

ADMINISTRATIVE PANEL DECISION

Terex Corporation and Genie Industries, Inc. v. Powko Industries LLC Case No. D2010-1468

1. The Parties

Complainants are Terex Corporation and Genie Industries, Inc. of Westport, Connecticut, United States of America, represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States of America.

Respondent is Powko Industries LLC of Prairieville, Louisiana, United States of America, represented by McGlinchey Stafford PLLC, United States of America.

2. The Domain Names and Registrar

The disputed domain names <genielighttower.com>, <genielighttowers.com>, <terexlighttower.com>, and <terexlighttowers.com> (the "Domain Names") are registered with GoDaddy.com, Inc.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 1, 2010. On September 1, 2010, the Center transmitted by email to GoDaddy.com, Inc. a request for registrar verification in connection with the Domain Names. On September 1, 2010, GoDaddy.com, Inc. transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified Respondent of the Complaint, and the proceedings commenced September 2, 2010. In accordance with the Rules, paragraph 5(a), the due date for Response was September 22, 2010. The Response was filed with the Center on September 22, 2010.

On September 24, 2010, Complainants filed an Offer to Submit Supplemental Filing, in which Complainants requested that, if necessary, they would like to be provided an opportunity to submit a Supplemental Filing concerning why the Declaration of Mr. Bennett should be fully considered (see discussion below) and that would include a statement, contradicting the Affidavit of Mr. Tonguis, to confirm that Mr. Bennett never

discussed the Domain Names with Mr. Tonguis. On September 24, 2010, the Center received Respondent's Objection to Complainants' Offer to Submit Supplemental Filing, arguing that such a supplemental filing is beyond the bounds of the applicable rules.

The Center appointed Christopher S. Gibson, Alan L. Limbury and Peter L. Michaelson as panelists in this matter on October 21, 2010. The Panel finds that it was properly constituted. Each member of the Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Preliminary Issue: Offer to Submit Supplemental Filing

Paragraph 12 of the Rules provides that in addition to the complaint and the response, a panel may request, in its sole discretion, further statements or documents from either of the parties. Here, although Complainants have offered to submit a supplemental filing, the Panel determines that it will not request or accept any additional filings in this case. In respect of Respondent's argument, discussed below, about an alleged technical defect in the Declaration of Richard Bennett, the Panel refers to paragraph 10(d) of the Rules, which provides that the "Panel shall determine the admissibility, relevance, materiality and weight of the evidence." With this mandate in mind, the Panel decides that, without any evidence in the record or other indication to discredit the substance of Mr. Bennett's declaration, it would be inappropriate to ignore the content on formal grounds, even assuming that a technical defect may exist under certain state law requirements as to which the Panel in this administrative procedure is not bound. The Panel will carry out its duty to assess the relevance, materiality and weight of this evidence, along with the other evidence presented in the case.

5. Factual Background

Complainant Terex Corporation is a diversified global manufacturer operating in four business segments: aerial work platforms, construction, cranes, and materials processing. Complainant Genie Industries, Inc. is a wholly owned subsidiary of Complainant Terex Corporation. Genie Industries is a world leader in the production of material lifts, portable aerial work platforms, scissor lifts, and self-propelled telescopic and articulated booms. Complainants' products are manufactured in more than 50 facilities in North America, Europe, South America, Asia and Australia. Complainants market products to customers in more than 150 countries.

Complainant Terex Corporation is the owner of U.S. federal trademarks for the TEREX mark, with registrations dating from 1985 and 1998. Complainant Genie Industries is the owner of federal trademarks for the GENIE mark, with two registrations dating from 1991.

Respondent registered all of the Domain Names on March 25, 2009.

Respondent is using the Domain Names <terexlighttowers.com> and <genielighttowers.com> in connection with commercial websites that use and display Complainants' TEREX and GENIE trademarks.

Respondent is using the Domain Names <terexlighttower.com> and <genielighttower.com> in connection with parking pages that contain links to products competitive with Complainants' products, including links labeled "Whole Forklifts & Equip", "Tower Crane", "Liebherr Tower Cranes" and "Genie Man Lifts."

