



NATIONAL ARBITRATION FORUM

DECISION

Jerry Damson, Inc. v. Texas International Property Associates
Claim Number: FA0702000916991

PARTIES

Complainant is **Jerry Damson, Inc.** (“Complainant”), represented by **Angela Holt**, of **Lanier Ford Shaver & Payne, P.C.**, P.O. Box 2087, Huntsville, AL 35804. Respondent is **Texas International Property Associates** (“Respondent”), represented by **Gary Wayne Tucker**, of **Law Office of Gary Wayne Tucker**, PO Box 703431, Dallas, TX 75370.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**jerrydamsonacura.com**>, registered with **Compana, LLC**.

PANEL

The undersigned certify that they have acted independently and impartially and to the best of their knowledge have no known conflict in serving as Panelist in this proceeding.

Michael Albert, Houston Putnam Lowry, Chartered Arbitrator, and Judge Ralph Yachnin as Panelists.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on February 13, 2007; the National Arbitration Forum received a hard copy of the Complaint on February 14, 2007.

On February 19, 2007, Compana, LLC confirmed by e-mail to the National Arbitration Forum that the <**jerrydamsonacura.com**> domain name is registered with Compana, LLC and that Respondent is the current registrant of the name. Compana, LLC has verified that Respondent is bound by the Compana, LLC 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 February 21, 2007, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of March 13, 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@jerrydamsonacura.com by e-mail.

A timely Response was received and determined to be complete on March 13, 2007.

On March 16, 2007, Complainant submitted an additional written statement in reply to Respondent's response, pursuant to NAF Supplemental Rule 7. This response was received in a timely manner and is accepted by this panel.

On March 26, 2007, Respondent submitted an additional statement in objection and reply to Complainant's additional submission. This submission was received in a timely manner pursuant to NAF Supplemental Rule 7. Here, Respondent contested Complainant's additional submission as being beyond the scope of both the UDRP and the NAF Supplemental Rules.

On March 26, 2007, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the National Arbitration Forum appointed Michael Albert, Houston Putnam Lowry, Chartered Arbitrator, and Judge Ralph Yachnin as Panelists.

RELIEF SOUGHT

Complainant requests that the Domain Name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

Complainant Jerry Damson, Inc. ("Complainant") is an automobile dealer in Huntsville, Alabama, where it has been offering products and services, namely Acura automobiles and repair orders, since July 1989. Complainant claims it has continuously used the mark JERRY DAMSON ACURA in connection with the marketing and sales of said products and services for the past seven years. For the reasons stated below, Complainant requests this Panel to transfer the domain name, <jerrydamsonacura.com> ("Domain Name").

Complainant asserts that it is entitled to the Domain Name, as it meets the required elements of Paragraph 4(a) of the Policy, ("Paragraph 4(a)") because: (1) Respondent's domain name is identical to a service mark in which Complainant has rights; (2) because Respondent has no rights or legitimate interests in respect of the Domain Name; and (3) because the Domain Name was registered and is being used by Respondent in bad faith.

Complainant asserts that the Domain Name <jerrydamsonacura.com> is identical to its service mark JERRY DAMSON ACURA. Further, it has produced actual evidence to support the contention that it was the original user of said mark, that it has used it continuously since at least as early as July 1989, and that through such use it has established secondary meaning in said mark so as to be entitled to common law rights in it.

Complainant provides the sworn Affidavit of Philip L. Damson to support its assertion that as of July 1989 it has been using the mark JERRY DAMSON ACURA in association with its business and that it has invested significant time and money into advertising under said mark. Complainant further provides its July 31, 1989 Sales and Service

Agreement with American Honda Motor Co. as well as its sales, advertising, and repair information over the past seven years to evidence such use. Given this demonstration of continuous use of the JERRY DAMSON ACURA mark dating back at least as far as July 1989, Complainant asserts that it has established secondary meaning in this mark.

