

CPR International Institute for Conflict Prevention and Resolution

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COMPLAINANT

Mudd (USA), LLC

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E-mail: gfecther@mccarter.com

File Number: CPR-05-16

Date of Commencement: October 26, 2005

Domain Name: muddsuckers.com

Registrar: Domain Registration Services

vs.

Arbitrator: Peter L. Michaelson, Esq.

RESPONDENT

Mechentine Design

1030 15th Avenue, SE

Minneapolis, Minnesota 55414

Tel: 612-379-7175

E-mail: webkid@webkid.com

Before Peter L. Michaelson, Esq., Arbitrator

PROCEDURAL HISTORY

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (“the Policy”), which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999 and approved on October 24, 1999 and in accordance with the ICANN Rules for Uniform Domain Name Dispute Resolution Policy (“the Rules”) as approved on October 24, 1999 and the CPR International Institute for Conflict Prevention and Resolution (“CPR”) Supplemental Rules for Uniform Domain Name Dispute Resolution Policy then in effect (“the Supplemental Rules”).

The Complaint, including accompanying Exhibits A-G, was filed with CPR on October 26, 2005 and, after review for administrative compliance, served on the Respondent. The Respondent did not file any Response. Accordingly, through an e-mail letter dated November 23, 2005, CPR notified the parties that no Response had been filed. On November 28, 2005, CPR appointed Mr. Peter L. Michaelson, Esq. as the sole Arbitrator pursuant to the Policy and the Rules.

CONTESTED DOMAIN NAME

The contested domain name, MUDDSUCKERS.COM, was registered by the Respondent with the Registrar on September 7, 2005. In registering the name, the Respondent agreed to submit to this forum to resolve any dispute concerning the domain name, pursuant to the Policy, and is now so bound.

FINDINGS

Paragraph 4(a) of the Policy provides that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent's domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

The record before this Panel solely consists of the Complaint and its Exhibits. In view of the lack of any Response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed representations. On the basis of such representations appearing in the record, the Panel makes the findings set forth below.

A. CONFUSING SIMILARITY/IDENTICALITY

The Complainant alleges that the contested domain name, MUDDSUCKERS.COM, is identical or confusingly similar to Complainant's federally registered trademark, MUDD, which the Complainant uses in conjunction with various goods, including *inter alia* eyeglasses, jewelry and clothing.

In particular, the Complainant owns several United States trademark registrations as well as numerous foreign counterpart registrations for the term "MUDD", alone or in conjunction with other terms (collectively the "MUDD Marks") on which this dispute is based. The Complainant has provided, in Exhibit E to the Complaint, a list of the MUDD Marks. Details of the pertinent US registrations are as follows, with a copy of each corresponding registration certificate appearing in Exhibit F to the Complaint:

- 1) MUDD (block letters)
US registration 2,537,262; registered February 5, 2002
This mark was registered for use in connection with: "eyeglasses, eyeglass frame and sunglasses" in international class 9; "costume jewelry, watches" in international class 14; "leather goods, namely wallets, card cases, pocket organizers; backpacks, luggage, tote bags, cosmetics cases sold empty" in international class 18; "athletic shoes, shoes,

hosiery, jackets, coats, swim wear, sweat suits, sweat pants, shorts, T-shirts, warm up suits, socks and clothing belts" in international class 25; and "hair bows, hair ornaments and hair bands" in international class 26. The registration states that first use and first use in commerce of the mark in conjunction with the goods in: class 9 commenced as of June 25, 1999; classes 14 and 26 commenced as of June 16, 1999; class 18 commenced as of December 3, 1998; and class 25 commenced as of July 20, 1998.

2) MUDD (stylized)

US registration 2,397,457; registered October 24, 2000

This mark was registered for use in connection with: "sunglasses" in international class 9; "costume jewelry, watches" in international class 14; "leather goods, namely, wallets, credit card cases, and business card cases; backpacks, tote bags, cosmetics cases sold empty" in international class 18; "shoes, hosiery, jackets, sweat suits, sweat pants, shorts, T-shirts, warm up suits, socks, clothing belts, jeans" in international class 25; and "hair bows, hair ornaments, hair pins and hair bands" in international class 26. The registration states that first use and first use in commerce of the mark in conjunction with the goods in: classes 9, 14 and 26 commenced as of April 30, 1999; class 18 commenced as of December 31, 1998; and class 25 commenced as of September 30, 1995.

3) MUDD (block letters)

US registration 1,992,148; registered August 6, 1996

This mark was registered for use in connection with "jeans, overalls, skirts, shirts, shorts, dresses" in international class 25. The registration states that first use and first use in commerce of the mark in conjunction with the goods in classes 25 commenced as of September 30, 1995.

The Complainant and Complainant's predecessor, Mudd, LLC (now known as PD&C), (both of which, for simplicity, will be collectively referred to below as the "Complainant" unless the context dictates otherwise) adopted the mark MUDD as early as September 1995. Since that date and continuing to the present, the Complainant has used the mark MUDD on and in connection with a variety of goods such as women's and girls' apparel, including jeans, pants, tops, skirts, shorts, jackets, sweaters, shoes, leather goods and accessories.