6. Parties' Contentions

A. Complainant

Complainants contend that Respondent is using the Domains Names, without permission or consent from

Complainants, in connection with websites that falsely appear to be affiliated, connected or associated with Complainants. Specifically, Respondent is using the Domain Names <terexlighttowers.com> and <genielighttowers.com> in connection with fully developed commercial websites that prominently use Complainants' TEREX and GENIE trademarks; and Respondent is using the Domain Names <terexlighttower.com> and <genielighttower.com> in connection with monetized parking pages that contain links to products competitive with Complainants' products, including links labeled "Whole Forklifts & Equip," "Tower Crane," "Liebherr Tower Cranes" and "Genie Man Lifts."

Confusingly similar:

Complainant asserts that each of the Domain Names is confusingly similar to either of the TEREX or GENIE trademarks. The relevant comparison to be made is with the second-level portion of each of the Domain Names. Where, as here, a domain name wholly incorporates a complainant's registered trademark, that is sufficient to establish confusing similarity for purposes of the Policy. Furthermore, where, as here, the second-level domain contains a complainant's trademark plus descriptive words ("light" and "tower" or "towers"), a wide variety of panelists have considered that the addition of generic words to trademarks was not sufficient to escape the finding of similarity and does not change the overall impression of the designations as being connected to Complainants. In particular, when the words in a domain name that are added to a complainant's trademark (*i.e.*, "light" and "tower"; or "light" and "towers") have some relevance to goods or services provided within complainant's industry, the domain names are confusingly similar to complainant's marks. Additionally, the overall impression of each of the Domain Names is one of being connected to the trademark of Complainant. Accordingly, each of the Domain Names is confusingly similar to one of Complainants' trademarks.

No rights or legitimate interests:

Complainants contend that Respondent has no rights or legitimate interests in the Domain Names. Although Complainants are aware that Respondent purchases and resells equipment from Complainants, Respondent is not, and never has been, a party to any written agreement with Complainants for the distribution or sale of any products manufactured or marketed by Complainants. Neither of Complainants has ever granted to Respondent any rights to use the TEREX or GENIE trademarks in a domain name or otherwise. In fact, it is the policy of Complainants to oppose such practices, as all authorized distributors or resellers for Complainants are required to enter into an agreement containing the following restriction: "Distributor shall not include all or any portion of the Trademarks in its legally registered corporate, company, domain or trade name". In all applicable agreements, the definition of "Trademarks" includes the TEREX and GENIE marks. Complainants have never assigned, granted, licensed, sold, transferred or in any way authorized Respondent to register or use the TEREX or GENIE marks in any manner. This fact, on its own, can be sufficient to prove the second criterion of the Policy.

Complainants also argue that Respondent cannot demonstrate rights or legitimate interests because, upon information and belief, Respondent has never used, or made preparations to use, the Domain Names or any name corresponding to the Domain Names in connection with a *bona fide* offering of goods or services. Specifically, Respondent is using the Domain Names <terexlighttowers.com> and <genielighttowers.com> in connection with fully developed commercial websites that prominently use Complainants' TEREX and GENIE marks; and Respondent is using the Domain Names <terexlighttower.com> and <genielighttower.com> in connection with monetized parking pages that contain links to products competitive with Complainants' products. With respect to the Domain Names <terexlighttower.com> and <genielighttower.com>, the use for landing pages is not a *bona fide* offering of goods or services under the Policy. These Domain Names revert to a rudimentary directory site, which is little more than a list of links. A respondent that has and is confident of its rights or legitimate interests in a website might be expected to invest more in it than this Respondent. As such, the nature of the site itself is suggestive of a lack of rights or legitimate interests.

Further, with respect to the Domain Names <terexlighttowers.com> and <genielighttowers.com>, Respondent has not acquired any rights or legitimate interests merely because it may be reselling

Complainants' products. Complainants contend that although Respondent claims to be a "Terex Authorized Agent," Respondent has no reseller, distributor or agency agreement with Complainants, and, as stated above, is not authorized by Complainants to use the Domain Names or the TEREX or GENIE trademarks in any manner. Moreover, as previous panels have decided, to establish a legitimate interest under the Policy, a licensee or reseller using a domain name that consists solely of a trademark owner's mark must take steps to prevent confusion by making clear in its use of the domain name that it is not the mark owner, even if it offers legitimate goods. Here, however, as shown by evidence submitted by Complainant, Respondent has done nothing to prevent confusion or to make clear that it is not either of the Complainants. Instead, the presentation of Respondent's unauthorized reseller websites is likely to mislead Internet users into believing that the sites are operated or endorsed by or affiliated with Complainants. The dominant position of Complainants' logos on Respondent's websites without any statement as to the true ownership of the site or any disclaimer of association with Complainants creates a strong impression that the site is an official site of Complainants – actions that negate any rights or legitimate interests that Respondent could claim to the Domain Names. To establish rights or legitimate interests, a reseller's website should accurately disclose the registrant's relationship with the trademark owner; it may not, for example, falsely suggest that it is the trademark owner. Here, however, Respondent's websites do not disclose Respondent's relationship with Complainants and in fact falsely suggest that Respondent is the owner of the TEREX and GENIE marks.

