



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**U.S. Fence, LLC v. U. S. Pool Fence**

**Case No. D2001-1397**

#### **1. The Parties**

Complainant is U.S. Fence LLC (“Complainant” or “US Fence”), a limited liability company of the State of Ohio and having its principal place of business in the State of Ohio, USA.

Respondent is U.S. Pool Fence (“Respondent” or “US Pool”) located at 7741 North 68<sup>th</sup> Avenue, Glendale, Arizona, USA.

#### **2. The Domain Name(s) and Registrar(s)**

The domain name at issue is <usfence.com> (the “Domain Name”). The registrar is Network Solutions, Inc. (the “Registrar”) located at 505 Huntmar Park Drive, Herndon, Virginia, 20170 USA.

#### **3. Procedural History**

On November 13, 2001, the WIPO Arbitration and Mediation Center (the “Center”) received a copy of the Complaint of Complainant via email. On November 14, 2001, the Center received hardcopy of the Complaint. On November 29, 2001, the Center sent an Acknowledgment of Receipt of Complaint to Complainant. The Complainant paid the required fee.

On December 10, 2001 after the Center sent a Request for Verification to the Registrar requesting verification of registration data, the Registrar confirmed, *inter alia*, that it is the registrar of the Domain Name.

The Center verified that the Complaint satisfies the formal requirements of the ICANN Uniform Domain Name Dispute Resolution Policy (the “Policy”), the Rules for

Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “WIPO Supplemental Rules”).

On December 18, 2001, the Center sent a Notification of Complaint and Commencement of Administrative Proceeding to the Respondent together with copies of the Complaint with Amendment, with a copy to the Complainant. This notification was sent by the methods required under paragraph 2(a) of the Rules.

On January 8, 2002, the Center received the Response of Respondent via email. On January 9, 2002, the Center received the Response of Respondent in hardcopy.

On March 13, 2002 after the Center received a completed and signed Statement of Acceptance and Declaration of Impartiality and Independence from each of the panelists, the Center notified the parties of the appointment of a three-member panel consisting of Peter L. Michaelson, Jeffrey M. Samuels, as panelists, and Richard W. Page as the Presiding Panelist.

On March 14, 2002, Complainant submitted as a Supplemental Filing, copies of public records (1) of its merger with Action Sales and Marketing, Inc., an Ohio corporation and (2) its notification to the United States Patent and Trademark Office of the merger. The Center notified the panelists of Complainant’s Supplemental Filing, which the panelist in their discretion have chosen to consider.

#### **4. Factual Background**

Complainant has been using the mark U.S. FENCE in connection with pressure treated wood deck specialties, namely, deck posts, balusters, rails, post tops and caps, lattices and stair parts, wood and vinyl lattices, melamine particle board, wood fencing and fence boards, and vinyl fencing since at least February 8, 1979. On November 16, 1999, Complainant was granted U.S. Trademark Registration No. 2,292,220 in class 19 on an application filed March 26, 1998.

Respondent registered the domain name <uspoolfence.com> on June 13, 1998. At the same time, Respondent registered the Domain Name <usfence.com> as a variation of its business name. Between approximately August 1998 and July 1999, both <uspoolfence.com> and <usfence.com> directed all traffic to Respondent’s website at <uspoolfence.com>. Respondent used the Domain Name in connection with its <uspoolfence.com> website for sales of its pool fencing service.

#### **5. Parties’ Contentions**

##### **A. Complainant’s contentions**

- i. Complainant contends that it has a registration of the trademark U.S. FENCE (the “Trademark”) with the United States Patent and Trademark Office.
- ii. Complainant argues that the Domain Name is identical with and confusingly similar to the Trademark, pursuant to Paragraph 4(a)(i) of the Policy.

- iii. Complainant contends that Respondent has no rights or legitimate interests in the Domain Name, pursuant to Paragraph 4(a)(ii), and that Respondent has failed to demonstrate any of the three circumstances that constitute rights to or legitimate interests in the Domain Name.

Respondent cannot demonstrate rights or legitimate interest in the Domain Name under Paragraph 4(c)(i) because it has not made use, or demonstrable preparations to use, the Domain Names in connection with the bona fide offering of goods or services.

