



NATIONAL ARBITRATION FORUM

DECISION

Ruth Vending, Inc. d/b/a Tuffronts v. Profits On The Web
Claim Number: FA0602000646989

PARTIES

Complainant is **Ruth Vending, Inc.** d/b/a **Tuffronts** (“Complainant”), represented by **Frank E. McLain**, of **Frank E. McLain Law Firm, P.C.**, 8226 Douglas Avenue, Suite 600, Dallas, TX 75225. Respondent is **Profits On The Web** (“Respondent”), P O Box 171867, Arlington, TX 76003-1867.

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are <**tuffronts.com**> and <**tuffronts.net**>, 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 February 16, 2006; the National Arbitration Forum received a hard copy of the Complaint on February 21, 2006.

On February 17, 2006, Wild West Domains, Inc. confirmed by e-mail to the National Arbitration Forum that the <**tuffronts.com**> and <**tuffronts.net**> domain names are registered with Wild West Domains, Inc. and that the 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 February 23, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of March 15, 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@tuffronts.com and postmaster@tuffronts.net by e-mail.

A timely Response was received and determined to be complete on March 15, 2006.

On March 21, 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.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

This dispute concerns the <**tuffronts.com**> and <**tuffronts.net**> domain names ("the Domain Names"). The registrar for both disputed Domain Names is the same, Profits on the Web, which maintains a place of business in the United States.

Complainant, Ruth Vending, Inc., owns the TUFFFRONTS mark ("Trademark") by and through federal trademark registration No. 2,923,138 filed February 1, 2005, serial number 78/355,628, and holds the assumed named certificate for Tuffronts for the State of Texas duly filed January 17, 2003.

Complainant states that its Trademark ownership entitles it to a transfer of each of the disputed Domain Names set forth in Section 6(a). The Trademark is used as identification to build good will for Complainant's products sold to the vending machine industry and any potential market that requires precut hard surface panels that are placed on, over and around vending machines.

FACTUAL AND LEGAL ALLEGATIONS

The TUFFFRONTS Mark

- a. The Complainant has received the TUFFFRONTS mark by a Certificate of Registration from the Commissioner of Patents and Trademarks pursuant to a notice of publication issued by the United States Patent and Trademark Office dated October 20, 2004. In addition, Complainant is the owner of strong common law rights in the TUFFFRONTS mark. Through extensive and continuous use, advertising and promotion, the TUFFFRONTS mark has become synonymous in the vending machine industry with durable, dependable and affordable panels to replace existing front panels on vending machines, and the mark enjoys an excellent reputation. Further, the TUFFFRONTS mark is entitled to the widest scope of protection afforded by the law including protection against dilution. Complainant secured its assumed name registration for the TUFFFRONTS mark with the Texas Secretary of State's office on January 17, 2003 to use in conjunction with marketing and promotion of its replacement panels to existing front panels on vending machines.

Thereafter it secured a federal registration of the TUFFFRONTS mark (Reg. No. 2,923,138 issued February 1, 2005) with the United States Patent and Trademark Office.

