associated with the trademarks identified above. Respondent's intent is for commercial gain and to misleadingly divert consumers. The website at **cotmantransmissions.com** advertises the Cottman Transmission Centers of Respondent's employer, and no other Centers. There are over 30 Cottman Transmission Centers in Texas and 13 in the Houston area. The website permits the input of a zip code and returns the nearest location of Respondent's employer, rather than the nearest Cottman Transmission Center.

Respondent has no license to use any of Complainant's trademarks in any way. Respondent is misrepresenting to the public that he is an authorized user of Complainant's trademarks, which he is not. Complainant does not sponsor or endorse Respondent's website.

Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor. There are over 30 Cottman Transmission Centers in Texas and 13 in the Houston area. Respondent's website permits the input of a zip code and returns the nearest location of Respondent's employer, rather than the nearest Cottman Transmission Center. Also, only the locations of Respondent's employer appear on the map, rather than all Cottman Transmission Centers.

Other franchisees of Complainant are not included on Respondent's website. Potential customers seeking a Cottman Transmission Center by using the internet are mis-directed to Respondent, rather than the website of the Complainant, owner of the trademarks. The other franchisees of Complainant are missing out on business. Additionally, Complainant must control the quality of the goods and services associated with its trademarks, which it cannot do if Respondent is permitted to continue to use its trademarks as a domain name.

Respondent has acquired the domain name for the purpose of selling the registration to Complainant Cottman Transmission Systems, LLC. As described above, Complainant is the owner of the trademarks which have been used as domain names by Respondent. Complainant has attempted to resolve this dispute with Respondents. During one such attempt, Kevin Gordon, Vice President of Marketing and Brand Development of Cottman Transmission Systems, LLC, had a telephone conversation with Respondent. He had requested that the domain names be transferred to Cottman, and offered to pay the out-of-pocket costs directly related to the domain names. Respondent stated the out-of-pocket costs were several thousand dollars. Cottman Transmission Systems, LLC offered to cover these expenses. Mr. Bancroft rejected the offer and demanded that Cottman pay additional money for the transfer of the domain names in excess of the claimed several thousand dollars of out-of-pocket costs.

Respondents not only wanted to be paid an amount in excess of out-of-pocket expenses associated with the domain name, they have exaggerated their out-of-pocket expenses. Accordingly, Respondent has acquired the domain name for the purpose of selling the registration for profit.

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

FINDINGS

Complainant, Cottman Transmission Systems, LLC, is a provider of various automotive goods and services. Complainant and its predecessor-in-interest have operated under the COTTMAN and COTTMAN TRANSMISSION marks since at least 1962 and 1994,

respectively. Complainant holds a service mark registration with the United States Patent and Trademark Office (“USPTO”) for the COTTMAN TRANSMISSION mark (Reg. No. 2,906,318 issued November 30, 2004). Complainant also operates websites at the <cottman.com> and <cottmantransmission.com> domain names.

Respondent registered the <cotmantransmissions.com> domain name on October 25, 2006. Respondent’s disputed domain name resolves to a website that advertises the franchises of one particular franchisee, despite the explicit affiliate agreement between Complainant and its franchisees which states that no domain names incorporating Complainant’s mark may be registered. Respondent is employed by one of Complainant’s franchisees.

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 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

The Panel finds Complainant’s registration of the COTTMAN TRANSMISSION mark with the USPTO sufficiently establishes Complainant’s rights in the mark under Policy ¶4(a)(i). *See Disney Enters., Inc. v. Kudrna*, FA 686103 (Nat. Arb. Forum June 2, 2006) (finding that the complainant’s registration of the DISNEY trademark with the USPTO prior to the respondent’s registration of the disputed domain name is sufficient to prove

that the complainant has rights in the mark pursuant to Policy ¶4(a)(i); *see also AOL LLC v. AIM Profiles*, FA 964479 (Nat. Arb. Forum May 20, 2007) (“Complainant has established rights in the AIM mark through its use and federal trademark registrations for the purposes of Policy ¶4(a)(i).”).

Complainant has asserted the <**cotmantransmissions.com**> domain name is confusingly similar to Complainant’s COTTMAN TRANSMISSION mark. The Panel agrees because the disputed domain name contains Complainant’s mark in its entirety, with the slight alterations of the deletion of a letter “t” from the mark and the addition of the letter “s” to the end of the mark, as well as the addition of the generic top-level domain (“gTLD”) “.com.” These modifications do not sufficiently distinguish the <**cotmantransmissions.com**> domain name from Complainant’s mark under the requirements of Policy ¶4(a)(i). *See Neuberger Berman Inc. v. Jacobsen*, D2000-0323 (WIPO June 12, 2000) (finding that the respondent’s <newbergerberman.com> domain name was confusingly similar to the complainant’s NEUBERGER BERMAN mark despite the slight difference in spelling); *see also State Farm Mut. Auto. Ins. Co. v. Try Harder & Co.*, FA 94730 (Nat. Arb. Forum June 15, 2000) (finding that the domain name <statfarm.com> is confusingly similar to the complainant’s STATE FARM mark); *see also Busy Body, Inc. v. Fitness Outlet Inc.*, D2000-0127 (WIPO Apr. 22, 2000) (“[T]he addition of the generic top-level domain (gTLD) name ‘.com’ is . . . without legal significance since use of a gTLD is required of domain name registrants . . .”).

