

ADMINISTRATIVE PANEL DECISION

Rheem Manufacturing Company v. Rick Burns, tstats hvac supply
Case No. D2024-1490

1. The Parties

Complainant is Rheem Manufacturing Company, United States of America (“United States”), represented by Eversheds Sutherland (US) LLP, United States.

Respondent is Rick Burns, tstats hvac supply, United States.

2. The Domain Name and Registrar

The disputed domain name <relyonruud.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 April 9, 2024. On April 9, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 9, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on April 10, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on April 15, 2024.

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 Respondent of the Complaint, and the proceedings commenced on April 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 8, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 10, 2024.

The Center appointed Christopher S. Gibson as the sole panelist in this matter on May 14, 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

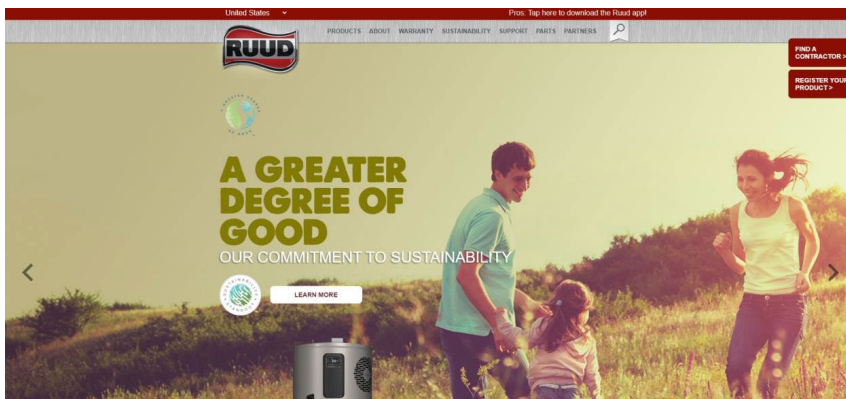
Complainant is a leading manufacturer of commercial and residential air and water heating and cooling equipment and parts, offering products under the RUUD trademark, which has been in use in commerce since as early as 1961. Complainant owns all right, title, and interest in the RUUD line of air and water products, tools, and supplies. Complainant’s goods are among the most well-known water and air products in the United States and throughout the world.

Complainant owns all right, title, and interest in the RUUD trademarks, which are registered on the principal register at the United States Patent and Trademark Office (“USPTO”), and include the following marks, two of which are incontestable:

Mark	Registration No.	Date of Registration	International Class and Goods
RUUD	0,737,477	September 11, 1962	International Class 9: Electric water heaters
	1,804,327	November 16, 1993	International Class 11: Furnaces, heat pumps, and air conditioners
	6,302,165	March 23, 2021	International Class 11: Electric water heaters; furnaces, heat pumps and air conditioners; heat pump pool heaters
RUUD	7,072,359	June 6, 2023	International Class 11: Air filters for HVAC units

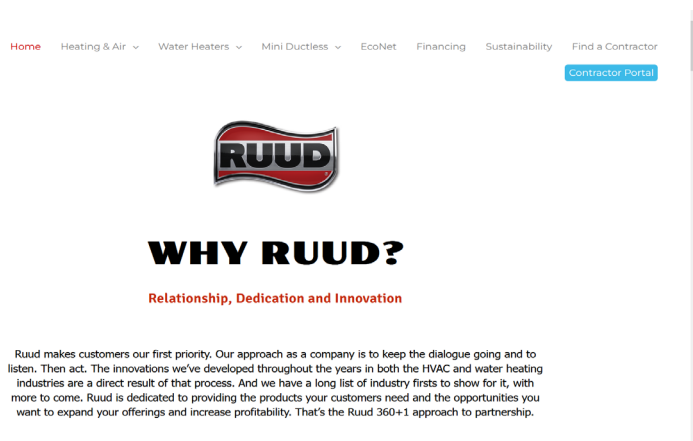
Additionally, Complainant has trademark registrations around the world for its marks, including in Australia, Bahrain, Brazil, Canada, China, Colombia, the European Union, France, India, Japan, Oman, Paraguay, Peru, Qatar, Romania, Saudi Arabia, the United Kingdom, and Venezuela (Bolivarian Republic of). The RUUD marks (Registration Nos. 1693033 and 1518051) are also registered through WIPO and designated to countries around the world under the Madrid Protocol.

