



NATIONAL ARBITRATION FORUM

DECISION

Michael Erb v. First In Products
Claim Number: FA0604000678032

PARTIES

Complainant is **Michael Erb** ("Complainant"), represented by **Bernard C. Dietz**, of **Dozier Internet Law, PC**, 301 Concourse Boulevard, West Shore III, Suite 300, Glen Allen, VA 23059. Respondent is **First In Products** ("Respondent"), 9121 Atlanta Avenue, #911, Huntington Beach, CA 92646.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**larescue.com**>, registered with **Wild West Domains, 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 April 13, 2006; the National Arbitration Forum received a hard copy of the Complaint on April 14, 2006.

On April 13, 2006, Wild West Domains, Inc. confirmed by e-mail to the National Arbitration Forum that the <**larescue.com**> domain name is registered with Wild West Domains, Inc. and that Respondent is the current registrant of the name. Wild West Domains, Inc. has verified that Respondent is bound by the Wild West Domains, 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 April 18, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of May 8, 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@larescue.com by e-mail.

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

On May 12, 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:

The Complainant, Michael Erb, is the majority shareholder of L.A. Rescue, Inc., a California corporation formed by the Complainant on October 9, 1986. L.A. Rescue designs and sells a wide range of bags and accessories to firefighters, emergency medical services personnel, law enforcement officers, ambulance companies, search and rescue groups, and related service providers. Over the last twenty years of nationwide sales, L.A. Rescue has developed a reputation for providing high quality, durable products and excellent customer service.

L.A. Rescue sells its products worldwide through a national distribution arrangement with Emergency Medical Products, Inc., the leading distributor of emergency equipment in the United States.

On March 14, 1989, L.A. Rescue, Inc. registered a federal trademark for the mark "L.A. Rescue," registration number 1530379, for the international class 18, which trademark is still in effect and live. On November 9, 1995, L.A. Rescue, Inc. assigned the trademark to the Complainant, which was then licensed on a non-exclusive basis to L.A. Rescue, Inc. for its use. The registered trademark has been used continuously, and is being used, to market and sell products to the emergency responder marketplace.

The Respondent, First In Products, upon information and belief, is a California corporation formed on July 30, 1998. The Respondent sells products similar to those of the Complainant to the same potential purchasers as the Complainant. Specifically, the Respondent, through its web site, sells bags and accessories to firefighters, law enforcement and emergency medical service personnel.

- [a.] The Respondent's domain name, larescue.com, minus the generic ".com" TLD, is clearly identical to the registered trademark in which the Complainant has rights. Complainant, by registering the L.A. Rescue mark with the USPTO, has established rights in this mark pursuant to Policy ¶4(a)(i). See *Innomed Techs., Inc. v. DRP Servs.*, FA 221171 (Nat. Arb. Forum Feb. 18, 2004) ("Registration of the NASAL-AIRE mark with the USPTO establishes Complainant's rights in the mark."); *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."); see also *Janus Int'l Holding Co. v. Rademacher*, D2002-0201 (WIPO Mar. 5, 2002) ("Panel decisions have held that registration of a mark is prima facie evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive.").

For the foregoing reasons, Complainant respectfully requests the Panel to find that the "larescue.com" domain name is identical or confusingly similar to the "L.A. Rescue" mark in which the Complainant has registered federal trademark rights.

- [b.] The Respondent does not have any demonstrable rights or legitimate interests in the domain name larescue.com. The domain name in dispute does not reflect a name by which the Respondent is commonly known or in which the Respondent has any rights, which the Respondent expressly acknowledges on the web site to which the domain resolves by stating that "(w)e are NOT affiliated with L.A. Rescue®". In addition, nothing in the Whois record for Respondent establishes a right of Respondent in the domain name. The Respondent registered the domain larescue.com on January 22, 2003, more than fourteen years after the Complainant registered its trademark with the USPTO and more than seventeen years after the Complainant first used the mark in commerce. The Respondent is using the Complainant's registered trademark without the authorization or consent of the Complainant.

