

## **ADMINISTRATIVE PANEL DECISION**

Sonobond Ultrasonics, Inc. v. Mitch Gordon  
Case No. D2024-0823

### **1. The Parties**

Complainant is Sonobond Ultrasonics, Inc., United States of America (“United States”), represented by Indel Services LLC, United States.

Respondent is Mitch Gordon, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <sonobond.com> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 23, 2024. On February 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 26, 2024, 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 February 29, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 20, 2024. The Response was filed with the Center on March 1, 2024.

On May 20, 2024, the Panel issued Procedural Order No. 1 to the parties seeking additional information, and stating in relevant part:

“Having reviewed the file in the above-referenced case, pursuant to paragraphs 10 and 12 of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), the Panel issues the following order and invites the Parties to provide additional information on the following two points:

(i) Prior to registering the disputed domain name, did Respondent seek any permission from Complainant, or otherwise have any communications with Complainant, concerning the registration of the disputed domain name;

(ii) Noting that Respondent has stated that he had previously spoken to the Complainant's legal team a few times over the years and that he had made changes to his website based on those discussions, after the disputed domain name was registered, did the Parties (or their legal representatives) communicate regarding Respondent's use of the disputed domain name and, if so, what was communicated."

Both parties responded promptly and their replies were forwarded by the Center to the Panel on May 21, 2024.

The Center appointed Christopher S. Gibson as the sole panelist in this matter on April 2, 2024. 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 has offered goods under the SONOBOND trademark since 1954 across a variety of industry sectors. Complainant has provided evidence that it is the owner of the following trademark registration:

- SONOBOND, United States Patent and Trademark Office ("USPTO") registration number 781,392 in class 34, dated December 8, 1964, with a date of first use in commerce of June 30, 1954, for ultrasonic welding equipment and generators for ultrasonic equipment.

The mark was initially registered under the name of Sonobond Corporation, but Sonobond Corporation became Sonobond Ultrasonics, Inc. on February 18, 1982, and the ownership records for the mark were updated.

The Domain Name was registered on October 26, 2005. Complainant states it is not aware of any communication with Respondent prior to registration of the Domain Name where Respondent sought permission to register and use it. Complainant states it only became aware of the Domain Name's registration in May 2017 when a Whois database search was performed after a third party brought the redirection to Complainant's attention.

The Domain Name redirects to the website of Nawon USA, Inc., a company that repairs Sonobond equipment (among others) using parts and equipment from competing suppliers. The parties both acknowledge that Respondent was a former distributor for Complainant's equipment, but that the relationship was terminated in November 2005.

The Domain Name's redirected website states on its home page:

"NAWON USA IS NO LONGER A SONOBOND® (SONOBOND ULTRASONICS, INC.) DEALER. AS A FORMER DEALER,

NAWON USA CAN REPAIR YOUR SONOBOND® MACHINERY AND SUPPLY COMPATIBLE SPARE PARTS AND PATTERN ROLLERS (NOT SUPPLIED BY SONOBOND®)"

The website also provides the following:

"Please note: We're not a SONOBOND® dealer nor are we affiliated with them in any way. We are a machinery supplier with high quality compatible parts for SONOBOND® brand machines. Please see disclaimer below."

The disclaimer provides:

“NAWON USA is not affiliated with SONOBOND, we are an independent repair and parts facility.

\*To the extent NAWON USA uses trademarks, service marks, tradenames, or other identifying information of other companies, NAWON USA is making use of those Trademarks for identification or is making use by permission. The owner of the Trademarks has not consented to further use or copying of the trademarks and NAWON USA cannot license such. Sonobond, Lacemaster, Seam master, SM86, LM920, RINGMASTER and any words prefixed by the word SONOBOND or SONOBOND's trademarks which all belong to SONOBOND. Chicago Pneumatic, JUKI, Brother, Mitsubishi, Efka, PFAFF, FRAMIS ITALIA, ARMDEL, Etc. are all trademarks of their respectful owners. This is not necessarily a full list of trademark notifications we must make, if you feel we have missed one, please contact us at 800-[REDACTED] to have it added.”

