

NATIONAL ARBITRATION FORUM

DECISION

Classic Metal Roofs, LLC v. Interlock Industries, Ltd.
Claim Number: FA0606000724554

PARTIES

Complainant is **Classic Metal Roofs, LLC** (“Complainant”), represented by **Kay Lyn Schwartz**, of **Gardere Wynne Sewell, LLP**, 1601 Elm Street, Suite 3000, Dallas, TX 75201. Respondent is **Interlock Industries, Ltd.** (“Respondent”), represented by **Owen Dukelow**, of **Kolisch Hartwell, P.C.**, 520 SW Yamhill, Ste 200, Portland, OR 97204.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**classicmetalroofing.com**>, registered with **Domainpeople Inc.**

PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

Honorable Richard B. Wickersham, Judge (Ret.), as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on June 1, 2006; the National Arbitration Forum received a hard copy of the Complaint on June 5, 2006.

On June 2, 2006, Domainpeople Inc. confirmed by e-mail to the National Arbitration Forum that the <**classicmetalroofing.com**> domain name is registered with Domainpeople Inc. and that the Respondent is the current registrant of the name. Domainpeople Inc. has verified that Respondent is bound by the Domainpeople Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On June 6, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of June 26, 2006 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent’s registration as technical, administrative and billing contacts, and to postmaster@classicmetalroofing.com by e-mail.

On June 26, 2006, Respondent requested, pursuant to Supplemental Rule 6, an extension of eleven days to respond, because Respondent did not procure counsel until June 20, 2006, leaving it with insufficient time to investigate the underlying claim. On June 27, 2006, the National Arbitration Forum, with Complainant's consent, granted Respondent an extension and set a new deadline of July 11, 2006 for a filing of a Response.

A timely Response was received and determined to be complete on July 11, 2006.

Additional Submissions from Complainant and Respondent were received on July 18, 2006 and July 25, 2006, respectively, and the National Arbitration Forum determined both to be timely and complete according to Supplemental Rule #7.

On July 18, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Richard B. Wickersham, Judge (Ret.), as Panelist.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

Classic Metal Roofs has used continuously since 2004, and is currently using, the mark "CLASSIC METAL ROOFS," in connection with roofing products and services. Classic Metal Roofs has acquired extensive rights and associated goodwill through its continuous use of the "CLASSIC METAL ROOFS" mark and "CLASSIC METAL ROOFS and design" mark (collectively the "CLASSIC METAL ROOFS Marks"). Classic Metal Roofs' website at <classicmetalroofs.com> provides information concerning Classic Metal Roof's business and the use of its marks. Classic Metal Roofs' valuable trademarks are sufficiently distinctive and have come to be associated with the Complainant, Classic Metal Roofs. In addition, Classic Metal Roofs has developed substantial good will as a result of its use of the CLASSIC METAL ROOFS Marks. Further, Classic Metal Roofs is affiliated with the Metal Roof Alliance (MRA), and has achieved a five-star rating from Service Magic, an organization that prescreens and rates companies specializing in home improvement goods and services.

The predominant portion of Respondent's domain name, <**classicmetalroofing.com**>, is virtually identical to the CLASSIC METAL ROOFS Marks, and/or is confusingly similar to such Marks. A domain name is, by definition, identical or confusingly similar, when the domain name incorporates Complainant's mark, thus creating a presumption that the domain name is affiliated with the Complainant. *See Wyndham Int'l, Inc. v. Golden Door Designs*, FA 146932 (Nat. Arb. Forum Apr. 2, 2003); *see also Perot Sys. Corp. v. Perot.net*, FA 95312 (Nat. Arb. Forum Aug. 29, 2000). The fact that Respondent includes the top level domain designation ".com" or that the domain name omits the final

letter “S” in “ROOFS” and adds “ING” (i.e., the term “ROOFING” is used instead of the term “ROOFS”) does not negate the confusion created by Respondent’s domain name. A domain name is identical or confusingly similar to a mark “when the domain name includes the trademark, or a confusingly similar approximation, *regardless of the other terms in the domain name.*” See *College Summit, Inc. v. Yarmouth Educational Consultants, Inc.* D2000-1575 (WIPO Jan. 17, 2001) (inclusion of term “net” into contested domain name, collegenetsummit, did not render domain name sufficiently dissimilar to mark, COLLEGE SUMMIT, as to preclude confusion of internet user); see also *Rollerblade, Inc. v. McCrady*, D2000-0429 (WIPO June 25, 2000) (finding that the top level of the domain name such as “.net” or “.com” does not affect the domain name for the purpose of determining whether it is identical or confusingly similar); see also *Little Six, Inc. v. Domain For Sale*, FA 96967 (Nat. Arb. Forum Apr. 30, 2001) (finding that <mysticlake.net> is plainly identical to Complainant’s MYSTIC LAKE trademark and service mark).

