



NATIONAL ARBITRATION FORUM

DECISION

Safeguard Operations, LLC v. Safeguard Storage
Claim Number: FA0604000672431

PARTIES

Complainant is **Safeguard Operations, LLC** (“Complainant”), represented by **Stephen L. Sapp**, of **Locke Liddell & Sapp**, 2200 Ross Avenue, Suite 2200, Dallas, TX 75201. Respondent is **Safeguard Storage** (“Respondent”), represented by **Robert E. Robbins**, of **Robert E. Robbins, P.C.** 16930 Robbins Road, Suite 105, Grand Haven, MI 49417.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**safeguard-storage.com**>, registered with **Wild West Domains, 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.

Mr. Peter L. Michaelson, Esq. as Panelist.

PROCEDURAL HISTORY

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (“Policy”), available at <icann.org/services/udrp/udrppolicy24oct99.htm>, 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 (“Rules”) as approved on October 24, 1999, as supplemented by the National Arbitration Forum Supplemental Rules for Uniform Domain Name Dispute Resolution Policy then in effect (“Supplemental Rules”).

Complainant submitted a Complaint to the National Arbitration Forum electronically on April 6, 2006; the National Arbitration Forum received a hard copy of the Complaint on April 10, 2006, together with Exhibits A-J.

On April 7, 2006, Wild West Domains, Inc. confirmed by e-mail to the National Arbitration Forum that the <**safeguard-storage.com**> domain name is registered with Wild West Domains, Inc. and that Respondent is the current registrant of the name. Wild West Domains, Inc. has verified that Respondent is bound by the Wild West Domains,

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 April 14, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of May 4, 2006 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@safeguard-storage.com by e-mail.

A timely Response, with Exhibits 1-19, was received and determined to be complete on May 4, 2006.

Thereafter and pursuant to Supplemental Rule 7, Complainant timely filed an additional submission with the Forum on May 9, 2006. Subsequently, on May 15, 2006, Respondent timely filed its additional submission with the Forum.

On May 11, 2006, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Mr. Peter L. Michaelson, Esq. as Panelist and set a deadline of May 25, 2006 to receive the decision from the Panel.

In light of unexpected time conflicts experienced by the Panel -- which amounted to exceptional circumstances, the Forum, at the Panel's request, extended the deadline for the decision to June 5, 2006.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

1. Confusing similarity/identity

Complainant alleges that the disputed domain name, <**safeguard-storage.com**>, is confusingly similar to Complainant's SAFEGUARD Marks. Specifically, Complainant states that its mark "SAFEGUARD SELF STORAGE" and the disputed domain name only differ by a hyphen between the words "SAFEGUARD" and "STORAGE" and omits the descriptive term "SELF", these differences being insufficient to adequately distinguish the disputed domain name from that mark.

Complainant further alleges that, since the disputed domain name resolves to a "parked" web page that lists self-storage facility services and other related services, similar and in competition to those currently offered by Complainant, and also includes a link to Complainant's own website, the similarity of the disputed domain name to Complainant's mark actually accentuates, rather than ameliorates, confusion of Internet users who happen to visit the parked page inasmuch as those users would increasingly think that Respondent's website (and others so listed) is affiliated or related in some way with Complainant, when, in actuality, it is not. Consequently, the goodwill in Complainant's marks is being diluted and hence damaged.

Hence, Complainant concludes that it has met the requirements of paragraph 4(a)(i) of the Policy.

2. Rights and legitimate interests

Complainant contends that, for various reasons, Respondent has no rights or legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy.

First, Complainant contends that Respondent has not been using the disputed domain name in connection with a *bona fide* offering of goods or services. Rather, Respondent has been using the name to lead consumers to competing services by directing Complainant's consumers and potential consumers to a commercial website which is not affiliated with, nor otherwise sponsored or approved by Complainant, and which provides direct links to third-party websites offering services directly competitive with Complainant. This use does not constitute bona fide use of the name and moreover deceives Internet users and misappropriates the goodwill of Complainant's marks.

Second, Complainant contends that neither Respondent nor the commercial website to which the disputed name resolves has any affiliation to Complainant or is authorized to use any of Complainant's SAFEGUARD Marks.