## **5. Parties' Contentions**

### **A. Complainant**

Complainant contends that it has satisfied each of the elements required under the Policy for transfer of the Domain Name.

#### **(i) Identical or confusingly similar**

Complainant states it has prominently and extensively used, promoted, and advertised the SONOBOND mark for approximately 70 years. By virtue of these efforts, the mark has become well recognized by consumers as designating Complainant as the source of the goods so marked. Accordingly, the mark is extremely valuable to Complainant.

Complainant further submits that the Domain Name is identical to the SONOBOND mark in which Complainant has superior rights because the Domain Name is a complete and exact reproduction of Complainant's SONOBOND mark.

#### **(ii) Rights or legitimate interests**

Complainant states that Respondent registered the Domain Name on October 26, 2005, long after Complainant registered the SONOBOND mark with the USPTO and began using the mark in commerce. Complainant states that Respondent did not seek permission or communicate with Complainant prior to registering the Domain Name. Respondent is not a licensee of Complainant nor is Respondent otherwise authorized to use Complainant's SONOBOND mark for any purpose. Respondent is a direct competitor of Complainant for ultrasonic products, parts, and services. Complainant states Respondent was briefly an authorized distributor of SONOBOND goods; however, Complainant terminated this relationship on November 30, 2005, based on Respondent's earlier violation of the terms of their agreement. Complainant asserts that Respondent is not commonly known by the Domain Name, and upon information and belief operates as Nawon USA, Inc. Therefore, Respondent has not established rights or legitimate interests in the Domain Name.

The Domain Name currently redirects to Respondent's website at “[www.nawonusa.net/SONOBOND.html](http://www.nawonusa.net/SONOBOND.html)”. On this page, Respondent offers for sale replacement parts compatible with products offered under the SONOBOND mark “without paying OEM prices.” Such conduct serves the purpose of generating revenues from sales of goods directly competing with Complainant's goods. For these reasons, Complainant urges it is very probable that an Internet user might be misled to Respondent's webpage in searching for Complainant's webpage, diverting potential customers on the strength of Complainant's SONOBOND mark.

Complainant contends Respondent is using the Domain Name identical to Complainant's mark to redirect Internet users to Respondent's own site offering goods and services directly competing with Complainant's

goods and services for commercial gain. Complainant states UDRP panels have consistently held that such use is not a bona fide offering of goods or services or a legitimate noncommercial or fair use. Furthermore, Complainant explains that while Respondent was briefly an authorized distributor of Complainant's goods, Respondent's authorization was revoked upon violation of the underlying representation agreement on November 30, 2005. Complainant states that as panels tend to assess a respondent's rights or legitimate interests at the time of the complaint, and any prior relationship between the parties was terminated well before the present Complaint was filed in this case, Respondent lacks rights or legitimate interests in the Domain Name. Additionally, Complainant asserts that prior UDRP panels have found that when the disputed domain name is identical to the complainant's mark, as in this case, the respondent lacks rights or legitimate interests in the domain name due to a risk of implied affiliation with the owner of the trademark.

Complainant concludes there is no legitimate basis for Respondent's registration and use of the Domain Name, which is identical to Complainant's SONOBOND mark.

### **(iii) Registered and used in bad faith**

Complainant refers to paragraph 4(b) of the Policy with its four non-exhaustive examples of circumstances showing registration and use in bad faith. In particular, Complainant refers to paragraphs 4(b)(iii) and (iv) and asserts that a complainant may establish the registration and use of a domain name was in bad faith by showing that by using the domain name, the respondent attempted to intentionally attract for commercial gain Internet users to its website by creating a likelihood of confusion with the complainant's marks as the source of the website or of a product or service on the site. In addition, Complainant claims it may independently demonstrate bad faith in accordance with general notion of bad faith under paragraph 4(a)(iii), because the overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant seeks to profit from or exploit the trademark of another.

