

ADMINISTRATIVE PANEL DECISION

Witmer Public Safety Group, Inc. v. Gerald Hayden
Case No. D2023-4455

1. The Parties

Complainant is Witmer Public Safety Group, Inc., United States of America (“US”), represented by The Belles Group, P.C., US

Respondent is Gerald Hayden, US, represented by Sheppard, Mullin, Richter & Hampton, US.

2. The Domain Name and Registrar

The disputed domain name <usedfirestore.com> (the “Domain Name”) is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 26, 2023. On October 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 28, 2023, the Registrar 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 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on October 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 24, 2023. Respondent submitted the Response on November 21, 2023.

The Center appointed Christopher S. Gibson as the sole panelist in this matter on December 13, 2023. The Panel finds that it was properly constituted. 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. Factual Background

Complainant is a provider of on-line retail store services selling products that are targeted towards persons and entities operating in the firefighting and emergency rescue services space. Complainant operates its primary website at <thefirestore.com> since the year 2000, to promote its services and provide means for purchasing equipment, gear, tools, and related goods in the emergency services space. Complainant's domain name <thefirestore.com> was registered on August 12, 1999. Complainant is also the registered owner of the following two incontestable federal trademark registrations used in the fire equipment market. Each registration is for a figurative mark (with design elements):

- (1) THEFIRESTORE.COM, registration no. 3364210, registered Jan 8, 2008, with a date of first use in commerce of August 1999, in class 35 for “[r]etail store services featuring apparel used in connection with fighting fires and performing emergency rescue services, products and tools use in connection with fighting fires, and products and tools used in connection with performing emergency rescue services”. The mark is described as “an illustration drawing which includes word(s)/letter(s)/number(s)” and “[c]olor is not claimed as a feature of the mark”.



- (2) THEFIRESTORE, registration no. 4656646, registered Dec 16, 2014, with a date of first use in commerce of September 2012, in classes 25 and 35 for (i) “[o]n-line retail store services featuring apparel used in connection with fighting fires and performing emergency rescue services, products and tools for use in connection with fighting fires, and products and tools used in connection with performing emergency rescue services” and (ii) “[s]hirts for promoting a website featuring products and tools for fighting fires and performing emergency rescue services”. The mark is described as “consist[ing] of the wording ‘THEFIRESTORE’ in a stylized font alongside a flame design” and “[c]olor is not claimed as a feature of the mark”.



Respondent's Domain Name was registered on July 18, 2022. In February 2023, Respondent formed a limited liability company in Maryland under the name “Used Fire Store, LLC.” The Domain Name is linked to Respondent's website, which offers used fire equipment. Respondent appears to serve as a broker for used equipment, as its website states “Used Fire Store is not the owner of this equipment/apparatus” and “is not responsible for the condition of any brokered equipment/apparatus on our site.”

5. Parties' Contentions

A. Complainant

- (i) Identical or confusingly similar

Complainant states its Complaint is based on its longstanding and continuous use and registration of its well-known THEFIRESTORE trademarks, as a provider of on-line retail store services selling new and used products that are targeted towards, and used by, persons and entities operating in the firefighting and emergency rescue services space. Complainant emphasizes it is the registered owner of its THEFIRESTORE marks, in which Complainant enjoys substantial goodwill and valuable reputation, and the registration and use of these marks predates use by Respondent. Complainant submits UDRP panels have reached the consensus view that when a complainant owns a trademark, then it generally satisfies the

threshold requirement of having trademark rights. The location of the trademark, its date of registration (or first use), and the goods and/or services for which it is registered, are all irrelevant for the purpose of finding rights in a trademark under the first element of the UDRP.