Third, Complainant contends that Respondent can not demonstrate that it has been commonly known by the disputed domain name. Specifically, Complainant points to an April 6, 2006 printout of the WhoIs record for the disputed domain name (a copy of the printout appears in Exhibit H to the Complaint) which lists "Domains by Proxy, Inc." as the original listed registrant of that name. That owner is not related to the designation "SAFEGUARD-STORAGE" contained in the disputed name, and Complainant has found no evidence that Domains by Proxy, Inc. had ever done business using the mark "SAFEGUARD" or any variants thereof, prior to its registration of the name on January 26, 2005 -- that registration having been more than twelve (12) years after Complainant began using its SAFEGUARD Marks. Moreover, the fact that the registrant of the disputed domain name is presently listed by WhoIs records as Respondent, Safeguard Storage, does not rise to the level of being "commonly known" by that name. Furthermore, the name does not resolve to a legitimate "SAFEGUARD-STORAGE.COM"

website (as associated with Complainant), nor to a website offering products or services under Complainant's designation "SAFEGUARD" (other than with respect to Respondent's inclusion of a link, to Complainant's own website, on the third-party commercial website to which the name resolves).

Lastly, Complainant contends that Respondent cannot demonstrate a legitimate non-commercial or fair use of the disputed name. Instead, Respondent has used that name to direct consumers to a commercial website providing multiple links to third-party websites, which in turn, offer services directly competitive with the Safeguard Services. This is not a legitimate noncommercial use. Further, Complainant alleges that Respondent has made unfair use of the name by using it to deceptively direct consumers to ultimately third-party websites through which services are offered that compete with those offered by Complainant.

3. Bad faith use and registration

Complainant contends that, for various reasons, Respondent has registered and is using the disputed domain name in bad faith, hence in violation of paragraph 4(a)(iii) of the Policy

First, Complainant contends that Respondent registered and then used the name in spite of both its actual, or at least constructive, prior knowledge of Complainant's SAFEGUARD Marks and Complainant's prior 6-year use of its <safeguardit.com> domain name.

Second, Complainant states that, as evidenced by a hard-copy printout of the April 6, 2006 WhoIs record for the disputed domain name -- which appears in Exhibit H to the Complaint, Respondent failed to provide its true name and contact information when registering the name by using a domain name registration proxy service, i.e., Domains by Proxy, Inc., through which Respondent masked his true identity. Only after Complainant filed the Complaint on April 6, 2006, did the Registrar reveal Respondent as the true owner of the name. Hence, Complainant contends that Respondent exhibited bad faith by not registering the name under Respondent's own identity and hence providing misleading or false registration information.

Third, Complainant contends that Respondent is using the name to ultimately redirect, for Respondent's own economic benefit, Complainant's customers to a commercial third-party website that is not affiliated with Complainant and is doing so without authorization from Complainant, for the apparent purpose of competing with Complainant. In that regard, Complainant believes that Respondent is paid by businesses which directly benefit from Respondent's linkage of websites through an incentive affiliate program or the like, with payments being made to Respondent based on the number of "hits" to any one linked site.

B. Respondent

1. Confusing similarity/identity

Respondent counters by contending that the disputed domain name is not confusingly similar to Complainant's SAFEGUARD Marks.

Specifically, while the name has a hyphen between the terms "Safeguard" and "Storage" and does not contain the word "self" -- differences which Complainant believes are insufficient to adequately distinguish the name from Complainant's marks, Respondent states that "Web is full of domain names wherein the only distinguishing difference is the presence or absence of a hyphen" and no one is likely to be confused or misled by either the presence or absence of a hyphen.

Moreover, Respondent states that here there is not only no perceived or actual confusion but also no attempt by Respondent to mislead any Internet user. In support, Respondent points to the specific services which it and Complainant provide (or will provide in Respondent's case): public-use storage facilities. While the services are identical, the service markets are not coextensive and, in fact, are rather localized.

Those seeking such space do not look for self-storage space hundreds or thousands of miles away, but rather seek convenient, accessible and secure storage relatively close to their homes or businesses. What distinguishes and separates Complainant and Respondent from each other is that they operate in entirely different geographical areas, hundreds if not thousands of miles apart. They do not compete with one another. Neither party has any market share in the other's geographic areas of operation. Further, despite the allegation that Complainant has spent considerable sums of money to further its various marks, Complainant has done nothing to establish itself in a Michigan market -- which Respondent seeks to serve -- and, as a result nothing Respondent has done or failed to do has resulted in any adverse impact on Complainant's service market in Indiana.