Complainant contends that, upon information and belief, Respondent registered and is using the Domain Name primarily to profit from and exploit Complainant's SONOBOND mark by misdirecting Internet users to Respondent's website. The Domain Name redirects users to a landing page on Respondent's site offering for sale competing replacement parts compatible with products offered under the SONOBOND mark. Respondent's diversionary use of Complainant's SONOBOND mark to redirect Internet users to its own site offering competing goods and services constitutes bad faith registration and use of the Domain Name under Policy Paragraph 4(b)(iv).

Furthermore, Complainant asserts that the very nature of Respondent's registration and use of the Domain Name evidences bad faith. As Respondent is a former authorized distributor of Complainant's goods, Respondent was keenly aware of Complainant's SONOBOND mark prior to the registration of the Domain Name. In response to the Panel's inquiry in Procedural Order No. 1 as to whether Respondent sought any permission from Complainant prior to registering the Domain Name, Complainant states that it is unaware of any communication with Respondent prior to the registration, and that Complainant only became aware of the Domain Name in May 2017. As such, Complainant contends Respondent knowingly registered the Domain Name containing an exact reproduction of the well-known SONOBOND mark to capitalize on consumer recognition in the mark.

Moreover, in response to the Panel's inquiry concerning whether, after the Domain Name was registered, the Parties (or their legal representatives) communicated regarding Respondent's use of the Domain Name, Complainant has provided evidence to indicate that the messages it sent to Respondent in 2014 referenced various alleged copyright and trademark violations on Respondent's website that required corrective action. However, the same evidence indicates that, at that time, Respondent's website was linked to the following domain names, <nawonusa.net> and <sonobondultrasonics.com>, and not to the Domain Name challenged in this case. Consistent with Complainant's statement that it only became aware of Respondent's use of the Domain Name in 2017, Complainant's letter of June 2017 for the first time refers to the Domain Name, alleged trademark violations, and demands that Respondent voluntarily transfer the Domain Name to Complainant.

Further, while Respondent's website now disclaims any affiliation with Complainant, Complainant asserts UDRP panels have found that redirecting the domain name to a different respondent-owned site, even where the site contains a disclaimer, supports a finding that the respondent has registered a domain name to attract, for commercial gain, Internet users to its site by creating a likelihood of confusion with complainant's mark. Furthermore, only in cases where the respondent appears to otherwise have a right or legitimate interest in a disputed domain name can a clear and sufficiently prominent disclaimer lend support to circumstances suggesting good faith. Because Respondent has no right or legitimate interest in the Domain Name in this case, no disclaimer is sufficient to overcome the presumption of bad faith.

Complainant concludes that these bad faith allegations, combined with Respondent's lack of rights or legitimate interest in the Domain Name, should lead the Panel to conclude there is no plausible circumstance in which Respondent could legitimately register or use the Domain Name and that, therefore, the Domain Name was registered and is being used by Respondent in bad faith.

## **B. Respondent**

Respondent has provided a short Response, indicating he is not a lawyer. In his defense, Respondent claims he previously spoke to Complainant's legal team a few times over the years and that he had made changes to his website based on those discussions. Respondent contends that he was an agent for Complainant, not for a brief period, but for approximately six years. During that time Respondent's company, NAWON USA, was and still is known as the welding machine dealer that sold and serviced all kinds of welding and seam sealing equipment.

Respondent states he is not breaking any laws and is not representing his company as being associated with Complainant; instead, his company is able to repair Sonobond equipment with generic parts, just like any auto parts company selling generic parts for name brand cars. Respondent states that the webpage linked to the Domain Name does not try to steer customers to any other page or machinery; it just lets them know that Respondent can repair the machinery and supply spare parts, which are readily available from a Taiwan manufacturer and clearly marked on all relevant equipment.

Respondent contends there are multiple other domain names on the Internet linked to sites selling service for Sonobond equipment that have never been affiliated with Complainant. Respondent explains that upon conducting an Internet search for "Sonobond repair" or "Sonobond," Respondent's website does not even appear near the top of the page, and most people have never even seen Respondent's page.