Internet users that access the Respondent's larescue.com domain name are shown a temporary page that states:

"Your Web-browser has redirected you to the web site of First In Products, Inc.
We do NOT sell products from L.A. Rescue®.
We are NOT affiliated with L.A. Rescue®.
If you would like to view High Performance Gear designed for Fire Fighters, Law Enforcement, and EMS Professionals, please click on the link below and view
www.firstinproducts.com
Or wait 10 seconds and you will be redirected automatically.
If your intent was to go to the L.A. Rescue® Website,
Please close your browser and try another link."

Within a matter of ten seconds, the Internet user is automatically taken to the Respondent's homepage at www.firstinproducts.com on which it sells competing products. The Respondent's domain name serves merely as a vehicle to redirect Internet users that are searching for the Complainant to Respondent's competing web site to generate revenue off of the confusion. Based on the traffic counter that is displayed on Respondent's domain, showing 5,396 visitors to Respondent's domain over some period of time, this confusion is substantial and severely damaging to the Complainant.

For the foregoing reasons, the Complainant respectfully requests the Panel to find that the Respondent has no rights or legitimate interest in the larescue.com domain name.

- [c.] The domain name was registered and is being used in bad faith. As discussed above, the Respondent has no demonstrable right or legitimate interest in the L.A. Rescue mark. In addition, the Complainant and Respondent are operating in the same industry selling very similar products to the same customer base.

The Respondent, on its domain, acknowledges the existence and validity of the Complainant's registered mark in "L.A. Rescue" and states that it is not affiliated with the Complainant. The Respondent then provides multiple links to its competing web site and requests that visitors click through to Respondent's web site. However, whether the visitor wants to or not, the visitor is automatically redirected and taken to the Respondent's web site after ten seconds of landing on Respondent's domain. Given the size of the industry in which the Complainant and Respondent operate and the prominence that the Complainant has earned in its markets over the last twenty years of continuous operations, it is clear that Respondent recognized the value of the domain in dispute and has registered and used it solely to capitalize, for commercial gain, on the Complainant's registered mark.

Respondent's use of its domain to offer similar goods in competition with the Complainant is not a legitimate noncommercial or fair use under Policy ¶4(c)(iii). See *Microsoft Corp. v. Random Interactive Tech., Inc.*, FA 614528 (Nat. Arb. Forum Feb. 13, 2006) ("Respondent's use of a domain name that is confusingly similar to Complainant's XBOX mark to redirect Internet users interested in Complainant's goods and services to a website that offers similar goods and services in competition with Complainant is not a use in connection with a bona fide offering of goods or services pursuant to Policy ¶4(c)(i) or a legitimate noncommercial or fair use of the domain name pursuant the Policy ¶4(c)(iii)."); see also *Microsoft Corp. v. Woo Seungchul*, FA 601455 (Nat. Arb. Forum Jan. 20, 2006) ("The panel finds that appropriating another's mark to refer Internet traffic to competitors and unrelated third parties is not a bona fide offering of a

good or service . . .”). See also *Nokia Corp. v. Private*, D2000-1271 (WIPO Nov. 3, 2000) (finding bad faith registration and use pursuant to Policy § 4(b)(iv) where the domain name resolved to a website that offered similar products as those sold under the complainant’s famous mark).

For the foregoing reasons, the Complainant respectfully requests the Panel to find that the Respondent registered and is using the larescue.com domain name in bad faith.

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

FINDINGS

Complainant, Michael Erb, is the founder and majority shareholder of L.A. Rescue, Inc., a California corporation that designs and sells bags and accessories to firefighters, emergency medical services personnel, law enforcement officers, ambulance companies and other related services.

Complainant has continuously and extensively used the L.A. RESCUE mark in connection with its products since 1986. Complainant holds a trademark registration for the L.A. RESCUE mark with the United States Patent and Trademark Office (“USPTO”) (Reg. No. 1,530,379 issued March 14, 1989).

Respondent registered the <larescue.com> domain name on January 22, 2003 and is using the disputed domain name to redirect Internet users its own website at the <firstinproducts.com> domain name, where it offers bags and accessories to emergency personnel in direct competition with Complainant. Respondent’s website at the disputed domain name also includes a disclaimer stating that it is not affiliated with Complainant and does not sell Complainant’s products

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

Complainant has demonstrated its rights in the L.A. RESCUE mark by registering the mark with the USPTO. *See Innomed Techs., Inc. v. DRP Servs.*, FA 221171 (Nat. Arb. Forum Feb. 18, 2004) (“Registration of the NASAL-AIRE mark with the USPTO establishes Complainant's rights in the mark.”); *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.”).