The Complainant states that, over the years, it has invested a substantial sum of money in advertising and establishing its MUDD Marks in the minds of customers as a branded source of high quality jeans, other apparel, accessories and related products. These products have been sold throughout the United States and the world. Consequently, the Complainant alleges that, through its continuous, extensive and prolonged use of the MUDD Marks, it has developed very substantial goodwill, value and recognition as a source identifier for high quality apparel, jewelry and leather goods.

On May 21, 2004, PD&C assigned all of its worldwide MUDD trademark registrations and the goodwill associated therewith to Mudd (USA), LLC. A copy of the master trademark assignment and the foreign trademark assignment appears in Exhibit D to the Complaint.

Inasmuch as the Respondent registered the contested domain name on September 7, 2005 which

is after the Complainant's first use date in the United States as well as the dates on which the Complainant's US and foreign registrations were granted, the Complainant contends that it has superior rights over the Respondent in the mark MUDD.

Furthermore, by virtue of the Complainant's prior worldwide trademark registrations, the Complainant also contends that the Respondent has constructive notice of the Complainant's trademark rights when the Respondent registered the contested domain name.

The Panel finds that the disputed domain name is formed of a generic term, specifically “suckers”, appended to the Complainant’s mark “MUDD” to form the term “MUDDSUCKERS” and with “.com” gTLD (generic top level domain) appended to that term, though the addition of any gTLD is completely ignored in assessing identity/similarity under paragraph 4(a)(i) of the Policy.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that minor variations, such as adding short letter or number groups or even generic words to a mark, are each insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. “Suckers” is certainly such a generic word. See, e.g., *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766 (September 12, 2005); *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531 (July 19, 2005); *Caesars Entertainment, Inc. v. Nova Internet Inc*, WIPO Case No. D2005-0411 (June 22, 2005); *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824 (January 18, 2005); *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836 (December 1, 2004) and *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491 (August 30, 2004). This result follows from a simple comparison of the disputed domain name against the Complainant’s marks.

Such confusion, should it occur, would undoubtedly cause Internet users intending to access the Complainant’s web site, but who were to reach the Respondent’s site resolvable through the disputed domain name, to think that an affiliation of some sort exists between the Complainant and the Respondent or its third-party transferee, when, in fact, no such relationship would exist at all. See, also, e.g., *Cheesecake Factory, Napster, Caesars Entertainment, Lockheed v. Skunkworx, and Lockheed v. Teramani, all cited supra; Register.com, Inc. v. Wolfgang Reile a/k/a RWG Internet et al*, FA208576 (National Arbitration Forum, January 27, 2004); *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services Corp. v. ESJ Nutritional Products*, FA 173362 (National Arbitration Forum, September 16, 2003); *American Family Life Assurance Company of Columbus v. defaultdata.com aka Brian Wick*, FA 123896 (National Arbitration Forum, October 14, 2002); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, WIPO Case No. D2002-0605 (September 11, 2002); *L.F.P., Inc. v. B and J Properties*, FA 109697 (National Arbitration Forum, May 30, 2002); *Peter Frampton v. Frampton Enterprises, Inc.*, WIPO Case No. D2002-0141 (April 17, 2002); *Spence-Chapin Services to Families and Children v. Stanley Wynman*, FA 100492 (National Arbitration Forum, December 10, 2001); *Meijer, Inc. v. Porksandwich Web Services*, FA 97186

(National Arbitration Forum, July 6, 2001); *MPL Communications, Limited et al v. IWebAddress.com*, FA 97092 (National Arbitration Forum, June 4, 2001); *American Home Products Corporation v. Ben Malgioglio*, WIPO Case No. D2000-1602 (February 19, 2001); *Surface Protection Industries, Inc. v. The Webposters a/k/a Mark's Paint Store, Inc.*, WIPO Case No. D2000-1613 (February 5, 2001); *Dollar Financial Group, Inc. v. VQM NET*, FA 96101 (National Arbitration Forum, January 25, 2001); *eBAY Inc. v. G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd.*, WIPO Case No. D2000-1463 (January 10, 2001); *Treeforms, Inc. v. Cayne Industrial Sales Corp.*, FA 95856 (National Arbitration Forum, December 18, 2000); See also *Pep Boys Manny, Moe and Jack of CA v. E-Commerce Today, Ltd.*, AF-0145 (eResolution, May 3, 2000).

Therefore, the Panel finds that the contested domain name sufficiently resembles the Complainant's MUDD Marks as to cause confusion; hence, the Complainant has shown sufficient similarity between that name and the Complainant's marks under paragraph 4(a)(i) of the Policy.

B. RIGHTS AND LEGITIMATE INTERESTS

The Complainant contends that the Respondent has no rights or legitimate interests in the contested domain name.

