



ASIAN DOMAIN NAME DISPUTE RESOLUTION CENTRE (BEIJING OFFICE)

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Decision Submission

English Print

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| Decision ID | DE-0600057 |
| Case ID | CN-0500065 |
| Disputed Domain Name | www.vertispa.com |
| Case Administrator | Xinmin Cui |
| Submitted By | Shaojie Chi |
| Participated Panelist | |
| Date of Decision | 23-01-2006 |

The Parties Information

| | |
|-------------------|-------------------|
| Claimant | American Standard |
| Respondent | Rick Petralia |

Procedural History

On September 27, 2005, the Complainant submitted its Complaint in English to the Beijing Office of the Asian Domain Name Dispute Resolution Centre (the "Centre"), in accordance with the Uniform Domain Name Dispute Resolution Policy (the "Policy") adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on August 26, 1999, the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") approved by ICANN on October 24, 1999, and Asian Domain Name Dispute Resolution Centre Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "ADNDRC Supplemental Rules") being effected on February 28, 2002. The Centre confirmed the receipt of the Complaint on September 29, 2005.

On December 6, 2005, the Centre confirmed receipt of the fees paid by the Complainant by draft.

On September 29, 2005, the Centre notified the Registrar, GoDaddy.com of the domain name in dispute, and the latter confirmed the relevant registration information on December 9, 2005.

On December 9, 2005, the Centre sent the Complaint by the Complainant to the Respondent and notified the party of the proceedings to follow.

On December 13, 2005, the Centre notified the disputing parties, ICAAN and the Registrar of the commencement of the Proceedings.

The Respondent has filed no defense either in hardcopy or in e-form to the Centre.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance from Mr. Chi Shaojie, on January 6, 2006, the Centre informed the Complainant and the Respondent of the appointment of the Sole Panelist.

The Sole Panelist finds that the Panel was properly constituted and appointed in accordance with the Rules and the ADNDRC Supplemental Rules.

Having requested the Respondent to submit the Response, the Centre has received no such document from the requested party in the whole course of the proceedings.

The language of the proceedings is English, as being the language of the Domain Name Registration and Service Agreement, pursuant to Paragraph 11(a) of the Rules, and also in consideration of the fact that it is the language used by the disputing parties in communication and there is no express agreement to the contrary by the disputing Parties.

Factual Background

For Claimant

The Complainant contends that:

Complainant is a global manufacturer, supplier and seller of goods in the bath and kitchen industry, including Complainant's therapeutic shower devices sold under the mark VERTISPA. On or about March 2005, Respondent contacted one of Complainant's employees and requested payment of about \$1,500 in exchange for transfer of the above referred domain name. The Complainant did not answer Respondent's initial request and instead conducted a search for information on the registrant of the domain name. At the time of this search, Complainant viewed Respondent's website to which the domain name pointed, revealing that Respondent advertised the site as being for sale. Some time later, Respondent contacted the same employee and reiterated his request for payment in exchange for transfer of the domain name. After issuance of Complainant's United States trademark registration, Complainant contacted Respondent and requested transfer of the domain name, Respondent replied with a request for citation of "applicable law" upon which Complainant could rely and notably emphasized his own record of prior unlawful domain name registrations (stating, "I always win"). Complainant responded with an accurate citation of applicable United States law as well as ICANN's adoption of the Uniform Domain Name Dispute Resolution Policy (UDRP). Upon Complainant's further request for transfer of the domain name, Respondent contended that Complainant had attempted to take Respondent's domain name "without any sort of payment". Respondent thereafter changed this website to remove the offer for sale and substituted a nonsensical drawing thereof. Copies of the exchange between Complainant and Respondent, along with hard copies of Respondent's website both "for sale" and with the drawing, are provided with the hard copy of the Complaint.

Complainant asserts that Respondent has improperly registered the domain name purely for profit and has not activated any website that offers any type of goods or services. Respondent has registered a domain name that incorporates Complainant's valuable trademark and will likely confuse existing and future customers of Complainant and dilute the inherent value in Complainant's mark for which Complainant has expended both financial and temporal resources. Complainant further asserts that Respondent has repeatedly engaged in such behavior, based upon Respondent's own admission of such behavior. Such admission constitutes bad faith per se.

