

ADMINISTRATIVE PANEL DECISION

Palmetto State Armory, LLC v. Privacy service provided by Withheld for
Privacy ehf / Joseph Stone
Case No. D2022-1028

1. The Parties

Complainant is Palmetto State Armory, LLC, United States of America (“United States”), represented by Willoughby & Hoefer, P.A., United States.

Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Joseph Stone, United States.

2. The Domain Name and Registrar

The disputed domain name <palmettodagger.com> (“Disputed Domain Name”) 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 24, 2022. On March 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 25, 2022, 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. The Center sent an email communication to Complainant on March 28, 2022 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 March 28, 2022.

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 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 21, 2022. The Response was filed with the Center on April 4, 2022. On April 5, 2022, the Center sent a request for confirmation to Respondent to which Respondent replied to on the same day.

The Center appointed David H. Bernstein as the sole panelist in this matter on April 13, 2022. 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, Palmetto State Armory, LLC (“PSA”) is a South Carolina corporation that manufactures and sells firearms. Among its products is the “Palmetto Dagger” line of firearms. PSA’s trademark registrations and applications before the United States Patent and Trademark Office (“USPTO”) include the following:

- PALMETTO STATE ARMORY (Registration No. 4,337,087), registered March 21, 2013, for hats and firearms, with a claimed date of first use in commerce of January 4, 2010;
- PALMETTO STATE ARMORY (Registration No. 4,894,598), registered February 2, 2016, for knives and firearms, with a claimed date of first use in commerce of January 4, 2010;
- PALMETTO DAGR (Serial No. 88,750,504), intent to use application filed January 8, 2020;
- PS9 DAGR (Serial No. 90,001,671), intent to use application filed June 15, 2020;
- SWAGGER DAGGER (Serial No. 90,729,691), intent to use application filed May 24, 2021;
- PALMETTO DAGGER (Serial No. 97,200,169), application filed January 3, 2022, with a claimed date of first use in commerce of January 20, 2021.

Complainant operates a website at the domain name <palmettostatearmory.com>.

Respondent registered the Disputed Domain Name on October 13, 2021, and uses it to redirect to a GlockTalk.com forum for the “Palmetto State Armory Dagger™.” GlockTalk.com is a forum owned by Outdoor Hub, LLC, doing business as Carbon Media Group, a corporation with which Respondent is unaffiliated. Respondent indicates that he created the Palmetto State Armory Dagger thread on the GlockTock.com forum under the screen name wickedbeernut.

5. Parties’ Contentions

A. Complainant

Complainant maintains that it is a leading firearm manufacturer and seller, with a well-known commercial website, that sells its products in all fifty states.

Complainant argues that the Disputed Domain Name is confusingly similar to, or identical to, its registered and common law “Palmetto Dagger” related marks.

Complainant asserts that Respondent has no rights or legitimate interests in the Disputed Domain Name. In support of this contention, Complainant argues that Respondent (i) neither manufactures nor sells any product under the name “Palmetto Dagger,” (ii) is not an agent or representative of Complainant, (iii) is not commonly known by the Disputed Domain Name and has no trademark in it, (iv) did not register the Disputed Domain Name until “well after” Complainant sold products under the “Palmetto Dagger” name and acquired trademark rights in the same, and (v) inappropriately utilizes the Disputed Domain Name for commercial gain via advertisements and commercial links hosted on the Site.

Complainant also contends that Respondent registered the Disputed Domain Name in bad faith to prevent Complainant from utilizing it and to disrupt Complainant's business by diverting customers interested in Palmetto Dagger products to Complainant's competitors.

B. Respondent

Respondent contends that Complainant has no trademark in PALMETTO DAGGER because that mark is confusingly similar to the DAGGER trademark registration for gun silencers, which is owned Smith & Wesson Inc., another leading firearm manufacturer. In addition, Respondent argues that Complainant did not seek to register the "Palmetto Dagger" name until after he had already registered the Disputed Domain Name. Respondent further asserts that Complainant has provided no evidence of having marketed "Palmetto Dagger" firearms prior to Respondent's registration of the Disputed Domain Name.