Respondent claims he sent the following note to Complainant's legal counsel "a while back":

"You and I went over this a couple of years ago and you agreed that since I was an Authorized Sonobond dealer at one time, I am 100% in the right to use the name I did as long as I did not represent my company as a Sonobond dealer. The website CLEARLY states we are no longer a dealer. Phillip and I also came to the agreement that as long as I used the Registered Trademark symbol for Sonobond and put a disclaimer there we are ok."

In response to the Panel's question on Procedural Order No. 1 whether, prior to registering the Domain Name, did Respondent seek any permission from Complainant, Respondent states in relevant part "I was under the impression that it was legal for me to use since I was not trying to mislead anyone, just trying to continue servicing machinery that I was an agent of theirs for 6 to 8 years if memory serves me right."

In response to the Panel's second question whether, after the Domain Name was registered, did the Parties (or their legal representatives) communicate regarding Respondent's use of the Domain Name, Respondent contends that he "had been contacted by [Complainant's] legal team years after the domain was live and after a few Modifications Mr. Post had agreed that we are in compliance with the law." Respondent states he added the requested registered trademark symbols along with clear disclaimer language.

Respondent refers to the language on the website linked to his Domain Name:

“Please note: We’re not a SONOBOND® dealer nor are we affiliated with them in any way. We are a machinery supplier with high quality compatible parts for SONOBOND® brand machines. Please see disclaimer below.”

Respondent states he has done everything possible to inform customers, and he asks if they are too stupid to see the difference when they arrive at Respondent’s site, how is that his fault? Further, if Complainant had wanted the Domain Name, Complainant should have registered it when it was available.

Respondent contends that the Policy does not prohibit a registrant’s fair use of a domain name or any uses protected by the First Amendment. The most common successful defense is that the registrant did not have a bad faith intent to register the domain name in order to sell it to the mark owner for a profit and had some other reason to register it. In light of this, Respondent argues that he is not trying to sell the Domain Name nor squatting on the Domain Name, and he is not trying to disparage Complainant. Further, Respondent claims that because he did sell Sonobond goods at one point prior to Complainant cancelling the parties’ contract through no fault of Respondent, Respondent is entitled to use the Domain name. Respondent states he is just trying to make a living as a discarded Sonobond dealer.

With that said, Respondent contends that this case should be considered closed unless there is a legitimate reason why Respondent cannot use the Sonobond name. Respondent also asserts that there are domain names such as “www.chevyparts.com” that are not affiliated with the Chevy brand, and lists several other examples. Respondent claims his own name is being squatted by someone that took the domain name <nawonusa.com> and has no legitimate use but to sell it.

## **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**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between Complainant’s trademark and the Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ([“WIPO Overview 3.0”](#)), section 1.7.

Here, Complainant has shown it has rights in respect of a trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Moreover, the entirety of the mark is reproduced within the Domain Name with no variation. Accordingly, the Domain Name is identical to Complainant’s SONOBOND mark for purposes of the Policy.

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

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which Respondent may demonstrate rights or legitimate interests in a Domain Name. Regarding the second element of the Policy, section 2.1 of the

[WIPO Overview 3.0](#), states, “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 in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element”.