(ii) Rights or legitimate interests

Complainant contends Respondent should be considered to have no rights or legitimate interests in the Domain Name. Complainant states that where there is no evidence it authorized or otherwise permitted Respondent to register the Domain Name, and Complainant's rights in its trademarks predate Respondent's registration of the Domain Name, it is a prima facie case that Respondent has no rights or legitimate interests in the Domain Name. Complainant asserts the burden then shifts to Respondent to provide evidence to rebut this presumption, and if Respondent fails to demonstrate rights or legitimate interests, Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Complainant states Respondent is not a licensee of or otherwise affiliated with Complainant. Complainant has never authorized or otherwise condoned or consented to Respondent's registration of the Domain Name. Complainant claims Respondent registered its confusingly similar Domain Name in July 2022, more than 20 years after Complainant began use of its <thefirestore.com> domain name. As such Complainant has clear priority over Respondent. Respondent's Domain Name is virtually identical to Complainant's marks, except that the article "the" in front of FIRESTORE, which has been replaced with the generic descriptor "used." Furthermore, Complainant asserts that, as is evident from Respondent's website, the infringing mark is used in a way that places the main emphasis on the terms FIRE and STORE, which are wholly subsumed in Complainant's marks. Respondent uses the generic term "used" in smaller font and at a ninety-degree angle to the left of the terms FIRE and STORE, which are stacked on top of each other. Complainant alleges this choice of presentation of the infringing terms is deliberate and further establishes Respondent's intent to freeride off of Complainant's goodwill that has been carefully nurtured for over two decades. Respondent's continued use of the Domain Name is therefore likely to cause consumer confusion in the marketplace.

Complainant contends Respondent is operating in the same space and targeting the same consumer base as Complainant and is using the Domain Name for Respondent's own illegitimate commercial gain. Both Complainant and Respondent operate websites offering services to provide firefighting equipment and related goods to consumers via online retail means. Respondent's use is not intended for legitimate noncommercial or fair use purposes. Respondent is only using the Domain Name to mislead and divert the public for commercial gain. Under these circumstances, Complainant states it has made a prima facie showing that Respondent does not any have rights or legitimate interests in the Domain Name.

(iii) Registered and used in bad faith

Complainant maintains that the Domain Name should be regarded as having been registered and used in bad faith by Respondent. As an initial matter, given the long use and fame of Complainant's THEFIRESTORE marks in the used fire equipment space, Respondent clearly knew or should have known of the marks at the time it registered and used the Domain Name. Such knowledge is sufficient to establish that the Domain Name was appropriated by Respondent in bad faith. The deliberate selection of a generic term that is placed in front of the term FIRESTORE is just the type of infringement against which this Policy was designed to safeguard.

Furthermore, Complainant explains that in an attempt to resolve this issue, Complainant's attorneys contacted Respondent to advise them of Complainant's ownership of the THEFIRESTORE marks and that consumers are likely to be confused by the continued and unauthorized use of the similar Domain Name. In response, a representative of Respondent informed Complainant's counsel in an email dated September 19, 2023 that they "will [not] be meeting [Complainant's] demands." Complainant states this response was further emphasized by Respondent's counsel who, in a subsequent communication and with erroneous interpretation of applicable trademark laws, asserted that no issue of likelihood of confusion exists. Complainant submits such blatant disregard for, and abuse of, Complainant's ownership rights in its

THEFIRESTORE marks and <thefirestore.com> domain name leaves Complainant no choice but to assert rights via the present Complaint.

Finally, Complainant states that the examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are intended to be illustrative, rather than an exclusive list of all circumstances from which such bad faith may be found. In light of the above, Complainant concludes Respondent is holding the Domain Name willfully, in bad faith, and in complete disregard of Complainant's exclusive rights to use its THEFIRESTORE marks.

B. Respondent

Respondent contends that Complainant has not satisfied the elements required under the Policy.

(i) Identical or confusingly similar

Respondent states that both of Complainant's trademarks are graphic marks containing the descriptive words THEFIRESTORE, but Complainant does not have rights to the words standing alone. Respondent cites two prior UDRP cases where there were findings of no confusing similarity because the complainants in those cases did not have word marks, but instead only figurative marks that included common words. Respondent urges that the same reasoning should apply here because Complainant's marks contain the descriptive terms, "the fire store".