In addition, the domain name at issue, when entered into an internet browser, immediately resolves to the Respondent’s website at <interlockroofing.com>. Respondent is the competitor of Complainant, and also specializes in metal roofing products and related services. Classic Metal Roofs submits that the domain name, <**classicmetalroofing.com**>, is likely to cause confusion among consumers and internet users. When consumers enter the domain name at issue, <**classicmetalroofing.com**>, into a web browser expecting to find information about Classic Metal Roofs or its website, it is highly likely that those consumers will be puzzled when they reach Respondent’s website at <interlockroofing.com> and wonder why or how Respondent – who is Complainant’s competitor – is associated with Complainant. The fact is – there is no association or affiliation between Complainant and Respondent – yet the domain name registered in the name of Respondent, and presently directed to Respondent’s main website, creates substantial confusion. Furthermore, there have been instances of actual confusion among Complainant’s customers regarding Respondent’s domain name.

For all of these reasons, Classic Metal Roofs submits that the first element required under Rule 3 of the ICANN Rules has been clearly established. Classic Metal Roofs has substantial rights in the CLASSIC METAL ROOFS Marks, and the domain name at issue, <**classicmetalroofing.com**>, clearly employs the CLASSIC METAL ROOFS Marks, and is substantially identical or confusingly similar to trademarks and service marks in which Classic Metal Roofs has rights.

Respondent, Interlock Industries, Ltd., is one of Classic Metal Roofs’ competitors and offers metal roofing products and installation services as evidenced by Respondent’s website. Respondent clearly has no rights in “CLASSIC” and is not known by the phrase, “CLASSIC METAL ROOFING.” Upon information and belief, Respondent registered the domain name at issue, <**classicmetalroofing.com**>, with full knowledge of Classic Metal Roofs and its CLASSIC METAL ROOFS Marks, in order to divert traffic away from Classic Metal Roofs and to Respondent and its website, <interlockroofing.com>. Such conduct clearly shows that Respondent has no rights or legitimate interests in the domain name at issue.

Respondent was on at least constructive notice, and upon information and belief, had actual notice, of Classic Metal Roofs' rights when it registered <classicmetalroofing.com> on May 27, 2005. Respondent and Complainant's headquarters are located 45 miles from each other. Considering the activities of both Complainant and Respondent in the New England area, it is difficult to imagine that Respondent was not aware of Classic Metal Roofs at the time it registered the domain name, <classicmetalroofing.com>. In addition, Classic Metal Roofs, LLC and Respondent compete for the same customers, as many of Classic Metal Roofs' customers indicate that their ultimate choice of a roofing provider came down to Interlock and Classic Metal Roofs, LLC. Surely, if Interlock loses a customer to a competitor, good business practices mandate knowledge of that competitor so as to potentially avoid losing another potential customer to that competitor. Further, at the time Respondent registered the domain name at issue, a search of the Internet would have revealed information concerning Classic Metal Roofs and its Marks as its website at <classicmetalroofs.com> was on-line months prior to Respondent's registration of <classicmetalroofing.com>.

B. Respondent

Respondent, Interlock Industries, Ltd., claims that it registered the <classicmetalroofing.com> domain name in good faith in order to advertise and sell metal roofing products. Respondent argues that Complainant has not offered any evidence of its rights in the CLASSIC METAL ROOFS mark before Respondent registered the disputed domain name on May 27, 2005. Complainant also is apparently restricted from using the mark outside of three and one-half states in the United States by the "veiled real party-in-interest" in the present case, Classic Metal Roofing Systems. Under the arbitration rules and relevant trademark law, then, Complainant should be denied the transfer of the disputed domain name.

Complainant has provided no evidence that it used the CLASSIC METAL ROOFS mark continuously since 2004 and has actually only used it since May 2005, after Respondent registered the <classicmetalroofing.com> domain name. In addition, the terms of the domain name are of common usage, making Complainant's burden to show it has rights in the mark particular high in this instance. Many other roofing companies use the CLASSIC METAL ROOFS mark to refer to their services.