- b. Although Respondent has registered the Domain Names in dispute, it has done nothing more. Respondent has not established a web site for these names although they have been registered since November 6, 2003. Respondent's Domain Names have not been used primarily for any *bona fide* business or commercial purpose. Rather, these names were hijacked by Respondent for the benefit of its client Larry Stark of S. Thomas & Associates, 2517 East Union Bower, Irving, Texas, 75061 ("Respondent's Client"), who is in competition with Complainant.
- c. The genesis for Respondent's pirating came as a result of Respondent's Client finding out that Respondent's product marketed under the TUFFFRONTS name fit with Respondent's Client's product mix. Respondent's Client came to the Dallas, Texas office of Complainant on October 23, 2003 and purchased two TUFFFRONTS panels. Complainant was at that time using the TUFFFRONTS mark as its trade name. On October 31, 2003, Respondent purchased an additional six TUFFFRONTS vending machine panels from Complainant and an additional three panels from Complainant over the invoice trade name TUFFFRONTS. Thereafter, on November 6, 2003, Respondent's Client purchased an additional three TUFFFRONTS vending machine panels. Thereafter on November 14, 2003, Respondent's Client purchased an additional three TUFFFRONTS panels. At that time, Complainant was engaged in general advertising to the vending machine trade for its TUFFFRONTS precut plastic panels, which replace the existing front panels on vending machines in need of an updated fresh appearance.
- d. On November 6, 2003, without the consent or permission of Complainant, Respondent registered the disputed Domain Names.
- e. Users looking for Complainant's presence on the Internet will naturally access the Domain Names and will find there is no web site at either Domain Name, creating the impression that Complainant is inept, inefficient and does not have the resources and/or ability to develop a web site using the Domain Names.
- f. Respondent is currently holding the Domain Names hostage either for the purpose of selling, renting or otherwise transferring the Domain Names to Complainant for valuable consideration in excess of Respondent's costs or in order to prevent Respondent from using the Domain Names. Respondent is not making a legitimate non-commercial or commercial use of the domain names.

- g. The TUFFFRONTS mark has a strong reputation in the vending machine industry. Respondent can make no good faith use of the Domain Names and it is not possible to conceive of any plausible actual or contemplated active use of the Domain Names by the Respondent that would be legitimate, including passing off as Complainant, infringing consumer protection legislation, or infringing Complainant's rights under the trademark law. Respondent has registered the Domain Names primarily for the purpose of disrupting the business of Complainant.

B. Respondent

This Response specifically responds to the statements and allegations contained in the Complaint and includes any and all bases for the Respondent to retain registration and use of the disputed domain name. ICANN Rule 5(b)(i)

- a. At the time the disputed domain names were registered, November 6, 2003, the Complainant had not yet filed for a trademark registration for the TUFFFRONTS mark. The trademark filing date of January 24, 2005 followed a conversation between Complainant and Respondent in which Complainant threatened to ruin Respondent's reputation and business.
- b. Respondent registered the disputed domains with the intent of using them to market Respondent's "Premium Search Engine Program", a key component in Respondent's business of web site development services.
 - (i.) First use of Domain Names: The domain names were pointed to a specific page on Respondent's web site in December, 2003, <profitsontheweb.com/tufffronts/htm>
 - (ii.) Legitimate and Fair Use of Domain Names: The domain names are used to market TuffFront pages, web site front pages designed and optimized to rank high against the tough competition for search engine placement.
 - (iii.) Use of Domain Names for Competition: Domains names are used as a marketing tool in the highly competitive field of search engine placement. The domain names have never been used or intended to divert potential customers of or in any way hinder the Respondent's business in the vending machine industry.
- c. Domain Names were not registered in nor are they being used in bad faith.
 - (i.) Disputed domain names are not now, nor have they ever been for sale by Respondent. While Respondent is a reseller for Wild West Domains and as such makes a profit from selling domain name registrations, Respondent has never purchased a domain name for the purpose of selling

said domain name at a profit. Respondent's business is the Design, Development and Promotion of web sites for businesses.

- (ii.) Respondent has never engaged in the pattern of registering a domain name to prevent another company from using that name. Having sold web site services to approximately 100 clients over the last five years Respondent has many clients who are competitors within their industry. As every business is a potential client Respondent's business credibility would suffer from such practices.
- (iii.) Competition between Respondent and Complainant: There is no competition between Respondent's business and Complainant's business. Respondent has a client that is a direct competitor of Complainant's. However, their relationship is strictly limited to web site services provided to the client. The disputed domain names are not used in any manner whatsoever to benefit the client or harm the Complainant.
- (iv.) Use of the disputed domain names in regards to Complainant's Business: There is no relationship between the use of or intended use of the domain names that in any way competes with or conflicts with Complainant's business.