Respondent points out that in a prior UDRP proceeding, *Witmer Public Safety Group, Inc. v. Domains by Proxy Inc. / JTRE LLC*, WIPO Case No. [D2010-2051](#), Complainant unsuccessfully tried to assert its trademark for THEFIRESTORE.COM, one of the two marks that it asserts against Respondent here. There, the respondent operated a website under domain names that consisted of the word "firestore" preceded by the names of numerous states, e.g., <ohiofirestore.com>, <alabamafirestore.com>, and <arizonafirestore.com>, among other similarly named domain names. The respondent sold firefighter products and provided consulting services, and taught services related to firefighting, first responders, and rescue services. According to Respondent, the panel found that "thefirestore" consisted of three common words that merely describe the items Complainant offers to consumers and Complainant failed to prove these words were associated with it. Specifically, the panel found, "Complainant provides no evidence of association of 'firestore' or 'the firestore' uniquely or primarily with Complainant, and the Panel's cursory investigation of the term indicates that 'firestore,' as one word or two, is commonly used by many other vendors of products to firefighters and for many other fields, particularly firearms." Similarly, here, Respondent argues Complainant has not provided any evidence that consumers associate 'firestore' or 'the firestore' exclusively with Complainant. Respondent emphasizes its Domain Name is not identical to Complainant's marks; instead, the Domain Name has the prefix "used" before "firestore" and does not contain the term "the." Respondent claims that because we are dealing with purely descriptive/generic terms, these differences are material.

Respondent further claims that Complainant's naked contention that its trademarks are "well-known" should be rejected because Complainant failed to submit any such evidence in support. The UDRP panel in the previous case involving Complainant similarly rejected Complainant's same contention against a third party because Complainant did not submit supporting evidence. WIPO Case No. [D2010-2051](#), *supra* ("Without proof the unsupported allegations of Complainant's counsel are of no moment in this proceeding and there is nothing in the record before the Panel that would allow the Panel to make an inference to this effect."). Respondent urges that this Panel should come to the same conclusion and give no weight to its unsupported contentions that its marks are well-known.

In any case, Respondent states it is not necessary for the Panel to determine whether the Domain Name is confusingly similar to the Complainant's marks because, as shown below, Complainant cannot meet its burden in showing the existence of bad faith and the absence of legitimate interests.

(ii) Rights or legitimate interests

Respondent contends that while Complainant registered its marks before Respondent registered the Domain Name, that alone is not evidence of bad faith. Here, Respondent is running a legitimate business in a bona fide manner. In February 2023, Respondent formed a limited liability company under a business name that is nearly identical to the Domain Name, Used Fire Store, LLC. Respondent formed its company long before it received notice of this dispute, and its company has made actual sales since then. Respondent states that in Complainant's prior UDRP case, the panel denied the complaint after finding, in part, that "Respondent's business exists independently of the disputed domain names," and urges that the Panel should make the same finding here. WIPO Case No. [D2010-2051](#), *supra*.

Respondent maintains it registered the Domain Name without intent to trade on Complainant's goodwill, and without intent to misleadingly divert Complainant's consumers. Respondent's website does not copy the look and feel of Complainant's site and does not copy the design of Complainant's marks. In Complainant's prior UDRP case, the Panel considered these very facts to conclude that Respondent engaged in its own legitimate business. The panel denied the complaint after finding, in part, that Respondent's website did not "ape Complainant's in look and feel, layout, or general impression, and there is no other indication of copying or playing off of Complainant's mark." WIPO Case No. [D2010-2051](#), *supra*.

Respondent also contends that the parties offer different goods and services. While Complainant states it sells "new and used" products for firefighting and emergency equipment, there is no evidence on Complainant's website that it sells used products. Respondent claims none of the items that Complainant offers are advertised as "used", and Complainant has not offered any evidence to the contrary. In fact, it is evident from Complainant's website that it only offers new items. On the other hand, Respondent only lists used equipment and advertises itself as a broker to connect sellers and buyers, unlike Complainant who sells directly to consumers at retail. Respondent sells large ticket items such as used engines, used trucks, and used hydraulics. Complainant sells small ticket items, mainly personal protective equipment ("PPE") such as new gloves, helmets, and boots and advertises that it sells "everything but the truck" on its website. Respondent does not sell any PPE equipment. In fact, Respondent is effectively prevented from selling used PPE due to the safety standards under the National Fire Protection Agency, which do not permit the resale of PPE after 10 years of use. Thus, although the parties operate in a similar industry, they do not compete. In Complainant's prior UDRP dispute, the panel denied the complaint even though it found that the parties' goods and services slightly overlapped.

