ARBITRATION
AND
MEDIATION CENTER

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

ADMINISTRATIVE PANEL DECISION
The Reinalt-Thomas Corporation v. TechBlox Hostmaster, TechBlox
Case No. D2024-2100

1. The Parties

Complainant is The Reinalt-Thomas Corporation, United States of America ("United States"), represented by Ballard Spahr, LLP, United States.

Respondent is TechBlox Hostmaster, TechBlox, United States.

2. The Domain Name and Registrar

The disputed domain name <discounttiresales.com> (the "Domain Name") is registered with CloudFlare, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 21, 2024. On May 21, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 22, 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 (Data Redacted) and contact information in the Complaint. The Center sent an email to Complainant on May 22, 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 May 23, 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 May 27, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 16, 2024. The Response was filed with the Center on June 13, 2024.

The Center appointed Robert A. Badgley as the sole panelist in this matter on July 5, 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 alleges that it "operates the largest independent tire and wheel retail chain in the United States under the DISCOUNT TIRE Marks, with over 1,100 stores."

Complainant holds a registered trademark for the word mark DISCOUNT TIRE with the United States Patent and Trademark Office ("USPTO") in connection with "retail store services, namely, automobile and light truck tires and wheels," with a date of first use in commerce of November 1, 1970. This mark was registered on November 18, 2014, under USPTO Reg. No. 4,639,389.

Complainant also holds a registered trademark for the design mark DISCOUNT TIRE, USPTO Reg. No. 1,319,968, registered on February 12, 1985, in connection with "retail auto and light truck tire store services," with a date of first use in commerce of April 29, 1975.

Complainant has owned the domain name <discounttire.com> since May 14, 1997, and uses that domain name to operate its commercial website.

In a trademark infringement lawsuit under the United States Lanham Act, styled as *The Reinalt-Thomas Corporation, d/b/a Discount Tire v. Mavis Tire Supply, LLC*, Case No. 1:18-CV-5877, a United States District Court for the Northern District of Georgia, Atlanta Division, granted Complainant's motion for a preliminary injunction against another party. In its July 10, 2019 decision, the court made the following findings (in the context of a preliminary injunction, not a trial on the ultimate merits):

"[Complainant] RTC has, over the past fifty-eight years, spent over one billion dollars promoting its marks, and has a television commercial still running that originally aired in 1975 (that was named 'The World's Best Broadcasting Advertisement' by the Hollywood Radio and Television Society in 1976 and set a Guinness World Record for the longest-running television commercial in 2004). RTC promotes its 'discount tire' mark in various ways, including the internet, on a Nascar car, and in its retail stores. It provided evidence to the PTO in 2014 of secondary meaning based on evidence of billions of dollars of sales and over $1 billion in advertising. Since that time, it asserts, its sales have nearly doubled, and its advertising spending has increased. Based on the evidence, the Court finds that RTC is likely to succeed on the merits of its argument that it has demonstrated secondary meaning."

The Domain Name was registered on September 3, 2020. As of April 14, 2024, the Domain Name resolved to a landing page featuring various hyperlinks, such as "Auto Parts for Sale," "Best Wheel Accessories," and "Discount Auto Parts." Complainant alleges that Respondent derives pay-per-click ("PPC") revenue from these hyperlinks.

According to Respondent, he registered the Domain Name "as a potential domain for a project which never came to fruition." Respondent submitted no description, or corroborating evidence, of this purported "project."

Complainant alleges as follows:

"Respondent hacked Complainant's AT&T account and changed the contact email to one ending with the Domain. Respondent then used new email to impersonate Complainant and/or its principals to make at least fifteen purchases of Apple and Samsung products, amounting to USD 42,753.73."

Respondent denies having used the Domain Name to create a bogus email address and hack into Complainant's AT&T account. Respondent also asserts that he has no control over the hyperlinks present on the parking page to which the Domain Name resolves.

5. Parties' Contentions

A. Complainant

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

B. Respondent

As noted above, Respondent asserts that the Domain Name was registered "as a potential domain for a project which never came to fruition." Respondent denies having used the Domain Name for a fraudulent email address and asserts that he had no control over the hyperlinks placed at the parking page by the Registrar.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

(i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
(ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
(iii) the Domain Name has been registered and is being used 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 Names. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") section 1.7.

The Panel concludes that Complainant has rights in the trademark DISCOUNT TIRE through registration and use demonstrated in the record. The Panel also concludes that the Domain Name is confusingly similar to that mark. The Domain Name entirely incorporates the DISCOUNT TIRE mark and adds the term "sales." The Panel concludes that the mark remains clearly recognizable within the Domain Name despite this additional term.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

(i) before any notice to you [Respondent] of the dispute, your 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) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or

(iii) you [Respondent] are 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.

Although the overall burden of proof in UDRP proceedings 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 often primarily within the knowledge or control of the respondent. Thus, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the respondent fails to come forward with such relevant evidence, the complainant is deemed to have domain name (although the burden of proof always remains on the complainant). If the satisfied the second element. WIPO Overview 3.0, section 2.1.

The Panel concludes that Respondent lacks rights or legitimate interests in connection with the Domain Name. Respondent alludes to a "project" that "never came to fruition," but offers no other detail let alone contemporaneous evidence of demonstrable preparations to use the Domain Name "in connection with a bona fide offering of goods or services." It strikes the Panel, in the circumstances of this Domain Name, that evidence of such an alleged "project" would have been easy enough for Respondent to provide in this case.

Respondent's failure to explain his alleged "project" or corroborate it with contemporaneous documentation permits the Panel to draw an adverse inference from its absence from the record, and to conclude that Respondent's claimed "project" is merely pretextual.

Without deciding whether Respondent was in fact behind the alleged hack of Complainant's AT&T account, the Panel does find that Respondent derived PPC revenues from the hyperlinks on the parking page to which the Domain Name resolved. Respondent did not deny the allegation that he derived revenue from the PPC links. Such a use of the Domain Name, which incorporates an established, registered trademark in its entirety and then earns income from clicks on links related to products in the same general field (automotive parts) as Complainant's product line, is not a legitimate use of the Domain Name under the Policy.

Complainant has established Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation," are evidence of the registration and use of the Domain Name in "bad faith":

(i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or

(ii) that Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or

(iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that Respondent registered and used the Domain Name in bad faith under the Policy. The Panel incorporates its discussion above in the "Rights or Legitimate Interests" section. On this record, the Panel finds that Respondent targeted Complainant's mark when registering the Domain Name and did so in violation of the above-quoted Policy paragraph 4(b)(iv).

Complainant has established Policy paragraph 4(a)(iii).

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 <discounttiresales.com> be transferred to Complainant.

/Robert A. Badgley/
Robert A. Badgley
Sole Panelist
Date: June 26, 2024