Here, the Panel determines that Complainant has made out a *prima facie* case, while Respondent has failed to rebut adequately Complainant’s contentions. The Panel finds that Complainant has not authorized Respondent to use Complainant’s SONOBOND trademark for any purpose; that Complainant did not provide permission to Respondent to register the Domain Name; that Respondent is not commonly known by the Domain Name or the name “Sonobond”; that Respondent has not used the Domain Name for a legitimate noncommercial or fair use, nor used it in connection with a bona fide offering of goods or services. Instead, the Domain Name effectively impersonates or suggests sponsorship or endorsement by Complainant, by reproducing the entirety of Complainant’s mark in the Domain Name with no variation. See [WIPO Overview 3.0](#), section 2.5.1 (“Generally speaking, UDRP panels have found that domain names identical to a complainant’s trademark carry a high risk of implied affiliation.”). Further, as acknowledged by Respondent, the Domain Name redirects to Respondent’s website, where Respondent offers competing ultrasonic products, parts, and repair services for commercial gain. See [WIPO Overview 3.0](#), section 2.5.3 (“a respondent’s use of a complainant’s mark to redirect users (e.g., to a competing site) would not support a claim to rights or legitimate interests”). While both parties acknowledge that Respondent was once a distributor of Complainant’s products in 2005, “[p]anel 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.” See e.g., [WIPO Overview 3.0](#), section 2.11. Moreover, the evidence in this case suggests that Complainant was unaware of Respondent’s registration of the Domain Name until sometime in 2017, when Complainant first contacted Respondent to object to its registration and use of the Domain Name. Prior to that, Complainant’s 2014 communications (through legal counsel) to Respondent were focused on allegedly infringing content on Respondent’s website, which at the time appears to have been linked to the following domain names, <nawonusa.net> and <sonobondultrasonics.com>, and not to the Domain Name.

Having reviewed the available record, the Panel finds Complainant has established a *prima facie* case that Respondent lacks rights or legitimate interests in the Domain Name, and Respondent has not adequately rebutted Complainant’s *prima facie* showing. Accordingly, the Panel finds the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

The third element of paragraph 4(a) of the Policy requires that Complainant demonstrate that Respondent registered and is using 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”.

Here, the Panel determines that the Domain Name was registered and is being used in bad faith. Although Respondent states he was at one time a distributor of Complainant’s products, the evidence indicates that the commercial relationship between the parties terminated almost 20 years ago. As a former distributor of Complainant’s goods, Respondent was aware of Complainant and its SONOBOND mark and intentionally targeted the mark when registering the identical Domain Name, without Complainant’s permission or consent. Indeed, the Panel finds that the Parties’ responses to Procedural Order No. 1 confirm that Respondent did not seek permission from Complainant prior to registering the Domain Name in 2005, and that Complainant was not aware of this registration until years later in 2017 at a time when the Domain Name had begun to be used by Respondent. Further, as acknowledged by Respondent, the Domain Name redirects to Respondent’s own website, where Respondent offers competing ultrasonic products, parts, and repair services for commercial gain.

The Panel determines that Respondent has intentionally attempted to attract, for commercial gain, Internet users to his site by creating a likelihood of confusion with Complainant’s mark. Factors that support this

conclusion include the nature of the Domain Name itself, which is identical to Complainant's distinctive SONOBOND mark; the lack of Respondent's own rights to or legitimate interests in the Domain Name, particularly as Respondent conducts business under a completely different name, Nawon USA, and has no relationship to Complainant; linking the Domain Name to Respondent's own website, where competing goods and services are offered; and the absence of any conceivable good faith use of the Domain Name by Respondent.

Respondent has emphasized that he has a disclaimer on its website; however, only in cases where the respondent appears to otherwise have a right or legitimate interest in a disputed domain name can a disclaimer lend support to circumstances suggesting good faith. See [WIPO Overview 3.0](#), section 3.7. However here, "where the overall circumstances of a case point to the respondent's bad faith", and where Respondent has no rights or legitimate interests in the Domain Name, "the mere existence of a disclaimer cannot cure such bad faith." *Id.* Respondent is not precluded from providing repair services for Complainant's SONOBOND branded products; however, what Respondent cannot do is use Complainant's SONOBOND mark in an identical Domain Name to provide commercially competing goods and services.

In conclusion, the Panel determines that, for all of the above reasons, the Domain Name was registered and is being used in bad faith. Accordingly, Complainant has satisfied the third element of the Policy.

## **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 Domain Name, <sonobond.com>, be transferred to Complainant.

*/Christopher S. Gibson/*

**Christopher S. Gibson**

Sole Panelist

Date: May 22, 2024