



## NATIONAL ARBITRATION FORUM

### DECISION

Federal Signal Corporation v. Maltuzi, LLC  
Claim Number: FA0803001158611

#### PARTIES

Complainant is **Federal Signal Corporation** (“Complainant”), represented by **Heather J. Kliebenstein**, of **Merchant & Gould, P.C.**, Minnesota, USA. Respondent is **Maltuzi LLC** (“Respondent”), represented by **William A. Delgado**, of **Willenken Wilson Loh & Lieb LLP**, California, USA.

#### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**viperlightbar.com**>, registered with **Nameking.com, 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 March 6, 2008; the National Arbitration Forum received a hard copy of the Complaint on March 7, 2008.

On March 7, 2008, Nameking.com, Inc. confirmed by e-mail to the National Arbitration Forum that the <**viperlightbar.com**> domain name is registered with Nameking.com, Inc. and that the Respondent is the current registrant of the name. Nameking.com, Inc. has verified that Respondent is bound by the Nameking.com, 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 March 24, 2008, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of April 14, 2008 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@viperlightbar.com by e-mail.

A timely Response was received and determined to be complete on April 10, 2008.

On April 16, 2008, 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 name be transferred from Respondent to Complainant.

## **PARTIES' CONTENTIONS**

### A. Complainant

Federal Signal owns the United States trademark registration for the mark VIPER, Reg. No. 2,464,438 in International Class 9 for "halogen and strobe warning lights for use on vehicles."

## FACTUAL AND LEGAL GROUNDS

Federal Signal Corporation is a well-known manufacturer of vehicle warning lights. Federal Signal has extensively used and advertised the famous VIPER brand in association with vehicle warning lights dating back to at least as early as 1999. The VIPER trademark is highly regarded, representing valuable goodwill to Federal Signal. Federal Signal also owns the United States trademark registration for the mark VIPER, Reg. No. 2,464,438 in class 9 for "Halogen and strobe warning lights for use on vehicles." This trademark registration is *prima facie* evidence of Federal Signal's exclusive rights to use the VIPER mark.

As a result of the extensive promotion of the VIPER brand, Federal Signal has developed substantial goodwill and consumer loyalty under the VIPER mark. Federal Signal enjoys a strong reputation among consumers and customers of vehicle warning lights for the highest-quality, most highly effective products. As a result of these efforts, the VIPER mark is distinctive, widely known and extremely valuable to Federal Signal.

Respondent registered the domain name <**viperlightbar.com**> on September 18, 2006 with NameKing, Inc. ("NameKing") under NameKing's domain name policy. The Respondent has no statutory or common law trademark rights or any other right or legitimate interest to the mark VIPER or in the infringing domain name <**viperlightbar.com**>.

Respondent has registered and used the domain name in bad faith. There is no evidence the domain name was registered for a legitimate reason. Rather, the evidence shows the domain name was registered primarily for the purpose of commercial gain by placing links such as "Light Bars" and "Emergency Lighting" on the <**viperlightbar.com**> website. These links in turn provide further information and links relating to Federal Signal's competitors. The <**viperlightbar.com**> domain name in combination with links and information relating to products sold by Federal Signal under the VIPER trademark

creates confusion and is likely to trick consumers into clicking on links they believe will show Federal Signal's products and services. In turn, Respondent appears to receive money for each click or sale made through those links.

Respondent has no legitimate interest in the domain name **<viperlightbar.com>**. Moreover, Respondent's continued trafficking of that domain name without the permission of Federal Signal is bad faith. Transfer of the domain name to Federal Signal is appropriate.

- a. The Domain Name **<viperlightbar.com>** is Confusingly Similar to the VIPER mark

Respondent's domain name, **<viperlightbar.com>**, contains Federal Signal's VIPER mark. *See Sony Kabushiki Kaisha v. Inja, Kil*, D2000-1409 (WIPO Dec. 9, 2000) (finding that the addition of the suffix ".com" does not detract from the overall impression of the dominant part of the name).