For Respondent

The Respondent, Rick Petralia, registered the disputed domain name through the registrar, GoDaddy.com, on February 5, 2005. He was duly notified by the Centre of the Claim lodged by the Complainant and asked to submit the Response in accordance with the relevant regulations under the Policy, the Rules and the ADNDRC Supplementary Rules, but failed to give any sort of defense in any form against the Claim by the Complainant.

Parties' Contentions

Claimant

The Complainant contends that: it is a global company for the manufacture and marketing of the goods in bath and kitchen industry, and its products coverage includes therapeutic shower devices using the mark VERTISPA. That the mark VERTISPA has been registered with US Patent and Trademark Office (USPTO) and the registration certificate was officially issued on July 19, 2005. Obviously, the domain name in dispute containing Complainant's registered mark will undoubtedly confuse the existing and future users of the Complainant's products and service.

That the Respondent does not have rights on or legitimate interests in the disputed domain name.

That the Respondent improperly registered the domain name purposely for making profit out of the registration, and in his communication with the Complainant revealed that the domain name in dispute was not the only one being contended.

In view of the above, the Complainant requests the Panel to rule on the transfer of the domain name vertispa.com from the Respondent to the Claimant, and on the Respondent's refraining from registering any other domain name incorporating any of the Complainant's registered trademark.

Respondent

The Respondent did not make any contention against the Complainant's allegations.

Findings

Identical / Confusingly Similar

Pursuant to Paragraph 4(a) (i) of the Policy, a complainant must prove that the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights. To meet the requirement, the Complainant submitted a copy of the Certificate of Registration by USPTO of its trademark VERTISPA. The exhibit was passed to the Respondent who did not claim against the authenticity of the exhibit. The Panel analyzes the exhibit based upon its professional experiences and does not find any excuse not to believe the paper is true. Therefore, based upon the exhibit, the Panel holds that the Complainant owns a registered trademark VERTISPA, and the Certificate of the Registration shows that FIRST USE 11-1-2003; IN COMMERCE 6-1-2004; FILED 12-11-2003. The mark is for PLUMBING FITTINGS, NAMELY, THERAPEUTICS SHOWER SPRAYS, SHOWER HEADS AND SHOWER MASSAGES SYSTEMS, IN CLASS 11(U.S.CLS. 13,21,23,31 AND 34). The domain name in dispute is VERTISPA.COM. It is easy to see that the essential word VERTISPA in the domain name registered by the Respondent is identical to the Complainant's registered trademark VERTISPA.

Rights and Legitimate Interests

Paragraph 4(c) of the Policy stipulates how a Respondent can effectively demonstrate rights or legitimate interests in the disputed domain name. Unfortunately, the Panel does not see that the Respondent has any legitimate right or interest in respect of the disputed domain name, due to the fact that the Respondent does not claim such a right or interest, and nothing so far could lead the Panel to hold such a fact in the Respondent's favor. The Panel notices that the Respondent registered the domain name some time in February 2005 and the Complainant's trademark registration certificate was issued on July 19, 2005. Nevertheless, as held by the Panel in accordance with the exhibit adopted, the date of first use and marketing by the Complainant of product bearing the mark VERTISPA, as well as the filing date for registration was much earlier than the date the Respondent registered the disputed domain name. On the other hand, the Panel thinks of every probability it could, but sees no reason to make such a judgment that the Respondent is entitled to any prior existing right or interest in the domain name VERTISPA.COM. Based on the reasoning, the Panel rules that the Respondent has no right or legitimate interest in the domain name VERTISPA.COM.

Bad Faith

The Complainant also has to establish bad faith on the part of the Respondent as set forth in the Paragraph 4(a)(iii) of the Policy. Under the Paragraph 4(b)(i) of the Policy, the following circumstances, in particular, shall be considered evidence of the registration and use of a domain name in bad faith:

Circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name.

Based on the evidence submitted by the Complainant, the Panel finds that the Complainant has established the requisite bad faith. The Panel finds:

That the Complainant puts up advertisement on its website on the details of its product VertiSpa™ Shower System; and the public gets easily access to the Complainant's website.

That the Complainant started to produce and market the shower system bearing the trademark VERTISPA it later registered with USPTO, much earlier than the Respondent registered the domain name VERTISAP.COM.

That the Panel bases on no evidence to find out that the Respondent registered the disputed domain name for the purpose of its own use.

