



NATIONAL ARBITRATION FORUM

DECISION

The Weir Group PLC v. MIC c/o Domain Management
Claim Number: FA0707001036495

PARTIES

Complainant is **The Weir Group PLC** ("Complainant"), represented by **Carrie L. Kiedrowski**, of **Jones Day**, 1420 Peachtree Street, N.E., Suite 800, Atlanta, GA 30309-3053. Respondent is **MIC c/o Domain Management** ("Respondent"), 15 5th street, Closter, NJ 07624.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**weirspm.com**>, registered with **Enom, 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 13, 2007; the National Arbitration Forum received a hard copy of the Complaint on July 16, 2007.

On July 16, 2007, Enom, Inc. confirmed by e-mail to the National Arbitration Forum that the <**weirspm.com**> domain name is registered with Enom, Inc. and that Respondent is the current registrant of the name. Enom, Inc. has verified that Respondent is bound by the Enom, 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 20, 2007, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of August 9, 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@weirspm.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 15, 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:

Weir Pumps Limited ("Weir Pumps"), Complainant's principal United Kingdom trading company, is the owner of United States Trademark Registration ("US Registration") No. 3,031,061 for WEIRESIST and Design in connection with International Class 7: linings for power operated minerals processing machines, namely grinding mill liners, hose, conduit, chutes, hoppers, bins, screens, impact bars, wear plates, grates, general cast iron and rubber linings.

Weir Pumps is the owner of US Registration No. 3,078,024 for WEIR SLURRY GROUP and Design in connection with International Class 7: pumps, namely abrasion and corrosion resistant slurry pumps, abrasion resistant dredge and gravel pumps, sewage pumps, solution pumps and sump pumps; machine parts for chemical, metallurgical and refining processes, namely agitators, cyclones, sedimentation thickener mechanisms, apron feeders, hydro cyclones, automatic ore and slurry samplers, froth flotation machines, subsizing apparatus, mineral separation jigs, filters utilized in the separation of solid particles from liquid solutions, ore washers and scrubbers, trammel screens, mixers, classifiers, thickeners, and valves including gate valves; and structural and component parts for all of the aforementioned goods.

Weir Pumps is the owner of US Trademark Application Nos. 77/117,193 for WEIR (word mark) and 77/117,232 for WEIR (stylized), both filed on February 27, 2007.

EnviroTech Pumpsystems, Inc. d/b/a Weir Specialty Pumps ("EnviroTech"), a company under the Weir Clear Liquid Division, a division of Complainant, is the owner of US Registration No. 2,684,483 for WEIR SPECIALTY PUMPS and Design in connection with (i) International Class 7: industrial pumps, namely, grit classifier cyclones, positive

displacement pumps and centrifugal pumps, and (ii) International Class 37: pump repair services.

Weir Pumps is the owner of United Kingdom (“UK”) Trade Mark Registration No. 836149 for WEIR in connection with steam turbines and parts thereof included in Class 7.

Weir Pumps is the owner of UK Registration No. 1463885 for WEIR in connection with motors; control mechanisms for machines, engines, pumps, water purifying machines, water separators, pumps for desalination plants and sea-water distillers for use on ships to purify water; lubricating oil systems for pumps; parts and fittings for all of the aforesaid goods; all included in Class 7.

Weir Pumps is the owner of UK Registration No. 1463886 for WEIR in connection with apparatus for steam generating; desalination plants, distillation apparatus, distillation columns, filters for drinking water, purification installations for sewage, stills, water distribution installations, water filtering apparatus, water purification filtering apparatus, water purification installations, water sterilisers, water supply installations, sea water distillers for purification of water; parts and fittings for all the aforesaid goods; all included in Class 11.

Weir Pumps is the owner of UK Registration No. 1463887 for WEIR in connection with repair, maintenance and installation of air conditioning apparatus, boilers, electrical appliances, furnaces, heating apparatus, machinery and pumps; all included in Class 37.