Consumers are likely to be confused that the website located at **<viperlightbar.com>** is sponsored and/or endorsed by or affiliated with Federal Signal's VIPER brand products. The use of a mark that is so similar for identical goods is likely to confuse the public and those desiring to obtain a particular entity's services and products. *FaceTime Comm., Inc. v. Live Person, Inc.*, FA 92048 (Nat. Arb Forum Feb. 18, 2000). Unauthorized use of another's mark as a part of a domain name constitutes an infringement of the Complainant's rights in its registered marks. *See Fossil, Inc. v. NAS*, FA 92525 (Nat. Arb. Forum Feb. 25, 2000).

Federal Signal has promoted its goods, including vehicle warning lights, under the VIPER mark since at least 1999. Respondent's domain name uses the VIPER mark in connection with the term LIGHTBAR, which suggests a connection to Federal Signal's VIPER mark and VIPER branded vehicle warning lights. In addition, the content shown on Respondent's website includes links to the same goods that Federal Signal offers in connection with its VIPER mark, including "Light Bars" and "Emergency Lighting." Respondent clearly intends to trade off the goodwill of Federal Signal by using a domain name and website content referring to the VIPER mark and the goods sold in connection with the VIPER mark.

It is natural for consumers to assume that the website located at **<viperlightbar.com>** promotes Federal Signal's products and services under the mark VIPER. *See Brookfield Comm. Inc. v. West Coast Entm't Corp.*, 174 F.3d 1036 (9th Cir. 1999) (holding the content of a website may increase the likelihood of consumer confusion). The requirement of confusing similarity is met.

- b. The Respondent Does Not Have Any Right or Legitimate Interest in the Domain Name **<viperlightbar.com>**

Respondent does not have any right or legitimate interest in <**viperlightbar.com**>. Respondent has no connection to Federal Signal or Federal Signal's VIPER mark. A domain name registrant is presumed not to have a legitimate interest in a domain name where (1) Respondent is not a licensee of Complainant; (2) Complainant's prior rights in the domain name precede Respondent's registration; and (3) Respondent is not commonly known by the domain name. Policy ¶ 4(c)(ii); *RAB Lighting, Inc. v. DNS Support - Ultimate Search*, FA 363908 (Nat. Arb. Forum Dec. 30, 2004) (holding that opportunistic use of the complainant's mark to redirect Internet users to a directory website unrelated to the complainant's business was not legitimate); *Gallup, Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (holding that the respondent does not have rights in a domain name when the respondent is not known by the mark). Furthermore, it is "incumbent upon respondents to advance concrete evidence pursuant to Policy ¶ 4(a)(ii) rebutting the latter assertion because this information is uniquely within the knowledge and control of the respondent." *Wilson v. Whois Privacy Prot. Serv., Inc.*, FA 417186 (Nat. Arb Forum March 29, 2005).

Respondent (the actual holder of the domain name and not Federal Signal) does not have a legitimate interest in the domain name <**viperlightbar.com**>. NAF's Supplemental Rule 1(d) states that the holder of a domain name registration is "the single person or entity listed in the WHOIS registration information at the time of the filing of the Complaint with the Forum."

Respondent has no connection to Federal Signal or Federal Signal's VIPER mark. Federal Signal has not licensed its VIPER trademark to Respondent. Federal Signal's prior rights to the trademark VIPER since 1999 and its federal registration for the VIPER mark precede Respondent's domain name registration. Additionally, there is no evidence Respondent is commonly known by the name <**viperlightbar.com**> or VIPER. Respondent is not making a legitimate, non-commercial or fair use of the domain name in that its purpose in registering and using the domain name is to divert Federal Signal's web traffic to a search engine that contains links that appear to be terms that relate to Federal Signal's VIPER mark or Federal Signal's VIPER branded vehicle warning lights found on Federal Signal's website. The registration of a domain for the purpose of redirecting Internet users interested in another's products is not a *bona fide* offering of goods pursuant to Policy ¶ 4(c)(i) and is not a legitimate noncommercial or fair use of the domain name pursuant to Policy ¶ 4(c)(iii). See *Fluke Corp. v. Whois Privacy Prot. Servs., Inc.*, FA 304306 (Nat. Arb. Forum Sept. 9, 2004) (holding that use of a misleading domain name to direct users to a third party search engine does not constitute a bona fide offering of goods or services); *DSW Shoe Warehouse, Inc. v. Ultimate Search*, FA0501000412381 (Nat. Arb. Forum March 21, 2005) (holding that use of a domain name to redirect Internet users to a search engine website that provided various links to third parties was not legitimate). Respondent's use of VIPER in the domain name misappropriates Federal Signal's goodwill and cheats consumers by tricking them into clicking on Respondent's website when they think they will see information regarding Federal Signal's VIPER branded products. Transfer is appropriate.