Respondent claims that Complainant's real party in interest is another company that recently changed its name to Classic Metal Roofing Systems and that this party suffers from "domain name envy." Thus, this is not a straightforward attempt by a senior trademark owner to obtain a domain name in which it has a legitimate interest but a reverse domain name hijacking attempt by a party that adopted a mark long after Respondent had registered and begun use of the <classicmetalroofing.com> domain name.

Respondent asserts that it has rights and legitimate interests in the disputed domain name because it is comprised of three described keywords: classic, metal and roofing, and

these terms improve Respondent's ranking in search results.

C. Complainant's Additional Submission

COMPLAINANT'S ADDITIONAL SUBMISSION IN REPLY TO RESPONDENT'S RESPONSE

This is an Additional Submission by Complainant Classic Metal Roofs, LLC ("Classic Metal Roofs") in reply to Respondent's Response, timely submitted on or before July 17, 2006 (five Calendar Days, which excludes Sunday in accordance with NAF Supp. Rule 1(f), from July 11, 2006, the date Respondent's Response was received by the National Arbitration Forum).

"CLASSICMETALROOFING.COM" IS IDENTICAL OR CONFUSINGLY SIMILAR TO SERVICE MARKS IN WHICH CLASSIC METAL ROOFS HAS RIGHTS.

1. CLASSIC METAL ROOFS' SERVICE MARK RIGHTS

Classic Metal Roofs, LLC was organized in September 2004 and is headquartered in Stow, Massachusetts. Since at least as early as 2004, Classic Metal Roofs has provided roof installation and consultation services to consumers under the CLASSIC METAL ROOFS Marks. Classic Metal Roofs' Marks are protected under United States "common law."

Possession of a federal registered trademark is not required in order to prevail under the UDRP – common law rights are sufficient. As previous panels have recognized, a fundamental principle of trademark law is that rights in a trademark can be acquired through use, and such rights exist even though the trademark may not be registered. *See Imperial College v. Christophe Dessimoz*, WIPO Case No. D2004-0322. In addition, "rights" in a mark exist when a party shows that there is enough goodwill and reputation in and to a name and sufficient association of the same with the party itself, no matter how strong or weak those trademark and service mark rights may be. *See, e.g., Action Sports Videos v. Reynolds*, D2001-1239 (WIPO Dec. 13, 2001) (although registration of mark on USPTO's supplemental register indicated a "descriptive" mark without secondary meaning, the Panel still found that sufficient "rights" in the mark existed). In addition, the fact that trademark rights may only exist in a small geographic area does not limit complainant's rights in a common law trademark. The Policy makes no distinction between localized and widespread trademark rights, and there is no requirement that a Complainant own a famous mark to invoke the protections of the Policy. *See UEFA v. Fuzi Furniture*, D2000-0710 (WIPO Oct. 25, 2000) (complainant need not establish exclusive rights across all territorial boundaries, only a bona fide basis for making the complaint).

This submission influenced Panel's decision. It was timely received on July 17, 2006.

D. Respondent's Additional Submission

Respondent asserts that Complainant's Additional Submission includes "several factual allegations that should have been field as part of Complainant's *prima facie* case because, without the new allegations, Complainant simply has no evidence of trademark rights." Respondent claims that Complainant is raising new issues about conflicting that the Panel cannot disentangle because "Complainant is unilaterally controlling the information about its alleged rights."

Complainant's Additional Submission further highlights its lack of trademark rights in the CLASSIC METAL ROOFS mark and Complainant is still hiding information about its connection to the "shadow-complainant, Classic Products." The only evidence Complainant provides of its rights in the mark is a coupon distributed by ValPak in February 2005.

Respondent contends that it was not aware of Complainant before this proceeding and that Complainant is merely a licensee of the CLASSIC METAL ROOFS mark and therefore has no standing to bring the Complaint.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the Respondent has no rights or legitimate interests in respect of the domain name;
- and
- (3) the domain name has been registered and is being used in bad faith.

FINDINGS and LAW

Identical and/or Confusingly Similar Policy ¶ 4(a)(i).

Complainant alleges that it does not have a valid trademark registration for the CLASSIC METAL ROOFS mark. Nevertheless, the Panel decides that Complainant is not required to own a trademark registration for the CLASSIC METAL ROOFS mark in order to establish rights in the mark pursuant to Policy ¶ 4(a)(i). *See British Broad. Corp. v. Renteria*, D2000-0050 (WIPO Mar. 23, 2000) (noting that the Policy "does not distinguish between registered and unregistered trademarks and service marks in the context of abusive registration of domain names" and applying the Policy to

“unregistered trademarks and service marks”); *see also Great Plains Metromall, LLC v. Creach*, FA 97044 (Nat. Arb. Forum May 18, 2001) (“The Policy does not require that a trademark be registered by a governmental authority for such rights to exist.”).