Further, Complainant’s website at the domain name <ruud.com>, which has been registered since December 19, 1995, actively displays the RUUD marks. Complainant has consistently marketed its air and water heating and cooling products and services through its website:



Additionally, Complainant has utilized the “Rely on Ruud™” slogan as a common law trademark for over a decade in connection with its RUUD brand air and water heating and cooling products and services.

The Domain Name was registered on February 16, 2009. The website located at the Domain Name currently advertises water heating and HVAC units, and financing and other related services, using the RUUD trademark. The Domain Name incorporates the RUUD mark in full and adds the phrase “rely on.” The Domain Name mirrors Complainant’s slogan “Rely on Ruud,” which Complainant uses with its RUUD brand products. A screenshot of the website linked to the Domain Name is included below:



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 has submitted evidence of its ownership of multiple RUUD trademarks. Complainant contends it is well-established in UDRP precedent that the mere addition of a descriptive term or phrase to a trademark is insufficient to overcome a finding of confusing similarity with a registered mark.

In the present matter, the Domain Name incorporates Complainant’s RUUD registered mark in its entirety with only the addition of the phrase “rely on.” Furthermore, the full Domain Name mirrors the well-known slogan “Rely on Ruud” used by Complainant in connection with its RUUD brand products. As such, the Domain Name is confusingly similar to Complainant’s registered trademarks and violates Complainant’s intellectual property rights. Complainant states consumers accessing or viewing the Domain Name are likely to believe incorrectly that it is associated with Complainant because it incorporates both the RUUD mark and Complainant’s common law trademark “Rely on Ruud™” and advertises Complainant’s products.

(ii) Rights or legitimate interests

Complainant confirms that Respondent is an authorized distributor of RHEEM and RUUD brand products. The relationship between the parties is memorialized in a written Distributor Agreement entered into by Respondent and Complainant (through its subsidiary Rheem Sales Company, Inc.), which has been effective since June 30, 2008. Pursuant to this agreement, Respondent specifically agreed to not “use, register, apply to register or purchase any of Complainant Marks or any variations or derivations thereof as a domain name.” As such, Complainant contends Respondent is not licensed to use or hold domain names using the RUUD mark. Complainant has never licensed its trademarks to be used in the trade name of another business entity, including Respondent.

Complainant submits there is no evidence Respondent can demonstrate that any of the circumstances set out in paragraph 4(c) of the Policy apply in this case. The actual use of the Domain Name is neither a bona fide use of that name under paragraph 4(c)(i) of the Policy, nor a legitimate noncommercial or fair use pursuant to paragraph 4(c)(iii) of the Policy. Rather, Complainant asserts that Respondent is using the Domain Name to directly infringe on Complainant's registered and common law trademarks.

Complainant contends that as evidence of Respondent's lack of a bona fide use of the mark, Respondent has taken steps to hide its identity by using a privacy service.

Complainant asserts that under UDRP precedent, the fact that a respondent is authorized to sell a complainant's products does not grant the respondent carte blanche to misuse complainant's trademarks and mislead consumers as to the relationship between the parties. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). Instead, Complainant asserts that a respondent must comply with the "Oki Data test": "i) the respondent must actually be offering the goods or services at issue; ii) the respondent must use the site to sell only the trademarked goods or services; iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and iv) the respondent must not try to 'corner the market' in domain names that reflect the trademark." *Rheem Manufacturing Company v. John Sperratore*, WIPO Case No. [D2023-3057](#). In the present case, Respondent's name and contact information have been withheld on the Whois register. Further, and most concerning, Respondent has not disclosed its identity anywhere on the website linked to the Domain Name. No contact information is listed on the site, and no disclaimers or other information is provided that would identify an individual or entity other than Complainant to be the owner and operator of that site. As such, by failing to provide the necessary accurate and prominent disclosure of its identity, Respondent lacks rights or legitimate interests in the Domain Name.

Based on this evidence, Complainant states it is clear Respondent is using the RUUD mark without Complainant's authorization, consent, or license. In doing so, Complainant contends Respondent is fraudulently misleading the public to believe they are viewing products and applying for financing and other services directly affiliated with Complainant, when in fact they are interacting with a third-party company with no license or authorization to use Complainant's trademarks in this manner. In light of this information, Complainant maintains Respondent cannot establish that it has any right or legitimate interests in the Domain Name.