FINDINGS

The chronology of events is:

January 17, 2003 – Complainant registered the tradename Tuffronts with the Texas Secretary of State.

April 1, 2003 – Complainant first uses the Tuffronts trademark in commerce.

November 6, 2003 – Respondent registers the two domain names at issue in this proceeding.

January 1, 2004 – Complainant files its trademark application with the United States Patent & Trademark Office.

November 9, 2004 – The United States Patent & Trademark Office publishes Complainant's mark.

February 1, 2005 – United States Patent & Trademark Office registers the Tuffronts trademark.

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the 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.

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 the 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 the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the 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 alleges it has established rights in the TUFFFRONTS mark by registering the mark with the United States Patent and Trademark Office (“USPTO”) (Reg. No. 2,923,138 filed January 22, 2004 and issued February 1, 2005). *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.”).

The Panel finds registration of a mark with the USPTO or in another country is not required under the Policy. *See SeekAmerica Networks Inc. v. Masood*, D2000-0131 (WIPO Apr. 13, 2000) (finding that the Rules do not require that the complainant's trademark or service mark be registered by a government authority or agency for such rights to exist); *see also Great Plains Metromall, LLC v. Creach*, FA 97044 (Nat. Arb. Forum May 18, 2001) (“The Policy does not require that a trademark be registered by a governmental authority for such rights to exist.”).

Complainant has continuously and extensively used the TUFFFRONTS mark in connection with its line of vending machine surface panels since at least January 17, 2003, when the State of Texas granted it an assumed name certificate. The Panel concludes Complainant’s TUFFFRONTS mark has acquired secondary meaning sufficient to establish common law rights to the mark. *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); *see also Nat’l Ass’n of Prof’l Baseball Leagues v. Zuccarini*, D2002-1011 (WIPO Jan. 21, 2003) (finding that the complainant had provided evidence that it had valuable goodwill in the

<minorleaguebaseball.com> domain name, establishing common law rights in the MINOR LEAGUE BASEBALL mark).

The <tuffronts.com> and <tuffronts.net> domain names are identical to its TUFFFRONTS mark because each wholly incorporates the mark and merely adds a different generic top-level domain. The Panel finds that the mere addition of a generic top-level domain such as “.com” or “.net” is irrelevant in determining whether a domain name is confusingly similar to a complainant’s mark pursuant to Policy ¶4(a)(i). *See Rollerblade, Inc. v. McCrady*, D2000-0429 (WIPO June 25, 2000) (finding that the top level of the domain name such as “.net” or “.com” does not affect the domain name for the purpose of determining whether it is identical or confusingly similar); *see also Sporty's Farm L.L.C. vs. Sportsman's Mkt., Inc.*, 202 F.3d 489 (2d Cir. 2000), *cert. denied*, 530 U.S. 1262 (2000), (“For consumers to buy things or gather information on the Internet, they need an easy way to find particular companies or brand names. The most common method of locating an unknown domain name is simply to type in the company name or logo with the suffix .com.”).

Rights or Legitimate Interests

Complainant must first make a *prima facie* case Respondent lacks rights and legitimate interests in the disputed domain names under Policy ¶4(a)(ii), and then the burden shifts to Respondent to show it does have rights or legitimate interests. *See 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).”); *see also Do The Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000) (holding that, where the complainant has asserted that the respondent has no rights or legitimate interests with respect to the domain name, it is incumbent on the respondent to come forward with concrete evidence rebutting this assertion because this information is “uniquely within the knowledge and control of the respondent”).