Weir Pumps is the owner of European Community Trade Mark (“ECTM”) Registration No. 000490797 for WEIR in connection with International Classes 7, 11, and 37.

EnviroTech is the owner of ECTM Registration No. 002344752 for WEIR SPECIALTY PUMPS in connection with (i) International Class 7: machine pumps, industrial pumps, (ii) International Class 35: pump sales services, and (iii) International Class 37: pump repair services. The Weir Group PLC and related parties, Weir Pumps Limited and EnviroTech Pumpsystems, Inc. d/b/a Weir Specialty Pumps, are collectively referred to hereinafter as “Weir Group.”

In addition to the above, Weir Group has common law rights in the WEIR mark for all the above products and services since at least as early as 1895. Weir Group has similar registrations to those listed above in over 20 countries around the world, including Bahrain, Bangladesh, Canada, China, Cyprus, Denmark, Egypt, France, Germany, Hong Kong, India, Iran, Italy, Jordan, Kuwait, Malaysia, Nigeria, Norway, Pakistan, Somalia, Spain, Sudan, and the United Arab Emirates.

On June 21, 2007, The Weir Group PLC publicly announced its intention to acquire S.P.M. Flow Control, Inc. (“SPM”) through a stock purchase. On the day of the announcement, Weir also gave a presentation to investment analysts in London and

posted the presentation on its www.weir.co.uk website. In this presentation, a proposed “Weir SPM” logo was included evidencing Weir and SPM’s intention to use the combination of “Weir SPM” as a trademark and service mark for future branding and promotion of the combined company. Moreover, SPM supports Weir Group in this domain name dispute and has authorized Weir Group to assert SPM’s trademark rights in SPM in this UDRP Proceeding.

SPM is the owner of US Registration No. 1,760,988 for SPM in connection with (i) International Class 6: flow control products; namely, metal piping, metal manifolds, pipe fittings; namely, hammer unions and spanner unions, couplings, nipples, plugs and swages primarily of metal, and manually operated valves made primarily of metal and designed for use in the gas and oilfield industry, and (ii) International Class 7: centrifugal pumps and machine parts; namely, plunger pumps both made of metal designed for use in the gas and oilfield industry and aerospace products; namely, landing gear for airplanes and parts therefore.

SPM is the owner of US Registration No. 2,387,249 for SPM FLOW CONTROL, INC. in connection with International Class 35: distributorship in the field of oil field flow control products, namely, flow control products, namely, centrifugal pumps and machine parts, plunger pumps, metal piping, metal manifolds, pipe fittings, namely, hammer unions and spanner unions, couplings, nipples, plugs and swages primarily of metal and manually operated valves made primarily of metal and designed for use in the gas and oilfield industry.

SPM is the owner of US Registration No. 2,387,476 for SPM FLOW CONTROL, INC. and Design in connection with International Class 35: distributorship in the field of oil field flow control products, namely, flow control products, namely, centrifugal pumps and machine parts, plunger pumps, metal piping, metal manifolds, pipe fittings, namely, hammer unions and spanner unions, couplings, nipples, plugs and swages primarily of metal, and manually operated valves made primarily of metal and designed for use in the gas and oilfield industry.

SPM is the owner of US Registration No. 2,512,027 for SPM FLOW CONTROL, INC. and Design in connection with (i) International Class 6: flow control products, namely, metal piping, and metal manifolds, pipe fittings, namely, hammer unions and spanner unions, couplings, nipples, plugs and swages primarily of metal and designing for use in the gas and oilfield industry, metal swivel joints, pup joints and safety clamps, and (ii) International Class 7: pumps and machine parts, namely, plunger pumps both made of metal designed for use in the gas and oilfield industry, metal hose loops, check valves, plug valves, relief valves, integral union connections, and cable loops.

The certificates of registration are prima facie evidence of the validity of the identified trademarks, Weir Group and SPM’s ownership of those marks and their right to use the identified marks in connection with the goods and services specified in the certificates of registration. 15 U.S.C. § 1115(a); 15 U.S.C. § 1072.