Respondent cannot demonstrate rights or legitimate interests in the Domain Names under Paragraph 4(c)(ii), because Complainant has exclusive rights to use the Trademark in connection with the goods and services of fences and because Respondent also uses the domain name <uspoolfence.com>, which is sufficient for Respondent's uses.

- iv. Complainant contends that Respondent registered and is using the Domain Name in bad faith in violation of Paragraph 4(a)(iii).

Complainant further contends that the Respondent has not engaged in any meaningful use of the Domain Name, but has merely held it excluding Complainant's use.

Complainant has been contacted by Respondent and on at least one occasion offered to sell the subject domain name for a price in excess of Respondent's out-of-pocket expenses.

Complainant concludes that the totality of the above-mentioned circumstances surrounding the registration of the Domain Name by Respondent point to the existence of bad faith.

***B. Respondent's contentions***

- i. Respondent contests that the Complainant has a registration of the Trademark, because the trademark U.S. FENCE is owned by Action Sales and Marketing, Inc. and asserts that Complainant has provided no evidence showing that the Trademark has been assigned to Complainant.
- ii. Respondent does not contest that the Domain Name is identical with or confusingly similar to the Trademark.
- iii. Respondent asserts that it has rights to or legitimate interests in the Domain Name, because Respondent has been in the business of manufacturing and installing steel fences for swimming pools at least since 1991.

Respondent further asserts that before it received any notice of the dispute, there is evidence that Respondent's use of the Domain Name was in connection with a bona fide offering of goods or services. Respondent registered the similar domain name <uspoolfence.com> on June 13, 1998. At the same time, Respondent registered the Domain Name <usfence.com> as a variation of its business name. Between approximately August 1998 and July 1999, both <uspoolfence.com> and <usfence.com> directed all traffic to Respondent's website at <uspoolfence.com>.

Respondent further asserts that it used the Domain Name in connection with its <uspoolfence.com> website for sales of its pool fencing service. Sometime around July 1999, Respondent changed its internet service provider (“ISP”). The new ISP advised Respondent that it was not able to direct traffic from two domain names to one website and instead, required an additional twenty-five dollar (\$25) a month payment for upkeep of <www.uspoolfence.com> as one website and <www.usfence.com> as a second website. At the time, Respondent decided that it did not want to maintain a second separate website or pay an extra fee to do so. If a domain name holder used or prepared to use a domain name in connection with a bona fide offering of goods and services, the domain name holder is a legitimate claimant to the domain name. *See* 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 25:74.2 (2001).

- iv. Respondent denies that it registered or used the Domain Name in bad faith. Paragraph 4(b) suggests four types of evidence of bad faith registration, none of which apply.

Respondent specifically asserts that Complainant has not met its burden of proof on the issue of bad faith registration and use. Complainant has presented no evidence that the Domain Name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the Domain Name to Complainant, as the alleged owner of the Trademark or to a competitor of Complainant, for valuable consideration in excess of Respondent’s out-of-pocket costs directly related to the Domain Name.

Respondent further asserts that it registered the Domain Name without any knowledge that the Complainant existed. Respondent denies that Complainant “has been contacted by Respondent on at least one occasion offer[ing] to sell the subject domain name for a price in excess of Respondent’s out-of-pocket expenses.” Respondent responds that it has never approached Complainant to sell the domain name. To the contrary, on September 22, 1999, Complainant’s predecessor in interest sent a letter on September 22, 1999 to Respondent’s Scott Guthrie offering to purchase the Domain Name. Prior to receiving this letter, Respondent had never heard of Complainant or its predecessor in interest and was not aware that either entity had been selling products under the name “U.S. Fence”.

Respondent alleges that the evidence does not support Complainant’s contention that the Domain Name was registered for the purpose of preventing Complainant from reflecting the mark in a corresponding domain name or that, in connection therewith, Respondent has engaged in a pattern of such conduct.

Respondent further alleges that Complainant has presented no evidence showing that Complainant and Respondent are competitors and that the Domain Name was registered by Respondent primarily to disrupt Complainant’s business. To the contrary, in its September 22, 1999 letter, Complainant’s predecessor in interest admits that it is “in a completely different business” than Respondent, and thus the parties are not competitors. Respondent argues that in its September 22, 1999 letter, Complainant’s predecessor in interest admitted that Respondent’s

ownership of the Domain Name would not disrupt its business, and that it had “alternatives” if Respondent were unwilling to sell the domain name.