Specifically, the Complainant states that it has no relationship with Respondent and has never licensed or granted permission to Respondent to use the MUDD Marks or a domain name incorporating those marks or variations thereof. Moreover, the Complainant contends, that to the best of its knowledge, the Respondent has never been known by or operated a business under the mark MUDD or the contested domain name. Furthermore, the Complainant contends that the Respondent is not making a legitimate noncommercial or fair use of the domain name. In that regard, the Complainant contends that the Respondent's sole intent in using that name is to enhance its commercial gain by misleadingly diverting consumers and/or tarnishing Complainant's MUDD Marks.

Given the lack of any Response, not only does the Panel believe that the Respondent has not provided any basis that would legitimize any claim which the Respondent has to the contested domain name, but also the Panel infers that it is extremely unlikely that the Respondent could ever make such a claim.

The simple reason is that the disputed domain name contains the Complainant's mark "MUDD" under which the Complainant provides its goods and has continuously so provided those goods and services since 1995 – which is well prior, by some 10 years, to the date (September 7, 2005) on which the Respondent has registered the name. Moreover, the undisputed long-term recognition which the Complainant had apparently developed in its MUDD Marks during that 10 year period supports this Panel's view that the Respondent was very likely to have been well aware of the Complainant's goods and its marks prior to having registered the contested domain name – and in the absence of any Response it is quite reasonable for the Panel to infer such knowledge.

Furthermore, the Complainant has never authorized the Respondent to utilize any of the Complainant's MUDD Marks or any mark confusingly similar thereto in conjunction with the specific goods which the Complainant provides under its marks, nor does the Complainant have any relationship or association whatsoever with the Respondent.

Hence, any use to which the Respondent were to put the mark "MUDD" or one confusingly similar thereto, in connection with the goods provided by the Complainant or those similar thereto, would directly violate the exclusive trademark rights now residing in the Complainant. See, e.g., *Cheesecake Factory, Napster and Caesars Entertainment, cited supra*; *Pelmorex Communications Inc. v. weathernetwork*, WIPO Case No. D2004-0898 (December 18, 2004); *Sybase, Inc. v. Analytical Systems*, WIPO Case No. D2004-0360 (June 24, 2004); *Caesars World, Inc. and Park Place Entertainment Corporation v. Japan Nippon*, WIPO Case No. D2003-0615 (September 30, 2003); *Leiner Health Services Corp., AT&T Corp., and MPL Communications* FA 97086 and FA 97092, all cited *supra*; *Am. Online, Inc. v. Fu*, WIPO Case No. D2000-1374 (December 11, 2000); and *Treeforms, Inc.*, cited *supra*. Consequently, at least for those and similar goods, the Respondent could not legally acquire any public association between itself and the mark "MUDD" and hence could never be commonly known or recognized by that mark and thus could never fall within paragraph 4(c)(ii) of the Policy.

Thus, the Panel finds that the Respondent has no rights or legitimate interests in the contested domain name within paragraph 4(a)(ii) of the Policy.

C. BAD FAITH

The Complainant contends that the Respondent registered and is using the contested domain name in bad faith. Specifically, the Complainant contends that the Respondent appears to be using the name in connection with a website related to a religious organization. Given that, the Complainant alleges that the its customers and consumers of its products might be offended by use of the Complainant's mark MUDD by any religious organizations, thus tending to tarnish those marks and cause loss sales to the Complainant.

The Panel believes that the Respondent's actions constitute bad faith registration and use of the disputed domain name.

As discussed in the preceding section, the Panel infers that the Respondent was fully aware of the Complainant's mark "MUDD" when the Respondent registered the disputed domain name on September 7, 2005, and particularly the reputation which that mark had attained as a result of the Complainant's prior and continuing use starting some 10 years earlier.

Given that, this Panel also infers, again based on the lack of any Response, that the Respondent not only knew of the Complainant's prior and ongoing activities but also intentionally chose the contested domain name due to its inclusion of the Complainant's mark "MUDD" in order to trade off the Complainant's reputation or tarnish that reputation in some fashion, or divert Internet users away from the Complainant's web site to the Respondent's site -- all ultimately to the detriment of the Complainant.

Consequently, the Panel views the Respondent's actions as constituting bad faith registration and use in violation of paragraph 4(a)(iii) of the Policy.

CONCLUSION

In light of the findings above that: (a) the contested domain name is confusingly similar to the Complainant's MUDD Marks; (b) the Respondent does not have any rights or legitimate interests in the contested domain name; and (c) the Respondent registered and used that name in bad faith, the Panel concludes that the Complainant has provided sufficient proof of its allegations to establish a prima facie case under paragraph 4(a) of the Policy. Hence, the Panel finds in favor of the Complainant.

REMEDY

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel now grants the relief sought by the Complainant.

The contested domain name, MUDDSUCKERS.COM, is ordered transferred to the Complainant.

Peter L. Michaelson, Esq., Panelist

December 6, 2005