FACTUAL AND LEGAL GROUNDS

This Complaint is based on the following factual and legal grounds: ICANN Rule 3(b)(ix).

The domain name, WEIRSPM.COM, is confusingly similar to numerous trademarks and service marks in which the Complainant and SPM have rights. ICANN Rule 3(b)(ix)(1); ICANN Policy ¶4(a)(i).

As listed in Section 5(c), Paragraphs 1-19, Weir Group and/or SPM own several famous US registrations and foreign registrations containing the term WEIR or SPM.

Weir Group is a UK-listed engineering company, founded in 1895 and listed on the London Stock Exchange since 1947. It employs around 8,000 people worldwide across five divisions, in closely aligned, independently successful companies, each with leading brand name products in their own sectors. Weir Group reported revenues of £940.9 million and operating profits of £87.7 million in 2006 and is a global operation with locations in Australia, Brazil, Canada, Chile, China, France, India, Italy, the Netherlands, South Africa, the United Kingdom, and the United States of America, among other countries. Weir Group has received numerous accolades, including the Scottish Engineering Award for 2006, Scotland's most prestigious engineering award.

Since its founding in 1895, Weir Group has invested substantial amounts in advertising and promoting the Weir Marks in various forms in connection with (i) products, including hydrocyclones, mill lining systems, pumps, valves and controls products and replacement parts, and (ii) services, including maintenance and repair, plant operation, engineering design and systems integration. As a direct result of the considerable time, effort, money, advertising and promotion of the Weir Marks, goods and services identified by the marks have been well received in the marketplace and the marks have come to serve as a unique identifier of goods and services emanating from Weir Group.

The WEIR name and Weir Group's acquisition of SPM are extremely well known within the engineering industry worldwide such that when consumers see the domain name WEIRSPM.COM they will likely assume the website will direct them to the Complainant's website WEIR.CO.UK, SPM's official website, or to a website associated with Weir Group's acquisition of SPM. Complainant is the 3rd result on google.com when one enters "Weir," SPM is the 5th result on google.com when one enters "SPM," and at least the first 10 results on google.com when one enters "Weir SPM" are press releases or news stories announcing Weir Group's acquisition of SPM.

Weir Group and SPM are the owners of dozens of domain names which are utilized to promote the goods and services of Weir Group and SPM, including SPM-WEIR.COM, SPMWEIR.COM, WEIR-SPM.COM, WEIRSPMFLO.COM, WEIR.CO.UK,

THEWEIRGROUP.COM, WEIR.EU, WEIRGROUP.EU, SPMFLO.COM, SPMFLOW.COM, among others.

Respondent is capitalizing on Weir Group's trademarks and service marks by registering a domain name that includes the well-known Weir Marks, resulting in confusion when traffic gets misdirected to that domain. If a domain name incorporates a famous mark in its entirety, "it is confusingly similar to that mark despite the addition of other words." See *Dell Inc. v. George Dell and Dell Net Solutions*, D2004-0512 (WIPO Aug. 24, 2004) (*Dellnetsolutions.com*), citing *Wal-Mart Stores, Inc. v. MacLeod d/b/a/ For Sale*, D2000-0662 (WIPO Sept. 21, 2000) (first element of Policy is satisfied where domain name wholly incorporates complainant's mark). In similar disputes against Respondent, arbitration panels have held that a domain name composed of trademarks of two merging entities is confusingly similar to one of the entity's marks, even though that entity did not have registration of the other entity's mark per se. See *Yellow Corp. v. MIC*, D2003-0748 (WIPO Dec. 6, 2003); *Shire Biochem v. Hussain*, D2002-0453 (WIPO June 19, 2002) (decisions against same Respondent).