Respondent’s <larescue.com> domain name is identical to Complainant’s L.A. RESCUE mark pursuant to Policy ¶4(a)(i), because it includes the entire registered mark and merely eliminates punctuation marks and the space between terms, and simply adds the generic top-level domain (“gTLD”) “.com.” Panels have held the elimination of punctuation marks and spaces between words, as well as the mere addition of a gTLD, do not sufficiently differentiate a domain name from a registered mark pursuant to Policy ¶4(a)(i). *See Hannover Ruckversicherungs-AG v. Ryu*, FA 102724 (Nat. Arb. Forum Jan. 7, 2001) (finding <hannoverre.com> to be identical to HANNOVER RE, “as spaces are impermissible in domain names and a generic top-level domain such as ‘.com’ or ‘.net’ is required in domain names”); *see also Pomellato S.p.A v. Tonetti*, D2000-0493 (WIPO July 7, 2000) (finding <pomellato.com> identical to the complainant’s mark because the generic top-level domain (gTLD) “.com” after the name POMELLATO is not relevant); *see also Mrs. World Pageants, Inc. v. Crown Promotions*, FA 94321 (Nat. Arb. Forum Apr. 24, 2000) (finding that punctuation is not significant in determining the similarity of a domain name and mark). Therefore, the <larescue.com> domain name is identical to Complainant’s L.A. RESCUE mark.

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

Rights or Legitimate Interests

Complainant claims Respondent has no rights or legitimate interests in the <larescue.com> domain name. Complainant has the initial burden of proof in establishing Respondent lacks rights or legitimate interests in the domain name. Once Complainant makes a *prima facie* case in support of its allegations, the burden then shifts to Respondent to show it does have rights or legitimate interests pursuant to Policy ¶4(a)(ii). *See 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 the respondent has no right or legitimate interest is sufficient to shift the burden of proof to the respondent to demonstrate that such a right or legitimate interest does exist); *see also Do The Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000) (once the complainant asserts the respondent has no rights or legitimate interests with respect to the domain, the burden shifts to the respondent to provide “concrete evidence it has rights to or legitimate interests in the domain name at issue”).

Respondent’s failure to answer the Complaint raises a presumption Respondent has no rights or legitimate interests in the disputed domain name. *See Bank of Am. Corp. v. McCall*, FA 135012 (Nat. Arb. Forum Dec. 31, 2002) (“Respondent's failure to respond not only results in its failure to meet its burden, but also will be viewed as evidence itself Respondent lacks rights and legitimate interests in the disputed domain name.”); *see also Canadian Imperial Bank of Commerce v. D3M Virtual Reality Inc.*, AF-0336 (eResolution Sept. 23, 2000) (finding no rights or legitimate interests where no such right or interest was immediately apparent to the panel and the respondent did not come forward to suggest any right or interest it may have possessed). However, the Panel will now examine the record to determine if Respondent has rights or legitimate interests under Policy ¶4(c).

Respondent is not commonly known by the <larescue.com> domain name, because the WHOIS information lists “First In Products” as the registrant of the domain name, and there is no other evidence in the record suggesting Respondent is commonly known by the disputed domain name. Thus, Respondent has not established rights or legitimate interests in the disputed domain name pursuant to Policy ¶4(c)(ii). *See Broadcom Corp. v. Intellifone Corp.*, FA 96356 (Nat. Arb. Forum Feb. 5, 2001) (finding no rights or legitimate interests because the respondent is not commonly known by the disputed domain name or using the domain name in connection with a legitimate or fair use); *see also Am. Online, Inc. v. World Photo Video & Imaging Corp.*, FA 109031 (Nat. Arb. Forum May 13, 2002) (finding that the respondent was not commonly known by <aolcamera.com> or <aolcameras.com> because the respondent was doing business as “Sunset Camera” and “World Photo Video & Imaging Corp.”).