2. Rights and legitimate interests

Contrary to Complainant's view, Respondent contends that, for several reasons, it has rights and legitimate interests in the disputed domain name.

First, Respondent contends that prior to receiving notice of this dispute, it has made demonstrable preparations to use the name in connection with its *bona fide* offering of self-storage services, hence satisfying paragraph 4(c)(ii) of the Policy.

Specifically, Respondent, having intended as early as June 2003 to develop and operate a self-storage facility and consequently designed a business plan to do so, then undertook a series of acts, as detailed in the Findings section below, to implement that plan into a working facility. This intention is specifically exhibited in the language of Respondent's

Buy and Sell Agreement (a copy of which appears in Exhibit 2 to the Response) to acquire a suitable property on which to situate its facility. Moreover, Respondent secured the rights, from various county and Michigan state departments, to use the name "Safeguard Storage" as an assumed name in Ottawa and Muskegon Counties and throughout the entire state of Michigan (copies of Respondent's county and state business name registrations appear in Exhibits 6, 7 and 8 to the Response). Further, after Respondent registered the disputed domain name, it placed classified advertising in various local telephone directories in anticipation of commencing its self-storage business and used that name in those advertisements (copies of the various advertisements and the corresponding invoices appear in Exhibits 11, 12 and 13 to the Response).

Respondent has taken and continues to pursue very real, legitimate and costly steps to realize its goal of developing and operating a storage facility. Because of effects presented by adverse soil compaction and other related site conditions as well as the action of third parties beyond its control, Respondent has had to delay the opening of its self-storage facility to the public.

Second, Respondent contends that, within its localized geographic market and as a result of its telephone directory advertising, it indeed has become commonly known by the term "Safeguard Storage", particularly since no other operator of self-storage facilities in that geographic market has a domain name remotely similar to that term.

Third, Respondent contends that it is making a legitimate noncommercial and fair use of the disputed domain name. Simply stated, Respondent believes that all its acts over several years show its active pursuit of a legitimate business plan to actually implement an operating self-storage facility with which, under the plan, the disputed domain name is to be used. While Respondent's own website, to which the name will resolve, is currently inactive and under construction, that site will soon be operational and was to have been operational during the summer of 2005 but for the delay experienced by Respondent in commencing its operations.

Respondent has never intended to mislead or divert consumers or to tarnish any of Complainant's marks. While both parties are involved in the storage facility business, the service offered by each is limited to a relatively small geographical radius beyond its respective storage facilities and both geographic markets are separated by hundreds, if not thousands, of miles. In that regard, Respondent's is limited to western Michigan, primarily in northern Ottawa County and southern Muskegon County with this area being approximately 120 miles north of the Michigan-Indiana border. Not only does Complainant not have an storage facilities in this area, it has no facilities in the entire State of Michigan or in any other mid-western state for that matter. Hence, no Internet user who is looking on the web for Complainant's facilities would be confused by Respondent or its inactive website, and will be directed to a "RegisterCheaper.com" site which indicates that Respondent's domain name page is parked and, in turn, directs the consumer to a list of other possibilities including Complainant's site at <safeguardit.com>.

(a copy of the corresponding RegisterCheaper.com web-page appears in Exhibit 16 to the Response, and also Exhibit G to the Complaint).

3. Bad faith use and registration

As best understood by the Panel, Respondent appears to predicate its overall arguments on the domain name not being confusingly similar to Complainant's SAFEGUARD Marks and on its having rights and legitimate interests in the name, but without raising any specific counter-arguments indicating that it did not exhibit bad faith in either registering the name or using it.

C. Additional Submissions

The Panel has fully considered the additional submissions filed by both parties. The principal arguments, as seen by the Panel, are as follows.

1. Complainant

Complainant notes that Respondent has failed to prove that the differences between the disputed name and Complainant's mark, specifically inclusion in the former of a hyphen and omission of the term "self", do not sufficiently distinguish the two.