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

Rights or Legitimate Interests

Under Policy ¶4(a)(ii), Complainant must establish a *prima facie* case Respondent lacks rights and legitimate interests in the <**cotmantransmissions.com**> domain name. Once Complainant has met that burden, as it has in this proceeding, the burden shifts to Respondent to demonstrate that it does have rights or a legitimate interest in the disputed domain name under Policy ¶4(c). *See Compagnie Generale des Matieres Nucleaires v. Greenpeace Int’l*, D2001-0376 (WIPO May 14, 2001) (“Proving that the Respondent has no rights or legitimate interests in respect of the Domain Name requires the Complainant to prove a negative. For the purposes of this sub paragraph, however, it is sufficient for the Complainant to show a *prima facie* case and the burden of proof is then shifted on to the shoulders of Respondent. In those circumstances, the common approach is for respondents to seek to bring themselves within one of the examples of paragraph 4(c) or put forward some other reason why they can fairly be said to have a relevant right or legitimate interests in respect of the domain name in question.”); *see also G.D. Searle v. Martin Mktg.*, FA 118277 (Nat. Arb. Forum Oct. 1, 2002) (“Because Complainant’s Submission constitutes a *prima facie* case under the Policy, the burden effectively shifts to Respondent. Respondent’s failure to respond means that Respondent has not presented any circumstances that would promote its rights or legitimate interests in the subject domain name under Policy ¶4(a)(ii).”).

Respondent's WHOIS information lists Respondent as "Jonathan Bancroft," and there is no other evidence in the record to indicate Respondent is commonly known by the <cotmantransmissions.com> domain name. Complainant asserts Respondent is not authorized to use Complainant's mark in the registration of a domain name. Respondent has failed to dispute these facts. Accordingly, the Panel finds Respondent is not commonly known by the disputed domain name under Policy ¶4(c)(ii). See *RMO, Inc. v. Burbridge*, FA 96949 (Nat. Arb. Forum May 16, 2001) (interpreting Policy ¶4(c)(ii) "to require a showing that one has been commonly known by the domain name prior to registration of the domain name to prevail"); see also *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).

Complainant has presented evidence the disputed domain name resolves to a website that advertises the franchises of one particular individual within a specific geographic location of Texas, while preventing Internet users from accessing information regarding other franchises in the same geographic area. Complainant contends Respondent is a former employee of Complainant, and now works for the franchise which is benefiting from use of the <cotmantransmissions.com> domain name. The Panel finds Respondent's use of the disputed domain name is not a *bona fide* offering of goods or services under Policy ¶4(c)(i) or a legitimate noncommercial or fair use under Policy ¶4(c)(iii). See *MSNBC Cable, LLC v. Tsysys.com*, D2000-1204 (WIPO Dec. 8, 2000) (finding no rights or legitimate interests in the famous MSNBC mark where the respondent attempted to profit using the complainant's mark by redirecting Internet traffic to its own website); see also *DLJ Long Term Inv. Corp. v. BargainDomainNames.com*, FA 104580 (Nat. Arb. Forum Apr. 9, 2002) ("Respondent is not using the disputed domain name in connection with a bona fide offering of goods and services because Respondent is using the domain name to divert Internet users to <visual.com>, where services that compete with Complainant are advertised.").

Respondent has offered to sell the <cotmantransmissions.com> domain name to Complainant for an amount in excess of Respondent's out-of-pocket costs. Such action is further evidence Respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶4(a)(ii). See *Am. Nat'l Red Cross v. Domains*, FA 143684 (Nat. Arb. Forum Mar. 4, 2003) ("Respondent's lack of rights and legitimate interests in the domain name is further evidenced by Respondent's attempt to sell its domain name registration to Complainant, the rightful holder of the RED CROSS mark."); see also *Mothers Against Drunk Driving v. Hyun-Jun Shin*, FA 154098 (Nat. Arb. Forum May 27, 2003) (holding that under the circumstances, the respondent's apparent willingness to dispose of its rights in the disputed domain name suggested that it lacked rights or legitimate interests in the domain name).

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

Registration and Use in Bad Faith

Respondent's disputed domain name resolves to a website that advertises the services of a single franchisee that operates under Complainant's COTTMAN TRANSMISSION mark, but not others in the same geographic area. The Panel finds such use of the <cotmantransmissions.com> domain name is for Respondent's commercial gain, and is capable of creating a likelihood of confusion as to Complainant's sponsorship and affiliation with the disputed domain name and corresponding website. Such use of the disputed domain name qualifies as bad faith registration and use under Policy ¶4(b)(iv). *See Perot Sys. Corp. v. Perot.net*, FA 95312 (Nat. Arb. Forum Aug. 29, 2000) (finding bad faith where the domain name in question is obviously connected with the complainant's well-known marks, thus creating a likelihood of confusion strictly for commercial gain); *see also Am. Online, Inc. v. Fu*, D2000-1374 (WIPO Dec. 11, 2000) (finding that the respondent violated Policy ¶4(b)(iv) by displaying the complainant's mark on its website and offering identical services as those offered by the complainant).

Respondent's offer to sell the <cotmantransmissions.com> domain name to Complainant for an amount in excess of Complainant's out-of-pocket costs demonstrates bad faith registration and use under Policy ¶4(b)(i). *See Campmor, Inc. v. GearPro.com*, FA 197972 (Nat. Arb. Forum Nov. 5, 2003) ("Respondent registered the disputed domain name and offered to sell it to Complainant for \$10,600. This demonstrates bad faith registration and use pursuant to Policy ¶4(b)(i)."); *see also Am. Anti-Vivisection Soc'y v. "Infa dot Net" Web Serv.*, FA 95685 (Nat. Arb. Forum Nov. 6, 2000) (finding that "general offers to sell the domain name, even if no certain price is demanded, are evidence of bad faith").

The Panel finds Policy ¶4(a)(iii) has been 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 <cotmantransmissions.com> domain name be **TRANSFERRED** from Respondent to Complainant.


Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: September 17, 2007

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