Complainant asserts that it has continuously used the CLASSIC METAL ROOFS mark in connection with roofing products and services since 2004, before Respondent registered the <**classicmetalroofing.com**> domain name on May 27, 2005. Complainant states that it is a member of the Metal Roof Alliance and that it has a five-star rating with ServiceMagic, a service that rates home improvement companies. Complainant also claims that consumers associate the CLASSIC METAL ROOFS mark with Complainant and that the mark has developed “substantial goodwill.” The Panel finds that Complainant has provided sufficient evidence to show the CLASSIC METAL ROOFS mark has acquired secondary meaning in association with Complainant’s roofing products and services, and the Panel holds that Complainant has established common law rights in the mark under Policy ¶ 4(a)(i). *See Enfinger Dev., Inc. v. Montgomery*, FA 370918 (Nat. Arb. Forum Feb. 16, 2005) (finding that the complainant had common law rights in the McMULLEN COVE mark because the complainant provided sufficient evidence that the mark had acquired secondary meaning, including development plans, correspondence with government officials, and newspaper articles featuring the mark); *see also Kahn Dev. Co. v. RealtyPROshop.com*, FA 568350 (Nat. Arb. Forum June 23, 2006) (holding that the complainant’s VILLAGE AT SANDHILL mark acquired secondary meaning among local consumers sufficient to establish common law rights where the complainant had been continuously and extensively promoting a real estate development under the mark for several years).

In addition, Complainant asserts that the <**classicmetalroofing.com**> domain name is confusingly similar to its CLASSIC METAL ROOFS mark because the disputed domain name contains the first two terms of the mark, CLASSIC and METAL, and merely alters the final term of the mark, ROOFS, by omitting “s” and adding “ing.” The Panel finds that such a small alteration does not sufficiently distinguish the <**classicmetalroofing.com**> domain name from Complainant’s mark and thus Respondent’s domain name is confusingly similar to the CLASSIC METAL ROOFS mark pursuant to Policy ¶ 4(a)(i). *See Am. Online, Inc. v. Avrasya Yayincilik Danismanlik Ltd.*, FA 93679 (Nat. Arb. Forum Mar. 16, 2000) (finding that the respondent’s domain name, <americanonline.com>, is confusingly similar to the complainant’s famous AMERICA ONLINE mark); *see also Ty, Inc. v. O.Z. Names*, D2000-0370 (WIPO June 27, 2000) (finding that the domain names <beanybaby.com>, <beaniesbabies.com>, <beanybabies.com> are confusingly similar to the complainant’s mark BEANIE BABIES).

Rights or Legitimate Interests Policy ¶ 4(a)(ii).

The Panel notes that Complainant has the initial burden of making a *prima facie* case that Respondent has no rights or legitimate interests in the <**classicmetalroofing.com**> domain name under Policy ¶ 4(a)(ii), and if Complainant does, the burden then shifts to Respondent to prove that it has rights or legitimate interests. *See Starwood Hotels &*

Resorts Worldwide, Inc. v. Samjo CellTech.Ltd, FA 406512 (Nat. Arb. Forum Mar. 9, 2005) (“Complainant has made a *prima facie* showing that Respondent lacks rights to the Domain Name. The threshold for making such a showing is quite low, since it is difficult to produce evidence to support a negative statement. Here, Complainant has alleged that Respondent does not own any rights in the terms STARWOOD or STARWOODS, and that Respondent’s use of the Domain Name is not a fair one. These unsupported assertions, though sparse, are sufficient to make a *prima facie* showing in regard to the legitimacy element.”).

Complainant maintains that the WHOIS information lists the registrant of the domain name as “Interlock Industries, Ltd.” and that there is no other evidence in the record suggesting that Respondent is commonly known by the <**classicmetalroofing.com**> domain name. Complainant also alleges that it has not authorized or licensed Respondent to register or use a domain name incorporating a variation of Complainant’s CLASSIC METAL ROOFS mark. The Panel agrees that Respondent is not commonly known by the disputed domain name, and the Panel finds that Respondent does not have rights or legitimate interests in the <**classicmetalroofing.com**> domain name pursuant to Policy ¶ 4(c)(ii). *See Ian Schrager Hotels, L.L.C. v. Taylor*, FA 173369 (Nat. Arb. Forum Sept. 25, 2003) (finding that without demonstrable evidence to support the assertion that a respondent is commonly known by a domain name, the assertion must be rejected); *see also Wells Fargo & Co. v. Onlyne Corp. Services11, Inc.*, FA 198969 (Nat. Arb. Forum Nov. 17, 2003) (“Given the WHOIS contact information for the disputed domain [name], one can infer that Respondent, Onlyne Corporate Services11, is not commonly known by the name ‘welsfargo’ in any derivation.”).