Complainant contends Respondent is not commonly known by the <tuffronts.com> and <tuffronts.net> domain names, and Complainant has not authorized or licensed Respondent to register or use a domain name incorporating Complainant’s TUFFFRONTS mark. The Panel agrees with these contentions. Respondent is not commonly known by the disputed domain names. The Panel finds Respondent does not have rights or legitimate interests in the domain names pursuant to Policy ¶4(c)(ii). *See Ian Schrager Hotels, L.L.C. v. Taylor*, FA 173369 (Nat. Arb. Forum Sept. 25, 2003) (finding that without demonstrable evidence to support the assertion that a respondent is commonly known by a domain name, the assertion must be rejected); *see also Gallup, Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (finding that the respondent does not have rights in a domain name when the respondent is not known by the mark).

Complainant argues Respondent has been passively holding the <**tuffronts.com**> and <**tuffronts.net**> domain names since 2003 because Respondent's domain names resolve to a blank page, and there is no evidence that Respondent used the domain name previously. Complainant asserts Respondent has made no demonstrable preparations for use of the disputed domain names. Respondent counters that it was planning an advertising campaign that would use the TUFFFRONTS mark to gain search engine placement (although there is no showing why Respondent thinks he was authorized to do this or who he was doing it for). The Panel holds that such non-use of the disputed domain names for over two years does not constitute a *bona fide* offering of goods and services pursuant to Policy ¶4(c)(i) or a legitimate noncommercial or fair use pursuant to Policy ¶4(c)(iii). *See Boeing Co. v. Bressi*, D2000-1164 (WIPO Oct. 23, 2000) (finding no rights or legitimate interests where the respondent has advanced no basis on which the panel could conclude that it has a right or legitimate interest in the domain names, and no commercial use of the domain names has been established); *see also Am. Home Prods. Corp. v. Malgioglio*, D2000-1602 (WIPO Feb. 19, 2001) (finding no rights or legitimate interests in the domain name <solgarvitamins.com> where the respondent merely passively held the domain name).

Registration and Use in Bad Faith

Complainant claims Respondent has registered and is using the <**tuffronts.com**> and <**tuffronts.net**> domain names in bad faith, because it is not using the domain names for any purpose and is passively holding the disputed domain names.

A domain name can be used for a number of purposes:

1. Hosting a web site.
2. Providing email addresses.
3. Providing a "back-end" for ecommerce transactions.
4. Blocking another from using the domain name.

See Basic Chemical Solutions, LLC v. BCS California Corporation and Jason Singh, AF-0923 (8/3/2001). The fact there is no web site merely means the domain name is not being used for that purpose; it does not mean the domain name is not being used at all.

The Panel finds such non-use of the disputed domain names provides evidence of bad faith registration and use pursuant to Policy ¶4(a)(iii). *See DCI S.A. v. Link Commercial Corp.*, D2000-1232 (WIPO Dec. 7, 2000) (concluding that the respondent's passive holding of the domain name satisfies the requirement of ¶4(a)(iii) of the Policy); *see also Caravan Club v. Mrgsale*, FA 95314 (Nat. Arb. Forum Aug. 30, 2000) (finding that the respondent made no use of the domain name or website that connects with the domain name, and that passive holding of a domain name permits an inference of registration and use in bad faith).

The Panel finds Respondent registered the <**tuffronts.com**> and <**tuffronts.net**> domain names for the sole purpose of preventing Complainant from reflecting its TUFFFRONTS

mark in the domain names, and the registration of two domain names that infringe on Complainant's mark constitutes a pattern of bad faith conduct pursuant to Policy ¶4(b)(ii). *See YAHOO! INC v. SYRYNX, INC.*, D2000-1675 (WIPO Jan. 30, 2001) (finding a bad faith pattern pursuant to Policy ¶4(b)(ii) in the respondent's registration of two domain names incorporating the complainant's YAHOO! mark); *see also Gamesville.com, Inc. v. Zuccarini*, FA 95294 (Nat. Arb. Forum Aug. 30, 2000) (finding that the respondent engaged in a pattern of conduct of registering domain names to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, which is evidence of registration and use in bad faith).

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 <tuffronts.com> and <tuffronts.net> domain names be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.
Arbitrator

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

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