Furthermore, Complainant states it meets the second element of Paragraph 4(a) because Respondent has no rights or legitimate interests in the Domain Name. It argues that the Domain Name is being used by Respondent as a portal website of the type used to generate commissions or pay-per-click referral fees. The Domain Name and corresponding website are unrelated. Complainant also states that Respondent is known as “Texas International Property Associates” and thus, pursuant to Policy ¶ 4(c)(ii) is not commonly known by the Domain Name in question.

Finally, Complainant argues that it meets the third element of Paragraph 4(a) because Respondent registered and used the Domain Name in bad faith. Complainant asserts that under Policy ¶ 4(b)(iv), use of a Domain Name to divert users to a portal site containing pop-up advertising constitutes registration and use in bad faith. Complainant also provides evidence that Respondent holds several other domain names entailing well-known businesses, which similarly divert users to an advertising portal. Moreover, Complainant asserts that Respondent’s use will likely cause confusion as to Jerry Damson’s sponsorship or affiliation with Respondent’s website, and that this constitutes further evidence of bad faith.

B. Respondent

Respondent, Texas International Property Associates (“Respondent”), created the disputed domain name <jerrydamsonacura.com> on October 25, 2005. In its response, Respondent argues that Complainant has not met its burden of proof as to the three elements of Paragraph 4(a).

Respondent first asserts that Complainant holds no registered trademark for JERRY DAMSON ACURA and that it has failed to provide sufficient evidence establishing that a common law right to the mark Complainant is claiming existed at the time of Respondent’s registration of the disputed Domain Name. According to Respondent, the evidence provided by Complainant does not establish that the average consumer would associate Jerry Damson Acura with the products to which it claims a trademark, therefore it has not established secondary meaning in the mark. Additionally, Respondent asserts that the mark is merely the company owner’s personal name combined with the name of a car manufacturer and that as such, it should not be eligible for protection under the Uniform Domain Name Dispute Resolution Policy. Respondent argues that even if Complainant has acquired rights since Respondent’s registration, such rights would be irrelevant as to the registration. Respondent further claims that, if anything, Complainant only has a trade name which is not entitled to the protection afforded a trademark or a service mark.

Respondent further contends that it does, in fact, have rights and a legitimate interest in the disputed name. It asserts that it operates an advertising portal connecting users to a broad range of services and that because revenue is generated through advertising, such activity constitutes a legitimate interest. Respondent further asserts that it registered this name for this particular purpose as it believed the name Jerry Damson Acura to be a commonly used generic name to which no party had established secondary meaning. Given that this is in accord with its business practice of registering thousands of commonly used, generic, descriptive terms, Respondent contends that it had a legitimate interest in registering this name as well.

Finally, Respondent argues that Complainant has not demonstrated that the disputed Domain Name was registered and is now being used in bad faith. Respondent states here that, given its contention that Complainant did not have either a registered or unregistered trademark at the time of registration of the disputed Domain Name, Respondent could not have pursued the registration in bad faith. Respondent contends that this mark is a common name with substantial third-party use and that Complainant has not proffered evidence demonstrating that Respondent has specifically intended to confuse those consumers seeking out Complainant. Lastly, Respondent notes that it did not register the Domain Name with the intent to sell it to Complainant.

C. Additional Submissions

Complainant's Additional Submission:

In its Additional Submission in Reply to Respondent's Response, Complainant reasserts that it had common law rights to the JERRY DAMSON ACURA trademark far earlier than Respondent's registration in 2005. Complainant further states that Respondent's attempt to equate the Domain Name at issue with surname domain names such as <donna.com> are misplaced. As to Respondent's claimed legitimate interests in using this mark in its business of registering generic terms, Complainant argues that the mark JERRY DAMSON ACURA can in no way be considered a composition of generic terms. Given that Complainant has acquired secondary meaning in the mark, and that Respondent is using this meaning to divert users seeking information about Acura products, Complainant argues that Respondent does not have rights or legitimate interests in the Domain Name at issue. Finally, as to whether Respondent registered and used the Domain Name in bad faith, Complainant again points out that Respondent frequently registers domain names including famous or well-known marks and that here, it is using the Domain Name <jerrydamsonacura.com> for the purpose of capitalizing upon the goodwill engendered by the JERRY DAMSON ACURA mark. Since Respondent is capitalizing financially on such goodwill by diverting users to its website, Complainant asserts that Respondent is acting in bad faith.