Finally, Respondent cannot demonstrate rights or legitimate interests because, to Complaint's knowledge, Respondent has never been commonly known by any of the Domain Names and has never acquired any trademark or service mark rights in any of them. Specifically, according to the Whois records, the registrant of the Domain Names is "Powko Industries LLC" – not "Terex" or "Genie" or "Terex Light Tower(s)" or "Genie Light Tower(s)". This fact, combined with the lack of evidence in the record to suggest otherwise, allows the Panel to rule that Respondent is not commonly known by any of the Domain Names or any variation thereof. In addition, given Complainants' rights in the TEREX mark date from 1985 and in the GENIE mark date from 1991, it is unlikely that Respondent is commonly known by these marks. Respondent is not making a legitimate noncommercial or fair use of any of the Domain Names. Rather, Respondent is making an illegitimate, commercial, unfair use of the Domain Names, with intent for commercial gain misleadingly to divert consumers. Specifically, Respondent is using each of the Domain Names in connection with websites selling light towers and generators, which websites falsely appear to be affiliated, connected or associated with Complainants. Accordingly, Respondent has no rights or legitimate interests in respect of any of the Domain Names.

Bad faith registration and use:

Complainants contend that the Domain Names should be considered as having been registered and used in bad faith by Respondent. As noted above, Respondent is using the Domain Names <terexlighttowers.com> and <genielighttowers.com> in connection with fully developed commercial websites that prominently use Complainants' TEREX and GENIE marks. These websites appear to be websites operated by Complainants themselves. Such uses are intentionally attempted to attract, for commercial gain, Internet users to Respondent's sites by creating a likelihood of confusion with Complainants' marks as to the source, sponsorship, affiliation, or endorsement of Respondent's site or of a product or service on Respondent's site.

In addition, Complainants have submitted evidence to show that Respondent is using the TEREX and GENIE marks in meta tags for the HTML source code for the websites using the Domain Names <terexlighttowers.com> and <genielighttowers.com>. Such use is further evidence of bad faith under the Policy.

Respondent is using the Domain Names <terexlighttower.com> and <genielighttower.com> in connection with monetized parking pages that contain links to products competitive with Complainants' products. Complainants indicate that numerous panels under the Policy have found that a respondent's use of a domain name in connection with a monetized parking page is evidence of bad faith. Complainants cite a prior decision in which the panel found that respondent's use of the disputed domain name to resolve to a website linking Internet users to third-party products and services was intended to capitalize on the likelihood of confusion with complainant's mark in an attempt to generate click-through fees, conferring commercial

gain on respondent.

Further, with respect to all of the Domain Names, Respondent has acted in bad faith because it has registered the Domain Names in order to prevent Respondent from reflecting its TEREX and GENIE trademarks in corresponding domain names and has engaged in a pattern of such conduct.

Complaint includes four Domain Names indicating a pattern of conduct by Respondent. This pattern is also shown by Respondent's registration of at least one other domain name, <magnumlighttowers.com>, which contains a trademark (MAGNUM) owned by a competitor of Complainants.

Finally, given Complainants' rights in the TEREX and GENIE marks established for as long as 25 and 19 years, respectively, and the fact that each of the Domain Names is so obviously connected with Complainants' marks, Respondent's actions suggest opportunistic bad faith in violation of the Policy.

B. Respondent

Respondent admits that it is engaged in the business of reselling industrial equipment purchased from original equipment manufacturers, including TEREX and GENIE branded products, and that it does so using conventional and Internet-based channels of sales promotion and distribution. In so doing, Respondent has registered the Domain Names for the purpose of assisting potential and existing customers to find information pertaining to the products offered by Respondent. Respondent specifically denies Complainants' allegations that (a) any affiliation apparent from the websites linked to the Domain Names is "false," (b) it receives any pecuniary benefit from the parking pages linked to any of the Domain Names, and (c) it controls the placement of any competitive product links on those parking pages.