Further, Complainant contends that, inasmuch as Respondent actually intended to attract Internet users, for commercial gain, from Complainant's website to Respondent's site by creating likely confusion between the disputed name and Complainant's SAFEGUARD Marks, then such use is not bona fide. As such, Respondent's preparations to use the domain name were not made in furtherance of, as required under paragraph 4(c)(i) of the Policy, a bona fide offering of services. In that regard, Complainant notes that Respondent admitted that through the name, Internet users are diverted to services competitive with those offered by Complainant and surmises that Respondent receives monetary income for doing so, and that Respondent intends to offer services identical to and hence competitive with those currently being offered by Complainant.

Regarding Respondent's argument of geographically limited markets, Complainant counters by arguing that regardless of its and Respondent's actual markets, Complainant's federal registrations have nationwide scope and hence provide Complainant with nationwide exclusivity.

Complainant further contends that the invoices which Respondent provided for its telephone directory advertisements show that these advertisements were published after the domain name was registered, thus evidencing that Respondent was not commonly known by the disputed domain name prior to the date on which it registered the name, thus failing to meet the requirements of paragraph 4(c)(ii) of the Policy.

Also, Complainant contends that Respondent's intended use of the disputed domain name is commercial, i.e., offering services competitive with those of Complainant, thus Respondent will not be putting the name to either a non-commercial or fair use.

As to bad faith registration and use, Complainant reiterates its view that Respondent committed bad faith in registering the disputed domain name in a manner that effectively cloaked Respondent's true name and contact information from the public.

2. Respondent

First, Respondent counters that since Complainant's registered marks contain not just text alone but also graphic design elements, then the inclusion of a hyphen into and the omission of the term "self" from the disputed domain name -- which is merely text and contains none of Complainant's graphical design elements, are sufficient to distinguish the name from those marks such that no confusion is likely to occur. Furthermore, Respondent points to Complainant's registrations themselves through which Complainant disclaimed any exclusive rights to the term "self storage" apart from the stylized marks themselves.

Second, Respondent contends that Complainant, in stating that Respondent has not made demonstrable preparations to use the name in connection with a *bona fide* service offering, has apparently ignored all the acts which Respondent has specifically undertaken (as described in the Findings section below) to develop an operational self-storage facility in Michigan.

Third, Respondent stated, contrary to Complainant's surmise, that it is not receiving and has never received, any revenue, click-through or otherwise, through use of the disputed domain name.

Fourth, Respondent states that although it registered the name on January 25, 2005, it commenced use of the term "Safeguard Storage" in the State of Michigan on February 25, 2004 -- which is approximately 11 months earlier. Hence, Respondent has become commonly known by that term in its trade territory prior to the date it registered the name.

Fifth, Respondent's use of the name in directing Internet users to a commercial website which provides links to third-party service providers, including Complainant, is a legitimate non-commercial use which does not misleadingly divert any of those users or tarnish Complainant's marks for the simple reasons that: (a) Respondent is not the party which directs any such user, rather it is the commercial web-site "RegisterCheaper.com"; (b) Respondent receives no revenue from any such direction; and (c) Complainant and Respondent do not compete with each other.

Lastly, Respondent contends that for various reasons, it did not register and use the disputed domain name in bad faith. Specifically, Respondent neither acquired nor registered its domain name for the purpose of selling, renting, or otherwise transferring the domain name registration to Complainant, rather Respondent's sole purpose in acquiring the name was for Respondent to use to establish a web presence for advertising and marketing its planned public storage facility. Respondent did not register the name to prevent Complainant from reflecting its mark in a domain name or engaged in a pattern of conduct to do so. Complainant never asserted Respondent had done so. Moreover, Respondent registered the disputed domain name at least nine months prior to the date Complainant acquired its domain name <safe-guard-storage.com>. Further, Respondent did not register the disputed domain name to disrupt Complainant's business. In that regard, Complainant does not operate its business, or offer any of its storage services, within the State of Michigan or any of the states immediately surrounding Michigan; as such, there is no evidence of any such disruption. Respondent has not intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with Complainant's marks. Also, Complainant's website fails to assist a potential Internet consumer in obtaining storage space in west Michigan -- Respondent's market area -- and, as a result, Complainant's potential customers are not being confused by Respondent's use of the name.