While Complainant contends that Respondent registered its Domain Name to trade on the goodwill of Complainant's marks, Respondent argues this is wholly unsubstantiated. Both of the marks claim and/or display flames as a prominent feature of the design marks. Respondent's mark does not have any flame designs and instead has an image of a badge with the words "fire" and "ems" on it. The parties' marks also have different connotations because Respondent only brokers "used" fire and emergency equipment. Besides use of the generic terms "fire" and "store," the parties' marks and their corresponding uses are sufficiently distinct and simply do not support the notion that Respondent adopted its mark to trade on Complainant's goodwill.

(iii) Registered and used in bad faith

Respondent claims Complainant cannot establish that Respondent registered the Domain Name in bad faith because Respondent is not targeting Complainant or its products or attempting to take advantage of Complainant's marks. First, Complainant has not submitted any evidence that Respondent knew or should have known of Complainant or its marks. Further, Respondent states Complainant has produced zero evidence as to the size of its business, number of customers, financial results, marketing expenses, or the like, and accordingly there is no evidence before the Panel to enable it to infer Respondent knew of Complainant when starting its business.

Moreover, Respondent argues that even assuming Respondent was aware of Complainant's marks, that does not mean that Respondent could not otherwise fairly adopt its Domain Name, which is comprised

strictly of generic and descriptive terms. Although the word elements of Complainant's marks are comprised of strictly generic/descriptive terms, this by no means grants Complainant a monopoly to those terms. Complainant cannot prevent others from fairly using some of those terms in connection with their own legitimate business, which is the case here.

Here, Respondent claims it adopted the Domain Name solely because that is the nature of Respondent's business – it brokers used fire equipment. Thus, Respondent adopted the Domain Name because it clearly communicated to consumers the nature of Respondent's business. Finding bad faith in this context would effectively grant Complainant a monopoly to otherwise generic and descriptive terms, which contradicts well-established trademark principles.

Second, Respondent did not register the Domain Name for the purpose of selling, renting, or otherwise transferring the domain name registration(s) to the Complainant for valuable consideration in excess of the Respondent's out-of-pocket costs directly related to the Domain Name. Such evidence is missing from the Complaint, and Respondent has never offered to sell the Domain Name to Complainant. Here, Respondent merely uses it fairly and in connection with its own legitimate business.

Finally, Respondent submits the fact Respondent responded to Complainant's cease-and-desist letter is not credible evidence of bad faith intent. Respondent set up its business prior to receiving Complainant's letter. Moreover, in its response, Respondent noted its good faith belief that it is not infringing on Complainant's design marks. Respondent has not copied any design elements from Complainant's marks, nor has Respondent copied verbatim the word elements of Complainant's marks. Respondent urges Complainant does not have a complete monopoly to the generic/descriptive terms "fire" and "store," particularly when those words are used fairly by Respondent in connection with its own legitimate business. In fact, in Complainant's prior UDRP case, the Panel came to a similar conclusion – the panel stated it could not "grasp how Respondent's registration of multiple domain names, each prefaced by the name of or initials for a state, itself demonstrates bad faith use of 'firestore' or the 'fire' and 'store' because the respondent used those words to describe its legitimate business." WIPO Case No. [D2010-2051](#), *supra*. The panel denied Complainant's prior UDRP complaint, stating that "[e]ven if the Panel were to infer from the fact that to some extent Respondent competes with Complainant, or the fact that Respondent's employees are all firefighters, that Respondent was aware of Complainant, there is no basis at all for an inference of targeting." *Id.* The panel further stated that it is just as likely respondent chose the disputed domain names as descriptive of its own goods and services as to take advantage of the complainant's mark, which was not enough for the complainant to meet its burden under the Policy. This Panel should make a similar finding here and deny the Complaint.

