

ADMINISTRATIVE PANEL DECISION

Benjamin Franklin Franchising SPE LLC v. Steve Slobodzian
Case No. D2023-0983

1. The Parties

The Complainant is Benjamin Franklin Franchising SPE LLC, United States of America (“United States”), represented by Faegre Drinker Biddle & Reath, United States.

The Respondent is Steve Slobodzian, Canada.

2. The Domain Name and Registrar

The disputed domain name <benfranklinplumbingatlanta.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 6, 2023. On March 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 7, 2023, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint (Privacy service provided by Withheld for Privacy ehf). The Center sent an email communication to the Complainant on March 13, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on March 17, 2023.

The Center verified that the Complaint, together with the amended 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 the Respondent of the Complaint, and the proceedings commenced on March 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 9, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 12, 2023.

The Center appointed Mihaela Maravela as the sole panelist in this matter on April 21, 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

According to information in the Complaint, the Complainant is a subsidiary of Authority Brands, Inc., a premier home service franchisor in North America that provides a network of more than 1,000 franchise owners across the United States and Canada with elite marketing, advanced technology, and operational support. The Complainant has over 260 independently owned and operated locations across the United States, including four locations in Georgia with two in Atlanta. The Complainant offers residential and commercial plumbing services.

The Complainant has registered various trademarks consisting of or including BENJAMIN FRANKLIN PLUMBING or BENJAMIN FRANKLIN or BEN FRANKLIN, such as the United States trademark registration for BENJAMIN FRANKLIN PLUMBING (word), registered under No. 5,785,500 as of June 25, 2019, or the United States trademark registration for THE BEN FRANKLIN SOCIETY (word), registered under No. 4,300,192 as of March 12, 2013. The Complainant has registered the domain name <benjaminfranklinplumbing.com> since April 2000.

The disputed domain name was registered on October 9, 2021, and does not currently resolve to an active website. According to un rebutted evidence in the Complaint, the disputed domain name was used to resolve to a website with the look and feel of an older version of the Complainant's website, and later redirected to a website offering competing services to those of the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant argues that the relevant portion of the disputed domain name, namely "Ben Franklin Plumbing", is virtually identical to the Complainant's BENJAMIN FRANKLIN trademarks, as it incorporates the dominant features of the registered BENJAMIN FRANKLIN trademark and shortens "Benjamin" to the common nickname "Ben". The addition of a geographical term in the disputed domain name does not prevent confusion. The Complainant further argues that the fact that the disputed domain name incorporates "Atlanta" increases the confusion as the Complainant offers its plumbing services in Atlanta, Georgia.

With respect to the second element, the Complainant argues that the Respondent is not an authorized franchisee of the Complainant; rather, the Respondent redirects Internet users to its own website that offers competitive plumbing services in the overlapping region of Atlanta, Georgia. Further, there is no evidence that the Respondent has become commonly known by the disputed domain name.

As regards the third element, the Complainant argues that its trademarks are well-known, and therefore, it is highly likely that the Respondent knew of the Complainant's trademarks at the time of registering the confusingly similar disputed domain name. The Complainant contends that under such circumstances, the Respondent registered the disputed domain name to attract Internet users to the Respondent's website for commercial gain by creating confusion with the Complainant's trademarks. The Respondent intentionally composed the website at the disputed domain name to mirror an old version of the Complainant's website to mislead and defraud Internet users looking for the Complainant. The Complainant sent a cease-and-desist letter to the Respondent, but no response was received. Thereafter, the website at the disputed domain name was taken down, but now redirects to the Respondent's own website which offers competitive plumbing services.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

No response has been received from the Respondent in this case. Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules. The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", and the Panel can draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

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

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

A. Identical or Confusingly Similar

The Complainant has provided evidence of its rights in the BENJAMIN FRANKLIN PLUMBING or THE BEN FRANKLIN SOCIETY trademarks. The BENJAMIN FRANKLIN PLUMBING trademark is reproduced almost in its entirety in the disputed domain name. The shortening of "Benjamin" to the common nickname "Ben", also used in other trademarks of the Complainant, as well as the addition of the geographical term "atlanta" does not prevent a finding of confusing similarity with the Complainant's trademarks. It is well accepted by UDRP panels that a generic Top-level-Domain ("gTLD"), such as ".com", is typically ignored when assessing whether a domain name is identical or confusing similar to a trademark. See section 1.11.1 of the [WIPO Overview 3.0](#).

This Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademarks and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* case demonstrating that the Respondent has no rights or legitimate interests in the disputed domain name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

In the present case, the Complainant has established that it holds rights over the BENJAMIN FRANKLIN PLUMBING or THE BEN FRANKLIN SOCIETY trademarks and claims that the Respondent has no legitimate reason to acquire and use the disputed domain name. There is no evidence that the Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services, nor does the Respondent appear to engage in any legitimate noncommercial or fair use of the disputed domain name. Rather, the disputed domain name was used to resolve to an active website which was a "copycat" of the Complainant's older website. The website displayed the BENJAMIN FRANKLIN trademark and logo and provided no disclaimer as to any lack of authorization from or affiliation with the Complainant. At a certain time, the disputed domain name has redirected to a third-party website offering competing services to those of the Complainant. These cannot amount in the Panel's view to a *bona fide* offering of goods or services

within the meaning of paragraphs 4(c)(i) of the Policy or to a legitimate noncommercial or fair use of the disputed domain name as provided by article 4(c)(iii) of the Policy. Also, there is no evidence that the Respondent is commonly known by the disputed domain name within the meaning of paragraph 4(c)(ii) of the Policy.

Furthermore, the nature of the disputed domain name, comprising the dominant part of the Complainant's trademark and the geographical term "atlanta" where the Complainant operates its activity, indicates an awareness of the Complainant and its mark and intent to take unfair advantage of such, which does not support a finding of any rights or legitimate interests.

The Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has failed to bring evidence to the contrary.

With the evidence on file, the Panel finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith.

The disputed domain name was registered many years after the Complainant has obtained registration of its trademarks. The disputed domain name is confusingly similar with the Complainant's trademark. The Panel also notes that the disputed domain name is similar to the Complainant's domain name <benjaminfranklinplumbing.com>. Moreover, the BENJAMIN FRANKLIN trademark of the Complainant was displayed on the website at the disputed domain name where the Respondent copied the look and feel of the Complainant's older website. Under these circumstances, there can be little doubt that the Respondent was aware of the Complainant's trademarks and targeted these at the time of registration of the disputed domain name.

As regards the use of the disputed domain name, the Panel finds that, according to the unrebutted evidence submitted by the Complainant, the disputed domain name resolved to a copycat version of the Complainant's older website, displaying the BENJAMIN FRANKLIN trademark and logo of the Complainant and, later, redirected to a third-party website offering competing services to those of the Complainant. This amounts to use in bad faith under the terms of paragraph 4(b)(iv) of the Policy. Furthermore, the Respondent has not replied to the Complainant's contentions and used a privacy service when registering the disputed domain name. These circumstances are further indications of bad faith. The fact that currently the disputed domain name does not resolve does not preclude a finding of bad faith in the circumstances of the case.

Based on the evidence and circumstances of this case, the Panel concludes that the requirement of paragraph 4(a)(iii) of the Policy is satisfied.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <benfranklinplumbingatlanta.com> be transferred to the Complainant.

/Mihaela Maravela/

Mihaela Maravela

Sole Panelist

Date: May 5, 2023