FINDINGS

A copy of the WhoIs registration record for the disputed domain name appears in Exhibit H to the Complaint. As indicated on these records, Respondent, through Domains by Proxy, Inc., registered the disputed domain name on January 26, 2005.

A. Complainant's SAFEGUARD Marks

Complainant owns four United States trademark registrations for its marks that incorporate the term SAFEGUARD, in conjunction with other terms and either in block letters or in a stylized pattern with a logo, and on which this dispute is based. Complainant has provided, in Exhibits A-D to the Complaint, a hard-copy printout of the registration certificate for each of these marks. Details of the registrations are as follows:

- a) THE SAFEGUARD GUARANTEE (stylized with logo)
United States registration 2,703,525; registered: April 8, 2003
filed: June 7, 2000
disclaimed portion: "GUARANTEE"

This mark was registered for use in connection with "providing secure self-storage facilities for lease to the public" in international class 39. The registration states that both first use and first use in commerce of this mark in conjunction with these services commenced as of May 31, 1997.

- b) SAFEGUARD SELF STORAGE (stylized with logo)

United States registration 2,703,524; registered: April 8, 2003
filed: June 7, 2000
disclaimed portion: "SELF STORAGE"

This mark was registered for use in connection with “providing secure self-storage facilities for lease to the public” in international class 39. The registration states that both first use and first use in commerce of this mark in conjunction with these services commenced as of January 31, 1992.

c) SAFEGUARD SELF STORAGE (block letters)
United States registration 2,701,658; registered: April 1, 2003
filed: March 20, 2000
disclaimed portion: "SELF STORAGE"

This mark was registered for use in connection with “providing secure self-storage facilities for lease to the public” in international class 39. The registration states that both first use and first use in commerce of this mark in conjunction with these services commenced as of January 31, 1992.

d) DON'T JUST STORE IT. SAFEGUARD IT! (block letters)
United States registration 2,482,089; registered: August 28, 2001
filed: June 7, 2000

This mark was registered for use in connection with “providing secure self-storage facilities for lease to the public” in international class 39. The registration states that both first use and first use in commerce of this mark in conjunction with these services commenced as of May 31, 1997.

Complainant also owns the domain names <safeguardit.com> and <safeguardselfstorage.com> through use of its corresponding websites, at which these names resolves, Complainant also promotes its services. Complainant also claims common law trademark rights in the term "SAFEGUARDIT.COM" and "SAFEGUARDSELFSTORAGE.COM", with its rights in the former commencing as of June 19, 1998 (the date it registered that name) and in the latter as of November 2005 (when Complainant acquired that name through settlement of a litigation). Complainant has provided samples of its use of these common law marks in Exhibits E and F to the Complaint.

B. Complainant

Complainant and its related companies provide, among other things, secure self storage facilities for public lease.

Complainant has extensively promoted its services using the SAFEGUARD Marks, has expended millions of dollars in advertising and promoting those marks, and has realized substantial revenues from sales of its services under those Marks.

The disputed domain name is being used to redirect Complainant's Internet customers to a commercial website which links to third-party websites that offer self storage services and related services that directly compete with those offered by Complainant. In addition, the site also contains a link to Complainant's site. However, neither Respondent nor that website has any affiliation with Complainant or is authorized by Complainant to use any of the SAFEGUARD Marks.

An April 6, 2006 printout of the WhoIs record for the disputed domain (a copy of that record appears in Exhibit H to the Complaint) shows that Respondent had registered the name through Domains by Proxy, Inc. with the latter, rather than the former, being listed as the registrant, hence cloaking Respondent's identity as the registrant. The Registrar provided Complainant with Respondent's true identity only after Complainant was filed. The name was registered more than 12 years after Complainant first started using its SAFEGUARD Marks.

C. Respondent

Respondent is a single-member Michigan limited liability company formed by Steven Kiekoover on February 7, 2003.

On June 20, 2003, Respondent entered into a Buy and Sell Agreement through which he (or a limited liability company then to be named later) agreed to pay \$ 226,400.00 to purchase 10.06 acres of vacant land on which Respondent' intended to develop and construct, among other things, a "store and lock" facility in Fruitport Township, Muskegon County, Michigan. Paragraph 27 of the Buy and Sell Agreement indicates that the Seller was aware of Respondent's desire to buy and use the property for that purpose as it recited, in pertinent part: "Seller's Approval of Site Plan not unreasonably withheld for Store and Lock Use." (Respondent has provided a copy of this agreement in Exhibit 2 to the Response). On September 16, 2003, the purchase closed with Respondent receiving a deed to the land as a result (a copy of that deed appears in Exhibit 4 to the Response).

