

CPR INSTITUTE FOR DISPUTE RESOLUTION

File: CPR-06-08
Domain Name: mudd-ox.com
Registrar: Go Daddy Software, Inc.

COMPLAINANT

MUDD (USA), LLC
1407 Broadway, 29th Floor
Suite 2004
New York, NY 10018

v.

RESPONDENT

Domains by Proxy, Inc.
15111 N. Hayden Road, PMB 353
Suite 160
Scottsdale, AZ 85260

Administrative Panel: Lynda M. Braun, Esq.

PROCEDURAL HISTORY

The Complaint was filed with CPR Institute for Dispute Resolution (“CPR”) on February 27, 2006. In accordance with the Uniform Domain Name Dispute Resolution Policy (“UDRP Policy”) and paragraphs 2(a) and 4(a) of the Rules for the UDRP (the “Rules”) promulgated by the Internet Corporation for Assigned Names and Numbers, CPR formally notified the Respondent of the Complaint. In accordance with the Rules, paragraph 5(a), the due date for a response was March 22, 2006. The Respondent did not submit any response. Accordingly, CPR emailed the Respondent a letter of non-response on March 27, 2006, informing Respondent that a panel would be appointed pursuant to UDRP Rule 6(b) no later than March 27, 2006.

CPR appointed Lynda M. Braun as the sole panelist in this proceeding on March 27, 2006 (hereinafter referred to as the “Panel”). The Panel has accepted the appointment and submitted a declaration of impartiality and independence, as required by CPR and UDRP Rule 7.

Paragraph 5(e) of the Rules provides that if a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based on the Complaint. The Panel finds no exceptional circumstances here and will, therefore, decide the dispute based on the Complaint and exhibits attached thereto.

FACTUAL BACKGROUND

The Complainant is a limited liability company whose principal place of business is in New York City. Complainant has federal registrations for the trademark MUDD in numerous international classes and has used that trademark continuously in commerce since as early as September 1995 in the United States and elsewhere throughout the world. Moreover, Complainant has invested substantial sums of money in advertising and promoting its brand, for which it has acquired substantial good will and recognition as a source identifier for apparel, jewelry and leather goods. In addition to the sale of its products in brick and mortar establishments, Complainant also advertises and offers its products for sale through its web site at www.muddjeans.com.

DISCUSSION AND FINDINGS

To prevail in a UDRP proceeding, a complainant must prove each of the following three elements:

- the domain name at issue is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- the respondent has no rights or legitimate interest in respect of the domain name at issue; and
- the domain name at issue has been registered and is being used in bad faith.

Identical or Confusingly Similar

First, Complainant must prove that the Domain Name is identical or confusingly similar to Complainant's trademark. (UDRP Policy, paragraph 4(a)(i)).

The only differences between the disputed Domain Name and Complainant's MUDD mark lie in the addition of a hyphen and the word "ox" and the inclusion of the generic top-level domain ".com." It is generally accepted that the addition of ".com" in no way distinguishes a domain name which otherwise wholly incorporates another's trademark. *Pomellato S.p.A v. Richard Tonetti*, WIPO Case No. D2000-0493 (finding <pomellato.com> identical to Complainant's mark because the generic top-level domain (gTLD) ".com" after the name "Pomellato" is not relevant); *Oxygen Media, LLC v. Primary Source*, WIPO Case No. D2000-0362 (finding <oxygen.com> identical to Complainant's mark because the addition of .com after the name "OXYGEN" was not a distinguishing difference).

As for the appending of "ox" to the MUDD mark, it is well established that the addition of generic words to a mark does nothing to change an otherwise identical or confusingly similar domain name. *PRL USA Holdings, Inc. v. Unasi Management Inc.*, WIPO Case No. D2005-1027 (descriptive or generic additions

do not avoid confusing similarity of domain names and trademarks); *International Organization for Standardization ISO v. Quality Practitioners Institute and Website Pros, Inc. and Quality*, WIPO Case No. D2005-1028 (the addition of generic words to a mark to form a domain name is insufficient to dispel confusing similarity). As argued in its Complaint, the Complainant is no stranger to third parties appending a word to its trademark in an attempt to confuse the public, and these domain names were deemed confusingly similar to Complainant's mark. See *Mudd (USA), LLC v. Unasi, Inc.*, WIPO Case No. D2005-0591; *Mudd (USA), LLC v. Unasi, Inc.*, WIPO Case No. D2005-0727; *Mudd (USA), LLC v. Strickland Drilling Fluids*, CPR-05-22.

The Panel therefore concludes that the disputed Domain Name – mudd-ox.com—is confusingly similar to Complainant's MUDD mark.

Rights or Legitimate Interest

The Complainant is also required to prove that Respondent has no rights or legitimate interest in respect of the Domain Name. (UDRP Policy, paragraph 4(a)(ii)).