Respondent's Objection and Reply to Complainant's Additional Submission

Respondent has made an additional submission both (1) objecting to Complainant's filing of an additional submission on the grounds that it is beyond the scope of both the UDRP

rules as well as the Supplemental Rules and (2) responding to the merits of the additional submission. First Respondent argues that Rule 7, which allows additional, unsolicited submissions, is an improper modification of the Rules for Uniform Domain Name Dispute Resolution Policy (“the Rules”). Additionally, Respondent notes that, assuming the Forum will accept such unsolicited filing, Rule 7 allows for only written statements and documents, not amendments. Respondent argues that Complainant’s submission was an undisguised attempt to amend its Complaint and that as such, it should be disallowed.

Furthermore, Respondent contests Complainant’s assertion that it has provided “extensive evidence” that it established secondary meaning in the JERRY DAMSON ACURA MARK. Respondent argues that neither the affidavit by Phillip L. Damson, the Jerry Damson Acura CEO, nor the sales records for the past seven years, nor the invoices of newspaper advertising, adequately connect Complainant’s actions with evidence that consumers recognize “Jerry Damson Acura” as a particular source for goods or services rather than merely being a trade name for a local business. Without such secondary meaning, Respondent asserts, Complainant can neither acquire common law rights, nor can it meet its burden of showing bad faith registration. Because Respondent had neither actual nor constructive notice of this mark, it maintains that it could not have acted in bad faith.

FINDINGS

The Panel finds Complainant has provided sufficient evidence to prove Complainant has acquired rights at common law to the JERRY DAMSON ACURA mark, the Domain Name in dispute is identical to Complainant’s mark, Respondent has no rights or legitimate interests in the mark, and Respondent registered and used the Domain Name in bad faith.

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 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;
- (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 provides sufficient evidence to establish it has rights in the JERRY DAMSON ACURA mark. Although its mark is not registered, Complainant has established common law rights in this trademark, which should be protected. *See British*

Broad Corp. v. Renteria, D2000-0050 (WIPO Mar. 23, 2000) (noting that the Policy “does not distinguish between registered and unregistered trademarks and service marks in the context of abusive registration of domain names” and applying the Policy to “unregistered trademarks and service marks”).

Complainant provides evidence demonstrating its acquisition of rights to do business under the JERRY DAMSON ACURA mark in 1989, its actual sales records over the past seven years, its expenditures on marketing and advertising, and several examples of its advertising practices under the mark. This evidence is sufficient to find Complainant has achieved a secondary meaning in the JERRY DAMSON ACURA mark and, through continuous use of this mark in connection with its car sales enterprise since 1989, has established its rights at common law in it. *See Tuxedos By Rose v. Nunez*, FA 95248 (Nat. Arb. Forum Aug. 17, 2000) (finding common law rights in a mark where its use was continuous and ongoing, and secondary meaning was established).

As Complainant contends and as the Panel now finds, the trademark JERRY DAMSON ACURA is identical to the Domain Name <jerrydamsonacura.com>. The mere addition of a generic top-level domain (“gTLD”) “.com” does not serve to adequately distinguish the Domain Name from the mark. *See Tropar Mfg Co., Inc. v. TSB*, FA 127701 (Nat. Arb. Forum Dec. 4, 2002) (“Respondent’s <tropar.us> domain name is identical to Complainant’s mark because it incorporates Complainant’s entire mark and merely adds the generic top-level domain “.us.” The addition of a generic top-level domain does not add any distinguishing characteristics to a domain name because it is a required feature in every domain name.”); *see also Gardline Surveys Ltd. v. Domain Fin. Ltd.*, FA 153545 (Nat. Arb. Forum May 27, 2003) (“The addition of a top-level domain is irrelevant when establishing whether or not a mark is identical or confusingly similar, because top-level domains are a required element of every domain name.”)