No confusing similarity:

Respondent readily concedes that the Domain Names include, in part, the standard character representations of the trademarks, TEREX and GENIE, respectively. The second level portions of the domains, however, are not "identical" to either mark because they further include generic, descriptive phrases pertaining to products being offered for sale by Respondent. Thus, the only question remaining is whether the second level domains are confusingly similar to the TEREX and GENIE marks. While it is possible that someone could be confused as a result of the presence of these trademarks as a portion of the second level portion of the Domain Names, Complainants have not established through evidence that confusion would or could be likely, or provided any evidence of actual confusion. Rather, Complainants rely on a presumption that confusion would exist merely because the marks are present in the second level portion of the Domains. Respondent submits that such a presumption in the current Internet environment is not valid, as most consumers now know that the presence of a trademark as a portion of a second level portion of a domain name does not necessarily indicate any affiliation with the trademark owner. Thus, according to Respondent, Complainant's failure of proof in this regard should be rejected as inadequate for purposes of establishing confusing similarity under Policy paragraph 4(a)(i). However, even if one assumes for purposes of argument that there is "confusing" similarity between Complainants' marks and the Domain Names, for the reasons which follow, Complainants cannot meet their burden of proof as to the other elements required to establish a basis for the requested transfer of the Domain Names.

Rights or legitimate interests:

As a preliminary matter, Respondent calls the Panel's attention to a defect in Complainants' evidence submitted with the Complaint on the issue of whether Respondent has rights or legitimate interests in respect of the Domain Names. In attempting to meet their burden, Complainants rely on a defective declaration. The Declaration of Mr. Bennett is in fact an unsworn statement because, while the notary signature at the bottom would appear give the impression that the declarant properly swore under oath to the truthfulness of the statements made, any reasonable reading of the notary acknowledgement makes clear that the declarant did not swear that the allegations made in the declaration were true and accurate. Rather, the declarant merely swore and deposed that he was in fact Mr. Bennett. The Respondent's authorized

representative is informed by his law firm colleagues licensed in the State of Mississippi that, under Mississippi state law (the law applicable to the Notary Public in this instance), a sworn affidavit or declaration must at least indicate on its face that the declarant swore under oath or affirmed, before someone competent to take oaths, the truthfulness of the statements made by the declarant. Because no such oath or affirmation appears to have been made, the Declaration of Mr. Bennett should be stricken, disregarded, or at a minimum, given very little evidentiary weight.

Respondent asserts, however, for the sake of argument only, that even if Mr. Bennett's Declaration is given some evidentiary weight, it does nothing to refute the facts established by the Affidavit of Mr. Tonguis, which was submitted with the Response, as well as the "About Us" and home pages on Respondent's websites, which show that Respondent is in fact offering the respective branded goods at its sites; is using each of the respective sites to sell only the respective, trademarked goods; and is not intentionally using the marks to bait web users who visit the respective sites and then switch them to another brand. Moreover, the accompanying evidence establishes that the sites do not falsely suggest that they are Complainants' official sites or misstate the relationship between Respondent and Complainants, as the sites clearly identify Powko Industries, LLC as a separate company with a separate logo and as an "agent" both at the main home page where the only contact information is provided and in the "About Us" page of the sites.

Moreover, Respondent has not tried to "corner the market" by registering numerous variations of the trademarks in all of the top level domains, but rather has merely registered the singular and plural of <[genie/terex]lighttower[s].com>. As legal scholars and panels have noted previously, the registration and use of domain names in connection with a *bona fide* offering of goods under such circumstances cannot trigger the limited prohibitions of the Policy. Several panel decisions have refused similar attempts to force the transfer of like domain names. In many of these cases, unauthorized resellers were permitted to retain their domain names due to a failure to establish an absence of a right or legitimate interest, and/or a failure to establish bad faith.