In support of the contention that he has rights or legitimate interests in the Disputed Domain Name, Respondent argues that his sole interest in the Disputed Domain Name is to use it to educate the firearms community about Complainant's "Dagger" series of firearms. Moreover, he argues, he realizes no commercial gain from the domain because he is unaffiliated with Carbon Media Group, the owner of GlockTalk.com.

Respondent also denies that he registered or uses the Disputed Domain Name in bad faith. Rather, his use is a fair use of the Disputed Domain Name to host a forum about the "Dagger" series of firearms. In addition, Respondent argues that the disclaimer of affiliation at the top of the GlockTalk.com "Palmetto State Armory Dagger™" thread eliminates any potential consumer confusion.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, in order to prevail, Complainant must prove each of the following:

- (i) The Disputed Domain Name 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 Disputed Domain Name; and
- (iii) The Disputed Domain Name has been registered and is being used by Respondent in bad faith.

For the reasons stated below, the Panel finds Complainant has proven each of these elements.

A. Identical or Confusingly Similar

Respondent asserts that Complainant has submitted no evidence that it used the PALMETTO DAGGER name to market firearms prior to his registration of the Disputed Domain Name, but that is both not correct and irrelevant.

First, it is not correct because Complainant has asserted in the Complaint that it has marketed PALMETTO DAGGER firearms prior to Respondent's registration and Complainant includes a certification that the facts alleged in the Complaint are complete and accurate to the best of Complainant's knowledge. Although that may not be "documentary" evidence, it is "evidence" nonetheless. Moreover, in its application to register PALMETTO DAGGER as a trademark with the USPTO, Complainant represented that the mark was used in commerce at least as early as January 20, 2021.

Respondent alleges that these assertions are false, relying on evidence that Complainant used other names for firearms prior to "Palmetto Dagger." But that evidence does not prove Complainant did not also use the name "Palmetto Dagger" prior to the registration of the Disputed Domain Name.

In any event, using the Internet Wayback Machine, the Panel has confirmed that firearms under the “Palmetto Dagger” name were indeed displayed and offered for sale on Complainant’s website as of at least September 17, 2020. <https://web.archive.org/web/20200917233708/palmettostatearmory.com/palmetto-dagger.html>. Taken together, Complainant’s assertions to the Panel and the USPTO, the evidence from the Internet Wayback Machine, and Respondent’s lack of direct contrary proof, are sufficient to establish by a preponderance of the evidence that Complainant did market PALMETTO DAGGER firearms prior to Respondent’s registration of the Disputed Domain Name.

Second, Respondent’s assertion is irrelevant for several reasons. Most significantly, the first factor does not require that trademark rights predate the registration of the domain name; rather it requires that Respondent have trademark rights at the time of the complaint. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Decision Overview 3.0”), Section 1.1.3. Moreover, there is no dispute that Complainant had trademark rights in other marks containing PALMETTO, DAGR, and DAGGER, and the domain name is confusingly similar to all of those trademarks as well.

Where the timing of trademark rights is sometimes relevant is in the context of assessing bad faith, since a domain name registrant generally cannot register a domain name in bad faith if the registration occurs before the complainant has developed trademark rights. But that general principal does not apply when the respondent has knowledge of the complainant’s nascent trademark rights. Here, Respondent concedes that he registered the Disputed Domain Name after express confirmation from Complainant’s Chief Executive Officer that the firearm would be called the “Dagger.” As the [WIPO Overview 3.0](#) makes clear, a respondent’s registration of a domain name that is intended unfairly to capitalize on a complainant’s nascent trademark rights can be sufficient to establish bad faith. *Id.* at Section 3.8.2.