c. The Domain Name Has Been Registered and Used In Bad Faith

Respondent's registration of a domain name in association with Federal Signal's federally registered VIPER mark shows the registration was in bad faith in violation of Policy ¶ 4(b)(ii). Respondent had constructive, if not actual, knowledge of the VIPER mark when it registered the domain name. Respondent's intentional attempt to attract Internet users to its website by using a name that is confusingly similar to Federal Signal's VIPER marks is also in violation of Policy ¶ 4(b)(iv). The proper website for consideration is that website existing at the time the Complaint was filed. *MB Fin. Bank v. MB Bank*, FA 644517 (Nat. Arb. Forum Apr. 4, 2006).

Bad faith intent can be inferred from Respondent's choosing to use a designation that it knows to be similar to another's registered trademark. See *G.D. Searle & Co. v. Celebrex Drugstore*, FA 123933 (Nat. Arb. Forum Nov. 21, 2002) (finding that the respondent registered and used the domain name in bad faith pursuant to Policy ¶ 4(b)(iv) because the respondent was using the confusingly similar domain name to attract Internet users to its commercial website). Indeed, "there is a legal presumption of bad faith when Respondent reasonably should have been aware of Complainant's trademarks, actually or constructively." *Digi Int'l v. DDI Sys.*, FA 124506 (Nat. Arb. Forum Oct 24, 2002); see also *Pavillion Agency, Inc. v. Greenhouse Agency, Ltd.*, D2000-1221 (WIPO Dec. 4, 2000) (finding that the domain names are so obviously connected with the complainant that the use or registration by anyone other than the complainant suggests opportunistic bad faith).

Respondent had constructive knowledge of Federal Signal's ownership of the VIPER mark before it registered the <**viperlightbar.com**> domain name based on the federally registered VIPER mark. See *Edmunds.com, Inc. v. Ult. Search Inc.*, WIPO Case D2001-1319 (Feb 1, 2002) (holding the failure to conduct a trademark search considered an element of bad faith).

In addition to constructive knowledge, the contents of Respondent's web page at the time the original Complaint was filed show Respondent had actual knowledge of Federal Signal's ownership of the VIPER mark. The website <**viperlightbar.com**> contained links to "Light Bars" and "Emergency Lighting," both of which relate to Federal Signal's VIPER branded products. This evidence also demonstrates Respondent's attempt to confuse consumers into believing Respondent's web page is sponsored by or associated with Federal Signal.

Bad faith is shown because Respondent registered the domain name in order to trade on Federal Signal's goodwill associated with its VIPER mark by creating a likelihood of confusion as to the source of the website. The use of commercial links in a directory form shows bad faith. See *Neiman Marcus Group, Inc. & NM Nevada Trust v. Horoshiy, Inc.*, FA 338381 (Nat. Arb. Forum. Nov. 17, 2004) (finding bad faith based on use of commercial links on website); see also *Deluxe Corp. v. Dallas Internet*, FA 105216 (Nat. Arb. Forum Apr. 10, 2002) (finding bad faith registration based on redirection of users to domain name and receiving commission through affiliate program).

Here, Respondent used numerous commercial links on its website. Respondent used the domain name to attract consumers to his website who are searching for Federal Signal or VIPER brand products. That, together with the evidence of actual and constructive knowledge, demonstrates Respondent's bad faith.

## B. Respondent

Respondent lacked any bad faith in the registration of the Domain Names at issue. Upon learning of this matter and in an effort to resolve this matter expeditiously, Respondent attempted to contact Complainant and its representative various times to offer a voluntary transfer of the domain name at issue. Neither Complainant nor its representative responded to these communications.

Therefore, without admitting fault or liability and without responding substantively to the allegations raised by Complainant herein, to expedite this matter for the Panel so that its time and resources are not otherwise wasted on this undisputed matter, Respondent stipulates that it is willing to voluntarily transfer of the Domain Names to the Complainant. For the reasons stated below, Respondent respectfully requests that the transfer be ordered without findings of fact or conclusions as to Policy 4(a) other than the Domain Names be transferred.