Respondent contends that Complainants' allegation that no formal, written distributorship agreement was signed by the parties fails to establish that no contractual relationship existed between the parties under applicable law. Under at least the law of the State of Louisiana (the domicile of Respondent), a contractual relationship can be established orally and without any formal, written agreement, as long as the documented facts and circumstances establish an agreement to permit Respondent to buy and resell branded products from Complainants. Such a relationship is evidenced by Mr. Tonguis' affidavit. Respondent's account for buying from Complainant Genie was established on March 24, 2009, and the entire course of dealing between Respondent and Complainants' representatives establishes that the parties had agreed that Respondent would act as a reseller of the branded products of Complainants.

Thus, at least until this dispute was raised by Complainants, Respondent had a right or legitimate interest in the Domain Names. It appears that somewhere between Respondent's establishment of rights as a reseller of the branded products and the date this dispute was initiated by Complainants, Complainants decided to impose new requirements upon its product resellers, or to expand its portfolio of domain name registrations, and that it would do so regardless of whatever rights had already been established by others. The UDRP policies and existing precedent dictate that such domain name power grabs should be refused. For at least this reason, Complainants failed to meet their burden of establishing Respondent has no rights or legitimate interests in the Domain Names, and the requested transfer should be denied.

No registration and use in bad faith:

Respondent argues that Complainants have also failed to establish that the Domain Names were registered, and are being used, in bad faith. Mr. Tonguis' affidavit establishes that, at the time of registration of the Domain Names (March 25, 2009) through the date Respondent was given notice of this dispute on December 11, 2009, Complainants were in fact selling products to Respondent and Respondent was engaged in the *bona fide* resale of such products. This was ongoing with the knowledge of more than one representative of Complainants for several months prior to the giving of any notice of this dispute, and prior to giving Respondent notice of any further requirement that it enter into a formal, written distributorship

agreement before it engaged in the authorized resale of Complainants' products.

It may be that Complainants are primarily concerned with the way in which logos are used, the sequence in which they appear, or the manner in which products are described in the sites operated by Respondent, because of some concern about formatting raising a possibility of viewer confusion. Respondent has been and remains willing to consider reasonable requests for modification to the content of its sites, but has avoided modifications of content during the pendency of this dispute so as to avoid any negative inferences that might otherwise be drawn or exploited in furtherance of an effort to expand a domain name portfolio through improper use of UDRP procedures. Nevertheless, Respondent's evidence establishes that it did register the Domain Names in good faith and that it is and has been using them in good faith.

In a manner consistent with the findings of prior panel decisions such as *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2010-0903, and the decisions in *Volvo Trademark Holding AB v. Volvospare / Keith White*, WIPO Case No. D2010-1860 and *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265, Respondent submits that Complainants have failed, despite their citation laden arguments, to meet their burden to establish that the Domain Names have been registered in bad faith, and furthermore have failed to meet their additional burden to establish that the Domain Names are being used in bad faith. On the contrary, Respondent has established that the Domain Names were legitimately registered in connection with Respondent's establishment of a reseller's account with Complainants in order to conduct legitimate sales and promotion operations, and prior to notice of this dispute the Domain Names were being used by Respondent in connection with *bona fide* efforts to sell goods, namely those goods manufactured and supplied to Respondent by Complainants, with the full knowledge of representatives of Complainants. For these additional reasons, the requested transfer should be denied.

7. Discussion and Findings

The burden for Complainants under paragraph 4(a) of the Policy is to prove:

- (i) that the Domain Names registered by Respondent are identical or confusingly similar to a trademark or service mark in which Complainants have rights; and
- (ii) that Respondent has no rights or legitimate interests in respect of the Domain Names; and
- (iii) that the Domain Names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that Complainant owns registered trademark rights in its TEXEX and GENIE marks and that each of the Domain Names incorporates one of Complainants' marks in its entirety along with the singular or plural version of descriptive generic noun, "light tower(s)." Given that the Domain Names are not identical to Complainants' marks, the question is whether they are confusingly similar. Respondent has argued that Complainants have not provided actual proof of confusion but instead rely on a presumption of confusion, which presumption should not be considered valid in the current Internet environment. Thus, according to Respondent, Complainant's failure of proof in this regard should be rejected as inadequate for purposes of establishing confusing similarity.