6. Discussion and Findings

In order to succeed on its Complaint, Complainant must demonstrate that the three elements set forth in paragraph 4(a) of the Policy have been satisfied. These elements are that:

- (i) the Domain Name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) Respondent has registered and is using the Domain Name in bad faith.

A. Identical or Confusingly Similar

The Panel finds that Complainant has demonstrated rights in its THEFIRESTORE trademarks for purposes of the Policy through registration and longstanding use of its marks. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.2.1 ("Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case.").

Moreover, the Panel determines that the Domain Name is confusingly similar to Complainant's marks. [WIPO Overview 3.0](#), section 1.7 ("This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name."). The replacement of the word "the" in Complainant's marks with the word "used" in the Domain Name is not enough to prevent confusing similarity, given the commonality of the dominant other words "fire store" in Complainant's marks and the Domain Name.

Respondent has referenced two prior UDRP cases that involved figurative marks to contend there is no confusing similarity. [WIPO Overview 3.0](#), section 1.10, provides guidance addressing the question, "[h]ow are trademark registrations with design elements or disclaimed text treated in assessing identity or confusing similarity?" Section 1.10 states in relevant part that "[p]anel assessment of identity or confusing similarity involves comparing the (alpha-numeric) domain name and the textual components of the relevant mark. To the extent that design (or figurative/ stylized) elements would be incapable of representation in domain names, these elements are largely disregarded for purposes of assessing identity or confusing similarity under the first element." Further, "where design elements comprise the dominant portion of the relevant mark such that they effectively overtake the textual elements in prominence, or where the trademark registration entirely disclaims the textual elements (i.e., the scope of protection afforded to the mark is effectively limited to its stylized elements), panels may find that the complainant's trademark registration is insufficient by itself to support standing under the UDRP." Here, the Panel finds that the design elements of Complainant's THEFIRESTORE marks do not comprise the dominant portion of the marks such that they effectively overtake the textual elements in prominence. Instead, the three words that appear in Complainant's marks – "the", "fire" and "store" – are clearly visible and comprise an integral feature of the marks, dominant over any design elements. Moreover, Complainant has only disclaimed "color" as not being a feature of the marks. Therefore, comparing the textual elements of Complainant's marks with the Domain Name is appropriate for the confusing similarity analysis in this case.

At the same time, [WIPO Overview 3.0](#), section 1.10, adds that "[t]o the extent the complainant could nevertheless establish UDRP standing on the basis of a mark with design elements, the existence of such [design] elements (or a disclaimer) would be relevant to the panel's assessment of the second and third elements, e.g., in considering possible legitimate trademark co-existence or scenarios where the textual elements correspond to a dictionary term." Here, where Complainant's two trademark registrations correspond to figurative marks (and not word marks), it is appropriate to consider the existence of the design elements in the analysis of the second and third elements of the Policy, discussed below.

Accordingly, the Panel finds that the Domain Name is confusingly similar to a trademark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests / Registered and Used in Bad Faith

In certain cases, panels have found that the facts and circumstances of the case may benefit from a joint discussion of the second and third elements of the Policy. See [WIPO Overview 3.0](#), section 2.15. The Panel finds that this is one of those cases because any finding concerning the second element is inextricably intertwined with a finding as to the third element.

Concerning rights or legitimate interests, although the overall burden of proof is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests. [WIPO Overview 3.0](#), section 2.1.