In numerous prior UDRP decisions, Panels have consistently ruled that when a complaint has been filed and the respondent consents to the transfer of the domain name, it is inappropriate to issue any decision other than simply ordering the transfer of the domain name. Such panels consistently hold that it would be improper to issue any findings of fact in such cases. For example, in *Cartoon Network LP, LLLP v. Morgan*, D2005-1132 (WIPO Jan. 5, 2006), the Panel stated as follows:

[T]his Panel considers that a genuine unilateral consent to transfer by the Respondent provides a basis for an immediate order for transfer without consideration of the paragraph 4(a) elements. Where the Complainant has sought transfer of a disputed domain name, and the Respondent consents to transfer, then pursuant to paragraph 10 of the Rules the Panel can proceed immediately to make an order for transfer. This is clearly the most expeditious course (see: *Williams-Sonoma, Inc. v. EZ-Port*, WIPO Case No. D2000-0207).

In *Body Shop International plc v. Agri, Lacus & Caelum LLC*, FA 679564 (Nat. Arb. Forum May 25, 2006), the complaint set forth allegations and requested that the domain name be transferred to complainant. The respondent therein, after the deadline for a response, filed a stipulation agreeing to the transfer of the domain name to the complainant. The panel limited its decision to an order that the domain name be transferred. Regarding the stipulation, the panel stated the following:

Consistent with a general legal principle governing arbitrations as well as national court proceedings, this Panel holds that it cannot issue a decision that would be either less than requested, or more than requested by the parties. Because both Complainant and Respondent request the transfer of the disputed domain name to Complainant, the Panel must recognize the common request of the two parties. See: *Malev Hungarian Airlines, Ltd. v. Vertical Axis Inc.*, FA 212653 (Nat. Arb. Forum, Jan. 13, 2004) (“Since the requests of the parties in this case are identical, the Panel has no scope to do anything other than to recognize the common request, and it has no mandate to make findings of fact or of compliance (or not) with the Policy.”); see also *Boehringer Ingelheim Int’l GmbH v. Modern Ltd. - Cayman Web Dev.*, FA 133625 (Nat. Arb. Forum, Jan. 9, 2003); see also *Alstyle Apparel/Active Wear v. Schwab*, FA 170616 (Nat. Arb. Forum, Sept. 5, 2003).”

Other panels have gone further to state that it would be unwise to issue findings of fact or conclusions other than an order transferring the name:

Indeed, it would be unwise to make any other findings [other than the transfer] in case the same issues were to arise in later proceedings. Accordingly, the Panel will not make any findings of fact or compliance or otherwise, but will make the only order that is appropriate in the circumstances, which is an order for the transfer of the domain name to Complainant. *Diners Club International Ltd. v. Nokta Internet Technologies*, FA 720824 (NAF August 2, 2006).

Numerous other panels have followed the principle noted above including: *Atmos Energy Corp. v. Chesterton Holdings, LLC*, D2007-1793 (WIPO Feb. 7, 2008); *Cartoon Network LP, LLLP v. Morgan*, D2005-1132 (WIPO Jan. 5, 2006); *Deutsche Bank AG v. Seigler*, D2000-0984 (WIPO Nov. 15, 2000); *Williams-Sonoma, Inc. v. EZ-Port*, D2000-0207 (WIPO May 8, 2000); *Vacation Pubs., Inc. v. Portfolio Brains, LLC*, FA 1139522 (Nat. Arb. Forum March 27, 2008); *Int’l Edge, Inc. v. Overseas Research & Dev., LLC*, FA 1144130 (Nat. Arb. Forum March 28, 2008); *Kohler Co. v. Atkins*, FA 760086 (Nat. Arb. Forum Sept. 7, 2006); *Herbalife Int’l of Am., Inc. v. Montanya Ltd.*, FA 733012 (Nat. Arb. Forum Aug. 8, 2006); *Diners Club Int’l Ltd. v. Nokta Internet Tech.*, FA 720824 (Nat. Arb. Forum Aug. 2, 2006); *Norgren, Inc. v. Norgren, Inc.*, FA 670051 (Nat. Arb. Forum May 23, 2006); *Disney Enters., Inc. v. Morales*, FA 475191 (Nat. Arb. Forum June 24, 2005); *Met. Life Ins. Co. & Met. Prop. & Cas. Ins. Co. v. Gaines Enter.*, FA 474807 (Nat. Arb. Forum June 16, 2005); *PSC Mgt. Ltd. P’ship v. PSC Mgt. Ltd. P’ship*, FA 467747 (Nat. Arb. Forum June 6, 2005); *MICROS Sys., Inc. v. Walkercity*, FA 444485 (Nat. Arb. Forum May 11, 2005); *Enter. Rent-A-Car Co. v. Almon*, FA 422884 (Nat. Arb. Forum March 22, 2005); *Lake Receptions, Inc. v. Kelsey*, FA 404428 (Nat. Arb. Forum March 4, 2005); *Tech Int’l, Inc. v. Clear Choice of New York*, FA 372828 (Nat. Arb. Forum Jan. 27, 2005); *Malev Hungarian Airlines, Ltd. v. Vertical Axis Inc.*,