The Panel disagrees with Respondent. There can be no question but that the Domain Names are confusingly similar to Complainants' respective TEREX and GENIE marks for purposes of the Policy. The Panel follows the consensus view of many UDRP panels, as expressed in the *WIPO Overview of WIPO Panel Views on Selected UDRP Questions*. The *WIPO Overview* states in paragraph 1.2 that, rather than look to the content of a website or other factors, "[t]he test for confusing similarity should be a comparison between the trademark and the domain name to determine the likelihood of confusion." In the influential UDRP case, *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903, to which both of the parties

in this case cited, the panel helpfully explained that “[t]he issue in the analysis of the first factor is not whether there is confusion in the trademark infringement sense (an issue more properly considered under the legitimate interest and bad faith factors), but rather whether there is sufficient similarity between the domain name and the trademark to advance to consideration of the second and third factors.” In this case, the terms “light tower” or “light towers”, which are descriptive of goods or services within Complainants’ industry, do not sufficiently distinguish the Domain Names from Complainants’ marks. See *Wikimedia Foundation Inc. v. commens, Nan Jiang*, WIPO Case No. D2009-1699 (“[t]he weight of authority of past panel decisions have established that a domain name incorporating a trademark in its entirety with the addition of non-distinctive prefixes or suffixes is generally not distinguishable from the trademark”); *American Express Company v. MustNeed.com*, NAF Claim No. 257901 (finding respondent’s <amextravel.com> domain name confusingly similar to complainant’s AMEX mark because the “mere addition of a generic or descriptive word to a registered mark does not negate” a finding of confusing similarity under Policy 4(a)(i)). Moreover, where the words in a domain name that are added to a complainant’s trademark “have some relevance to goods or services provided within [complainant’s] industry,” the domain names are confusingly similar to complainant’s trademarks. *Inter-Continental Hotels Corporation, Six Continents Hotels, Inc. v. Daniel Kirchhof*, WIPO Case No. D2009-1661.

Accordingly, the Panel finds that Respondent’s Domain Names are confusingly similar to Complainants’ marks pursuant to Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

A complainant is normally required to make out a *prima facie* case that respondent lacks rights or legitimate interests. Once such *prima facie* case is made, respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP. See *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case. No D2003-0455.

In this case, the Panel finds that Complainants have indeed made a *prima facie* showing that Respondent does not have rights or legitimate interests in the Domain Names within the meaning of paragraph 4(a)(ii) of the Policy, and that Respondent has been unable to rebut this showing.

This finding is based on the following circumstances brought forward by Complainants:

- (1) There is no doubt that Respondent registered the Domain Names with Complainants’ TEREX and GENIE trademarks in mind. Respondent has candidly acknowledged that it is in the business of reselling industrial equipment, including TEREX and GENIE branded products, and that it registered the Domain Names “for the purpose of assisting potential and existing customers to find information pertaining to the products offered by Respondent.”
- (2) Complainants have never authorized Respondent to use the TEREX or GENIE trademarks in a domain name or otherwise. Complainant has submitted evidence of its policy to oppose such practices even in its agreements with authorized distributors or resellers by including a restriction that they must not include any portion of Complainants’ trademarks in their company, trade or domain names. Respondent argues that Complainants must have “decided for whatever reason to impose new requirements upon its product resellers.” However, this statement is merely argumentative and does not adequately rebut Complainants’ statement of standard policy.
- (3) There is no indication in the record before the Panel that Respondent is commonly known by any of the Domain Names or has ever acquired any trademark or service mark rights in any of them.
- (4) Respondent is not making a legitimate noncommercial or fair use of any of the Domain Names.
- (5) Respondent is using the Domain Names <terexlighttower.com> and <genielighttower.com> in connection with parking pages that contain links to products competitive with Complainants’ products.

With respect to these two Domain Names, their use for landing pages is not a *bona fide* offering of goods or services under the Policy. By directing Internet users to such landing pages containing links to sites of third parties that compete with Complainants' business, Respondent has failed to demonstrate any right or legitimate interests in these Domain Names during the period in which they have been registered and used. Moreover, Respondent's alleged lack of control over the content of the landing pages to which these two Domain Names resolve does not serve as an adequate justification and has been rejected as a defense by many previous panels. See *Gaylord Entertainment Company v. Nevis Domains LLC*, WIPO Case No. D2006-0523; *ServiceMaster Brands, LLC v. Texas International Property Associates*, WIPO Case No. D2009-1108.

Accordingly, the Panel determines that the circumstances referenced in paragraphs (1) through (5) above are sufficient to support a finding that Respondent has no rights or legitimate interests in the Domain Names <terexlighttower.com> and <genielighttower.com>.