Once a complainant establishes that a respondent's domain name is identical or confusingly similar to complainant's mark, and that complainant has not authorized respondent to use the mark, the burden shifts to respondent to establish some right or legitimate interest in respect of the domain name. *Sony Kabushiki Kaisha v. Sony.net*, WIPO Case No. D2000-1074. In light of Respondent's default, the Panel presumes that Respondent has no such rights or legitimate interest.

The Respondent's default notwithstanding, there is no evidence in the record that Respondent is in any way associated with Complainant, that Respondent is now or was ever known by mudd-ox.com, or that Respondent has other authority or permission to use Complainant's mark. Furthermore, by not submitting a response, Respondent has failed to invoke any other circumstance that might demonstrate, pursuant to paragraph 4(c) of the UDRP Policy, that it holds some right or legitimate interest in the disputed Domain Name. *Ahead Software AG v. Leduc Jean*, WIPO Case No. D2004-0323; see also *Nintendo of America, Inc. v. Tasc, Inc. and Ken Lewis*, WIPO Case No. D2000-1563 (respondent's default alone sufficient to conclude that it had no rights or legitimate interest in the domain name).

Moreover, Respondent's use of the Domain Name to redirect unsuspecting internet users to click-through advertisements and sponsored links present on mudd-ox.com, including to those competing with Complainant, fails to constitute a bona fide commercial offering of goods and services under the contested Domain Name. Such use certainly does not constitute a legitimate non-commercial or fair use without any intent either for commercial gain, or to mislead or divert consumers or tarnish the trademark at issue. See *MSNBC Cable, LLC v. Tsysys.com*, WIPO Case No. D2000-1204.

As such, the Panel finds that the Respondent has no rights or legitimate interest in the disputed Domain Name. Accordingly, the Complainant has proven paragraph 4(a)(ii) of the UDRP Policy.

Registered and Used in Bad Faith

The Complainant must additionally establish that the disputed Domain Name has been registered and is being used in bad faith (UDRP Policy, paragraph 4(a)(iii)). Based on the record presented, the Panel concludes that Complainant has proffered sufficient evidence of bad faith.

First, the Respondent's knowledge of the Complainant's mark when the Respondent registered the Domain Name, as the record evidence demonstrates, supports a finding of registration in bad faith. As the undisputed evidence set forth in the Complaint shows that the Complainant owns numerous U.S. trademark registrations in various international classes, aside from multiple international trademark registrations in many countries around the world, the Panel infers that the Respondent was well aware of the Complainant's mark but chose, in spite of such knowledge, to register mudd-ox.com with the intent of causing consumer confusion and financially benefiting from the goodwill inherent in that well known mark. Such conduct is a demonstration of bad faith. *See J. Crew International, Inc. v. crew.com*, WIPO Case No. D2000-0054.

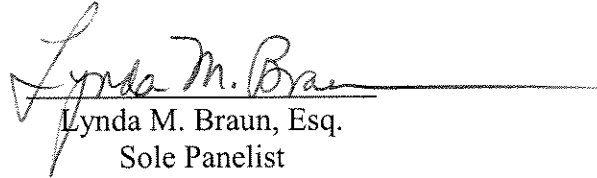
The Panel further infers the Respondent's bad faith intent from the Respondent's lack of response to the Complaint. *See Awesome Kids LLC and/or Awesome Kids L.L.C. v. Selavy Communications*, WIPO Case No. D2001-0210.

Perhaps the most blatant demonstration of Respondent's bad faith, however, is the fact that Respondent provides links on its web site to Complainant's competitors' web sites – other apparel manufacturers that market and sell the identical products as Complainant. Diverting traffic in this manner with the result that consumers searching for Complainant may land on a competitor's site inadvertently, but then decide to purchase from that manufacturer because it has taken an interest in the goods offered, is the epitome of bad faith. Indeed, the foregoing is known as initial interest confusion in U.S. trademark law and is actionable. *See Micro Electronics, Inc. v. J Lee*, WIPO Case No. D2005-0170 (*diversion of traffic evidence of bad faith*). Moreover, the diversion of traffic to another site trades on the goodwill of the trademark owner, creates a mistaken belief that the trademark owner condones the conduct or somehow is affiliated with the other site and/or gives the impression to consumers that the products from the site with the confusingly similar Domain Name are MUDD products or are otherwise associated with the Complainant. This, too, demonstrates bad faith.

Given the above facts and circumstances, the Panel finds that Respondent has registered and is using the Domain Name at issue in bad faith.

DECISION

For all the foregoing reasons, in accordance with paragraphs 4(i) of the UDRP Policy and 15 of the Rules, the Panel orders that the Domain Name mudd-ox.com be transferred to the Complainant.


Lynda M. Braun, Esq.
Sole Panelist

Date: April 7, 2006