Here, the Panel determines that Complainant has initially made out a prima facie case. Complainant confirms that Respondent is not a licensee of or otherwise affiliated with Complainant, and Complainant did not authorize or otherwise consent to Respondent's registration of the Domain Name. Respondent registered the Domain Name in July 2022, more than 20 years after Complainant began use of its own

<thefirestore.com> domain name, and more than 14 years after Complainant registered its first THEFIRESTORE trademark in 2008, and approximately 10 years after it registered its second mark in 2012. It is undisputed that Respondent's use is not intended for noncommercial or fair use purposes. Instead, Respondent operates a commercial website offering used firefighting and related equipment. Moreover, Respondent's site arguably competes (or has the potential to compete), at least indirectly, with Complainant's business and website offering new firefighting equipment (and based on a review of Complainant's website, the Panel found no evidence that Complainant offers used equipment, nor did Complainant offer any evidence that it did). Moreover, although Respondent states it only sells "large ticket" items such as used engines, used trucks, and used hydraulics, a review of Respondent's site shows that it purports to offer (or broker) at least some "small ticket" items, such as gloves, helmets, hand tools, and handlights, similar to the new equipment offered by Complainant. Thus, the businesses appear to compete to a degree in the firefighting and related equipment market by giving customers a choice between Complainant's new equipment offerings or the used equipment listed and brokered on Respondent's website. Finally, Complainant alleges Respondent is taking advantage of the goodwill and reputation in its marks, using the Domain Name to mislead and divert consumers for commercial gain, and under these circumstances Respondent does not have any rights or legitimate interests in the Domain Name.

In response, Respondent has provided evidence that before any notice of this dispute, Respondent formed a company in Maryland named Used Fire Store, LLC in February 2023, and began using the Domain Name in July 2023 in connection with a bona fide offering of goods or services. See Policy, para. 4(c)(i). A review of Respondent's website (and Respondent's submission of an invoice to demonstrate that it has made at least one sale) supports the view that Respondent is operating a legitimate business. And Respondent has emphasized that its website does not copy the look and feel of Complainant's site, nor does Respondent's logo design (see below) copy the design of Complainant's marks:



Normally, "[p]anels tend to assess claimed respondent rights or legitimate interests in the present, i.e., with a view to the circumstances prevailing at the time of the filing of the complaint." [WIPO Overview 3.0](#), section 2.11. With this timing in mind, it would appear that Respondent is operating a legitimate business and has provided evidence representing an important step towards demonstrating rights or legitimate interests in the Domain Name. However, this is not the end of the analysis, as the focus must turn to the third element of the Policy, because Respondent's use of the Domain Name cannot be considered to be in connection with a bona fide offering of goods or services (in accordance with the Policy, para. 4(c)(i)), if the Domain Name, as alleged by Complainant, was registered while targeting Complainant's mark and used to attract, for commercial gain, Internet users by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation. See Policy, para. 4(b)(iv).

Paragraph 4(a)(iii) of the Policy provides that Complainant must establish that Respondent has registered and used the Domain Name in bad faith. [WIPO Overview 3.0](#), section 3.1, states, "bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark". This case presents a close call.

The first question is whether Respondent registered the Domain Name in bad faith. Complainant alleges that it has substantial goodwill and valuable reputation in its THEFIRESTORE marks, and given the longstanding use and fame of Complainant's marks in the used fire equipment space, Respondent clearly knew or should have known of the marks at the time it registered and used the Domain Name, and such knowledge is sufficient to establish the Domain Name was registered in bad faith. Respondent responds, however, that Complainant's naked contention that its trademarks are "well-known" should be rejected because Complainant has failed to submit any evidence in support, such as the size of its business, number of customers, financial results, and marketing expenses, and there is no evidence before the Panel to enable it to infer Respondent knew of Complainant when starting its business.

The Panel makes three observations on these points. First, the Panel observes that Complainant's began using its <thefirestore.com> domain name in 2000, and subsequently registered its figurative THEFIRESTORE marks in 2008 and 2012, many years before Respondent registered the Domain Name in July 2022, established its company name in February 2023, and began operations in July 2023. By comparison, the previous UDRP case cited by Respondent, in which Complainant unsuccessfully challenged a third-party's domain name registration, was decided in 2010, just two years after Complainant had registered its first trademark and 13 years before Complainant brought its Complaint in this case. The length of time Complainant has used its trademarks and domain name prior to Respondent's registration of the Domain Name makes the circumstances in this case substantially different from the prior case. See *Witmer Public Safety Group, Inc. v. Domains by Proxy Inc. / JTRE LLC*, WIPO Case No. [D2010-2051](#) ("No evidence in the record indicates *that in March 2010* Respondent knew of Complainant or its marks.") (italics added).