Respondent’s <larescue.com> domain name, which is identical to Complainant’s L.A. RESCUE mark, ultimately resolves to a website selling clothing and accessories to emergency personnel in direct competition with Complainant. In *Or. State Bar v. A Special Day, Inc.*, FA 99657 (Nat. Arb. Forum Dec. 4, 2001), the panel found that the respondent’s use of the <oregonstatebar.tv> domain name to redirect Internet users to its own website selling products that competed with the complainant’s products under the OREGON STATE BAR mark was not a *bona fide* offering of goods or services, stating, “Respondent is using a mark confusingly similar to the Complainant's to sell competing goods.” Likewise, Respondent is also diverting Internet users seeking Complainant’s emergency personnel products under the L.A. RESCUE mark to a website offering competing services. Such diversionary use of the disputed domain name for Respondent’s own commercial gain does not constitute a *bona fide* offering of goods or

services pursuant to Policy ¶4(c)(i), or a legitimate noncommercial or fair use of the domain name pursuant to Policy ¶4(c)(iii). *See Computerized Sec. Sys., Inc. v. Hu*, FA 157321 (Nat. Arb. Forum June 23, 2003) (“Respondent’s appropriation of [Complainant’s] SAFLOK mark to market products that compete with Complainant’s goods does not constitute a bona fide offering of goods and services.”). Despite Respondent’s use of a disclaimer on its website, the Panel finds Respondent’s use of Complainant’s entire L.A. RESCUE mark in the domain name does not mitigate consumer confusion and thus does not give Respondent rights or legitimate interests in the <**larescue.com**> domain name. *See DaimlerChrysler Corp. v. Bargman*, D2000-0222 (WIPO May 29, 2000) (finding that addition of a disclaimer, when the domain name consists of the complainant’s well-known trademark, does not counter the expectation of Internet users that the domain name is sponsored by the complainant)

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

Registration and Use in Bad Faith

Respondent has registered and is using the <**larescue.com**> domain name in bad faith pursuant to Policy ¶4(b)(iv), because the disputed domain name resolves to a website selling products in direct competition with Complainant. The Panel infers Respondent profits from each consumer who buys emergency personnel products from Respondent instead of from Complainant. Respondent is taking advantage of consumer confusion as to the affiliation of Respondent’s domain name with Complainant’s L.A. RESCUE mark, and profiting from the goodwill associated with the mark. The addition of a disclaimer to Respondent’s website does not negate a finding of bad faith pursuant to Policy ¶4(b)(iv). *See Luck's Music Library v. Stellar Artist Mgmt.*, FA 95650 (Nat. Arb. Forum Oct. 30, 2000) (finding the respondent engaged in bad faith use and registration by using domain names that were identical or confusingly similar to the complainant’s mark to redirect users to a website that offered services similar to those offered by the complainant); *see also Identigene, Inc. v. Genetest Labs.*, D2000-1100 (WIPO Nov. 30, 2000) (finding bad faith where the respondent's use of the domain name at issue to resolve to a website where similar services are offered to Internet users is likely to confuse the user into believing the complainant is the source of or is sponsoring the services offered at the site); *see also Ciccone v. Parisi*, D2000-0847 (WIPO Oct. 12, 2000) (“Respondent’s use of a disclaimer on its website is insufficient to avoid a finding of bad faith. First, the disclaimer may be ignored or misunderstood by Internet users. Second, a disclaimer does nothing to dispel initial interest confusion that is inevitable from Respondent’s actions. Such confusion is a basis for finding a violation of Complainant’s rights.”).

The Panel’s level of scrutiny is higher for domain names that forward to a web site at another domain name.

Respondent has registered and used the <**larescue.com**> domain name for the primary purpose of disrupting the business of Complainant. Respondent’s domain name ultimately resolves (by forwarding) to a website at the <**firstinproducts.com**> domain

name, which offers competing goods to emergency personnel. Respondent has registered and used the domain name in bad faith pursuant to Policy ¶4(b)(iii). *See S. Exposure v. S. Exposure, Inc.*, FA 94864 (Nat. Arb. Forum July 18, 2000) (finding the respondent registered the domain name in question to disrupt the business of the complainant, a competitor of the respondent); *see also Disney Enters., Inc. v. Noel*, FA 198805 (Nat. Arb. Forum Nov. 11, 2003) (“Respondent registered a domain name confusingly similar to Complainant's mark to divert Internet users to a competitor's website. It is a reasonable inference that Respondent's purpose of registration and use was to either disrupt or create confusion for Complainant's business in bad faith pursuant to Policy ¶4(b)(iii) [and] (iv).”).

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



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: May 23, 2006

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