Further, Complainant contends Respondent cannot maintain that it is using the Domain Name in connection with any bona fide offering of goods or services as the website located at the Domain Name features infringing uses of Complainant's RUUD trademarks in order to trade upon Complainant's substantial goodwill in the marketplace for water and air heating and cooling products and services. Respondent has designed the site to confuse consumers into believing they are viewing goods offered directly by Complainant when in fact they are accessing a site operated by an undisclosed third party with no right, license, or authorization to use the RUUD mark in this manner. Respondent's use of the mark and adoption of Complainant's common law trademarked slogan in the Domain Name is intended to mislead consumers searching for legitimate RUUD brand products. Complainant submits reasonable inference in these circumstances is that the registration of the Domain Name constitutes a deliberate attempt to capitalize on the goodwill associated with the RUUD mark, as Respondent is actively using it in the content of the website located at the Domain Name, including the header of every webpage and product descriptions. Further, Respondent has posted official RUUD marketing materials, including product photographs, brochures, and videos, to the site, further enhancing the likelihood that consumers will inaccurately believe the Domain Name is owned and operated by or affiliated with Complainant. Lastly, Respondent has failed to disclose anywhere on the website hosted on the Domain Name that it is in fact the registrant of the Domain Name or its relationship with Complainant.

Moreover, there is no evidence that the Domain Name is the legal name of Respondent or, to the knowledge of Complainant, of any entity with which Respondent is lawfully associated. Further, Respondent has no registered trademark or service mark rights in RUUD or "Rely on Ruud." As previously noted, Respondent has explicitly agreed in its Distributor Agreement with Complainant that it would not register, own, or use domain names that incorporate Complainant's trademarks, including the RUUD mark. Furthermore, in this Distributor Agreement, Respondent agreed "that Rheem Manufacturing Company at all times, owns and

retains all right, title and interest in and to its intellectual property, including, but not limited to, all trademarks,” which would include both the registered RUUD mark and the common law “Rely on Ruud” slogan.

Additionally, in the footer of the website hosted on the Domain Name, Respondent refers to itself as “RelyOnRuud.” A search of the Better Business Bureau and Internet search engines did not disclose any businesses registered or operating under that name aside from the Domain Name. Further, Respondent has taken steps to hide its identity from the public, including remaining anonymous on the Whois register and failing to provide any contact information on its website, which suggest that it is attempting to hold itself out to the public as Complainant. Based on this evidence, it appears that Respondent has made no efforts to establish a legitimate business venture under the RelyonRuud name and is instead merely seeking to trade off of the significant goodwill that Complainant has established in its brand to mislead consumers for Respondent’s own commercial gain.

Finally, Complainant asserts that Respondent’s use of the Domain Name does not constitute a fair use under United States law. Respondent is neither merely referencing RUUD brand products and services in a nominative manner, nor is Respondent using RUUD in a descriptive manner. Rather, Respondent has commercially gained from using the Domain Name to create an infringing website to purposefully confuse the public as to its association with Complainant and trade upon Complainant’s goodwill and reputation in the market for water heaters and HVAC units and related products and services.

(iii) Registered and used in bad faith

Complainant contends Respondent is seeking to trade upon the goodwill and reputation Complainant has fostered over the years in the Ruud brand and trademarks. Complainant quotes [WIPO Overview 3.0](#), paragraph 3.1.4, which states “Panels have consistently found that a presumption of bad faith arises from the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity.” Here, Complainant states Respondent does not have legitimate interests or rights in the Domain Name, and there is no evidence of conceivable good-faith use. Moreover, Respondent had direct knowledge of Complainant’s marks, as evidenced by Respondent’s misappropriation and unauthorized use of Complainant’s registered trademarks, particularly its highly stylized RUUD logo, and the unauthorized copying of its copyright-protected marketing materials in the content of the website hosted on the Domain Name. Complainant emphasizes it is important to note Respondent has misappropriated not only the RUUD trademark but also many of Complainant’s other registered and common law marks in the content of the website, including A Greater Degree of Good®, Achiever®, Econet®, and Marathon®, which evidences Respondent’s blatant goal of holding itself out to the public as Complainant. Lastly, in registering the Domain Name, Respondent violated its explicit contractual obligations contained within the Distributor Agreement entered into with Complainant, which evidences manifest bad faith.