Second, as to Respondent's contention that Complainant has failed to submit any evidence to support the goodwill and reputation in its marks, the Panel agrees that Complainant's submission is lacking in this important respect. However, the Panel cannot ignore that both parties have put into evidence Complainant's website, where it offers firefighting equipment and related goods to consumers via on-line retail. See e.g., [WIPO Overview 3.0](#), section 4.10 ("panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision"). A perusal of Complainant's site shows that it not only operates online, but also has three locations (including its headquarters) in Pennsylvania, as well as showrooms or sales operations in New York, Virginia and Maryland. The Panel also observes that Respondent is located in Maryland. Given Complainant's longstanding online and offline operations in the niche firefighting equipment market (and Respondent's presence in that market as well), and the proximate location of the two parties in the mid-Atlantic region of the United States, the Panel disagrees with Respondent's claim that "there is no evidence before the Panel to enable it to infer the Respondent knew of the Complainant when starting its business." Again, the evidence before the Panel in this case is distinguishable from the prior case involving Complainant, where the panel found that "as for a basis for the Panel to infer actual knowledge, there is only the statement in the Amended Complaint that '[Complainant's] trademark is very well known and it is extremely unlikely that the Respondent would not have been aware of this fact.'" WIPO Case No. [D2010-2051](#), *supra*.

Third, Respondent, although presented with the opportunity to specifically deny that it was aware of Complainant and its marks (e.g., by filing an affidavit with its Response), did not do so. Instead, Respondent stated that "even assuming that Respondent was aware of Complainant's marks, that does not mean that Respondent could not otherwise fairly adopt its domain, which is comprised strictly of generic and descriptive terms."

The Panel recognizes that Complainant has the burden of proof to demonstrate registration and use in bad faith. The Panel determines that on the basis of all of the evidence in the record, it is more likely than not that Respondent was aware of Complainant and its THEFIRESTORE trademarks when registering the Domain Name. However, given the nature of Complainant's trademark registrations as figurative marks (as compared to word marks), the noteworthy lack of evidence (beyond what can be inferred from Complainant's website) about the strength of Complainant's marks (and lack of any related demonstrated harm or actual confusion), and the descriptive terms used in both the textual elements of Complainant's figurative trademarks and the Domain Name, the Panel is unable to find that Respondent targeted Complainant's marks in bad faith when registering the Domain Name. As noted under the analysis of the first element, "the existence of such [design] elements (or a disclaimer) would be relevant to the panel's assessment of the second and third elements, e.g., in considering possible legitimate trademark co-existence or scenarios where the textual elements correspond to a dictionary term." [WIPO Overview 3.0](#), section 1.10. Moreover, the Panel's conclusion is further supported by the facts that Respondent's logo design, as well as the layout and look and feel of Respondent's website, do not appear to copy or target Complainant, its trademarks and website, nor is there any other indication of attempts to take advantage of Complainant or its marks. This last point serves to support Respondent's contention that the Domain Name has not be used with the intent to attract and confuse Internet users as to source or affiliation of Respondent's business. See WIPO Case No. [D2010-2051](#), *supra*.

As observed by the panel in the prior case brought by Complainant, “things may turn out differently in an infringement action, in which the substantive law may differ and each party will have the opportunity to develop a complete record through discovery and confrontation.” WIPO Case No. [D2010-2051](#), *supra*.

Therefore, the Panel makes no comment on the likelihood of success of an infringement action under United States law. However, in this case, the Panel concludes that, on the basis of the entire record, Complainant has not carried its burden of proving Respondent’s bad faith as required by the Policy.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Christopher S. Gibson/

Christopher S. Gibson

Sole Panelist

Date: March 3, 2023