Further, the "overall impression" left by WEIRSPM.COM suggests that it belongs to Weir Group and SPM, and consumer confusion will inevitably result. Dissimilarities in a registered domain name and the complainant's trademark do not preclude a finding of likelihood of confusion when "the difference was not apt to influence the overall impression left by the domain name." See *Time Warner Inc. and EMI Group PLC v. CPIC Net*, D2000-0433 (WIPO July 27, 2000), quoting *EFG Bank European Fin. Group SA v. Jacob Found.*, D2000-0036 (WIPO Mar. 22, 2000) (noting also that CPIC Net is an affiliated company of Respondent, MIC). The "overall impression" left by WEIRSPM.COM is confusingly similar to the registered Weir Marks, and is meant to suggest a joint ownership by Weir and SPM. Consumers will naturally assume that WEIRSPM.COM is owned or affiliated with Weir Group and SPM, and is a reflection of the publicized acquisition of SPM.

Even though Weir Group has not registered the trademark WEIRSPM, Paragraph 4(a)(i) of the ICANN Policy does not expressly limit the application of the ICANN Policy to a registered trademark or service mark of Weir Group. The fame of the Weir Marks and the publicity surrounding its acquisition of SPM have allowed Weir Group to establish common law rights in the combination of "WEIR" and "SPM" into "WEIRSPM." See *Time Warner Inc. and EMI Group PLC v. CPIC Net*, D2000-0433 (WIPO July 27, 2000). In fact, on the day of the acquisition announcement, Weir Group posted an analyst presentation on its website, which included the logo "Weir SPM" that had been developed, at Weir Group's instruction, by its marketing consultants. This presentation clearly detailed Weir Group's intention to use the combination of the WEIR and SPM marks for future branding and promotion purposes.

Respondent's use and/or registration of the domain name WEIRSPM.COM is likely to deceive and cause confusion and mistake among consumers as to the source, affiliation, sponsorship or endorsement of the domain name with Complainant.

Respondent has no rights or legitimate interests in respect of the WEIRSPM.COM domain name that is the subject of this Complaint. ICANN Rule 3(b)(ix)(2); ICANN Policy ¶4(a)(ii).

On June 26, 2007, Complainant became aware that Respondent had registered the WEIRSPM.COM domain name.

Respondent has no legitimate interest in the WEIRSPM.COM domain name. Respondent is not a licensee of, or otherwise currently affiliated with, Weir Group or SPM. Neither Weir Group nor SPM have ever authorized or otherwise condoned or consented to Respondent's registration of the domain name WEIRSPM.COM.

As is apparent from the website WEIRSPM.COM, Respondent's whole business model consists of luring Internet users to the WEIRSPM.COM domain with the Weir Marks and then making money on the resulting confusion from "pay per click" and search engine relationships. Hot "links" on the WEIRSPM.COM website include links titled "BioHeat Renewable Energy," "Renewable Energy Credits," "Alternative Energy Stocks," and "Top 5 Energy Stocks," as well as many others. If the Internet user follows any of these "sponsored" links, Respondent gets paid. See *Société Air France and Koninklijke Luchtvaart Maatschappij v. MIC*, D2006-0437 (WIPO June 1, 2006) (noting also that this case was against the same Respondent).

Respondent's name is not "Weirspm" and does not contain the words "Weir" or "SPM."

Respondent registered WEIRSPM.COM on June 22, 2007 with eNom.com exactly one day after the Weir Group Press Release announcing Weir Group's acquisition of SPM. eNom is an "all inclusive" registrar offering resale services and up to 100 email addresses with a domain name registration. The domain name dispute policy is contained under eNom's Terms and Conditions.

For the reasons forth above, Respondent must have been aware of Weir Group's extensive goodwill and reputation in the Weir Marks when it registered WEIRSPM.COM. Given that the domain name was registered with knowledge of the extensive goodwill and reputation in the Weir Marks, Respondent is not making a legitimate, non-commercial or fair use of the domain name.