Additionally, Complainant asserts that Respondent is a competitor of Complainant and that Respondent’s <**classicmetalroofing.com**> domain name redirects Internet users to Respondent’s <interlockroofing.com> domain name, where Respondent sells metal roofing products and offers installation services. The Panel finds that Respondent is redirecting Internet users searching for Complainant’s metal roofing products and services to Respondent’s competing website at the <interlockroofing.com> domain name for commercial gain and that such diversionary use is not a *bona fide* offering of goods or services pursuant to Policy ¶ 4(c)(i) or a legitimate noncommercial or fair use pursuant to Policy ¶ 4(c)(iii). *See DLJ Long Term Inv. Corp. v. BargainDomainNames.com*, FA 104580 (Nat. Arb. Forum Apr. 9, 2002) (“Respondent is not using the disputed domain name in connection with a bona fide offering of goods and services because Respondent is using the domain name to divert Internet users to <visual.com>, where services that compete with Complainant are advertised.”); *see also Ameritrade Holdings Corp. v. Polanski*, FA 102715 (Nat. Arb. Forum Jan. 11, 2002) (finding that the respondent’s use of the disputed domain name to redirect Internet users to a financial services website, which competed with the complainant, was not a *bona fide* offering of goods or services).

Registration and Use in Bad Faith Policy ¶ 4(a)(iii).

Complainant asserts that Respondent’s use of the <**classicmetalroofing.com**> domain name to redirect Internet users to Respondent’s competing website suggests that

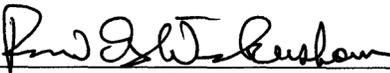
Respondent registered the disputed domain name for the primary purpose of disrupting Complainant's business. The Panel accepts Complainant's assertion and finds that Respondent has registered and used the <classicmetalroofing.com> domain name in bad faith pursuant to Policy ¶ 4(b)(iii) by diverting Internet users to its own website selling competing products and services. *See Surface Prot. Indus., Inc. v. Webposters*, D2000-1613 (WIPO Feb. 5, 2001) (finding that, given the competitive relationship between the complainant and the respondent, the respondent likely registered the contested domain name with the intent to disrupt the complainant's business and create user confusion); *see also EthnicGrocer.com, Inc. v. Latingrocer.com*, FA 94384 (Nat. Arb. Forum July 7, 2000) (finding bad faith where the respondent's sites pass users through to the respondent's competing business).

Moreover, Complainant claims that Respondent is intentionally attempting to attract Internet users seeking Complainant's metal roofing products and services under the CLASSIC METAL ROOFS mark to Respondent's competing website at the <interlockroofing.com> domain name for commercial gain. Complainant alleges that some of its customers have mistakenly reached Respondent's website and became confused as to the affiliation Complainant had with the <classmetalroofing.com> domain name. Based on Complainant's claims, the Panel finds that Respondent is taking advantage of the confusing similarity between the disputed domain name and Complainant's mark in order to profit from the goodwill associated with the CLASSIC METAL ROOFS mark, which constitutes bad faith registration and use pursuant to Policy ¶ 4(b)(iv). *See Identigene, Inc. v. Genetest Labs.*, D2000-1100 (WIPO Nov. 30, 2000) (finding bad faith where the respondent's use of the domain name at issue to resolve to a website where similar services are offered to Internet users is likely to confuse the user into believing that the complainant is the source of or is sponsoring the services offered at the site); *see also MathForum.com, LLC v. Weiguang Huang*, D2000-0743 (WIPO Aug. 17, 2000) (finding bad faith under Policy ¶ 4(b)(iv) where the respondent registered a domain name confusingly similar to the complainant's mark and the domain name was used to host a commercial website that offered similar services offered by the complainant under its mark).

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <classicmetalroofing.com> domain name be **TRANSFERRED** from Respondent to Complainant.



Honorable Richard B. Wickersham
Arbitrator

Richard B. Wickersham, Judge (Ret.), Panelist
Dated: August 1, 2006

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