Prior to the closing, Respondent retained engineering and planning services of Westshore Consulting, of 2534 Black Creek Road, Muskegon, Michigan 49444, to assist in design, planning, engineering and site improvement of the land as a storage facility. The professional services performed by Westshore Consulting resulted in a phased multi-year storage facility project as set forth in a proposed site plan which was ultimately approved by Fruitport Charter Township, Muskegon County, Michigan (a copy of the proposed site plan dated August 23, 2005 appears in Exhibit 5 to the Response).

Through a Certificate of Assumed Name issued by the Michigan Department of labor and Economic Growth, Respondent was authorized to transact business under the assumed name of "Safeguard Storage" on and after March 3, 2004 (a copy of that certificate appears in Exhibit 6 to the Response). Respondent commenced use of this assumed name some 11 months prior to the date on which it registered the disputed domain name. Respondent had no actual knowledge of either Complainant or its SAFEGUARD Marks when Respondent began using the business name and subsequently the disputed domain name.

On January 25, 2005, Respondent filed a Certificate of Assumed Name in the Office of the Muskegon County Clerk, Muskegon County, Michigan, indicating that he "now own, intend to own, conduct or transact business in the County of Muskegon, State of Michigan, under the name, designation or style" of "Safeguard Storage" (a copy of this certificate appears in Exhibit 7 to Complainant). On January 27, 2005, Respondent filed a Certified Business Registration for assumed name purposes in the Office of the Ottawa County Clerk, Ottawa County, Michigan, indicating that Respondent was the person "owning, conducting, transacting, or composing" a business to be operated under the name of "Safeguard Storage" (a copy of this registration appears in Exhibit 8 to the Response).

On May 23, 2005, Respondent and Trachte Building Systems, of Sun Prairie, Wisconsin, entered into Contract #27273 through which Respondent agreed to purchase storage facility building materials for a purchase price of \$58,562.88, to be used by Respondent's building contractors to construct a 30' wide by 300' long storage building containing a total of 35 individual storage areas (a copy of the corresponding purchase agreement appears in Exhibit 9 to the Complaint). Respondent paid Trachte \$ 17,900.00 in deposits toward the contract purchase price. Because of various adverse site conditions and delays incurred due to the action of third parties, Respondent has not yet taken possession of the building materials from Trachte.

Anticipating the commencement of its self-storage operations, Respondent also entered into agreements for annual advertising of its facility in various telephone books circulated in northern Ottawa County and southern Muskegon County, Michigan. Specifically, on March 11, 2005, Respondent contracted with Verizon SuperPages for classified advertising to appear in its June 2005 telephone directory and at a cost of \$299.50 per month (a copy of the Verizon purchase agreement and advertising proof appears in Exhibit 11 to Complainant). This Verizon advertising was renewed by Respondent for the June 2006 telephone directory and at a monthly cost of \$307.50 (a copy of that corresponding Verizon purchase agreement and advertising proof appears in Exhibit 12 to the Response).

On February 1, 2005, Respondent contracted with Yellow Book USA for classified advertising to appear in its June 2005 telephone directory and at a monthly cost of \$15.00 (a copy of this purchase agreement appears in Exhibit 13 to the Response).

Since acquiring the land on which Respondent intended to construct and operate its storage facility, Respondent has additionally expended over \$72,695.00 in fees, costs and expenses in the process of buying, developing and holding the land, purchasing building materials, and placing advertising for its intended purposes (a spreadsheet detailing this amount appears in Exhibit 14 to the Response).

Complainant has no self-storage sites in the State of Michigan or any other mid-western state. Respondent's market is limited to western Michigan, primarily in northern Ottawa County and southern Muskegon County, approximately 120 miles north of the Michigan-Indiana state border. As the geographic marketplaces for self-storage facilities are rather localized with the corresponding markets of both Complainant and Respondent separated by at least 100 miles, if not more, from each other, both Respondent and Complainant do not appear to compete with each other.