It is clear that Respondent intentionally chose a domain name incorporating the well-known Weir Marks. There is no conceivable use of WEIRSPM.COM which could be considered legitimate in light of the fame of the Weir Marks and its association with the Weir Group and SPM. See *Telstra Corp. v. Nuclear Marshmallows*, D2000-0003 (WIPO Feb. 18, 2000). It is therefore appropriate to presume or infer that there is a likelihood of confusion between WEIRSPM.COM and the Weir Marks. See *Sun-Fun Prods., Inc. v. Suntan Research & Dev., Inc.*, 656 F.2d 186 (5th Cir. 1981) (proof that defendant

intended to copy plaintiff's mark may justify inference of confusing similarity); Perfect Fit Indus., Inc. v. Acme Quilting Co., 618 F.2d 950 (2d. Cir. 1980) (intentional copier is presumed to have intended to create confusion and to have succeeded).

The domain name, WEIRSPM.COM should be considered as having been registered and being used in bad faith. ICANN Rule 3(b)(ix)(3); ICANN Policy ¶4(a)(iii).

Respondent reserved, used and is holding WEIRSPM.COM willfully, in bad faith and in complete disregard of Weir Group's exclusive rights to use the Weir Marks. Indeed, Respondent's actions constitute numerous circumstances indicative of bad faith as set forth in ICANN Policy ¶4(a)(iii).

Respondent's history of illegitimate and bad faith registration of domain names that incorporate marks owned by well-known entities is extensively documented. The NAF and WIPO have collectively ordered Respondent to transfer its rights in domain names in over forty cases. These facts lead to the inescapable conclusion Respondent has engaged in a pattern of conduct where he has registered multiple domain names incorporating well-known marks. See ICANN Policy ¶4(b)(ii). See General Electric Co. v. LaPorte Holdings, Inc., WIPO (D2005-0076) (the existence of other proceedings against the same registrant is evidence of bad faith). See also Hewlett-Packard Co. v. Jeff Burgar, FA 93564 (Nat. Arb. Forum Apr. 10, 2000) (multiple registrations of famous names is evidence of bad faith).

In addition, Respondent has engaged in a pattern of cybersquatting on the heels of announced mergers, which arbitration panels have consistently held to show bad faith under Paragraph 4 of the ICANN Policy. See Yellow Corp. v. MIC, D2003-0748 (WIPO Dec. 6, 2003); Shire Biochem v. Hussain, D2002-0453 (WIPO June 19, 2002); Time Warner Inc. and EMI Group PLC v. CPIC Net, D2000-0433 (WIPO July 27, 2000). In this case, Respondent registered WEIRSPM.COM one day after the announcement of Weir Group's acquisition of SPM.

Respondent has taken deliberate steps to conceal his true identity. Specifically, Respondent's omission of his full name of "Syed Hussain" in his WHOIS registration is misleading and another indication of bad faith. See, e.g., Yellow Corp. v. MIC, D2003-0748 (WIPO Dec. 6, 2003) ("[f]rom other UDRP proceedings, it is evident that Mr. Hussain operates ... as MIC, CPIC, and/or CPIC NET."); Telstra Corp. v. Nuclear Marshmallows, (WIPO D2000-0003); Lincoln Property Company v. LPC, WIPO (D2001-0238).

Respondent has reserved, used and is holding the domain name registration WEIRSPM.COM with a bad faith intent to confuse the consuming public and benefit from misdirected traffic in search of the official WEIR.CO.UK and SPMFLO.COM websites. Indeed, it appears that Respondent is using the WEIRSPM.COM domain to

make money by using the website as advertising space with numerous sponsors, such as green energy companies. Respondent profits from the confusion he has created. Arbitration panels have repeatedly held that the practice of diverting Internet users for referral fees or other commercial benefit is evidence of bad faith. See ICANN Policy ¶4(b)(iv). See *Société Air France and Koninklijke Luchtvaart Maatschappij v. MIC*, D2006-0437 (WIPO June 1, 2006); see *General Electric Co. v. LaPorte Holdings, Inc.*, WIPO (D2005-0076).