Finally, Respondent’s suggestion that Complainant does not own the PALMETTO DAGGER mark due to Smith & Wesson’s DAGGER registration is unavailing. The Smith & Wesson registration is for different (albeit related) goods, and Respondent has not alleged that Smith & Wesson has challenged Complainant’s use of this trademark. In the absence of any challenge by the brand owner, there is no basis to conclude on this record that Complainant’s use of the PALMETTO DAGGER trademark has failed to establish common law trademark rights.

For all of these reasons, the Panel concludes that Complainant has proven by a preponderance of the evidence that the Disputed Domain Name is identical and/or confusingly similar to various trademarks in which Complainant has rights.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, Respondent may establish rights or legitimate interests in the Disputed Domain Name by demonstrating the following:

- (i) before any notice of the dispute, Respondent’s use of, or demonstrable preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) Respondent has been commonly known by the Disputed Domain Name, even if he has acquired no trademark or service mark rights; or
- (iii) Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Complainant alleges that Respondent uses the Disputed Domain Name for commercial gain through the use of advertisements and links on the redirected-to GlockTalk forum. Respondent denies that there are any ads on that forum but the Panel has reviewed the website and has identified ads on the right side of the forum discussion. Respondent also denies that he is enjoying any commercial gain through the operation of the forum, but, given Respondent’s other demonstrably false assertions, the Panel is skeptical of that contention,

and believes that Respondent must be enjoying some kind of gain – commercial, reputational, or otherwise – in return for driving traffic to the GlockTalk forum from the Disputed Domain Name.

Respondent also argues that he has made a noncommercial or fair use of the Disputed Domain Name without intent to misleadingly divert consumers because he uses it only to redirect to an informational forum. Complainant did not address this issue in its Complaint (and the Panel has elected not to invite Complainant to address this point in a supplemental submission because Respondent's use was obvious and Complainant could and should have addressed it in its Complaint). Nevertheless, the Panel has considered Respondent's argument, and finds it lacking in validity.

Had Respondent registered a domain name that made clear that he was hosting a forum for talking about Palmetto Dagger firearms, the Panel might have agreed that a noncommercial use is a legitimate use under the Policy. See [WIPO Overview 3.0](#), Section 2.6.3. Here, though, Respondent registered a domain name that copied, in its entirety, Complainant's trademark. As such, the Disputed Domain Name impersonates Complainant, which misleadingly diverts consumers to Respondent's website on the false premise that the website is run by, sponsored by, associated with, or approved by Complainant. That is not legitimate if "the public would perceive the disputed domain name as being affiliated with or authorized by a complainant." *Everytown for Gun Safety Action Fund, Inc. v. Contact Privacy Inc. Customer 1249561463 / Steve Coffman*, WIPO Case No. [D2022-0473](#) (citing *Dover Downs Gaming & Entertainment, Inc. v. Domains by Proxy, LLC / Harold Carter Jr., Purlin Pal LLC*, WIPO Case No. [D2019-0633](#) ("Dover Downs")). See generally [WIPO Overview 3.0](#), Section 2.6.2.

Accordingly, the Panel finds that Complainant has established by a preponderance of the evidence that Respondent lacks rights or legitimate interests in the Disputed Domain Name.

C. Registered and Used in Bad Faith

For similar reasons discussed above, Complainant has shown that Respondent registered and used the Disputed Domain Name in bad faith. Respondent clearly knew of Complainant and its mark; in fact, as noted above, Respondent only registered the Disputed Domain Name after Complainant's CEO personally confirmed that Complainant intended to use the DAGGER name for this gun. Further, Respondent registered and uses an impersonating domain name to misleadingly attract Internet users to its website. Such conduct constitutes registration and use in bad faith under the Policy. See [WIPO Overview 3.0](#), section 3.1.4 (iv). That Respondent felt it important to include a disclaimer on the website is itself evidence that Respondent recognized that the use of the Disputed Domain Name in connection with this website could be confusing and deceptive. *Id.*, section 3.7.

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 <palmettodagger.com> be transferred to Complainant.

/David H. Bernstein/
David H. Bernstein
Sole Panelist
Date: April 27, 2022