That a piece of information on the web says: "This domain name www.Vertispa.com is for sale. If you would like to make an order, email me at rp3000gt@yahoo.com." On the left side of the information, it mentions that Email me Name: Rick Petralia Email: rp3000gt@yahoo.com.

That the email address used by the Respondent in its communications with the Complainant is rp3000gt@yahoo.com.

That in an email from the Complainant to the Respondent, the former says: "It has come to our attention that you are seeking payment from American Standard for transfer of the domain name www.vertisap.com. As you know, American Standard uses the trademark VERTISPA in commerce for its shower massage system and has secured a lot of value in this mark. In fact, the United States Patent and Trademark Office has issued federal registration number 2,974,285 to American Standard for VERTISPA, thereby granting American Standard prima facie ownership of this mark. Under the

applicable law, it is therefore presumed that you have secured this domain name in bad faith. We therefore demand transfer of the domain name to American Standard. American Standard shall make no payments for such transfer. If you fail to transfer the domain name within 10(10) days of receipt of this message, we shall file a domain name dispute as provided according to ICANN rules."

That in an email dated July 26, 2005 from the Respondent to the Complainant, the former says: "I would be more than happy to transfer to you the domain name. First however, I'd like to see a copy of this 'applicable law' you speak of that says I cannot register a domain name in the name of a copywritten product. If you wanted the domain name bad enough where you would file a complaint against me, why didn't you file in the first place? Who creates a product whose 'mark has a lot of value' (as you put it) yet doesn't even think to spend \$9.99 to register a domain name? I'll tell you who, a bunch of idiots for a marketing team. I've had complaints like this followed against me before. I always win. My latest was with Weber Grills. So, as I said, if you can produce for me a law saying that I can't do what I am doing, then I will transfer you the domain name immediately."

That in its follow-up emails to the Complainant, the Respondent expresses, "You're right. I guess the definition of 'Bad Faith' may have possibly described what I was doing. I don't believe so, but your twisted definition does. And as to the laws you referred to, I didn't really go back and research those to make sure they were valid. But, I decided to change my page. www.vertispa.com no longer directs you to a 'For Sale' page. I am no longer advertising that my site is for sale. The page is no longer about your company or your product." "You misunderstand my last email. I'm not giving you the domain name. It belongs to me. Not you. I simply took the 'bad faith' out of it. It is no longer for sale. I am no longer trying to make profit off of it. You are the one trying to make profit off of me. You want to take my domain name from me without any sort of payment. I may be using a domain name that is identical or confusingly similar to your mark, however I do not have a bad faith intent to profit from it. So now I am doing nothing illegal."

Based upon the above fact-findings, the Panel holds that the Complainant has made advertisement on its product bearing its registered trademark VERTISPA in a wide range on the web and the advertising information is easily accessible to the public. The Respondent registered the domain name VERTISPA.COM and made it to the public that it intended to sell the registered domain name. Only when the Complainant contacted the Respondent contending for the transfer of the disputed domain name without any payment, the latter made the expression that it no longer offers the domain name for sale. The Panel emphasizes that what the Complainant must establish in terms of "Bad Faith" is the situation when the Respondent registered the disputed domain name and thereafter. Obviously, no evidence could lead the Panel to hold the Respondent's innocence at the time of its registering the domain name, and there are evidences making the Panel to hold that the Respondent offered for sale the domain name after its registration with an intention for monetary consideration. In accordance with the stipulations under the applicable laws, e.g. the Policy, etc. such behaviors of the Respondent are in bad faith.

Based upon all the above findings, the Panel ruled that the Complaint fulfills the conditions provided in Paragraph 4(a)(i) (ii) (iii) of the Policy, thus its claims shall be held.

Status

www.vertispa.com Domain Name Transfer

Decision

In light of all the foregoing findings and in accordance with Paragraphs 4(a), 8(a) of the Policy and 5(e) of the Rules, the Panel holds:

- a) That the disputed domain name "vertispa.com" is identical to the trademark "VERTISPA"; and
- b) That the Respondent has no rights or legitimate interest in respect of the disputed domain; and
- c) That the domain name was registered and subsequently used in bad faith.

As such the Panel decides that the registration of the "vertispa.com" domain name be transferred to the Complainant.

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