The circumstances in paragraphs (1) through (4) apply with equal force to the remaining two Domain Names to be considered, <terexlighttowers.com> and <genielighttowers.com>. However, an additional set of circumstances should also be considered for assessing whether Respondent has established any rights or legitimate interests in these Domain Names:

- (1) Respondent has been using the Domain Names <terexlighttowers.com> and <genielighttowers.com> in connection with commercial sites that prominently display Complainants' TEREX and GENIE marks.
- (2) Complainants' contend that Respondent is making an illegitimate, commercial, and unfair use of the Domain Names, with intent for commercial gain, by misleadingly diverting consumers to Respondent's websites. In particular, Complainant contends that Respondent has failed to take adequate steps to prevent confusion by making clear Respondent is not the trademark owner. The dominant position of Complainants' logos on Respondent's sites, without a statement as to the true ownership of the site or disclaimer of association with Complainants, creates a strong impression that the site is an official site of Complainants. While upon review of the two websites concerned, the Panel is quite inclined to agree with Complainants' view that the sites are confusing as to the ownership, implied association with or sponsorship by Complainants, Respondent has countered that information on the home pages and the "About Us" pages for its respective websites provides adequate clarification of its status as an "agent" of Complainants.
- (3) The principal focus of Respondent's argument lies in attempting to prove that it should be considered an authorized agent to resell Complainants' products and thus it has a right to use Complainants' marks. Although Complainants acknowledge they have sold goods to Respondent, they emphasize that they have never entered into any written agreement with Respondent for the distribution or sale of their products, nor have they ever given Respondent any permission to use their TEREX or GENIE trademarks in the Domain Names or on Respondent's websites.
- (4) The Panel considers that if this dispute was focused only on whether or not Respondent should be considered an "agent" of Complainants and the extent of implied rights accompanying that designation, it would likely be beyond the scope of the UDRP. However, both of the Domain Names concerned, <terexlighttowers.com> and <genielighttowers.com>, resolve to commercial sites that, while primarily devoted to Complainants' products, contain links leading to other websites operated by Respondent, which offer products that compete with Complainants' products. This leads to the conclusion that, even assuming Complainants may be found to have given Respondent some implied authority to use their TEREX or GENIE marks in the Domain Names, such authority was limited to the promotion of Complainants' products. In this respect, the *WIPO Overview*, in paragraph 2.3, states the consensus view that, in order for a reseller to have a legitimate interest in a domain name, its use must meet certain requirements, including "the actual offering of goods and services at issue, the use of the site to sell only the trademarked goods and the site accurately disclosing the registrant's relationship with the trademark owner." The Panel here decides that while the adequacy of the disclosure of Respondent's relationship with Complainants presents a close call, Respondent has not

used these sites to promote only Complainants' trademarked goods.

Accordingly, once Complainants established their *prima facie* case, the burden was on Respondent to prove it has a right or legitimate interest in the Domain Names. Respondent's brief period of use of the four Domain Names prior to receiving Complainants' objections, when viewed in light of the circumstances discussed above, convinces the Panel that Respondent has not met its burden.

The Panel finds that Respondent has no rights or legitimate interests in respect of the Domain Names pursuant to Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

As noted above, there is no dispute that Respondent registered the Domain Names with Complainants' TEREX and GENIE trademarks in mind. With Respondent's lack of any right or legitimate interest in any of the Domain Names, the Panel finds that Respondent has exhibited conduct that fits into bad faith registration and use by (i) the opportunistic and intentional registration of all of the Domain Names as they contain Complainants' TEREX and GENIE marks in their entirety; (ii) connecting two of the Domain Names to landing pages containing links to competing products, and (iii) using two of the Domain Names for commercial websites with links to other websites operated by Respondent that offer competing products. These instances fall within paragraph 4(b) of the Policy ("by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site...by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.").

For all of the above reasons, the Panel finds that all the Domain Names have been registered and are being used in bad faith pursuant to Policy, paragraph 4(a)(iii).

8. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Names, <genielighttower.com>, <genielighttowers.com>, <terexlighttower.com>, and <terexlighttowers.com>, be transferred to Complainants.

Christopher S. Gibson
Presiding Panelist

Alan L. Limbury
Panelist

Peter L. Michaelson
Panelist
Dated: November 14, 2010