Respondent further alleges that Complainant has presented no evidence showing that the Domain Name was registered by Respondent in an intentional attempt to attract for commercial gain, Internet users to Respondent’s website or other on-line location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s web site or location or of a product or service on Respondent’s web site or location.

Respondent claims that there is no showing of bad faith based on Paragraph 4(b).

- v. Respondent assert the defense of laches because Complainant has been aware of Respondent’s registration and use of the Domain Name since at least September 22, 1999. Notwithstanding this fact, Complainant waited more than two years to file its Complaint. Respondent has already successfully used the Domain Name to direct customers to its website offering its pool fencing services. Thus, Complainant should be barred from filing this action.

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “A Panel shall 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.”

Because both the Complainant and Respondent are domiciled in the United States and United States courts have recent experience with similar disputes, to the extent that it would assist the Panel in determining whether the Complainant has met its burden as established by Paragraph 4(a) of the Policy, the Panel shall look to rules and principles of law set out in decisions of the courts of the United States. *Tribeca Film Center, Inc. v. Brusasco-Mackenzie*, WIPO Case No. D2000-1772, April 10, 2001), n. 3.

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

### **Enforceable Trademark Rights**

Respondent contests that the Complainant has a registration of the Trademark, because the trademark U.S. FENCE, is owned by Action Sales and Marketing, Inc. and Complainant has provided no evidence showing that the Trademark has been assigned to Complainant.

The Supplemental Filing of Complainant is sufficient to show the assignment of any relevant trademark rights in U.S. FENCE from Action Sales and Marketing, Inc. to the Complainant. Therefore, the Panel concludes that the Complainant has shown enforceable trademark rights for the purposes of this proceeding.

### **Identity or Confusing Similarity**

Complainant contends that the Domain Names are identical with or confusingly similar to the Trademark pursuant to the Policy paragraph 4(a)(i). Complainant notes that the Domain Name <usfence.com> identical to the Trademark, with the exception of the absence of space and periods, which are not allowed to exist in domain names.

Respondent has not contested the assertions by Complaint that the Domain Name is identical with or confusingly similar to the Trademark.

Therefore, the Panel finds that the Domain Name is identical with or confusingly similar to the Trademark pursuant to the Policy paragraph 4(a)(i).

### **Rights or Legitimate Interest**

Complainant contends that Respondent has no rights or legitimate interests in the Domain Name, pursuant to Paragraph 4(a)(ii), and that Respondent has failed to demonstrate any of the three circumstances that constitute rights to or legitimate interests in the Domain Name.

Paragraph 4(a)(ii) requires the Complainant to prove that the Respondent has no rights to or legitimate interests in the Domain Name. Once a Complainant establishes a *prima facie* showing that none of the three circumstances establishing legitimate interests or rights apply, the burden of production on this factor shifts to the Respondent to rebut the showing. The burden of proof, however, remains with Complainant to prove each of the three elements of Paragraph 4(a). *See Document Technologies, Inc. v. International Electronic Communications, Inc.*, WIPO Case No. D2000-0270, June 6, 2000.

The Policy paragraph 4(c) allows three nonexclusive methods for the Sole Panelist to conclude that Respondent has rights or a legitimate interest in the Domain Name:

- (i) before any notice to you [Respondent] of the dispute, your use of, or 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; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel finds that, regardless of the shifting of the burden of proof, Respondent has demonstrated by a preponderance of the evidence that prior to the dispute Respondent had used the Domain Name in connection with the *bona fide* offering of pool fencing materials. Therefore, Respondent has shown pursuant to the Policy, paragraph 4(c)(i) that it does have rights or a legitimate interest in the Domain Name.

Having made this showing, the Panel does not need to analyze Complainant's allegations of bad faith or Respondent's defense of laches.

## 7. Decision

The Panel concludes that the Domain Name <usfence.com> is identical with and confusingly similar to Complainant's registered trademark U.S. FENCE. However, Respondent has shown that it has rights and legitimate interest in the Domain Name. Therefore, the Panel denies Complainant's request that the Domain Name be transferred.

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Richard W. Page  
Presiding Panelist

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Peter L. Michaelson  
Panelist

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Jeffrey M. Samuels  
Panelist

Dated: April 13, 2002