The timing of Respondent’s registration of the Domain Name more than 60 years after the first use in commerce and registration of the RUUD trademark, and more than 10 years after Complainant’s adoption of the “Rely on Ruud” slogan, supports a bad faith finding. Based on the totality of the evidence, Complainant submits it is clear that Respondent intended to create confusion in the market and trade upon Complainant’s reputation and established goodwill to the detriment of the public by registering the Domain Name in bad faith.

B. Respondent

Respondent did not reply to Complainant’s contentions.

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 well-established rights in its RUUD trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Moreover, the Panel finds the mark is recognizable within the Domain Name, while Complainant also claims common law rights in the "Rely on Ruud" slogan that is identical to the Domain Name. See [WIPO Overview 3.0](#), section 1.8 ("Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity...").

Accordingly, the Panel determines that the Domain Name is identical or confusingly similar to Complainant's mark for the purposes of the Policy, and the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy gives non-exclusive examples of instances in which a respondent may establish rights or legitimate interests in a domain name, by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent's 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) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is 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.

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 respond to the Complaint. The Panel finds that Complainant has not authorized Respondent to use Complainant's RUUD trademark; that Respondent is not commonly known by the Domain Name; 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 was been linked to a

website which impersonates Complainant and its RUUD brand, using Complainant's trademarks and other copyrighted content without permission and purportedly offering products and services that Complainant also offers. Although Complainant has confirmed that Respondent is an authorized distributor of RHEEM and RUUD brand products, the evidence indicates that all of this has been done without Complainant's permission. Indeed, Complainant has provided evidence of a contract with Respondent in which Respondent agreed not to "use, register, apply to register or purchase any of Complainant Marks or any variations or derivations thereof as a domain name." Moreover, the website linked to the Domain Name fails to disclose the identity of Respondent or its relationship with Complainant. No contact information is listed, and no disclaimers or other information is provided that would identify an individual or entity other than Complainant to be the owner and operator of that site. This goes hand-in-hand with Respondent's use of a privacy service to shield Respondent's identity as registrant of the Domain Name.

Respondent has not rebutted Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Name.

Accordingly, the Panel finds that Complainant has made a prima facie showing of Respondent's lack of rights or legitimate interests in respect of the Domain Name, which has not been rebutted by Respondent. The Panel therefore finds that Complainant has established the second element of the Policy in accordance with paragraph 4(a)(ii).

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. First, the Panel is of the view that Respondent, as a distributor of RHEEM and RUUD brand products pre-dating the registration date of the Domain Name, was aware of Complainant and its distinctive RUUD trademark when registering the Domain Name, and intentionally targeted Complainant and its marks. Respondent did this despite clear language in its Distribution Agreement where Complainant prohibited Respondent from registering domain names containing Complainant's RUUD mark. The Panel observes that Respondent registered the Domain Name incorporating Complainant's RUUD mark in its entirety, preceded by the phrase "rely on," thereby copying a slogan that Complainant has used in connection with its products and services, and for which Complainant has claimed common law rights. Moreover, in the circumstances of this case, where Respondent was an authorized distributor but also prohibited from registering domain names containing the RUUD trademark, it is pertinent to observe that Respondent used a privacy service for the Domain Name's registration details, so that its identity could not be easily discovered. All of this evidence demonstrates registration in bad faith.

Regarding use of the Domain Name, at the time the Complaint was filed the Domain Name directed to a website featuring infringing uses of Complainant's RUUD trademarks and copyright-protected marketing materials, designed to confuse consumers into believing they are viewing goods offered directly by Complainant when in fact they are accessing a site operated by a third party with no authorization to use Complainant's content in this manner. In addition, the site fails to disclose the identity of Respondent, as no contact information or disclaimers are provided. In view of all of the above evidence, the Panel determines, on the balance of the probabilities, that Respondent has used the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to Respondent's site by creating a likelihood of confusion with Complainant and its RUUD trademark. See Policy, paragraph 4(b)(iv).

In conclusion, in this case, where Respondent failed to submit a Response to Complainant's contentions, 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, <relyonruud.com>, be transferred to Complainant.

/Christopher S. Gibson/

Christopher S. Gibson

Sole Panelist

Date: June 7, 2024