Respondent's passive holding of the WEIRSPM.COM domain name containing the famous Weir Marks prevents the valid owner of a federally registered mark from using its mark. Passive holding of a domain name is evidence of "use" of that domain name in bad faith. See *Telstra Corp. v. Nuclear Marshmallows*, (WIPO D2000-0003). See also *Jupiters Ltd. v. Aaron Hall* (WIPO D2000-0574) ("passive holding" of domain names constituted bad faith use); *Ladbroke Group Plc v. Sonoma Int'l LDC* (WIPO 2002-0131) (same).

Additionally, there is evidence suggesting that Respondent has registered the domain name to solicit inquires about the availability of WEIRSPM.COM, presumably for sale. Registration of a domain name for the purposes of selling it is evidence of bad faith. ICANN Policy ¶4(b)(i). The web site which contains the advertisement "BUY THIS DOMAIN The domain weirspm.com may be for sale by its owner!" and when the "More details..." link is clicked, the user is directed to the SEDO.COM website, where the user can make an offer to purchase the WEIRSPM.COM domain name.

Respondent has no right to use the Weir Marks, and it is inconceivable that Respondent was not aware of the Weir Marks when he registered WEIRSPM.COM considering its history of registering domain names that incorporate marks owned by well-known entities, especially after merger announcements. See *Telstra Corp. Ltd. v. Nuclear Marshmallows*, (WIPO D2000-0004) (finding that it was inconceivable that the registration and non-use of *Telstra.org*, given the fame of the *Telstra* mark, was not done in bad faith). See also *Weetabix Ltd. v. Mr. J. Clarke*, (WIPO D2001-0775) (finding bad faith where "the respondent knew or should have known of the registration and use of the trade mark prior to registering the domain name.").

Moreover, it is undeniable that Respondent was aware of the Weir Marks when he knowingly combined the words "WEIR" and "SPM" to create the domain name WEIRSPM.COM one day after the announcement of Weir Group's acquisition of SPM. See *Eastman Chem. Co. v. Manila Indus., Inc.*, FA 450806 (Nat. Arb. Forum May 6, 2005) (finding bad faith for registering EASTMANCHEMICALS.COM; "knowingly registering a domain name, either actually or constructively, which encompasses a well known third-party trademark, is evidence of bad faith registration and use pursuant to Policy ¶4(a)(iii)."). See also *Eastman Chem. Co. v. Patel*, FA 524752 (Nat. Arb. Forum Sept. 7, 2005) (finding bad faith registration where respondent registered EASTMAN-CHEMICAL.COM).

From all of this evidence, the conclusion is inescapable that Respondent registered WEIRSPM.COM without any legitimate right or interest in using that domain, and holds it in bad faith to prevent Weir Group from acquiring it, and to confuse Weir Group's consumers who are seeking information on Weir Group, its products and services, and the Weir Group acquisition of SPM.

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

FINDINGS

Complainant, The Weir Group PLC, is a United Kingdom-based engineering company that offers, pumps, valves, control products, maintenance and repair services, plant operation, engineering design, and systems integration, along with a myriad of other products and services. Complainant has conducted business under the WEIR and related marks for over a century and holds a trademark registration for the WEIR mark with the United Kingdom Intellectual Property Office ("UKIPO") (Reg. No. 836,149 issued June 25, 1962).

On June 21, 2007, Complainant publicly announced its intention to acquire S.P.M. Flow Control, Inc. ("S.P.M"), which manufactures various flow control products. It also announced the intention of the two companies to use the name "Weir SPM" for future branding and promotion of the merged company. S.P.M. holds a trademark registration for the SPM mark with the United States Patent and Trademark Office ("USPTO") (Reg. No. 1,760,988 issued March 30, 1993). As evidenced by a letter provided in the Complaint, S.P.M. has expressly authorized Complainant to assert its trademark rights in the SPM mark for the purposes of this proceeding.