FA 212653 (Nat. Arb. Forum Jan. 13, 2004); *Alstyle Apparel/Active Wear v. Schwab*, FA 170616 (Nat. Arb. Forum Sept. 5, 2003); *Boehringer Ingelheim Int'l GmbH v. Modern Ltd. - Cayman Web Dev.*, FA 133625 (Nat. Arb. Forum Jan. 9, 2003).

Accordingly, Respondent requests that the Domain Names be transferred to Complainant without further findings of fact or liability, including those related to the elements set forth in Paragraph 4(a) UDRP Policy.

## **FINDINGS**

Respondent has consented to the relief sought by Complainant.

## **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.

In this case, Respondent requests the Panel issue a decision summarily transferring the domain name to the Complainant without the necessity of reviewing the elements required under Policy. The Panel has an option to do so according to *Boehringer Ingelheim Int'l GmbH v. Modern Ltd. - Cayman Web Dev.*, FA 133625 (Nat. Arb. Forum Jan. 9, 2003), *Alstyle Apparel/Active Wear v. Schwab*, FA 170616 (Nat. Arb. Forum Sept. 5, 2003), *Malev Hungarian Airlines, Ltd. v. Vertical Axis Inc.*, FA 212653 (Nat. Arb. Forum Jan. 13, 2004), *Disney Enters., Inc. v. Morales*, FA 475191 (Nat. Arb. Forum June 24, 2005), *Body Shop Int'l plc v. Agri, Lacus & Caelum LLC*, FA 679564 (Nat. Arb. Forum May 25, 2006), *Royal Bank of Scotland Group plc v. rbspayments*, FA 728805 (Nat. Arb. Forum July 7, 2006), *Diners Club Int'l Ltd. v. Nokta Internet Tech.*, FA 720824 (Nat. Arb. Forum Aug. 2, 2006), *Kohler Co. v. Atkins*, FA 760086 (Nat. Arb. Forum Sept. 7, 2006), *Lucifer Lighting Co. v. Montanya lLtd*, FA 787062 (Nat. Arb. Forum Oct. 4, 2006), *Digg Inc. v. Overeem*, FA 836770 (Nat. Arb. Forum Dec. 20, 2006), *H. Savinar Luggage Co., Inc. v. ANY-Web Ltd.*, FA 874177 (Nat. Arb. Forum Feb. 12, 2007), *Fall Out Boy, Inc. v. Global Access*, FA 882167 (Nat. Arb. Forum Feb. 23, 2007), *Euroclear Plc. v. Intensed Creations Inc.*, FA 918540 (Nat. Arb. Forum March 14, 2007), *Genzyme Corp. v. Tex. Int'l Prop. Assocs.*, FA 921807 (Nat. Arb. Forum April 13, 2007), and *Pride Studios Inc. v. Global Access*, FA 1154068 (Nat. Arb. Forum April 17, 2007).

While this Panel believes it always has the inherent authority to review its subject matter jurisdiction to ensure it does not issue collusive *ultra vires* orders, it finds no evidence of collusion here. The interests of justice and brevity require the honoring of Respondent's request.

## **DECISION**

Respondent having consented to the requested relief under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

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



Houston Putnam Lowry, Esq.  
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist  
Dated: April 30, 2008

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