Given the Panel finds Complainant has achieved secondary meaning in the mark JERRY DAMSON ACURA, and given that its mark is identical to the Domain Name now in dispute, it is unnecessary under Policy ¶ 4(a)(i) to make a determination as to whether the Domain Name is comprised of common, generic terms.

For the above stated reasons the Panel finds Complainant satisfies Paragraph 4(a)(i) of the Policy.

Rights or Legitimate Interests

Complainant contends Respondent has no rights or legitimate interests in the <jerrydamsonacura.com> domain name. Respondent is operating a website in which the disputed domain name resolves to a portal displaying hyperlinks to various third-party websites as well as pop-up advertisements. The website also links to various car dealerships, which may be in competition with Complainant. It has been established that such use of a domain name constitutes neither a *bona fide* offering of goods and services under Policy ¶ 4(c)(i) nor a legitimate noncommercial or fair use under Policy ¶ 4(c)(iii). *See 24 Hour Fitness USA, Inc. v. 24HourNames.com-Quality Domains For Sale*, FA

187429 (Nat. Arb. Forum Sept. 26, 2003) (holding that Respondent's use of the <24hrsfitness.com>, <24-hourfitness.com> and <24hoursfitness.com> domain names to redirect Internet users to a website featuring advertisements and links to the Complainant's competitors could not be considered a *bona fide* offering of goods or services or a legitimate noncommercial or fair use); *see also Wells Fargo & Co. v. Lin Shun Shing*, FA 205699 (Nat. Arb. Forum Dec. 8, 2003) (finding that using a domain name to direct Internet traffic to a website featuring pop-up advertisements and links to various third-party websites is neither a *bona fide* offering of goods or services under Policy ¶ 4(c)(i) nor a legitimate noncommercial or fair use under Policy ¶ 4(c)(iii) because the registrant presumably receives compensation for each misdirected Internet user).

Furthermore there is no evidence Respondent is commonly known by the <jerrydamsonacura.com> Domain Name. Rather, according to the WHOIS information for the Domain Name, Respondent is known as Texas International Property Associates, a completely unrelated name. Under Policy ¶ 4(c)(ii), therefore, Respondent cannot have any rights or legitimate interests in the name. *See Gallup Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (finding that Respondent does not have rights in a domain name when Respondent is not known by the mark).

For the above stated reasons, the Panel finds Complainant has satisfied Paragraph 4(a)(ii) of the Policy.

Registration and Use in Bad Faith

Paragraph 4(b) of the Policy provides bad faith registration and use of a domain name can be shown by a variety of means, including by evidence that:

- (iv) by using the domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website ... by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website ... or of a product or service on its website...

Respondent is using the disputed Domain Name <jerrydamsonacura.com>, which is identical to Complainant's trademark, in order to divert users seeking information about Jerry Damson Acura to Respondent's website where, as a result of the pop-up advertisements and/or "click-through-fees" that resolve on this site, Respondent obtains commercial benefit. Respondent concedes, by way of its argument as to its legitimate interest, that it generates revenue through this activity. That Respondent registered this domain name and is using it for this purpose is evidence of bad faith. *See 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 paragraph 4(b)(iv) of the Policy because the Domain Name provided links to the Complainant's competitors and the Respondent presumably commercially benefited from the misleading domain name by receiving 'click-through-fees.'"); *see also*

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).

For the above stated reasons the Panel finds Complainant satisfies Paragraph 4(a)(iii) of the Policy.

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 <**jerrydamsonacura.com**> domain name be **TRANSFERRED** from Respondent to Complainant.



Michael A. Albert, Esq.
Arbitrator

Michael Albert, Panelist and Chair
Houston Putnam Lowry, Chartered Arbitrator, Panelist
Judge Ralph Yachnin, Panelist

Dated: April 10, 2007

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