Respondent registered the <weirspm.com> domain name on June 22, 2007, one day after Complainant's announcement of its merger with S.P.M. Respondent's domain name resolves to a website featuring links to third-party websites offering "green energy" services, an industry which is presumably unrelated to Complainant's business. In addition, Respondent has been the respondent in several previous UDRP decisions in which the disputed domain names in those cases were transferred from Respondent to the respective complainants. *See Time, Inc. v. MIC c/o Domain Mgmt.*, FA 857580 (Nat. Arb. Forum Jan. 12, 2007); *see also Yellow Corp. v. MIC*, D2003-0748 (WIPO Dec. 6, 2003); *see also Hain Food Group v. MIC*, FA 94729 (Nat. Arb. Forum June 15, 2000).

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 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; 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 WEIR mark with the UKIPO and S.P.M.'s registration of the SPM mark with the USPTO sufficiently establishes Complainant's rights in the marks under Policy ¶4(a)(i). As S.P.M. has expressly authorized Complainant to assert its trademark rights in the SPM mark, the Panel will hereinafter collectively refer to the two marks as "Complainant's marks." *See 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.").

Respondent's <**weirspm.com**> domain name is confusingly similar to Complainant's WEIR and SPM marks, as it simply combines the two marks and adds the generic top-level domain ("gTLD") ".com." Previous panels have found, and this Panel so finds, that merely combining two marks does not negate any confusing similarity between the marks and a disputed domain name (especially where a merger of the two trademarks owners has been publicly announced). This creates the anticipation of common control of the two sets of trademarks once the merger is consummated. The addition of the gTLD ".com" is irrelevant, as a top-level domain is a required element of all domain names. In light of these facts, the Panel finds the <**weirspm.com**> domain name is confusingly similar to Complainant's WEIR and SPM marks pursuant to Policy ¶4(a)(i). *See Nintendo of Am. Inc. v. Pokemon*, D2000-1230 (WIPO Nov. 23, 2000) (finding confusing similarity where respondent combined the complainant's POKEMON and PIKACHU marks to form the <pokemonpikachu.com> domain name); *see also G.D. Searle & Co. v. Pelham*, FA 117911 (Nat. Arb. Forum Sept. 19, 2002) (finding that the addition of other

drug names does not create a distinct mark capable of overcoming a claim of confusing similarity, “it merely creates a domain name with severe potential to confuse Internet users as to the source, sponsorship and affiliation of the domain”); *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”); *see also Isleworth Land Co. v. Lost in Space, SA, FA 117330* (Nat. Arb. Forum Sept. 27, 2002) (“[I]t is a well established principle that generic top-level domains are irrelevant when conducting a Policy ¶4(a)(i) analysis.”).

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

Rights or Legitimate Interests

Complainant asserts Respondent lacks rights and legitimate interests in the <**weirspm.com**> domain name. Under Policy ¶4(a)(ii), Complainant has the initial burden of proving this assertion. Once Complainant has made a *prima facie* case, however, the burden shifts to Respondent to show that it does have rights or legitimate interests in the disputed domain name. In the instant case, the Panel finds Complainant has established a *prima facie* case under the Policy. *See 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”); *see also 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 that 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).

Based on Respondent’s failure to answer the Complaint, the Panel presumes Respondent lacks rights or legitimate interests in the <**weirspm.com**> domain name. *See Am. Express Co. v. Fang Suhendro*, FA 129120 (Nat. Arb. Forum Dec. 30, 2002) (“[B]ased on Respondent's failure to respond, it is presumed that Respondent lacks all rights and legitimate interests in the disputed domain name.”); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) (“[Rule 14(b)] expressly provide[s] that the Panel ‘shall draw such inferences’ from the Respondent’s failure to comply with the rules ‘as it considers appropriate.’”). Nevertheless, the Panel will still examine the record to determine if Respondent has rights or legitimate interests under Policy ¶4(c).

Complainant asserts Respondent is not commonly known by the <**weirspm.com**> domain name, which indicates Respondent lacks rights or legitimate interests in the disputed domain name pursuant to Policy ¶4(c)(ii). The Panel agrees, because Respondent’s WHOIS information does not indicate Respondent is known by the <**weirspm.com**> domain name, and there is no further evidence in the record to suggest

Respondent is commonly known by the disputed domain name. In addition, Complainant has not licensed or authorized Respondent to use the WEIR or SPM marks for any purpose. The Panel finds Respondent lacks rights and legitimate interests under Policy ¶4(c)(ii) based upon the record in this case. *See Tercent Inc. v. Lee Yi*, FA 139720 (Nat. Arb. Forum Feb. 10, 2003) (stating “nothing in Respondent’s WHOIS information implies that Respondent is ‘commonly known by’ the disputed domain name” as one factor in determining that Policy ¶4(c)(ii) does not apply); *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).