Though Respondent uses the disputed domain name to re-direct Internet users to a third-party website that contains links to both Complainant and to competitive service offerings by others, Respondent receives no income, such as click-through revenue or other fees, by virtue of that use.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that 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;
- (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.

Rights or Legitimate Interests

The Panel finds that Respondent has rights and legitimate interests to the disputed domain name under paragraph 4(c)(i), of the Policy.

Specifically, under this paragraph of the Policy, a respondent has rights and legitimate interests if before Respondent received any notice of the dispute, that respondent has made "demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services."

It is exceedingly clear to this Panel that Respondent's undisputed activities here, which are fully described above and collectively constitute a well-defined business plan that culminates in the operation of a self-storage facility, and included, as of the filing of the Complaint: the purchase of a suitable parcel of land for over \$ 226,000; retention of suitable engineering and planning professionals to develop an appropriate site plan; contracting with a materials provider to procure necessary building materials to construct the facility; filing for necessary business permits with local and state authorities; and purchase of suitable advertising -- for all the latter items Respondent incurred additional expenses of approximately \$ 73,000. Respondent also, at part of its activities, registered the disputed domain name under which it intended to develop an Internet presence and market its self-storage facility.

Respondent was well into executing its plan when the Complaint was filed on April 6, 2006. In fact, its actions started some three years earlier in February 7, 2003, when Respondent formed its limited liability company, and then increased in earnest when Respondent made a significant financial commitment shortly thereafter on June 20, 2003 and in furtherance of its plan when it entered into a \$ 226,000 buy/sell agreement to purchase its land.

The record is devoid of any evidence that rebuts Respondent's contention that it had no actual notice of this dispute prior to when it received notice of the Complaint, which occurred no earlier than April 14, 2006.

While Complainant would like the Panel to find that Respondent's actions in choosing the disputed domain name which included the term "SAFEGUARD", a formative common to all of Complainant's SAFEGUARD Marks, and the term "SAFEGUARD STORAGE", a formative portion of one of those marks, and its subsequent use of that name for re-direction, precludes Respondent's future service offering from being bona fide, the Panel will not do so. The simple reason is that the Panel must view Respondent's actions in their totality rather than myopically focus, as Complainant would rather have the Panel do, merely on similarities between the domain name and Complainant's marks and the use of that name.

When Respondent's actions are properly viewed, the Panel is not persuaded that, here Respondent's concerted efforts, including the considerable expense it incurred to date coupled with all the specific actions it has taken thus far, to transform its plan into an actual operating business to provide a public self-storage facility, the end result would be anything but a bona fide service offering. Consequently, Respondent's actions meet the requirement of paragraph 4(c)(i) of the Policy, hence evidencing Respondent's rights and legitimate interests in the disputed domain name.

Thus, Respondent has satisfied paragraph 4(c)(i) of the Policy.

All questions as to whether the disputed domain name sufficiently infringes on Complainant's SAFEGUARD Marks as to constitute trademark infringement and/or unfair competition -- which appear to underlie Complainant's allegations -- are well beyond this Panel's competence and its very limited jurisdiction under the Policy. Consequently, this Panel renders no opinion whatsoever on any of those questions and relegates all such questions, where they must be, to an appropriate judicial tribunal for their ultimate analysis and resolution.

Identical and/or Confusingly Similar; Registration and Use in Bad Faith

Given the Panel's findings that Respondent possesses rights and legitimate interests in the disputed domain name under paragraph 4(a)(ii) which is sufficient in and of itself to defeat Complainant's request for relief under paragraph 4(a) of the Policy, there is no need for the Panel to address any issue as to whether: (a) the domain name is identical or confusingly similar to the disputed domain name, or (b) whether Respondent both registered and used the name in bad faith. Thus, the Panel declines the opportunity to do so and hence will not opine on any of these issues.

Inasmuch as Complainant has failed to meet its burden under paragraph 4(a)(ii) of the Policy, therefore it has failed to establish a *prima facie* case for relief under paragraph 4(a).

DECISION

Consequently and in accordance with the elements of the ICANN Policy, the relief sought by Complainant is hereby **DENIED**.

Peter L. Michaelson, Esq., Panelist
Dated: June 5, 2006