Respondent’s <**weirspm.com**> domain name resolves to a website featuring links to third-party websites unrelated to Complainant. The Panel presumes Respondent accrues click-through fees when Internet users click on these links. This does not qualify as 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), which further indicates Respondent lacks rights and legitimate interests in the disputed domain name pursuant to Policy ¶4(a)(ii). *See Bank of Am. Corp. v. Nw. Free Cmty. Access*, FA 180704 (Nat. Arb. Forum Sept. 30, 2003) (“Respondent’s demonstrated intent to divert Internet users seeking Complainant’s website to a website of Respondent and for Respondent’s benefit is not a bona fide offering of goods or services under Policy ¶4(c)(i) and it is not a legitimate noncommercial or fair use under Policy ¶4(c)(iii).”); *see also WeddingChannel.com Inc. v. Vasiliev*, FA 156716 (Nat. Arb. Forum June 12, 2003) (finding that the respondent’s use of the disputed domain name to redirect Internet users to websites unrelated to the complainant’s mark, websites where the respondent presumably receives a referral fee for each misdirected Internet user, was not a *bona fide* offering of goods or services as contemplated by the Policy).

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

Registration and Use in Bad Faith

Respondent is using the <**weirspm.com**> domain name to redirect Internet users, seeking Complainant’s business, to a website displaying links to unrelated third-party websites. As mentioned above, the Panel presumes Respondent benefits commercially through the accrual of click-through fees when users click on these links. Respondent is capitalizing on the likelihood that Internet users will confuse the source of the <**weirspm.com**> domain name as being affiliated with Complainant. This is evidence Respondent registered and is using the disputed domain name in bad faith pursuant to 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. Univ. v. Cook*, FA 208629 (Nat. Arb. Forum Dec. 22, 2003) (“Registration and use of a domain name that incorporates another’s mark with the

intent to deceive Internet users in regard to the source or affiliation of the domain name is evidence of bad faith.”).

Respondent has been the respondent in several previous UDRP decisions in which the disputed domain names in those cases were transferred from Respondent to the respective complainants. *See Time, Inc. v. MIC c/o Domain Mgmt.*, FA 857580 (Nat. Arb. Forum Jan. 12, 2007); *see also Yellow Corp. v. MIC*, D2003-0748 (WIPO Dec. 6, 2003); *see also Hain Food Group v. MIC*, FA 94729 (Nat. Arb. Forum June 15, 2000). It also appears Respondent watches for merger announcements and then promptly registers the combined name as a domain name. This suggests Respondent registered and is using the <**weirspm.com**> domain name in bad faith under Policy ¶4(b)(ii). *See Nat’l Abortion Fed’n v. Dom 4 Sale, Inc.*, FA 170643 (Nat. Arb. Forum Sept. 9, 2003) (finding bad faith pursuant to Policy ¶4(b)(ii) because the domain name prevented the complainant from reflecting its mark in a domain name and the respondent had several adverse decisions against it in previous UDRP proceedings, which established a pattern of cybersquatting); *see also Sport Supply Group, Inc. v. Lang*, D2004-0829 (WIPO Dec. 10, 2004) (“[Respondent] registered the <usgames.com> domain name in order to prevent [Complainant] from reflecting its U.S. GAMES Mark in a corresponding domain name [pursuant to Policy ¶4(b)(ii)]. The pattern of such conduct is established, inter alia, by the public decisions of two different UDRP proceedings [against] Respondent.”). This is not a business model which suggests the good faith required under the UDRP.

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



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: August 29, 2007

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